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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Vitasoy International Holdings Limited**

Serial No. 75/**465,778**

Carole F. Barrett of **Coudert Brothers** for **Vitasoy International Holdings Limited**.

Carol A. Spils, Trademark Examining Attorney, Law Office 101 (**Jerry Price**, Managing Attorney).

Before **Chapman**, **Rogers** and **Drost**,
Administrative Trademark Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

Vitasoy International Holdings Limited has filed an application to register VITA as a trademark in International Class 30 for goods identified, following amendment, as "soybean curd desserts, namely pudding, custard and ice cream."¹

¹ Serial No. 75/465,778, filed April 9, 1998, based on applicant's allegation of a bona fide intention to use the mark in commerce. During prosecution, applicant stated, in response to an inquiry from the Examining Attorney regarding the meaning of applicant's mark, that, to applicant's knowledge, the mark has

The Examining Attorney has made final a refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The ground is that applicant's mark, if used in connection with the identified goods, would be likely to cause confusion or mistake or to deceive consumers, in view of the prior registration of the mark VITALITE for "frozen yogurt and ice milk."²

When the refusal was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion for this case, key considerations are the similarities of the marks and of the identified goods, and the number and nature of similar

no meaning in any foreign language. After the Examining Attorney made an Italian dictionary entry of record, the applicant acceded to the Examining Attorney's request that applicant confirm that VITA is an Italian word that translates in English to "life."

² Registration No. 1,817,037, issued January 18, 1994 to Vitamilk Dairy, Inc.; Section 8 and 15 affidavits accepted and acknowledged, respectively, as of June 22, 1999. The registration does not include a translation statement.

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marks that have been adopted and used on or in connection with similar goods.

In regard to the goods, applicant has concluded that, because registrant is a dairy, the goods identified in the cited registration are "dairy-based" and "originate from a dairy and are therefore unlikely to be confused with the non-dairy, soy-based food products of Applicant." The Examining Attorney, however, has noted that registrant's goods cannot be read so restrictively and must be presumed to include both dairy-based and soy-based frozen yogurt and ice milk. We agree, as our analysis of the similarity or relatedness of the goods is based on the identifications in the involved application and registration. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). The identification in the registration is not restricted in any way and could include soy-based products. Moreover, we agree with the Examining Attorney that it is likely the same consumers would be exposed to the identified goods, since registrant's frozen yogurt and ice milk and, at a minimum, applicant's ice cream are competitive goods. Cf. In re National Dairy Products

Corporation, 158 USPQ 55 (TTAB 1968) (applicant's mark for ice cream, ice cream sandwiches and ice cream bars refused registration in view of similarity to registered mark for frozen confections).

Finally, while applicant relies to some extent on the Asian origin of its products, there are no restrictions on channels of trade in the identification of goods for either applicant or registrant. Thus, we cannot assume that applicant's goods will be marketed solely in stores specializing in Asian products. Rather, we must assume that applicant's goods will be offered in all the usual channels of trade for pudding, custard and ice cream, including channels of trade for registrant's frozen yogurt and ice milk.

Turning to the marks, the Examining Attorney essentially argues that VITA is the dominant portion of the registered mark, because the LITE portion is descriptive of the reduced-calorie or low-fat nature of registrant's goods, and that applicant has "appropriated" the dominant element of registrant's mark. Applicant does not dispute that its mark consists of the dominant portion of registrant's mark, though it does note that it already owns registrations for VITA and for Chinese characters that

translate to VITA.³ In addition, applicant argues that VITA is weak, "is used in nineteen federally registered marks by eleven different registrants for food products [and] the scope of protection for each VITA-formative mark is narrowed by the crowded filed [sic] of VITA-based marks used in connection with food-related products."⁴

The Examining Attorney generally discounts the relevance of the registrations obtained by applicant, because they are for marks consisting of "non-Latin" characters "and/or" are for goods different from those in

³ Applicant claims to own six (brief p. 7) or seven (brief p. 4) prior registrations for VITA or "design" marks composed of Chinese characters that translate to VITA. In fact, one of the prior registrations (No. 1,147,761) is for a mark consisting of three Chinese characters, and includes a translation statement that explains that the first two characters are the phonetic equivalent of "VITA" and the third is "MILK."

