

Hearing:

September 26, 1997

THIS DISPOSITION IS NOT

CITABLE AS PRECEDENT OF THE TTAB

Paper No. 44

HANAK/MD/LB

JUNE 5, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rudolf Wild GmbH & Co. KG

v.

1 Uno Espresso, Inc., d/b/a Orlandi Specialty Foods and
d/b/a Caffe Mauro

Opposition No. 93,813
to application Serial No. 74/320,679
filed on October 6, 1992

Brendan J. O'Rourke of Paul, Hastings, Janofsky & Walker LLP
for Rudolf Wild GmbH & Co. KG.

Patrick Michael Dwyer of Dwyer Marquardt PLLC for 1 Uno
Espresso, Inc., d/b/a Orlandi Specialty Foods and d/b/a
Caffe Mauro.

Before Seeherman, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

1 Uno Espresso, Inc. d/b/a Orlandi Specialty Foods and
d/b/a Caffe Mauro (applicant) seeks registration of CAPRI in
typed capital letters for "whole and ground coffee beans,
espresso and other coffee beverages." The application was

Opposition No. 93,813

filed on October 6, 1992 with a claimed first use date of July 24, 1991.

Rudolf Wild GmbH & Co. KG (opposer) filed a notice of opposition on February 23, 1994 alleging that prior to July 24, 1991, opposer had both registered and, through a licensee, "used the trademark CAPRI SUN in connection with fruit drinks." (Notice of opposition paragraphs 2 and 4). Furthermore, opposer alleged that it owned a "CAPRI SUN family of marks." (Notice of opposition paragraphs 5, 11, 12 and 13). Finally, opposer alleged that "applicant's mark CAPRI consists of and comprises a mark which so resembles [petitioner's] aforesaid CAPRI SUN family of marks which are registered in the U.S. Patent and Trademark Office, as to be likely, when used on or in connection with goods of applicant, to cause confusion, or to cause mistake, or to deceive." (Notice of opposition paragraph 14). Subsequently, opposer realized that its original notice of opposition was not accompanied by a duplicate copy for service on applicant, and on March 15, 1994 opposer filed a second notice of opposition (duplicating the first) which this Board in an order dated June 28, 1994 characterized as an "amended notice of opposition." Thereafter, applicant filed a timely answer which denied the essential allegations of the notice of opposition.

Opposition No. 93,813

Opposer's evidence in this case includes the testimony depositions with exhibits of Kent Wilson (a brand manager at Kraft Foods) and Monica Griesdorn (a senior brand manager at Kraft Foods). In addition, opposer has properly made of record by means of a notice of reliance dated August 15, 1995 certified status and title copies of seven registrations in the name of opposer. They are:

- (1) Registration No. 1,130,086 for CARPI-SUN for "fruit drinks containing water and orange juice";
- (2) Registration No. 1,187,978 for CAPRI SUN NATURAL FRUIT DRINK APPLE and design for "fruit drinks containing water and apple juice";
- (3) Registration No. 1,279,154 for CAPRI SUN FRUIT PUNCH and design for "fruit juice drinks containing water";
- (4) Registration No. 1,287,165 for CAPRI SUN GRAPE DRINK and design for "fruit drink containing water and grape juices";
- (5) Registration No. 1,303,000 for CAPRI SUN and design for "fruit drink containing lemon juice and water";
- (6) Registration No. 1,567,441 for CAPRI SUN MAUI PUNCH and design for "non-alcoholic fruit juice drink";
- and (7) Registration No. 1,660,010 for CAPRI SUN and design for "fruit drink containing juice and water." By the same notice of reliance, opposer also made of record an eighth registration, namely, Registration No. 1,199,783 for CAPRI SUN NATURAL FRUIT DRINK ORANGE and design. However, the owner of that registration is not opposer but rather Zick-

Opposition No. 93,813

Zack-Werk Rudolf Wild. Likewise, in its "amended notice of opposition" dated March 15, 1994, opposer attached certified status and title copies not only of the foregoing eight registrations, but also a ninth registration, namely, Registration No. 1,545,561 for CAPRI SUN 100% NATURAL for "natural fruit drinks containing water." This ninth registration is in the name of opposer. We note that with regard to this ninth registration, a Section 8 affidavit was due on June 27, 1995, and that this ninth registration was not included in opposer's notice of reliance dated August 15, 1995. A check of PTO records revealed that it was canceled for failure to file a Section 8 affidavit.

