

Paper No. 57
RFC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 6/30/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Alanis Seafoods, Inc.
v.
La Gloria Foods Corporation

Opposition No. 88,423
to application Serial No. 74/190,011
filed on July 30, 1991

Jon M. Rannells of Baker & Friedman for Alanis Seafoods,
Inc.

Lee New of Thorpe & Thorpe for La Gloria Foods Corporation

Before Cissel, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 30, 1991, applicant, a corporation organized
and existing under the laws of California, applied to
register the mark "LA GLORIA" in typed form for "corn and
flour tortillas and taco shells" in Class 30, based on a
claim of use of the mark since August of 1954 and use in
interstate commerce since January of 1964. Applicant
provided an English translation of the Spanish words "LA
GLORIA" as "THE GLORY." The Patent and Trademark Office

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passed the application to publication, which took place on May 5, 1992.

On July 20, 1992, a timely notice of opposition was filed by Alanis Seafoods, Inc., a Massachusetts corporation. As grounds for the opposition, opposer asserted prior use and registration¹ of the mark "GLORIA" for "canned, bottled, or packaged foods-namely, pickled peppers, olives, mixed garden salad, vinegar, onions, maraschino cherries, fruits, vegetables, fish, and grated cheese" and for "edible olive oil" ; and that applicant's use of "LA GLORIA" in connection with the goods set forth in the application so resembles opposer's mark that it is likely to cause confusion, mistake, or to deceive.

In answer to the notice of opposition, applicant denied the essential allegations of opposer and asserted, as an affirmative defense, that opposer is barred from objecting to registration of applicant's mark by the doctrine of laches in view of applicant's thirty-eight years of use of "LA GLORIA" on its products.

A trial was conducted in accordance with the Trademark Rules of Practice. The testimony of Maria Vera, applicant's vice president, was taken, and both parties filed notices of

¹ Reg. No. 851,541, issued on June 25, 1968, and renewed for 20 additional years on June 25, 1988. Reg. No. 1,250,570, issued September 6, 1983; affidavits under Sections 8 and 15 filed. Both of these registrations are owned by opposer by virtue of assignments from the original owner of them.

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reliance with respect to each other's responses to certain of the interrogatories and requests for admission.

Additionally, opposer relied on several excerpts from printed publications. Briefs were filed by both parties, but an oral hearing before the Board was not requested.

In its appeal brief, opposer moved to strike a number of opposer's responses to applicant's interrogatories and requests for admission upon which applicant had relied by means of its first two notices of reliance. The discovery responses to which opposer objects relate to the actual form in which opposer's mark is used, the natures of the actual products on which the marks are used, and the actual trade channels and geographic areas of distribution for opposer's goods. Opposer argues that these facts are irrelevant and immaterial to the issues before the Board in this proceeding, and that the relied-upon responses should therefore be stricken.

Opposer's motion to strike is denied. The responses to which opposer objects, however, have very little probative value on the pleaded issues in the case. The drawings in both the application and opposer's registrations show the words in typed form, without any special form or design elements. The actual forms in which opposer and applicant present the words "GLORIA" and "LA GLORIA," respectively, are therefore not relevant to resolution of the issue of

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likelihood of confusion. In a similar sense, the Board must consider only the goods set forth in applicant's application and the registrations of opposer, respectively, without additions, deletions, limitations, restrictions, or qualifications as to channels of trade or customers which are not specifically reflected therein. For example, what actually happens in the particular marketplaces where the goods of the parties are sold, that applicant sells primarily to restaurants catering to Mexican Americans in the Los Angeles area, whereas opposer sells largely Greek and Italian food products in the Northeast region of the United States, is irrelevant to our inquiry. Opposer's registration must be accorded nationwide protection, and applicant seeks the same for its mark.

Accordingly, although opposer's motion to strike its responses to applicant's interrogatories and requests for admissions is denied, these responses do not help establish applicant's case.

In a similar sense, we also deny opposer's motion to strike certain portions of the testimony of Ms. Vera to which opposer had timely objected. Even if Ms. Vera's statements about the nature of her customers and their use of her company's products were not hearsay, for applicant to make distinctions based on the natures of the actual goods on which the marks are used, the design elements with which

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they marks are actually being used, the trade channels through which the goods actually move and the customers who actually purchase them is pointless. Such facts are of little probative value in this case because the marks in the application and the pleaded registrations are shown in typed form, without design elements, and the goods specified therein are not limited or restricted in the ways applicant argues they are in the actual markets where the products are sold under the parties' marks. Just as we deny opposer's motion to strike opposer's discovery responses, we also deny opposer's motion to strike Ms. Vera's testimony, but we note that it has little probative value for applicant because the testimony is largely related to facts which are irrelevant to the issues at hand.

