This Opinion is Not a Precedent of the TTAB

Mailed: January 8, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Plasencia 1865, LLC

Serial No. 87147187

Stewart L. Gitler of Welsh Flaxman & Gitler LLC,
for Plasencia 1865, LLC.

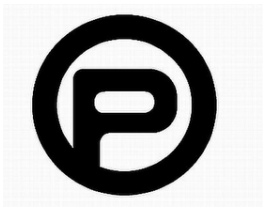
Monica L. Beggs, Trademark Examining Attorney, Law Office 105,
Jennifer Williston, Managing Attorney.

Before Kuhlke, Masiello and Heasley,
Administrative Trademark Judges.

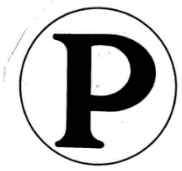
Opinion by Masiello, Administrative Trademark Judge:

Plasencia 1865, LLC ("Applicant") filed an application[1] for registration on the Principal Register of the mark shown below for "Cigars," in International Class 34:

[1] Application Serial No. 87147187 was filed on August 23, 2016 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant's alleged *bona fide* intention to use the mark in commerce. Applicant subsequently filed an allegation of use, stating July 1, 2016 as the date of first use and first use in commerce. The application includes the following description of the mark: "The mark consists of [a] stylized letter 'P' in a circle." Color is not claimed as a feature of the mark.



The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods, so resembles the registered mark shown below as to be likely to cause confusion, or to cause mistake, or to deceive.



The cited mark is registered for "Cigars."[2]

When the Examining Attorney made her refusal final, Applicant appealed to this Board and filed a request for reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney have filed briefs.[3]

I. Applicable Law

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 issue of

[2] Reg. No. 2775007, issued October 21, 2003. Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed. The mark consists of the letter "P" in a circle.

[3] Applicant appended 17 pages of evidence to its brief. While most of it appears to be duplicative of evidence already of record, to the extent that it includes any new evidence we have given it no consideration. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) ("Evidence should not be filed with the Board after the filing of a notice of appeal.").

likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also presented evidence and arguments regarding trade channels, sophistication of customers, and the strength of the cited mark.

A. The goods; trade channels; customers

We first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods in the application and the registration are identical. Therefore, this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Because the goods at issue are identical, we must presume that they move through the same channels of trade and are sold to the same classes of purchasers. *See In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.,* 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey,* 31 USPQ2d 1531, 1532 (TTAB 1994).

Applicant's contention that purchasers of "high end cigars"[4] are sophisticated and "are highly selective and intimately know the cigar manufacturers, the countries where the products are grown and the cigars sold thereby"[5] is unpersuasive. Applicant's identification of goods is not limited to high-end cigars, and we must interpret it as including within its scope all goods of the nature and type identified, in all relevant price ranges. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Moreover, there is no evidence of record to indicate that customers of cigars, in general, are sophisticated or careful in selecting the goods, and we must base our analysis "on the least sophisticated potential purchasers." *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163 (internal quotation marks omitted). The *du Pont* factor relating to the similarity of trade channels favors a finding of likelihood of confusion, and the *du Pont* factor of customer care and conditions of sale is neutral.

B. The marks

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (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

[4] Applicant's brief at 1, 7 TTABVUE 2.

[5] *Id*. at 3, 7 TTABVUE 4.

F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Moreover, marks must be considered in light of the fallibility of memory. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).

Although the marks are not identical, they are similar in appearance in that each consists solely of the letter P within a circle. The stylization of the letter P in each mark is slightly different, but both are conventional typefaces that are not particularly distinctive. The most significant difference between the marks is the slightly different positioning of the letter P within the circle. Overall, we find the visual differences between the marks to be minor. In sound, the marks are likely to be pronounced the same. Applicant does not argue that the letter P, or the letter P within a circle, has any particular meaning or connotation; but, to the extent that the two marks are perceived to have meaning, they are likely to project the same meaning. Applicant's contention that its mark would be understood to mean "Plasencia" and that the cited mark would be understood to mean "Perdomo" is not well taken.[6] Applicant has not sought to register a mark that includes the term PLASENCIA. Even if, as Applicant contends, Applicant and Registrant "almost always" use their marks together with the marks PLASENCIA and PERDOMO,[7] respectively, they are not constrained to do so and they might at any time choose to display their P marks alone. We must consider the marks as they appear in the application and registration.

[6] Applicant's brief at 3, 7, 7 TTABVUE 4, 8.

[7] *Id.* at 3, 7 TTABVUE 4.