Applicant's evidence includes the testimony depositions with exhibits of Mauro Cipolla and Mario Cipolla, son and father owners of applicant. In addition, by means of a notice of reliance dated October 13, 1995, applicant properly made of record third-party United States trademark registrations and applications for various marks containing the letters CAPRI. We use the term "letters" because in certain of the marks the letters stand apart as the word CAPRI and in other marks the letters are part of another word (e.g. CAPRICE).

Opposer's prior counsel (not current counsel) failed to file opposer's initial brief when due. Applicant filed its brief in timely fashion. Because of certain actions and

Opposition No. 93,813

inactions on the part of opposer's prior counsel, this Board took the following action in an order dated May 24, 1996:

"Applicant's request for sanctions in the form of dismissal is denied but opposer is hereby sanctioned by being precluded from filing any brief on the case, including a reply to applicant's brief, which is already of record ... The parties are allowed until 30 days from the mailing of this order to file their requests, if any, for oral argument."

Opposer sought reconsideration of the Board's order of May 24, 1996, which was denied in a detailed opinion of this Board dated December 9, 1996. Prior to that decision, opposer's prior counsel requested an oral argument which was held before this Board on September 26, 1997. In attendance at the oral argument were applicant's counsel and opposer's current counsel. At the oral argument, this Board permitted opposer's current counsel to submit an "Index of Opposer's Cases." This index consists of photocopies of thirty-one reported Court and Board decisions relied upon by opposer at the oral argument. In addition, opposer's current counsel was permitted to hand to the judges at the oral argument copies of exhibits which opposer had made of record during the depositions of Mr. Wilson and Ms. Griesdorn. Opposer's current counsel also submitted at the oral hearing other "exhibits" which were not part of the record, but which instead opposer had specially prepared for the hearing.

Opposition No. 93,813

While the Board judges saw these latter "exhibits," they were not considered in reaching our decision. However, what was considered was all of opposer's evidence and, to the extent helpful, the "Index of Opposer's Cases." This index, coupled with the oral comments of opposer's current counsel, essentially constituted a full presentation of opposer's arguments.

Turning to a consideration of opposer's evidence, we note at the outset that opposer has not made of record any trademark license agreement or any other agreement between opposer and Kraft Foods showing that the activities of Kraft Foods in selling CAPRI SUN products in the United States inure to the benefit of opposer. Both of opposer's witnesses (Mr. Wilson and Ms. Griesdorn) testified that they were employees of Kraft Foods. Mr. Wilson stated that he was the brand manager for "the CAPRI SUN brand." (Wilson dep. 6). Ms. Griesdorn testified that she was the senior brand manager for Kraft Foods in the ready-to-drink area and that this area included such brands as CAPRI SUN, KOOL-AID BURSTS and MR. FREEZE. (Griesdorn dep. 5). However, the testimony of both witnesses was extremely vague as to the relationship, if any, between opposer and Kraft Foods. This vagueness is demonstrated by the following question and answer series which took place between opposer's prior

counsel and Ms. Griesdorn at pages 9 and 10 of her deposition:

Q. Is it fair to say that you have spent your career at Kraft in the beverage field?

A. Yes.

Q. Are you familiar with a company called Capri Sun, Inc.?

A. Yes.

Q. And what is that company?

A. It's the company that allows us in the United States to have the sole right to distribute Capri Sun products through, I believe, a licensing agreement.

Q. And with whom would that licensing agreement be?

A. Wild Corporation.

Q. Would that be Rudolf Wild --

A. Yes.

Q. -- Company?

Is Capri Sun, Inc. related to General Foods -- I'm sorry, to Kraft Foods in any way that you're familiar with?