Applicant's other registrations for marks consisting of Chinese characters include varying translation statements. One, No. 1,747,259, states that the characters "transliterate to 'WEI TA' and this means 'VITA' in English." Another, No. 1,900,795, states that the Chinese characters "translate to 'Vita'. The term 'Vita' is a coined expression." Unlike the application now before us, neither of applicant's two registrations for the English letters VITA, Nos. 1,833,973 and 1,893,224, includes a translation statement.

Thus, for purposes of our considering the probative value of applicant's prior registrations, we consider applicant to have two prior registrations for VITA, four prior registrations for Chinese characters which, for those who are bilingual in Chinese and English, will be pronounced as WEI TA and may translate in English to VITA, and one prior registration for Chinese characters which will be translated to VITAMILK.

⁴ Because applicant's list of these registrations, set forth *infra*, omits one of applicant's prior registrations and the cited registration, we consider the claim to be that there are 21 existing registrations by 11 different registrants for VITA-formative marks (including applicant's Chinese character marks).

applicant's current application. However, the Examining Attorney does not explain why applicant's Chinese character registrations should be discounted and does not discuss the relevance of any of the particular third-party registrations referenced by applicant. In regard to the third-party registrations, the Examining Attorney only recites the oft-proclaimed maxim that third-party registrations are of little probative value because they are not evidence that the marks shown therein are in use or that consumers are familiar with them.

Reproduced below is the list of registered marks supplied by applicant in both its earlier response to an Office action by the Examining Attorney and its brief on appeal;⁵ the "VITA (Design)" marks are applicant's prior registrations for marks consisting of Chinese characters. Footnoted material has been added to reflect changes in status of some registrations, based on information in Office databases:

⁵ The Examining Attorney did not object to applicant's failure to introduce most of this evidence in the proper manner, i.e., its failure to file copies of the certificates of registration or printouts from the Office's computerized data base of registered marks. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974); see also Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). Accordingly, we have considered all the registrations.

MARK	GOODS / SERVICES	REG. NO.	OWNER
VVFP INC VAL VITA	Canned fruits and vegetables, canned fruit juice for food purposes, canned vegetable juice for food purposes, tomato paste, tomato sauce, canned port and beans	0396814	Hunt-Wesson, Inc.
LA DOLCE VITA	Tomato paste	0552146	Springfield Sugar & Products Company
CAFFE D'VITA "THE MAGNIFICENT CAPPUCINO"	Coffee	1036322	Brad Barry Company, Ltd.
VITA	Processed fish products	1087024	Vita Food Products, Inc.
NU VITA ⁶	Breakfast cereals and flour	1119745	Nu Vita Foods, Inc.
VITA (Design)	Vegetable based milk substitute made from soy beans	1147761	Vitasoy International Holdings, Limited
VITA LITE	Cream and milk combinations	1469903	Vitamilk Dairy, Inc.
VITA (Design)	Vegetable based food beverage used as a milk substitute made from soya beans; tofu; and canned, dried, soybean curd	1747259	Vitasoy International Holdings Limited

⁶ Registration expired on July 3, 2000.

PASTA DELLA VITA ⁷	Pasta	1758578	Food Services of America, Inc.
PIZZA VITA ⁸	Frozen pizza	1797204	Pizza concepts, Inc.
CHOCO VITA D'LITE	Cocoa mix	1803344	Paradise Valley Foods, Inc.
VITA	Coffee and tea drinks	1833973	Vitasoy International Holdings Limited
POMODORI DELLA VITA ⁹	Tomatoes which have been canned, cooked or otherwise processed; tomato paste; tomato puree	1856352	Food Services of America, Inc.
VANA VITA D'LITE	Non-dairy, chilled, rice-based food beverage with vanilla flavoring	1891789	Paradise Valley Foods, Inc.
VITA	Soy-based beverage used as a milk substitute ¹⁰	1893224	Vitasoy International Holdings Limited
VITA (Design)	Coffee and tea drinks	1900795	Vitasoy International Holdings Limited

⁷ Registration cancelled under Section 8 of the Trademark Act on September 20, 1999.

