

**This Opinion Is Not a
Precedent Of The TTAB**

Mailed: August 19, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board

—————
In re Randolph Leonard Spencer Churchill

—————
Serial No. 85446588

Lauren J. Krupka of Nixon Peabody LLP, for Randolph Leonard Spencer Churchill.

Anne Madden, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

—————
Before Cataldo, Ritchie, and Masiello, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Randolph Leonard Spencer Churchill (“Applicant”) filed an application to register the mark shown below, for goods identified as “cigarillos; cigars,” in International Class 34:¹

¹ Serial No. 85446588, filed October 13, 2011, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging dates of first use and first use in commerce in April, 2011.



The mark includes the following description: The mark consists of a crest with several decorative elements and the curved wording "HONI S" with a small dot between the "I" and "S". Toward the left of the crest is the curved wording "L Y PENNSE" toward the right of the crest with a small dot between the "L" and "Y", the "Y" and "P" and after the second "E" in "PENNSE". At the bottom of the design appears the wording "FIEL" "PERO" and "PESDICHADO" set against a curved banner with a small dot separating "FIEL" and "PERO". Below the banner is "WINSTON CHURCHILL". Below that is the word "LANCASTER," flanked to the left, right and bottom with decorative curved lines. The entire mark is set against a solid background. Also the colors red, gold and white are claimed as a feature of the mark.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the following mark, which is registered for

“chewing tobacco,” that when used on or in connection with applicant’s identified goods, it is likely to cause confusion or mistake or to deceive:²



The registration states that the mark contains the literal elements “LANCASTER LIMITED-RESERVE CHEWING TOBACCO.”

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29

² Registration No. 1401491, issued July 15, 1986, and disclaiming an exclusive right to the term “LIMITED RESERVE CHEWING TOBACCO” apart from the mark as shown. Section 15 affidavit acknowledged; renewed.

(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”). We consider each of the factors as to which applicant or the examining attorney presented arguments or evidence. The others, we consider to be neutral.

The Goods and Channels of Trade and Classes of Consumers

We first consider the similarity of the goods at issue in the application and the cited registration. The Examining Attorney submitted numerous third-party registrations that include both “cigars” as identified in the application and “chewing tobacco” as identified in the cited registration. These include, for example, Registration No. 2937896 (WISH); Registration No. 3115204 (901’Z); Registration No. 3028215 (SF, and design); Registration No. 3230862 (CUBAN ROOTS); Registration No. 3178215 (SELECTORS VARADERO); Registration No. 3286858 (HAMAO GENUINE LEYENDA CUBANA, and design); and Registration No. 3327337 (ARIQUE, and design). These third-party registrations serve to suggest that the goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

As to channels of trade and classes of consumers, neither the identification of goods in the application nor the identification of goods in the cited registration contains any limitations. Accordingly, we must assume that applicant’s and registrant’s goods may travel via all normal channels of trade and be marketed to typical consumers, which for these products would be those who consume or use tobacco, an overlapping set of consumers. *See Squirtco v. Tomy Corporation*, 697

F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). The Examining Attorney further submitted evidence of websites that offer for sale both chewing tobacco and cigars to show that they are frequently marketed together. Examples include *cigarpalace.net*; *finckcigarcompany.com*; *hilandscigars.com*; *swedishmatch.com*; *swisher.com*; and *tobaccotown.com*. Finally, we observe that Applicant does not present any arguments in his brief regarding these *du Pont* factors.

We find that the second and third *du Pont* factors weigh in favor of finding a likelihood of confusion.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Both marks at issue in this case are composite marks consisting of wording and a design. The mark in the cited registration contains the term “LANCASTER,” and in much smaller font, “LIMITED-RESERVE CHEWING TOBACCO.” Applicant’s mark contains the wording “WINSTON CHURCHILL LANCASTER,” with a crest above it containing Latin and Spanish wording presented in such small type as to be illegible to the extent it would be noticed at all by consumers. Accordingly, both marks share the prominent term “LANCASTER” although in the mark in the cited registration it is by far the dominant term,

whereas in Applicant's mark it is preceded by the term "WINSTON CHURCHILL." When considered in their entireties, the marks do not look or sound much alike, as they have different pronunciations and numbers of syllables.

We must also, however, consider the connotation and commercial impressions rendered by the marks. Similarity in any one of the elements of sound, appearance, meaning, or commercial impression is sufficient to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion") and *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) ("In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar'") (citations omitted). Therefore, even if the marks differ in appearance and sound, it would not necessarily mean there is no likelihood of confusion.

Applicant argues that the term "LANCASTER" gives the connotation and commercial impression of a place, and that therefore the mark in the cited registration would be understood as referring to a place whereas Applicant's mark would be understood as referring to the famous British Prime Minister Winston Churchill. To support this argument, Applicant submitted web evidence of the term "LANCASTER" as referencing various place names.

Amish Country News: The Amish vs. Tobacco: According to John Hostetler, author of *Amish Society*, "The Amish in Lancaster County started raising tobacco soon after the tobacco industry was established there, probably about 1838. They, along with a group in Saint Mary's County, Maryland, are the only Amish in the nation who grow tobacco."