A. Not positive.

We are somewhat constrained in describing the vagueness of Mr. Wilson's testimony regarding the relationship, if any, between opposer and Kraft Foods inasmuch as that portion of his deposition (pages 20-23) was designated as confidential by opposer's prior counsel. However, suffice it to say that Mr. Wilson -- who testified the he was the brand manager for

Opposition No. 93,813

only one product at Kraft Foods, namely, CAPRI SUN -- conceded that he was not even familiar with a company known as Capri Sun, Inc. (Wilson dep. 22, line 11 to 23, line 8).

Because of the absence of any agreement between opposer and Kraft Foods, and because of the vagueness of the testimony of Mr. Wilson and Ms. Griesdon as to the relationship, if any, between opposer and Kraft Foods, we simply cannot assume that the activities of Kraft Foods in selling and advertising CAPRI SUN products in the United States inured to the benefit of opposer. This determination affects the opposer in one crucial respect, namely, in that opposer has offered no evidence to support its contention, as articulated by opposer's current counsel at the oral hearing, that opposer's mark CAPRI SUN is famous in the United States. Obviously, opposer's registrations of CAPRI SUN in various forms for various fruit juice drinks do not constitute evidence that the mark CAPRI SUN is famous in the United States (or elsewhere). Nevertheless, in the event this determination is found in error on appeal, we will consider at the conclusion of this opinion opposer's claim that its mark CAPRI SUN is famous in the United States under the assumption that the sales and advertising of CAPRI SUN products in the United States by Kraft Foods inured to opposer's benefit.

Opposition No. 93,813

Turning to the merits of the case, we note that there is no dispute that priority rests with opposer because opposer properly made of record its aforementioned registrations for CAPRI SUN. Thus, the only issue before this Board is whether there exists a likelihood of confusion resulting from the contemporaneous use of opposer's CAPRI SUN mark for juice drink beverages and applicant's CAPRI mark for whole and ground coffee beans, espresso and other coffee beverages. To be perfectly clear, as previously noted, opposer alleged in its notice of opposition (and "amended notice of opposition") that it owned a "CAPRI SUN family of marks." Moreover, as previously noted, opposer has made of record seven existing registrations, each of which depicts the words CAPRI SUN (or CAPRI-SUN) in a prominent fashion, six times with other wording and/or designs and one time by itself. However, opposer has totally failed to establish that it owns a family of CAPRI SUN marks. Opposer has made of record no evidence showing that it has advertised, promoted or even displayed its various CAPRI SUN marks together. However, as a practical matter, this failure of proof is of little consequence. All of opposer's registered marks have as their most prominent feature the words CAPRI SUN. The other wording -- such as grape drink, fruit punch etc. -- is almost exclusively generic and has quite properly been disclaimed. Moreover,

Opposition No. 93,813

the design feature common to five of opposer's registered marks (pictured below) in no way serves to make any of opposer's marks more similar to applicant's mark.

Indeed, said design feature only serves to make certain of opposer's CAPRI SUN registered marks more dissimilar from applicant's mark. Finally, we note that in the depositions of Mr. Wilson and Ms. Griesdorn, there was no discussion whatsoever of opposer's various registered marks other than the mark CAPRI SUN per se. Moreover, when sales and advertising figures were given by Mr. Wilson for CAPRI SUN juice drink beverages, these figures lumped all twelve current flavors of CAPRI SUN juice drink beverages together. Hence, in our likelihood of confusion analysis, we will focus solely on a comparison of the marks CAPRI SUN for juice drink beverages and CAPRI for whole and ground beans, espresso and other coffee beverages.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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.").

Opposer's product and applicant's products share essentially only two common characteristics: (1) Both are beverages (or can be made into beverages); and (2) both can be purchased in grocery stores and supermarkets.

