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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB NOV. 23,99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Miguel Torres, S.A.  
v.  
Advantage Wine Group

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Opposition No. 101,101  
to application Serial No. 74/600,257  
filed on November 17, 1994

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Robert G. McMorrow of Sughrue, Mion, Zinn, McPeak & Seas for  
Miguel Torres, S.A.

Thomas F. Smegal, Jr. of Knobbe, Martens, Olson & Bear,  
L.L.P. for Advantage Wine Group.

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Before Hanak, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Advantage Wine Group (applicant) seeks to register DONA  
SOL in typed drawing form for wine. The application was  
filed on November 17, 1994 with a claimed first use date of  
December 23, 1993. At the request of the Examining  
Attorney, applicant indicated that the English translation  
of DONA SOL is "lady sun."

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Miguel Torres, S.A. (opposer) filed a notice of opposition alleging that prior to 1993 it both used and registered the trademarks VIÑA SOL and GRAN VIÑA SOL for wine. Opposer alleged that "the trademark of the opposed application is confusingly and deceptively similar to opposer's previously used and registered trademarks as applied to the products of the parties." (Notice of opposition paragraph 9). Finally, opposer alleged that "registration of the mark of the opposed application is barred by the provisions of Section 2(d) of the Trademark Act of 1946." (Notice of opposition paragraph 11).

Applicant filed an answer which denied the pertinent allegations of the notice of opposition. Applicant also set forth three affirmative defenses. However, in its brief applicant did not discuss these affirmative defenses. Accordingly, we have given no consideration to them.

Both parties filed briefs and were present at a hearing held on April 13, 1999.

The record in this case includes the depositions (with exhibits) of Luis De Javier (the manager of opposer's legal department) and Gary A. Ramona (the owner of applicant). Opposer properly made of record certified status and title copies of its United States registrations for the three marks depicted below (Registration Numbers 785,330; 1,349,893; and 1,358,372). The goods of each registration

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are wine. In Registration Numbers 1,349,893 and 1,358,372 registrant disclaimed the exclusive right to use VIÑA apart from the mark as shown. In addition, registrant explained that VIÑA SOL could be translated into English as "sun vineyard" or "vineyard of the sun." Registrant stated that GRAN VIÑA SOL could be translated as "great sun vineyard."

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Because opposer properly made of record the above registrations, priority rests with opposer. King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). As the parties agree, the sole issue in this proceeding is whether the contemporaneous use of applicant's mark and opposer's marks on wine is likely to result in confusion, mistake or deception. (Opposer's brief page 4; applicant's brief page 3). Obviously, of all of opposer's three marks, opposer's mark VIÑA SOL is most similar to applicant's mark DONA SOL. Indeed, on a number of occasions in its brief, opposer focuses solely on a comparison of the marks VIÑA SOL and DONA SOL. See opposer's brief pages 7 and 8.

In our likelihood of confusion analysis, we have considered all of the relevant DuPont factors. Because the goods of the parties (wine) are legally identical, a number of DuPont factors favor opposer. Obviously, with identical goods, there will be identical channels of trade and identical types of purchasers. Moreover, because the registrations and application list simply "wine" and not "expensive wine," we find that these common purchasers would exercise just an ordinary degree of care in making their purchases.

However, there is one DuPont factor which clearly favors applicant and which causes us to find that there is

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no likelihood of confusion. Put quite simply, we believe that opposer's mark VIÑA SOL and opposer's other marks are so dissimilar from applicant's mark DONA SOL that there is no likelihood of confusion. Our primary reviewing Court has made it clear that in appropriate cases, one DuPont factor can outweigh all of the other factors. Kellogg Co. v. Pack'em Enterprises, 951 F.2d 330, 21 USPQ2d 1142, 1144 (Fed. Cir. 1991). This is "especially [true] when that single factor is the dissimilarity of the marks." Champagne Louis Roederer v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998). In Champagne Louis, the Court affirmed a decision of this Board in which it was found that the contemporaneous use by applicant of CRYSTAL CREEK for wine and by opposer of CRISTAL and CRISTAL CHAMPAGNE for wine would not result in a likelihood of confusion.

