

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Ferrero S.p.A.

v.

Ruchi Soya Industries Limited

—
Opposition No. 91221291
to Application Serial No. 86184298

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Leo M. Loughlin of Rothwell Figg Ernst & Manbeck PC for Ferrero S.p.A.

Robert B. Golden of Lackenbach Siegel LLP for Ruchi Soya Industries Limited.

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Before, Mermelstein, Shaw and Goodman, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Ruchi Soya Industries Limited, seeks registration of the mark
NUTRELA for goods identified as:

Vanaspati, namely, edible fat; edible oils and fats; milk and dairy products excluding ice cream, ice milk and frozen yogurt; preserves and pickles; jams; jellies; soya chunks in the nature of formed textured vegetable protein for use as a meat substitute; soya granules for use in prepared meals or food; dal substitute, in International Class 29;

Products containing soya flour for use as an additive to foodstuffs for human consumption, namely, breads, biscuits; soya flour, in International Class 30; and

Mineral waters; aerated waters; non-alcoholic carbonated beverages; non-alcoholic drinks and beverages, namely,

energy shots, fruit juice beverages, squashes, fruit juices, herbal juices, vegetable juices, vegetable-fruit juices, in International Class 32.¹

The application states that the wording “NUTRELA” has no meaning in a foreign language.

Opposer, Ferrero S.p.A., has opposed registration of Applicant’s mark based on the grounds of likelihood of confusion and dilution. Applicant denied the salient allegations of the notice of opposition and asserted various affirmative defenses. However, Applicant did not pursue the defenses and we deem them waived.² *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422-23 n.7 (TTAB 2014).

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application. Opposer properly submitted the following evidence:

1. Testimony deposition of Noah Szporn, Opposer’s Regional Marketing Manager for North America, with exhibits, taken on October 21, 2016;³

¹ Application Serial No. 86184298, filed on February 4, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce, and under Section 44(e), 15 U.S.C. § 1126(e), based on Indian Registration Nos. 442435, 330743, and 334317.

² Applicant also counterclaimed for cancellation of two of Opposer’s registrations but did not file a main brief on the counterclaims. Following an order to show cause why the failure to file a brief should not be treated as a concession of the case, on February 1, 2018, the Board dismissed the counterclaims under Trademark Rule 2.128(a)(3). TBMP §§ 536 and 801.02(a). 26 TTABVUE.

³ 21 TTABVUE.

2. Status and title copies of four registrations comprising NUTELLA-formative marks owned by Opposer;⁴ and
3. Applicant's discovery responses.⁵

Applicant did not take testimony or otherwise submit any evidence. Only Opposer filed a brief.

II. Standing and Priority

Because Opposer's pleaded registrations are of record, valid and subsisting, Opposer's standing to oppose registration of Applicant's mark is established and its priority is not in issue as to the goods listed in the registrations. *See Empressa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

III. Likelihood of Confusion



Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between

⁴ 1 TTABVUE; 20 TTABVUE.

⁵ 19 TTABVUE.

the goods and the similarities between the marks. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer made of record the following four registrations for NUTELLA marks:

Reg. No.	Date Issued	Mark	Goods
0855647 ⁶	8/27/1968	NUTELLA	Spread containing cocoa and other ingredients (class 29).
1296656 ⁷	9/18/1984		Cocoa and hazelnut spread (class 30).
2000985 ⁸	9/17/1996		Hazelnut spread with skim milk and cocoa (class 30).
4192415 ⁹	8/21/2012		Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products excluding ice cream, ice milk and frozen yogurt; edible oils and fats (class 29); Coffee, tea, sugar, rice, tapioca, sago, substitute of coffee, flour, bread, biscuits, cakes, pastry and confectionary, namely, candy, cakes, wafers, waffles, muffins; eatable ice-creams; honey, treacle, yeast, baking powder; salt, mustard, pepper, vinegar, sauces; spices; ice; spread creams, namely, cocoa based spread, chocolate and chocolate products, namely, pastry for chocolate

⁶ 1 TTABVUE 13-19; 20 TTABVUE 5-12; renewed.

⁷ 1 TTABVUE 20-24; 20 TTABVUE 13-18; renewed.

⁸ 1 TTABVUE 25-29; 20 TTABVUE 19-24; renewed.

⁹ 1 TTABVUE 34-38.

Reg. No.	Date Issued	Mark	Goods
			beverage, chocolate pastry, chocolate coverings, chocolate, praline, chocolate for decorations of Christmas tree, chocolate covered candy containing alcoholic beverage content; pastry, chewing gum, chewing gum without sugar, candies without sugar (class 30); and Beers; mineral and aerated waters and other non-alcoholic drinks, namely, carbonated beverages; fruit drinks and fruit juices; syrups and syrup substitutes for making beverages (class 32).

We focus our likelihood of confusion analysis on Registration No. 4192415, for the mark **nutella** for the goods shown above. This mark and the identified goods are the most similar to Applicant’s mark and goods. If we find that there is a likelihood of confusion with this mark, there is no need for us to consider the likelihood of confusion with Opposer’s other marks. Conversely, if we find there is no likelihood of confusion with this mark, we would find no likelihood of confusion with Opposer’s other marks as they also comprise or incorporate the word NUTELLA and identify more narrowly defined goods. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The fame of Opposer’s marks.

We begin with the *du Pont* factor that requires us to consider the fame of Opposer’s marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A

famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame is not “an all-or-nothing factor,” *Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017), but instead involves assessing the mark “along a spectrum from very strong to very weak.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose*, 63 USPQ2d at 1308 (recognizing indirect evidence as appropriate proof of strength).