Opposer's CAPRI SUN product was characterized by Mr. Wilson as "a juice drink beverage; meaning it has some juice in it but it's not a hundred percent juice." (Wilson dep. 12). Of course, opposer has also made of record various registrations containing the words CAPRI SUN. In these registrations, the products are variously described as fruit drinks containing water and orange juice; fruit drinks containing water and apple juice; fruit juice drinks containing water; fruit drink containing water and grape juices; fruit drink containing lemon juice and water; non-alcoholic fruit juice drink; and fruit drink containing juice and water. Thus, despite the varying verbiage, Mr. Wilson's description of CAPRI SUN as a juice drink beverage having some fruit juice is an accurate description which essentially covers all of the products variously described in opposer's different registrations. Mr. Wilson went on to note that Kraft Foods markets CAPRI SUN juice drink beverages in twelve flavors, and that CAPRI SUN juice drink

beverages are packaged in single serving pouches which are typically sold in ten packs. (Wilson dep. 12). Mr. Wilson stated that Kraft Foods markets CARPI SUN juice drink beverages to children, primarily through television in what Mr. Wilson termed "a kid buy." (Wilson dep. 17 and 26). Mr. Wilson explained that "a kid buy is where you're going to advertise on television programs whose target audience is from between the ages of 4 and -- 4 and 11." (Wilson dep. 26). Mr. Wilson further explained that television advertising for CAPRI SUN juice drink beverages also included "a teen buy" for children between the ages of 9 and 14. (Wilson dep. 26). Mr. Wilson testified that approximately 80% of CAPRI SUN products are consumed by "school age children," with the remaining 20% being consumed by adults. (Wilson dep. 27). When asked who were the typical purchasers of CAPRI SUN products, Mr. Wilson replied as follows: "I'd say mothers typically purchase CAPRI SUN products." (Wilson dep. 27).

In contrast, the record demonstrates that applicant's CAPRI whole and ground coffee beans, espresso and other coffee beverages are marketed exclusively to and consumed exclusively by adults. In addition, applicant's primary manager (Mauro Cipolla) testified that in its advertising, applicant never pictured children, and never utilized cartoon characters or animation of any type. (Mauro Cipolla

dep. 28-29). The one television ad for CAPRI SUN juice drink beverages made of record by opposer uses animation and prominently features children promoting the product.

(Opposer's exhibit 4).

Moreover, the record reflects that juice drink beverages, on the one hand, and coffee beans, espresso and other coffee beverages, on the other hand, are sold in different sections of grocery stores. Ms. Griesdorn -- the senior brand manager at Kraft Foods responsible for CAPRI SUN products and other ready-to-drink products -- testified that in a grocery store or supermarket, one would "most often find CAPRI SUN located in the juice/juice drink aisle, shelf-stable aisle." (Griesdorn dep. 11). When asked to name some products that would be sold adjacent to CAPRI SUN products in grocery stores and supermarkets, Ms. Griesdorn answered as follows: "HAWAIIAN PUNCH, HI-C, OCEAN SPRAY, MINUTE MAID." (Griesdorn dep. 12). Opposer put on absolutely no evidence demonstrating that juice drink beverages such as CAPRI SUN are sold anywhere near coffee beans, espresso and other coffee beverages in grocery stores and supermarkets. Moreover, the record demonstrates that juice drink beverages and coffee beans are sold in totally different types of packaging. Likewise, juice drink beverages and espresso and other coffee beverages are sold in different packaging. Although Ms. Griesdorn did identify

two brands of "single serve iced coffee beverages" which came in cans (Griesdorn dep. 17, opposer's exhibit 7), there was absolutely no testimony demonstrating the extent to which coffee is served in ready-to-drink form in cans or other containers in United States grocery stores and supermarkets. Indeed, Ms. Griesdorn did not even testify that the two products pictured in opposer's exhibit 7 (cans of ready-to-drink iced coffee) were products which were sold in the United States. Moreover, when Mr. Mauro Cipolla was cross-examined by former counsel for opposer, he stated that he had never seen ready-to-drink canned or bottled coffees, although he had a vague recollection of one company's possible venture into that area. (Mauro Cipolla dep. 64).