Amishnews.com. Attached to October 24, 2011 Response to Office Action, p.3.

City of Lancaster:

Sovereign state: United Kingdom, England
Region: North West England
City Status: 1937
Government Type: City
Population total: 133,914
Website: lancaster.gov.uk
Wikipedia.org. Attached to October 24, 2011 Response to Office Action,
p.6.

Applicant also submitted numerous third-party registrations that include the term “LANCASTER” where the term is either disclaimed, or the registration is registered under Section 2(f) on the Principal Register with a claim of acquired distinctiveness. We note that the vast majority, although not all, of these are for businesses in Lancaster, Pennsylvania. Nevertheless, we accept that the term may be understood by some as referring to a place.³ That said, however the term is understood for the mark in the cited registration, it may likewise be understood in Applicant’s mark as well, notwithstanding Applicant’s arguments to the contrary regarding the WWII Lancaster bomber. *See* Shadler Decl. at Para. 3; and *bombercommandmuseum.ca*. In other words, the declaration of Applicant’s general counsel does not convince us that the term “LANCASTER” in Applicant’s mark will have a different connotation from that of Registrant’s mark merely because it is preceded by “WINSTON CHURCHILL.” We further observe that although Applicant’s mark begins with the term “WINSTON CHURCHILL,” it also features the same term that is the dominant portion of the cited registration, “LANCASTER.” This situation has been found to create a likelihood of confusion, in that consumers are likely to believe that Applicant is offering a new line of cigar and cigarillo products under the existing “LANCASTER” mark. *See In re Chatam*

³ Applicant also submitted a number of other registrations containing the term “LANCASTER,” some without the term disclaimed nor with a claim of acquired distinctiveness, but for the purpose of showing the weakness of the term. However, none of these were for tobacco products.

Int'l Inc., 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Cola-Cola Bottling Co. v. Joseph E. Seagrams & Sons, Inc.*, 526 F.2d 556 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN); *In re U.S. Shoe Corp.*, 229 USPQ 707(TTAB 1985) ("CAREER IMAGE" AND "CREST CAREER IMAGES"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE").⁴

Both marks contain design elements. The mark in the cited registration is an illustrated drawing in the shape of a frame or banner, around the word "LANCASTER," with a ribbon-like drawing on the bottom, containing the words "LIMITED-RESERVE CHEWING TOBACCO" in very small font. While we view the mark in its entirety, it is clear that the term "LANCASTER" is the dominant element in the mark, as the other words are very small, and are descriptive of the goods. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties."). The design element does little to change the commercial impression of the mark. The mark in the application contains a crest with wording in too small a font to likely be decipherable on typical advertising or on a pack of cigars or cigarillos. We find, here too, that the literal element "WINSTON CHURCHILL LANCASTER" is by far the dominant element of the mark, and the one which consumers will use to call for the

⁴ The Examining Attorney argues, based on other registrations owned by Applicant, that Applicant's mark is a house mark. We find sufficient evidence from Applicant to rebut the Examining Attorney's argument. In particular, Applicant's general counsel has attested that all of his marks are for "cigars." (Shadler decl. at para. 3). A "house mark," however, is generally understood as one that is used on "several different goods or services." 4 J. Thomas McCarthy *McCarthy on Trademarks and Unfair Competition*, § 23:43. Therefore, we need not discuss this argument. We observe in addition that if we found Applicant's mark to be a house mark, the result would be the same.

goods or refer to the mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012), *citing CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

In this regard, we find that the similarities of connotation and commercial impression outweigh dissimilarities of sight and sound such that the first *du Pont* factor also weighs in favor of finding a likelihood of confusion.

Coexistence/Actual Confusion

Applicant notes that he has already been selling his mark in the U.S. for two years without any verified instances of actual confusion. *See* Shadler Decl. at paras. 10-12. However, we note that the absence of actual confusion carries little weight, especially in an ex parte context. *In re Majestic Distilling Co, Inc.*, 65 USPQ2d at 1205.

We note further that Applicant attests to a fair amount of sales under this mark as well as his other “WINSTON CHURCHILL” marks. *See* Shadler Decl. at paras. 6, 10. To the extent applicant’s mark has enjoyed some degree of success, this does not avoid likelihood of confusion, and indeed may engender reverse confusion with the prior-registered cited mark.⁵ *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“The term ‘reverse confusion’ has been used to describe the situation where a significantly larger or prominent newcomer ‘saturates the market’ with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services.” [cites omitted])

Conclusion

Considering all of the evidence and arguments of record as it pertains to the *du Pont* factors, we conclude the marks are in their entireties sufficiently similar in connotation and commercial impression so as to outweigh differences in sound and

⁵ We do not opine as to applicant’s right to *use* his mark, but merely his right to registration, in light of the previously existing cited registration.

Serial No. 85446588

appearance; the goods are related; and they are likely to be sold through the same channels of trade to the same classes of purchasers. Accordingly, we find a likelihood of confusion between applicant's mark and the mark in the cited registration.

Decision: The Section 2(d) refusal to register is affirmed.