⁸ Registration cancelled under Section 8 of the Trademark Act on December 28, 2000.

⁹ Mark registered on September 27, 1994. The Section 8 affidavit is overdue, and the grace period for its filing has passed. See Trademark Rule 2.160.

¹⁰ Registration 1,893,224 was issued in two classes, for "soy-based beverage used as a milk substitute" and "fruit juices, vegetable juices, and soft drinks." The registration, however, is the subject of a recent filing in the Office's Post Registration section; and it appears from the TRAM database that it is now limited to "fruit juices, vegetable juices, and soft drinks."

VITA (Design)	Soybean curd desserts, namely pudding and custard	1990485	Vitasoy International Holdings Limited
VITA LEAN	Fish in patty form	2041165	Vita Food Products, Inc.
VITA GREEN	Herbal extracts in capsule form; dietary food supplements; liquid concentrates, namely, health tonic concentrates made from a honey and mushroom-like fungus for use as a nutritional supplement	2087986	Vita Green Health Products Company Limited

Applicant analogizes the case at hand to In re Hamilton Bank, 222 USPQ 174 (TTAB 1984). In that case, an Examining Attorney refused registration of a stylized version of the word KEY based on the prior registration of five KEY-formative marks for various banking services. The applicant therein entered into the record 15 additional registrations for KEY-formative marks, for various types of banking, lending or financial services. The Board stated:

In the case at hand we are presented with a total of twenty registered marks owned by fourteen different entities which contain the word "KEY" in combination with other word and design elements. Each registration is for some sort of financial service. Most relate specifically to banking services; all are related closely enough

so that use of confusingly similar marks to identify the services would create a likelihood of confusion.

It is clear that the term "KEY" has been widely adopted in the financial field. We attribute this to the suggestive quality of the term as applied to such services. ...Because the term "KEY" has been widely adopted and registered and because it may be considered suggestive of the services in this case, it is a weak element in the various marks in which it appears.

... The term has weak trademark significance in this field because of its suggestiveness, which is evidenced by its widespread adoption and registration. In the case at hand the applicant's mark is no more likely to cause confusion with the five cited registered marks than the five cited marks are likely to cause confusion with the fifteen other registered marks which contain the term "KEY."

Id. at 178-79.

Though the *Hamilton Bank* case at least appears to present an apt analogy to the case at hand, the Examining Attorney made no attempt to distinguish it. Nonetheless, we find the instant case not as analogous to *Hamilton Bank* as does applicant.

First, of the 21 prior registrations of or including VITA (including the cited registration), three are now cancelled or expired. A fourth shortly will be cancelled because a Section 8 affidavit was not filed to maintain it and it is long past the grace period under the statute for filing of such affidavit.

Second, we agree with the Examining Attorney's conclusion that less weight should be given to the five prior registrations obtained by applicant which are set forth in Chinese characters, because it is unlikely that consumers who cannot read Chinese characters will view these as "VITA" marks. Moreover, even for those who can read such characters, they may perceive the marks solely as the pictorial representation of WEI TA and may not make a further translation into "VITA," as an Italian or English word.¹¹

Third, the marks in some of the third-party registrations, e.g., LA DOLCE VITA and CAFFE D'VITA "THE MAGNIFICENT CAPPUCINO," would clearly be perceived as Italian phrases, such that the term VITA, as used therein, would be viewed as an Italian word. The marks in still other registrations, e.g., VITA for processed fish products and VITA LEAN for fish in patty form, and even VITALITE in the cited registration, may be viewed as arbitrary or suggestive.¹²

¹¹ See footnote 3, supra, in regard to translation statements in applicant's prior registrations. See footnote 12, infra in regard to statements in third-party registrations.