In sum, we find that the only two things common to both opposer's products (as described in its registrations) and applicant's products (as described in its application) are that both are beverages (or can be made into beverages) and both are sold in supermarkets and grocery stores. However, in all other respects, the products are different. They are sold in different sections of grocery stores and supermarkets; they are primarily advertised and marketed to entirely different age groups; and they come in different packaging in that there is no evidence that in the United States, espresso and other coffee products are typically

sold in supermarkets and grocery stores in ready-to-drink form as are juice drink beverages.

Turning to a consideration of the marks, they are, obviously, somewhat similar in terms of visual appearance and pronunciation. Both marks consist of or contain the word CAPRI. However, the word "capri" is not an arbitrary word. Rather, it is the name of a famous island in the Bay of Naples and the name for a pale dry wine originally made on that island. Websters Third New International Dictionary Unabridged (1976). Hence, it is not surprising that the word CAPRI has been used as a mark by others (e.g. CAPRI automobiles, CAPRI boats etc.). (Mauro Cipolla dep. 14; Mario Cipolla dep. 13-14). As previously mentioned, applicant properly made of record third-party registrations featuring marks consisting of or containing CAPRI. These registrations do not, of course, show that the various CAPRI marks are in actual use. However, these registrations, whether active or canceled, serve to show others have viewed CAPRI as a positive word for use as a mark for various foods and beverages. These third-party registrations include CAPRI for cookies; CAFÉ CAPRI for flavored instant coffee (canceled) and PIZZA CAPRI for pizza and related food items.

Considering the two marks in terms of meaning or connotation, we find that their connotations are clearly different, especially when the connotations are considered

Opposition No. 93,813

in connection with the products on which the marks are used. Applicant's mark CAPRI -- especially when used in conjunction with whole and ground coffee beans, espresso and other coffee beverages -- would bring to mind the Italian island of Capri. Mr. Mauro Cipolla noted that there was a distinction between "regular American coffees" and "espresso blends." (Mauro Cipolla dep. 18). We find that the use of the mark CAPRI on coffee products would suggest to consumers that said products are of European or Italian style. In this regard, we note that when applicant uses its mark CAPRI, said mark is followed by the following terminology: "Southern Italian Blend Espresso." Moreover, the packaging for applicant's CAPRI espresso contains the following statement: "Fresh Roasted in Seattle in the finest of Italian Traditions."

On the other hand, there is no evidence whatsoever that with regard to juice drink beverages, there is any distinction between American juice drink beverages and juice drink beverages from other parts of the world, including specifically Europe or Italy. It is our view that the typical purchasers of opposer's CAPRI SUN juice drink beverages, which according to Mr. Wilson are mothers, would recognize the SUN portion of said mark as reinforcing the notion that the product does indeed contain some fruit juices and hence is a healthy beverage for their children.

Moreover, we note that on the packaging for many flavors of CAPRI SUN juice drink beverages, there appears in rather prominent fashion a depiction of the sun. (Opposer's exhibit 1).

The differences in connotation between CAPRI for coffee products and CAPRI SUN for juice drink beverages simply outweigh the modest similarities between the two marks in terms of visual appearance and pronunciation. In a similar case, the Court noted the difference in connotation and held that there was no likelihood of confusion resulting from the use of DUVET on brandy and DUET on canned cocktails made with brandy despite the fact that DUVET and DUET differ only by the presence of an additional letter in the middle of DUVET. National Distillers Corp. v. William Grant & Son, Inc., 505 F.2d 719, 184 USPQ 34, 35 (CCPA 1974). With regard to the visual appearance and pronunciation of DUET and DUVET, the Court stated that "the similarities are obvious but so are the differences." 184 USPQ at 35. If anything, CAPRI and CAPRI SUN are more dissimilar in visual appearance (and perhaps pronunciation) than are DUET and DUVET. Of course, it need hardly be said that coffee products and juice drink beverages are more dissimilar than are cocktails made with brandy and brandy itself.