Opposer introduced evidence establishing the following facts regarding the fame of its NUTELLA marks:

- Opposer has used the NUTELLA mark in the U.S. since 1967.¹⁰
- NUTELLA is sold in 90% of large food stores in the U.S.¹¹

¹⁰ Szporn Dep., p. 12, 21 TTABVUE 15.

¹¹ *Id.* at 19, 21 TTABVUE 22.

- NUTELLA has a 94-95% brand awareness in the U.S.¹²
- Opposer spends approximately \$20-30 million dollars advertising NUTELLA in the U.S. each year.¹³
- NUTELLA appears regularly in national media advertising, which includes television ads, newspapers, magazines, the Internet, point-of-sale displays, as well as social media.¹⁴
- Opposer has achieved great financial success with NUTELLA in the U.S., for example, with annual U.S. sales of \$286 million in 2016.¹⁵
- NUTELLA has a large presence on social media, particularly, Twitter, Instagram, and Facebook. The NUTELLA Facebook page has approximately 3 million U.S. followers.¹⁶
- Fans of NUTELLA created World NUTELLA Day to celebrate the love of the product which has been discussed by national media such as BuzzFeed and the Today Show, and celebrities.¹⁷
- NUTELLA was the subject of a national truck tour in the U.S. which was covered by national and local media outlets.¹⁸

¹² *Id.* at 44, 21 TTABVUE 47.

¹³ *Id.* at 28, 21 TTABVUE 31.

¹⁴ *Id.* at 26-28, 21 TTABVUE 29-31.

¹⁵ *Id.* at 27, 21 TTABVUE 30.

¹⁶ *Id.* at 32-35, 21 TTABVUE 35-38.

¹⁷ *Id.* at 39, 21 TTABVUE 42.

¹⁸ *Id.* at 34-36, 21 TTABVUE 37-39.

Based on the foregoing, we find that Opposer has established that its NUTELLA brand has enjoyed very considerable success in the U.S. market and is a very strong mark. This factor favors a finding of likelihood of confusion.

B. The nature and similarity or dissimilarity of the goods, the established, likely-to-continue trade channels and classes of purchasers.

We next consider the similarity of the goods. Applicant's and Opposer's goods are, in part, identical. That is, each class of Applicant's goods includes some goods which are identified in Opposer's registration. For example, Applicant's "edible oils and fats; milk and dairy products excluding ice cream, ice milk and frozen yogurt; preserves and pickles; jams; [and] jellies," in Class 29 are legally identical to Opposer's "jellies, jams, . . . milk and milk products excluding ice cream, ice milk and frozen yogurt; [and] edible oils and fats," also in class 29. Applicant's "products containing soya flour for use as an additive to foodstuffs for human consumption, namely, breads, biscuits; [and] soya flour," in class 30 are legally identical to Opposer's "flour, bread, biscuits," also in class 30. And Applicant's "mineral waters; aerated waters; non-alcoholic carbonated beverages; [and] fruit juices," in class 32 are legally identical to Opposer's "mineral and aerated waters and other non-alcoholic drinks, namely, carbonated beverages; [and] fruit juices," also in class 32.


The identity in part of the recited goods in each class is sufficient for purposes of our determination. It is not necessary that Opposer prove likelihood of confusion with respect to all of the goods set forth in Applicant's applications. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Moreover, where Applicant's and Opposer's goods are in-part identical, we must presume that the channels of trade and classes of purchasers for those goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

The *du Pont* factors relating to the similarity of the goods, the channels of trade, and classes of purchasers favor a finding of likelihood of confusion.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

We now turn to the similarity or dissimilarity of the parties' marks in their entirety as to appearance, sound, connotation and commercial impression. *Du Pont*, 177 USPQ at 567; *Palm Bay*, 73 USPQ2d at 1692. We note that when trademarks appear on identical goods, the degree of similarity needed to support a conclusion of likelihood of confusion declines. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

Applicant's mark is NUTRELA, whereas Opposer's mark is . In terms of sound, the marks are nearly identical in pronunciation. The only significant difference between the marks is Applicant's addition of the letter "R" between the word "NUT" and the letters "ELA." However, this difference has only a miniscule

effect on the pronunciation of the respective marks and doesn't affect the number of syllables or the cadence of the marks' pronunciation.

In terms of appearance, the literal portions of both marks begin with the word "NUT" followed by the similar letters "RELA" or "ELLA." The fact that Opposer's mark is stylized is of little significance since Applicant's mark is in standard characters and can appear in any typeface including one similar to that used in Opposer's mark. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (the fact that an applied-for mark is presented in standard character form is not, by itself, sufficient to distinguish it from a similar mark in special form).

In terms of connotation and commercial impression, we have no evidence on likely consumer perception of the marks, however, the nearly identical pronunciation suggests that consumers would likely find that both marks have a similar connotation or commercial impression.

In sum, although the marks have minor differences, when we compare them in their entireties, we find that on the whole they are strongly similar in appearance, sound, connotation and commercial impression. This *du Pont* factor favors a finding of likelihood of confusion.

D. Conclusion

After considering all of the evidence of record and argument pertaining to the *du Pont* likelihood of confusion factors, including any not specifically discussed herein, we find that because Opposer's marks are strong, the goods are in-part identical, the channels of trade and consumers are presumed to overlap, and the marks are similar,

there is a likelihood of confusion between Applicant's mark and Opposer's marks when used in connection with the identified goods.

IV. Dilution

Because we have found that Applicant's mark is likely to cause confusion with Opposer's marks, we need not address Opposer's dilution claim. *See Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1478 (TTAB 2017) (stating that the Board has "discretion to decide only those claims necessary to enter judgment and dispose of the case,' as our 'determination of registrability does not require, in every instance, decision on every pleaded claim.'" (quoting *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013)).

Decision: The opposition is sustained and registration of the mark is refused.