¹² The record is unclear as to how members of the public would view the term "VITA" in many of the previously-registered marks. As noted earlier, in footnote 3, the translation statements included in applicant's prior registrations are varied. Also varying in their explanations of the significance of "VITA" are

In short, this case presents different circumstances than the Board had to consider in *Hamilton Bank*, wherein the "KEY" element of each of the cited and third-party marks presented the same commercial impression. In this case, the various third-party marks will not all be readily perceived as having an identical element. Thus, we do not view the prior registrations on which applicant relies as unequivocal evidence that "VITA" is a commonly adopted element for marks for food products, and one which always presents the same commercial impression, so that it should be viewed as weak and entitled to only a narrow scope of protection.

Finally, we agree with the Examining Attorney that even if some of the third-party registrations were viewed as having an identical element, they coexist on the register because of differences in the goods. In *Hamilton Bank*, in contrast, the services covered by the third-party

the third-party registrations referenced by applicant. Some include a translation statement that acknowledges "VITA" as an Italian word, while others do not.

We take judicial notice of the following dictionary definitions of "vita" as an English word and as an Italian word:

vita *n*, *pl vitae* : a brief autobiographical sketch (as in a thesis for a doctorate). Webster's Third New International Dictionary 2558 (1993); and

vita, *n.f.* Life; existence; spirit, animation, liveliness, vitality; livelihood, living; body, waist. Cassell's Italian/English Dictionary 565 (1977).

registrations were identical or closely related and the many KEY-formative marks coexisted because of differences in the marks.¹³

We readily acknowledge that the existence of numerous third-party registrations for VITA-formative marks for numerous food items at first glance appears unusual.¹⁴ Nonetheless, as articulated above, we find them largely able to coexist based on differences in the respective goods or cumulative differences in the goods and the marks. However, when consumers who are familiar with registrant's VITALITE mark for frozen yogurt and ice milk (whether soy- or dairy-based), encounter VITA for a soy-based ice cream, we believe confusion is likely. Moreover, even if we consider the third-party registrations as evidence that the cited mark is highly suggestive and somewhat weak, the

¹³ The mere fact that the prior registrations we have considered in this case all cover various food products does not dictate a finding that the various VITA-formative marks are for virtually identical goods or services and therefore coexist based on differences in the marks. Not all food products are related or would readily be perceived as having a common source. See Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 USPQ2d 1169, 1171-72 (TTAB 1987); see also, Federated Foods, Inc. v. Fort Howard Paper Company, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

¹⁴ While the Examining Attorney is entirely correct that the registrations themselves are not evidence of use of the registered marks in commerce, or of the extent to which consumers have been exposed to these marks, we note that the registrations are all either based on use in commerce or have been maintained through a post registration filing attesting to use in commerce.

owner of a registration for a weak mark still is entitled to protection against registration by a subsequent user of a virtually identical mark for closely related goods. See Hollister Incorporated v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976).¹⁵

Under the circumstances of this case, we resolve any doubts regarding the registrability of applicant's mark in favor of registrant. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997).

Decision: The refusal of registration is affirmed.

¹⁵ To the extent applicant has relied on its prior registrations of VITA per se (not in Chinese characters), we note that one of these two registrations (No. 1,833,973) issued for "coffee and tea drinks" and the other (No. 1,893,224) was issued in two classes, for "soy-based beverage used as a milk substitute" and "fruit juices, vegetable juices, and soft drinks." The latter registration, however, is the subject of a recent filing in the Office's Post Registration section; and it appears it is now limited to "fruit juices, vegetable juices, and soft drinks."

The goods in the current application are different in type than coffee and tea drinks, juices and soft drinks. The mere fact that applicant may own registrations for VITA covering these other goods does not guarantee that applicant will automatically be able to expand registration of that mark to new types of goods or services. See In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994).