

THIS OPINION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed:  
September 5, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Goya Foods Inc.  
v.  
Cerveceria Nacional Dominicana C. por A.

Opposition No. 91158354  
to application Serial No. 76405063  
filed on May 8, 2002

John M. Rannells of Baker & Rannells PA for Goya Foods Inc.

Barry M. Krivisky of Scully Scott Murphy Presser, P.C. for  
Cerveceria Nacional Dominicana C. por A.

Before Walters, Grendel and Cataldo, Administrative  
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Cerveceria Nacional Dominicana C. por A., applicant  
herein, seeks registration on the Principal Register of the  
mark depicted below for goods identified in the application  
as "non-alcoholic, non-fermented carbonated malt beverage."<sup>1</sup>

<sup>1</sup> Serial No. 76405063, filed May 8, 2002. The application is  
based on intent-to-use under Trademark Act Section 1(b), 15  
U.S.C. §1051(b).



The application includes a disclaimer of MALTA MORENA apart from the mark as shown. The application includes the following translation statement: The English translation of the non-English words 'MALTA MORENA' is 'dark brown malt.'<sup>2</sup>

Goya Foods Inc., opposer herein, has opposed registration of applicant's mark on the ground that the mark, as applied to applicant's goods, so resembles opposer's mark **MORENA**, previously registered (in standard character form) for "non-alcoholic malt beverage soft drink

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<sup>2</sup> The application includes the following description of mark statement:

The mark consists of two foreign words "MALTA MORENA" and the design elements. The two words "MALTA MORENA" are overlaid in a stylized lettering inside a rectangle in a diagonal position over the zigzag pattern on the background formed by straight diagonal lines. The circular design appearing below the zigzag pattern is comprised of concentric circles and rings. The inner circle encircles a stylized representation of a sheaf of wheat in its center.

The application also includes the following lining and stippling statement: "Color is not a feature of the mark and the lines appearing in the mark do not represent any colors."

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containing malt, barley and hops,"<sup>3</sup> as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>4</sup> Applicant's answer denied the salient allegations of the notice of opposition and asserted various affirmative defenses.

The evidence of record includes the file of the opposed application, the pleadings herein, and a status and title copy of opposer's pleaded registration, submitted by opposer via notice of reliance. Opposer filed a brief on the case; applicant did not. No oral hearing was requested. We sustain the opposition.

Because opposer has properly made its pleaded registration of record, and because opposer's likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded

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<sup>3</sup> Registration No. 1498856, issued August 2, 1988. Affidavits under Sections 8 and 15 accepted and acknowledged. The registration includes a claim of acquired distinctiveness under Trademark Act Section 2(f).

<sup>4</sup> Opposer also alleged dilution as a ground of opposition, but has presented no evidence or argument in support thereof. We deem that claim waived. Also, opposer pleaded, and has argued in its brief, that the Office, in examining applicant's application, improperly allowed applicant to disclaim MALTA MORENA. This ex parte matter is not a proper ground of opposition to registration of applicant's mark in this inter partes proceeding.

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registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find, first, that applicant's goods as identified in the application, i.e., "non-alcoholic, non-fermented carbonated malt beverage," and opposer's goods as identified in its registration, i.e., "non-alcoholic malt beverage soft drink containing malt, barley and hops," are essentially and legally identical. We also find that these identical goods are or would be marketed in the same trade channels, and to the same classes of purchasers. We also find that these goods are ordinary inexpensive consumer items which may be purchased on impulse, without a great deal of care or

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sophistication. Based on these findings, we conclude that the second, third and fourth *du Pont* factors weigh in favor of a finding of likelihood of confusion.

We turn next to the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ

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749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's goods are identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Opposer's mark is MORENA, registered in standard character form. The mark is registered pursuant to the provisions of Trademark Act Section 2(f). The reason for the Section 2(f) claim is not apparent from the registration, but in any event we presume the mark to have acquired distinctiveness. We also accord the registration all of the other presumptions to which it is entitled under Trademark Act Section 7(b).

Applicant's mark is MALTA MORENA and design. We find that the dominant feature in the commercial impression created by applicant's mark is the word MORENA. *See In re Chatam International Inc., supra; In re National Data Corp. supra.* Although this word is registered by opposer pursuant to Section 2(f), indicating that it may not be inherently distinctive, we find that it nonetheless is the dominant feature in applicant's mark. The word MALTA apparently is Spanish for "malt," which is generic as applied to the goods, denoting one of the ingredients. We note that

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applicant, in its answer to the notice of opposition, admitted that "the term 'malta' is used in conjunction with many non-alcoholic malt beverages, including Applicant's and Opposer's." (Answer, paragraph 14.) The design elements of applicant's mark, to the extent that they are not mere background carriers, do not detract from the dominance of the wording, especially the word MORENA, in the mark. Applicant's disclaimer of MALTA MORENA, which appears to have been wholly voluntary in the application as originally filed, does not remove the words from the mark, nor does it alter our finding that MORENA is the dominant feature in applicant's mark.

Viewing the marks in their entirety, we find that they are similar rather than dissimilar. The presence of the word MORENA in both marks, as the whole of opposer's mark and as the dominant feature in applicant's mark, renders the marks similar overall. This point of similarity outweighs the points of dissimilarity between the marks. That is, purchasers are more likely to assume, based on the presence of the word MORENA in both marks, that a source connection exists, than they are likely to assume, based on the presence of the additional word MALTA and the design elements in applicant's mark, that no such source connection exists.

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Weighing all of the *du Pont* factors, we find that a likelihood of confusion exists. The parties' goods, which are ordinary and inexpensive consumer items, are essentially identical, and are or would be marketed in identical trade channels to identical classes of ordinary purchasers. In these circumstances, we find that applicant's mark is sufficiently similar to opposer's registered mark to result in a likelihood of source or other confusion. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *Century 21 Real Estate Corp. v. Century Life of America*, *supra*; *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

Decision: The opposition is sustained.