After careful consideration of the facts before us and the relevant law on the issue of likelihood of confusion, we hold that applicant is not entitled to the registration it seeks. In view of its pleaded registrations, opposer has priority, and confusion is likely because the marks of the parties are very similar and the food products listed in the application and in opposer's registrations are closely related, complementary goods. Under these circumstances, the ordinary consumers to whom such grocery store items are commonly sold are likely to assume that a single source is responsible for both.

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As noted above, priority is not an issue in view of opposer's unchallenged registrations of the mark "GLORIA." King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Turning, then, to the marks, as we noted above, "GLORIA" is very similar to "LA GLORIA." The addition of the Spanish equivalent of the feminine definite article, "LA," to opposer's mark, "GLORIA," does little to distinguish applicant's mark from opposer's. Opposer notes that in *In re Hub Distributing, Inc.*, 218 USPQ 284, 285(f.n.1)(TTAB 1983), the Board recognized that "...use of the Spanish article does not require a 'the' in the equivalent English term." Applicant's mark may therefore be translated as either "the glory" or simply "glory." The marks of applicant and opposer are therefore either identical or virtually identical.

Several well recognized principles lead us to conclude that the use of these very similar marks on the goods set forth in the application and the pleaded registrations, respectively, is likely to cause confusion. Although the products in question are not identical, it is well settled that in order for confusion to be likely, they do not have to be. It is sufficient if they are related in some manner and their character or the circumstances surrounding their marketing are such that they would likely be encountered by

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the same people under circumstances that would give rise to the mistaken belief that the producer was the same for both. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). It is important to note, as we did above in connection with opposer's motions to strike, that our concern is not extended to all the products with which either party may actually be using its marks. Rather, we must restrict our consideration to the specific products listed in the respective application and registrations, without reading into them any limitations not reflected therein. Toys "R" Us, Inc. v. Lamps R Us, 219 USPQ 340, (TTAB 1983), and cases cited therein. Further along the same line, in the absence of restrictions in the respective identifications of the goods in the application and the pleaded registrations, we must assume that the products move through all the normal and usual trade channels for goods of the type identified. Fort Howard Paper Company v. Marchal Paper Mills, Inc., 189 USPQ 305 (TTAB 1975); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

When these principles are considered in light of the evidence presented by opposer which shows that many of the food items identified in the opposed application, such as peppers, olives, mixed garden salad, onions, vegetables, fish and grated cheese, are used as ingredients, along with taco shells and corn and flour tortillas, to make tacos,

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enchiladas and tostados, we are presented with a factual basis for concluding that confusion is likely. A consumer purchasing applicant's "LA GLORIA" brand tortillas or taco shells might also buy opposer's "GLORIA" brand peppers, olives, mixed green salad ingredients, onions, vegetables, fish and/or grated cheese to make enchiladas, tostados or tacos. Such an ordinary consumer is likely to assume that one business is the source of all these products because of the related natures of them and the similarity of the marks used on them. Opposer, at p.9 of its brief, cites a number of prior decisions wherein confusion was found likely when similar marks were used in connection with food products which were specifically different, but which could be sold to the same class of purchasers for complementary use.

The instant case presents similar circumstances. Here, applicant has admitted that the goods of the parties may be used together to make particular food items. In addition, opposer made of record cookbook excerpts which establish this fact independent of applicant's admission.

That there is no evidence of actual confusion in this case is easily explained by the fact that, at least at this juncture, these marks are used on the opposite sides of the country. Under these circumstances, it is not hard to understand why confusion has not yet occurred. There has simply been no opportunity for it to have taken place.

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Moreover, even though confusion in the marketplace would not be likely to occur if the parties were to maintain their current marketing practices, using different design elements as parts of their marks and selling their goods in different packaging to different customers in geographically remote areas of the country, as we noted above, our decision on this issue must be made on the unrestricted and unlimited identifications of goods with which the application and registrations here present us, and the usual trade channels in which these kinds of products ordinarily travel.

If we were left with any doubt that confusion is likely, (and we are not), it is important to remember that any such doubt would necessarily be resolved against applicant and in favor of opposer as the prior user. In re Apparel, Inc. 578 F.2d 308, 151 USPQ 353 (CCPA 1966).

In conclusion, we note that applicant cannot successfully defend this opposition proceeding by asserting the equitable defense of laches. Applicant did not present either evidence or argument on this pleaded defense, so there has been no showing of detrimental reliance on opposer's inaction, but even if applicant had demonstrated a basis for claiming that opposer had slept on its rights, the law is clear that laches has no application in an opposition such as this, where this proceeding is the first time opposer has had the opportunity to make the claim that

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applicant is not entitled to registration of its mark. See: National Cable Television Association v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

In summary, confusion is likely in the instant case because applicant's mark is virtually the same as opposer's mark, and the goods of the parties, as specified in the application and registrations, respectively, are complementary food products which move through the same channels of trade to the same purchasers. Accordingly, the opposition is sustained and registration to applicant is refused.

R. F. Cissel

E. W. Hanak

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board

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