

Mailed: February 9, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Societe Nationale des Chemins de Fer Francais
and
Venice Simplon-Orient Express, Inc.

v.

Stuart S. Hoffman

Opposition No. 91095769
Opposition No. 91097079
to Application No. 74466150
filed November 30, 1993

Opposition No. 91109552
Opposition No. 91109821
to Application No. 75253372
filed March 7, 1997

Oral Hearing: October 23, 2008

Jill Anderfuren of Marshall, Gerstein & Borun LLP for
opposers.

Stuart S. Hoffman, *pro se*.

**Before Walters,¹ Walsh, and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

By two separate applications, applicant seeks

¹ Judge Hohein, now deceased, participated in the oral hearing of this matter. Judge Walters is substituted in his place for the purposes of final decision. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985); TRADEMARK TRIAL AND APPEAL BOARD MANUAL PROCEDURE (TBMP) § 802.04 (2d ed. rev. 2004).

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registration of the following mark



for "cigars and smoking tobacco," in International Class 34,² and "perfume, cologne, eau de toilette, eau de parfum, and eau de cologne" in International Class 3.³

Opposers Societe Nationale des Chemins de Fer Francais ("SNCF") and Venice Simplon-Orient Express, Inc. ("VSOE") each filed an opposition to registration of each application, alleging priority and a likelihood of confusion with opposers' previously used and registered trademarks. Trademark Act § 2(d); 15 U.S.C. § 1052(d). VSOE additionally alleged that registration of applicant's marks is likely to cause dilution.

By his answers, applicant denied the salient allegations of each notice of opposition.

All four oppositions have been consolidated for discovery and trial, and we resolve all pending matters in this single opinion. The proceeding has been fully

² Application No. 74466150, alleging first use of the mark on October 28, 1993, and first use in commerce on November 12, 1993.

³ Application No. 75253372, based upon the allegation of a *bona fide* intention to use the mark in commerce.

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briefed,⁴ and the parties appeared at an oral hearing held on October 23, 2008. After careful consideration of the evidence of record and the arguments of counsel, we sustain the opposition as to Application No. 74466150, and dismiss the opposition as to Application No. 75253372.

I. Record

Pursuant to Trademark Rule 2.122, the record in this case includes the pleadings and the files of applicant's subject applications. In addition, the record includes the following items proffered during trial:

- Testimony of Annette Pines, VSOE's⁵ Director, Group Corporate and Incentive Sales for North America, taken August 29, 2007, and filed February 1, 2008;

⁴ Both parties attached a number of exhibits to their trial briefs. "Exhibits or attachments to briefs are of little or no use in a Board proceeding." *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008). We have given no consideration to any exhibits which were not properly submitted during the appropriate trial period. We note in this regard that the attachments to applicant's brief include a number of exhibits which were stricken pursuant to the Board's order of December 3, 2007 (granting opposer's motion to strike exhibits from applicant's notice of reliance).

⁵ While Ms. Pines provided her title at the beginning of her testimony, Pines. Test. at 4, she did not state whether she worked for VSOE or SNCF. However, the following exchange makes it apparent that she is employed by VSOE:

Q. And do you know what the relationship is between SNCF and Orient Express Hotels?

A. We are a licensee. We license the Orient Express from SNCF.

Q. What is the relationship between [VSOE] and Orient Express Hotels?

A. It's actually all part of one company. The corporate, the holding company, the parent company is Orient Express Hotels Limited, and under the umbrella is Venice Simphon

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- Opposers' Notice of Reliance, filed September 11, 2007, submitting title and status copies of six registrations owned by SNCF;
- Opposers' Notice of Reliance, filed September 11, 2007, submitting six third-party registrations and one owned by SNCF;
- Opposers' Notice of Reliance, filed September 11, 2007, submitting ten articles from various periodicals;
- Opposers' Notice of Reliance, filed September 13, 2007, submitting a dictionary definition of the term "*fleur de lis*" and copies of a U.S. Registration and International Registration owned by Relais & Chateaux;
- Applicant's Notice of Reliance, filed November 16, 2007. Applicant submitted a number of exhibits under this notice of reliance, all but one of which were stricken. See Order, Dec. 3, 2007. The remaining exhibit comprised two abandoned trademark applications filed by VSOE.⁶ Exh. C-1.

II. Pleadings and Historical Background

Opposer SNCF is a French company which provides the railways on which ORIENT-EXPRESS trains are operated in France. Pines Test. at 25. Opposer VSOE owns historic railroad cars and operates the ORIENT-EXPRESS railway line and provides associated goods and services. *Id.* at 25-26.