In sum, given the significant differences between coffee products and juice drink beverages, we find that the

limited similarities in the marks CAPRI and CAPRI SUN are simply not great enough so as to result in a likelihood of confusion. Indeed, coffee products and juice drink beverages are so dissimilar that opposer was not able to name even one company which marketed both products under the same mark.

We will now consider opposer's argument that its mark CAPRI SUN is famous in the United States on the assumption that the sales and advertising of CAPRI SUN products by Kraft Foods inured to opposer's benefit. We will also consider applicant's argument that despite over five of years of contemporaneous use, there have been no instances of actual confusion involving CAPRI SUN juice drink beverages and CAPRI coffee products.

Opposer made of record approximate sales figures (in terms of dollars and units) and advertising figures of CAPRI SUN products (all flavors) marketed by Kraft Foods in the United States for the years 1989 through 1995. (Opposer's exhibit 6). We are not at liberty to reveal these figures inasmuch as prior counsel for opposer submitted them under a protective order. However, simply standing alone, the United States sales and advertising figures for the CAPRI SUN products are not so great so as to cause this Board to find that CAPRI SUN is a famous mark. Moreover, opposer has failed to put the sales and

advertising figures for CAPRI SUN products in perspective by comparing them to sales and advertising figures for similar products. To be perfectly clear, Ms. Griesdorn testified at pages 12 and 13 of her deposition that CAPRI SUN outsold certain other brands. However, Ms. Griesdorn's testimony was limited to a comparison of the sales of CAPRI SUN in boxes (i.e. pouches) verses the sales of other brands in boxes. Both Mr. Wilson and Ms. Griesdorn testified that CAPRI SUN is available only in boxes (pouches). Ms. Griesdorn further testified that many of the other brands she selected for comparison purposes were sold in other forms, such as liquid concentrate, bottles, cans and large jugs. (Griesdorn dep. 12-13). Ms. Griesdorn never testified that the total sales of CAPRI SUN products exceeded the total sales of any other brand when all forms of packaging were considered. Indeed, even when she focused on sales of products solely in boxes (pouches), Ms. Griesdorn testified that she did not know whether CAPRI SUN outsold HI-C. (Griesdorn dep. 12).

If a party plaintiff in a Board proceeding is to rely simply on sales and advertising figures in an effort to establish that its mark is famous, then it is incumbent upon that party plaintiff to place the sales and advertising figures in some context, that is, to show that the product is the leading product in its category, the second leading

product in its category, etc. Raw sales and advertising figures -- unless they are extraordinarily large, which is not the case with CAPRI SUN products -- are simply not sufficient by themselves to establish that the mark is famous. If a party plaintiff wishes to establish that its mark is famous and further wishes to rely simply upon its sales and advertising figures, it should, at a minimum, place such figures in context by showing the ranking of its product. See General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1277 (TTAB 1992). Of course, the better practice is not to rely merely upon sales and advertising figures, but also to submit consumer and trade testimony as well as newspaper and magazine articles discussing the brand in question. In this case, opposer has done none of the foregoing or anything else to show that its CAPRI SUN mark is famous. Hence, in finding that there exists no likelihood of confusion, we have done so on the basis that opposer has utterly failed to prove that its mark CAPRI SUN is famous, even assuming that the activities of Kraft Foods in marketing CAPRI SUN products in the United States inured to opposer's benefit. We will not speculate whether our decision would have been different had opposer established that its mark was famous in the United States.