In sum, we find the marks at issue to be highly similar in appearance, sound, meaning, and overall commercial impression, and this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

C. Strength of the cited mark

Applicant argues that the cited mark "is only entitled to a narrow scope of protection" because it is "inherently weak and highly diluted …"[8] To support the contention that the mark is inherently weak, Applicant has submitted 10 third-party registrations of marks that include the letter P.[9] Third-party registrations for similar goods may be relevant to show the sense in which a term is used in ordinary parlance; for example, that a term has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the term is inherently relatively weak. *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016). In this case, only four of the third-party marks are registered for cigars, and those marks differ in significant ways from the cited registered mark:[10]

[8] *Id*. at 4, 7 TTABVUE 5.

[9] Response of January 27, 2017 at 8-17; Request for reconsideration of July 10, 2017 at 17-28. Not all of the third-party registrations were registered on the basis of use in U.S. commerce: Reg. Nos. 5053575 and 4030648 issued under Section 44 of the Trademark Act, 15 U.S.C. § 1126.

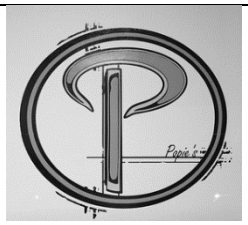
[10] One of the submitted registrations, Reg. No. 2912128, belongs to Registrant and relates to a different version of the cited mark.

Reg. No.	Mark
2074940[11]	
3060474	P1
3876299	E.P. CARRILLO
5053575[12]	

Other third-party registrations submitted by Applicant for marks including or comprising the letter P in stylized form, with or without additional designs, relate not to cigars, but to other smoker's articles:

[11] The mark consists of a design of concentric circles with trapezoidal wings to right and left. In the center of the circular design are the letters "P.G." Around the circumference of the circular design are the words "PAUL GARMIRIAN GOURMET SERIES" with eight stars. Along the center of the right trapezoidal wing are the words "PAUL GARMIRIAN."

[12] The mark consists of the phrase "PLATINUM SEVEN" in all capital letters, wherein "PLATINUM" is placed above "SEVEN" and in larger font, and wherein the letter "P" is placed over "PLATINUM" on a dark shield, and wherein a stylized letter "P" is placed within a double-lined square below "SEVEN"; and wherein the numeral "7" is placed within a dark box at the end of the word "SEVEN"; and finally wherein a stylized letter "P" is placed within a double-lined box below the word "SEVEN."

Reg. No.	Mark	Relevant Goods
673553		Pipes
1662705		Snuff and snuff dispensers
4030648		Electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes
4681578		Electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes
4925878		Electronic cigarettes, electronic cigarette refill cartridges and atomizers, sold as a component of electronic cigarettes; cases and accessories for electronic cigarettes
5161785		Filter tips

Applicant has also submitted two photographs showing a box of PATORO brand cigars marked "Serie 'P'" and a box of TATUAJE brand cigars marked "Series P."[13] We do not detect in this evidence any indication that the letter P has any descriptive or suggestive meaning in the field of cigars; and Applicant offers no explanation of what non-arbitrary significance the letter P may have in the field of cigars. The use of the letter P as a series designation is also not persuasive evidence of inherent weakness, as there is no reason a series designation cannot be arbitrary as applied to the goods. On this record, the cited registered mark is apparently arbitrary, and therefore inherently distinctive, as applied to the goods. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 764-66 (2d Cir. 1976).

The evidence discussed above also does not support Applicant's argument that the cited mark is "highly diluted." The two uses of "Serie P" and "Series P" are insufficient to "show that customers … have been educated to distinguish between different … marks on the basis of minute distinctions." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (internal quotations omitted). The third-party registrations do little to demonstrate the commercial weakness of Registrant's mark. Third-party registrations, without evidence to show that the registered marks are in actual use in the marketplace, do not demonstrate that a mark is commercially weak. *See Palm Bay Imps.,* 73 USPQ2d at 1693 ("The probative value of third-party trademarks depends entirely upon their usage."); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) ("[T]hird-party

[13] Applicant's request for reconsideration of July 10, 2017 at 30-31.

registrations are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use …"). In any event, the third-party registered marks are facially different from Registrant's mark. On this record, we find that Registrant's mark is inherently distinctive, and that Applicant has failed to demonstrate that it is commercially weak.

D. Balancing the factors.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. The goods at issue are identical and are presumed to travel through the same channels of trade to the same class of customers. The marks are highly similar in appearance, identical in sound, and alike in their meaning and overall commercial impression. Although the marks are not identical, when marks would appear on identical goods the degree of similarity necessary to support a conclusion of likely confusion declines. *Bridgestone Americas Tire Operations LLC v. Federal Corp*., 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012). Registrant's mark is inherently distinctive, and no meaningful commercial weakness has been demonstrated. Overall, we find that Applicant's mark, in the context of Applicant's identified goods, so resembles the cited registered mark as to be likely to cause confusion or mistake or to deceive.

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