

**This Opinion is Not a
Precedent of the TTAB**

Mailed: November 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
—————

In re James Robinson
—————

Serial No. 86914326
—————

Frank Herrera of H New Media Law,
for James Robinson.

Janice McMorrow, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

—————
Before Cataldo, Wolfson and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

James Robinson (“Applicant”) seeks registration on the Principal Register of the mark LEAF BY OSCAR (in standard characters) for

Cigars in International Class 34.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that

¹ Application Serial No. 86914326 was filed on February 20, 2016, based upon Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use anywhere and use in commerce since at least as early as March 27, 2014.

Applicant's mark, when applied to Applicant's goods, so resembles the previously registered mark OSCAR (in typed form) for "cigars" in International Class 34 as to be likely to cause confusion, mistake or deception.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Preliminary Issues

We address a few preliminary issues before we proceed to the merits of the refusal.

A. Applicant's New Attorney – Two Reply Briefs

We turn first to the change of Applicant's attorney, and the attendant confusion which resulted in both attorneys filing (timely) reply briefs.

On September 14, 2017, Applicant filed a revocation of the previous power of attorney and appointed Mr. Herrera new counsel.³ Prior counsel filed a reply brief on September 15, 2017, which will be given no consideration because he was not then counsel of record.⁴ On September 18, 2017, Mr. Herrera filed a reply brief on behalf of Applicant, which we have considered.

² Registration No. 2273233 issued on August 31, 1999, renewed. Before November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP 807.03(i) (October 2017).

³ The Board's records will be updated accordingly. On September 28, 2017, Applicant filed what appears to be a duplicate of the September 14, 2017 revocation and appointment of counsel.

⁴ In view thereof, prior counsel's November 3, 2017 communication, explaining the confusion between prior and current counsel concerning the filing of a reply brief on behalf of Applicant, and asking the Board to strike the September 15, 2017 reply brief, is moot.

B. Evidentiary Issues

Applicant attached to his September 18, 2017 reply brief “Cigar reviews, cigar blogs, cigar advertising.”⁵ Only evidence filed during examination is timely, Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), and it should not be submitted (or resubmitted) on appeal. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1203.02(e) (June 2017). Accordingly, we give no consideration to the evidence submitted for the first time with Applicant’s reply brief.

The September 18, 2017 reply brief also includes a first-time request to amend the application to seek registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).⁶ If Applicant wished to assert a claim of acquired distinctiveness after he had filed an appeal, the proper procedure would have been to file a request for remand in a separate document rather than as a statement in his reply brief so that the Examining Attorney could consider the claim. *In re Future Ads LLC*, 103 USPQ2d 1571, 1573 (TTAB 2012) (claim of acquired distinctiveness raised for first time in reply brief should have been made in a separate request for remand); *In re HerbalScience Grp. LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010 (request for remand should be filed by a separate paper, appropriately captioned “Request for Remand,” rather than by a request within a paragraph in the middle of a brief). We need not detail the deficiencies in Applicant’s request or remand the application, however, because whether Applicant’s mark has acquired distinctiveness “is not controlling on

⁵ 11 TTABVUE 9-16.

⁶ 11 TTABVUE 4-5.

the only question on appeal, viz., likelihood of confusion between the two marks.” *In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973).

We turn now to the likelihood of confusion refusal.

II. Applicable Law

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *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 Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (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 Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We discuss below these and other relevant factors. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within *du Pont* list, only factors that are “relevant and of record” need be considered).

A. The Goods and Channels of Trade

We begin with the *du Pont* factors involving the relatedness of the goods, and the similarity of established, likely to continue channels of trade. We base our evaluation on the goods as they are identified in the application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1171 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Integrated Embedded*, 120 USPQ2d 1504, 1514 (TTAB 2016). The goods are identical, as both the application and cited

registration identify “cigars.” Further, because the involved goods are identical, and neither the application nor registration contain any limitations as to the channels of trade and classes of purchasers, we must presume that they are the same. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in an application or registration, the identified goods, if identical, are “presumed to travel in the same channels of trade to the same class of purchasers.”) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1001 (Fed. Cir. 2002)); *see also Stone Lion*, 110 USPQ2d at 1161; *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518-19 (TTAB 2016). In his brief, Applicant concedes the identity of the goods and their channels of trade.⁷

Accordingly, these *du Pont* factors support a finding of a likelihood of confusion.

B. Similarity or Dissimilarity of the Marks

We next consider the *du Pont* factor of the similarity or dissimilarity of the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*, 177 USPQ at 567); *see also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). In comparing the marks, we bear in mind that “[t]he 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

⁷ In fact, the heading for paragraph IV of Applicant’s brief is titled: “The Dissimilarity of Applicant’s Mark with Respect to Registrant’s Mark is Sufficient to Overcome the Fact That the Marks are Associated with Identical Goods That are Sold in Identical Channels.” 7 TTABVUE 13.

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) (quotation omitted). We also are mindful that where, as in the present case, the identified goods are identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Id.* at 1721; *Viterra*, 101 USPQ2d at 1912 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)).

Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entireties. *Id.*; see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there 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 a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161. For instance, as our principal reviewing court has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark....” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In comparing Applicant's mark LEAF BY OSCAR to Registrant's mark OSCAR, we observe that Applicant has incorporated the entirety of the registered mark OSCAR. A likelihood of confusion frequently has been found in cases such as this. "When one incorporates the entire arbitrary mark of another into a composite mark, the inclusion of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion. [Internal citations omitted]. An inclusion of a merely suggestive or descriptive element, of course, is of much less significance in avoiding a likelihood of confusion." *The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design is similar to CONCEPT); *see also Coca-Cola Bottling Co. v. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER and Bengal Lancer soldier design is similar to BENGAL); *Bissett-Berman*, 177 USPQ at 529 (E-CELL is similar to the mark E). We therefore consider the degree of suggestiveness of the registered mark OSCAR, as well as the non-shared elements of the marks.

There is no evidence to indicate that third parties use OSCAR or any similar mark in relation to cigars. Similarly, there is no evidence that OSCAR has any meaning in connection with the cigars of Applicant or Registrant, notwithstanding Applicant's unsupported assertions in his brief that OSCAR is a "weak mark because it consists entirely of a personal name."⁸ And even if Applicant's and Registrant's marks identify different individuals named "Oscar,"⁹ the record does not support a finding that

⁸ 7 TTABVUE 13.

⁹ *Id.*, n.1.

consumers are aware of the difference or that such knowledge would affect their purchasing decisions. We therefore find OSCAR to be an arbitrary term in relation to cigars.

On the other hand, the record amply demonstrates that cigars are made of tobacco leaves and that it is common for cigars, including Applicant's, to be wrapped in tobacco leaves. Indeed, Applicant makes the latter point in connection with his primary argument concerning the purported dominance of the term LEAF in Applicant's mark:

For example, the web page "A Guide to Cigar Wrappers" states "a cigar's wrapper leaf can determine anywhere from 60% to 90% of the cigar's overall flavor." Office Action dated June 7, 2016, Attachment 2. Similarly, the "Manufacture" section of the cited Wikipedia article describes the importance of leaves to the overall taste and quality of a cigar. *Id.*, Attachment 9. For these reasons, consumers are very likely to recognize that tobacco leaves have a special significance with cigars and are more likely to remember Applicant's mark due to the use of the dominant term LEAF.

In addition, consumers are likely to recognize that the term LEAF is the dominant part of Applicant's mark because Applicant's cigars are actually wrapped in tobacco leaves. See August 25, 2015 Response to Office Action, exhibit 1. Thus, the term LEAF is not a mere descriptive "add-on" to Applicant's mark.¹⁰

For the very reasons cited by Applicant, we find that the term LEAF is descriptive of cigars and therefore has greatly reduced source-identifying capacity, leaving the identical common term OSCAR with the most source-identifying significance in

¹⁰ 7 TTABVUE 11-12.

Applicant's and Registrant's marks.¹¹ *Nat'l Data Corp.*, 224 USPQ at 751 (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there 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 entirety.”).

We make this finding even though, as Applicant points out, LEAF appears in the initial position in Applicant's mark.¹² We recognize that purchasers in general are inclined to focus on the first word or portion of a trademark. *Palm Bay*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is the often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered”). The general principle of primacy of position does not apply in this case, however, because the term LEAF is descriptive of the tobacco leaf that commonly serves as a wrapper to cigars, and the term OSCAR appears to be arbitrary as applied to these goods. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a

¹¹ Indeed, Applicant has disclaimed this term. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (finding DELTA the dominant part of the mark THE DELTA CAFÉ and design because CAFÉ was disclaimed).

¹² Applicant's Brief, p. 11.

conclusion on the likelihood of confusion.”) (quoting *Nat'l Data Corp.*, 224 USPQ at 752).

In addition, we find that purchasers who are familiar with both marks likely would perceive Applicant's mark LEAF BY OSCAR as a subset, product line extension, or variant of Registrant's mark OSCAR, especially when encountered in the context of identical goods, with both marks identifying cigars made by OSCAR. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion, noting that the marks are more similar than they are different and that the addition of applicant's "product mark," VANTAGE, to the registered mark would not avoid confusion). Applicant's use of the preposition BY reinforces the commercial impression that OSCAR is the source of Applicant's cigars, *i.e.*, that the LEAF cigars are "by Oscar."

Simply put, the additional words LEAF BY in Applicant's mark LEAF BY OSCAR are not sufficient to distinguish Applicant's mark from the cited mark OSCAR. They do not change the meaning or commercial impression of Applicant's mark from Registrant's mark. Rather, the meaning of OSCAR remains the same in both marks. *Cf. In re P. Ferrero & C.S.p.A.*, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973) (TIC TAC and TIC TAC TOE); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 USPQ 392 (CCPA 1972) (ALL and ALL CLEAR); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970) (PEAK and PEAK PERIOD).

In view of the foregoing, we find that when the marks LEAF BY OSCAR and OSCAR are compared in their entirety, they are sufficiently similar in appearance, sound, connotation, and commercial impression that, if applied to related goods, confusion would be likely to occur. As such, this *du Pont* factor also favors a finding of likelihood of confusion.

III. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that consumers familiar with Registrant's cigars offered under the mark OSCAR would be likely to believe, upon encountering Applicant's mark LEAF BY OSCAR for cigars, that the goods originated with or are associated with or sponsored by the same entity.

Decision: The refusal to register Applicant's mark LEAF BY OSCAR is affirmed.