We consider next applicant's argument that there have been no known instances of actual confusion involving CAPRI

Opposition No. 93,813

coffee products and CAPRI SUN juice drink beverages. Both of applicant's witnesses stated that they knew of no instances of actual confusion, and that if instances of actual confusion had existed, they would have been reported to one or both of the witnesses. Moreover, opposer has offered no evidence even suggesting that there have been instances of actual confusion. Furthermore, Mr. Mauro Cipolla testified that CAPRI was applicant's most popular brand, and that sales of CAPRI coffee products were made across the country. (Mauro Cipolla dep. 18-19). Without divulging the precise sales figures for CAPRI coffee products, suffice it to say that they are by no means minimal. In finding no likelihood of confusion resulting from the contemporaneous use of a red stripe design on champagne and a red stripe design and the words RED STRIPE on beer, the Court noted "that despite over a decade of the marketing by [applicant] of Red Stripe beer in certain of these United States, [opposer] was unable to offer any evidence of actual confusion. This too weighs against a holding of a likelihood of confusion." G.H. Mumm v. Desnoes, 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990). Of course, in this case, the period of contemporaneous use was not over a decade, but closer to five years. Accordingly, in reaching our conclusion that there is no likelihood of confusion, we have accorded very

Opposition No. 93,813

minimal weight to the fact that there has been no evidence of actual confusion. In any event, given the significant differences in the products of opposer and applicant and the differences in the marks, we would find that there is no likelihood of confusion even in the absence of evidence showing that no actual confusion has occurred.

Decision: The opposition is dismissed.

E. W. Hanak
Administrative Trademark Judge,
Trademark Trial and Appeal Board

E. J. Seeherman and T. J. Quinn, Administrative Trademark Judges, concurring:

We are in agreement with our colleague's ultimate conclusion on the merits of the likelihood of confusion issue in this case. We are compelled, however, to comment on what we view as an inappropriate proffer at the oral hearing.

As recounted in our colleague's opinion, opposer, due to certain actions and inactions of prior counsel, was sanctioned in this case by being precluded from filing any final brief or any reply brief. Opposer's current counsel who appeared at the oral hearing was allowed to submit to the judges copies of exhibits which opposer had properly

introduced during the trial phase of this proceeding. Opposer's current counsel also attempted to offer at the hearing other "exhibits" which were not part of the trial record, but which instead opposer had prepared expressly for use at the hearing.

Although these latter "exhibits" were not considered in reaching our decision, one of the "exhibits" produced at the oral hearing deserves particular mention. Counsel produced a photograph of a mock-up of opposer's unusual foil pouch container but with applicant's mark appearing thereon.¹ Only after showing this photograph to the Board did opposer's counsel acknowledge that the photograph was not of record.

The Board will generally allow certain types of materials, such as graphs, schedules, or charts, to be used at the oral hearing, either for clarification or to eliminate the need for extended description, when such materials are based on evidence properly of record. *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126-27 at n. 5 (TTAB 1990); and *Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, § 802.07. For example, opposer at the oral hearing in this case used a summary of its pleaded registrations which also were properly introduced at

¹ In point of fact, the container shape is the subject of opposer's Registration No. 1,418,517, issued under Section 2(f),

for "fruit juice drinks containing water." No mention of this fact was made at the oral hearing.

trial. This is the type of demonstrative exhibit contemplated by the case law and the *TBMP*.

We find, however, that the mock-up photograph, which was never made of record but rather was prepared expressly for the oral hearing, to be an extreme example of matter that is inappropriate for use at an oral hearing before the Board. Demonstrative exhibits that are displayed at an oral hearing, when the exhibits are based on evidence of record, can be of aid to the Board in its consideration of a case. To the contrary, when an "exhibit" is not based on evidence properly of record, as is the case here with the photograph of the mock-up showing applicant's mark on opposer's container, the shape of which is a registered trademark, there is no useful purpose served by its use inasmuch as the Board cannot consider the "exhibit."² We can presume only that the proffer of such materials not of record, but which instead were prepared specially for use at an oral hearing, is made with the hope of somehow subliminally affecting the Board's thinking in a case.

² So as to be clear, we also should point out that there is no evidence to suggest that coffee beverages are being sold in any foil pouch containers, let alone in the foil pouch container used by and registered as a trademark by opposer.

Opposition No. 93,813

The Board disapproves of, and discourages, the use of such materials in future oral hearings.

E. J. Seeherman

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