In the present case, while both VIÑA SOL and DONA SOL consist of two words with the second word being identical, the first words are so different in terms of appearance, pronunciation and connotation such that their contemporaneous use on identical goods (wine) is simply not likely to result in confusion. In terms of visual appearance and pronunciation, the differences between VIÑA and DONA are quite obvious. In terms of connotation, opposer's own legal director testified that VIÑA SOL means

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"sun vineyard" and that DONA SOL means "Madam Sol." (Javier deposition page 54). Indeed, Mr. Javier even went on to state that as applied to wine, "Vina is generic." (Javier deposition page 130). Moreover, in its brief, opposer stated that DONA SOL meant "lady sun" whereas VIÑA SOL meant "sun vineyard." (Opposer's brief page 8). However, opposer argued that "the average U.S. consumer cannot be expected to have such information" as to the foregoing meanings. (Opposer's brief page 8).

We simply disagree. The word "vino" - which is very similar to the VIÑA portion of opposer's marks - appears in ordinary, unabridged American dictionaries and it is defined as meaning "wine." Webster's New World Dictionary (2d ed. 1970). While some United States consumers may not understand the meaning of VIÑA in the abstract, we believe that most United States consumers would recognize VIÑA as meaning "wine" when said term is used in conjunction with wine. Indeed, at the oral hearing, counsel for opposer conceded this very point. Moreover, while some United States consumers may not understand DONA as referring to a lady in general, we believe that many of these consumers would, at a minimum, perceive DONA as a shortened form of the female name Donna. Thus, in terms of meaning or connotation, the marks VIÑA SOL and DONA SOL are quite different.

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There are other factors which also favor a finding of no likelihood of confusion. First, opposer has never contended that any of its marks are famous and thus are entitled to a greater scope of protection. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 222 USPQ2d 1453, 1456 (Fed. Cir. 1992). Indeed, opposer's United States sales of wine under the marks VIÑA SOL and GRAN VIÑA SOL are quite minimal. In 1996, opposer's United States sales of all products bearing either of these two marks came to less than 6,000 cases. (Javier deposition pages 59-60). Moreover, opposer acknowledged that "we don't spend much money in advertising or publishing in newspapers or media, like radio or television because we don't believe in this system." (Javier deposition page 15). Indeed, Mr. Javier was unable to state how much opposer had spent in advertising its VIÑA SOL and GRAND VIÑA SOL wines. (Javier deposition page 73). While it is true that over the years opposer's wines under these two marks have received mention in some industry publications and publications of interest to wine drinkers, these mentions have been rather sporadic.

Another factor favoring applicant is that there is no suggestion whatsoever that applicant adopted its mark DONA SOL in bad faith. In this regard, opposer's witness Mr. Javier testified that the trade dress for applicant's

product and opposer's products was quite different. (Javier deposition pages 163-164).

As for the remaining DuPont factors, we find them to be either neutral or slightly in favor of applicant. Despite four years of contemporaneous use, neither applicant's witness nor opposer's witness was aware of any instances of actual confusion involving their respective products. However, given opposer's very limited sales in recent years of VIÑA SOL and GRAND VIÑA SOL products, we have considered this absence of actual confusion to be a neutral factor.

As for the use of the word SOL in other wine trademarks, while applicant's witness Mr. Ramona testified there were approximately five or six other companies which marketed wines under marks containing the word SOL, we have accorded this factor limited weight simply because Mr. Ramona was unable to state the extent of sales of other wines marketed under trademarks having the term SOL as a component.

In summary, given the significant differences in the marks; the fact that none of opposer's marks is even remotely famous (and opposer does not contend otherwise); and the fact that applicant adopted its mark in complete good faith as witnessed by the significant differences in the trade dresses of applicant's product and opposer's

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products, we find that there exists no likelihood of confusion, mistake or deception.

Decision: The opposition is dismissed.

E. W. Hanak

B. A. Chapman

D. E. Bucher  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board