Orient Express Inc., which is the train, and Orient Express Hotels Inc., which are the hotel properties.

Pines Test. at 19.

⁶ In addition to other material, applicant's notice of reliance included excerpts from the testimony of Annette Pines. As noted in the Board's order, that testimony was already part of the record, and as such could be relied upon by applicant for any proper purpose.

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A related company, Orient Express Hotels Limited, provides hotel services. *Id.* at 19.

As noted, SNCF and VSOE filed separate oppositions to each of the subject applications. As grounds for its claim of likelihood of confusion, SNCF pleaded priority and use of the mark "'ORIENT EXPRESS' in connection with the advertising, promotion, licensing and marketing in the United States, of railway passenger services." Notice of Opp. ¶ 2 ('079 Opposition and '821 Opposition). In its two notices of opposition, VSOE pleaded prior use of the terms "VENICE SIMPLON-ORIENT-EXPRESS" and "ORIENT-EXPRESS" as well as ownership of Registration Nos. 1487834 (both oppositions), and 1368674 and 1201483 (VSOE and design).⁷ The '834 Registration has since been assigned to SNCF,⁸ and SNCF has in turn granted VSOE an exclusive license to use the registered trademarks. See Pines Test. at 19, Exh. 9.

Under notice of reliance dated September 17, 2007, opposers submitted title and status copies of six registrations. Although only one of these registrations was originally pleaded, we note that opposers' reliance on them was not objected to by applicant, either at the time they

⁷ The '674 and '483 Registrations were not submitted in evidence, and we give them no further consideration.

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were submitted, or in his trial brief. Accordingly, we find that the issue of likelihood of confusion with respect to these additional registrations was tried by the implied consent of the parties, and we deem the pleadings amended accordingly. See Fed. R. Civ. P. 15(b)(2); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193, n.7 (TTAB 2007); *Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1564, n.2 (TTAB 2007).

According to the testimony of Annette Pines, the original Orient Express was founded in 1883, providing transportation by rail from Paris, France to Constantinople (now Istanbul), Turkey. The original Orient Express ran until the mid-1970's. In 1977, VSOE began purchasing and restoring the original equipment of the defunct line, and resumed service in 1982 under the VENICE SIMPLON-ORIENT-EXPRESS trademark. The modern Orient Express is based in Venice, Italy, and offers service to a variety of European cities, including London, Paris, Rome, Vienna, Prague, and Budapest. Pines Test. at 4-6.

Like its predecessor, the modern Orient Express provides more than mere transportation:

⁸ See Confirmative Deed of Assignment of Trademarks, recorded March 23, 2004, Reel 2814, Frame 0949 (confirming an assignment made May 3, 2001).

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[B]esides the transportation itself, it's a very luxurious atmosphere, with fine dining cars, evening entertainment for our clients. We also have a boutique on board, so our clients can purchase memorabilia from their journey. ... We have a pianist, we have a baby grand piano in our bar car.

Pines Test. at 5-6. The luxury of travel on the Orient Express is not inexpensive; tickets sell at a significant premium over the price of commodity rail transportation on other lines. *Id.* at 9 ("Here in the U.S. the London-Venice trip is just about [\$]2600 per person.").

III. Preliminary Matters

Before discussing the merits of this matter, we note several arguments by the parties which are not properly before us. First, applicant argues that opposers' ORIENT-EXPRESS marks are "generic," App. Br. at 3, 7, that opposers have lost their trademark rights "through [an] [i]mproper or [b]logus licensing agreement," *id.* at 2 (emphasis omitted), or that opposers have abandoned their trademark rights, *id.* However, applicant has not filed a counterclaim to cancel opposer's registrations. The Board will not entertain an attack on the validity of a registration in the absence of a counterclaim for cancellation. *Scovill Mfg. Co. v. CTP Indus. Inc.*, 163 USPQ 491, 492 (TTAB 1969).

Applicant also makes much of the fact that its applications were approved by the examining attorney,

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arguing that this demonstrates that confusion is not likely. See App. Br. at 1, 6, 12. We disagree. By filing its oppositions, opposer is exercising its statutory right to object to registration of applicant's marks. See Trademark Act § 13. All oppositions occur after *ex parte* examination; if applicant's reasoning were correct, there would be no need for oppositions, since every application which is opposed has already been approved by an examining attorney. On the contrary, an opposition is completely independent of examination, and the fact that applicant's marks were approved for publication by the examining attorney has no bearing on our decision.

Finally, we note opposer's argument that

[a]pplicant intentionally sought to trade on the goodwill or reputation associated with [o]pposer's marks, violating § 1052(a). There is no reason for Hoffman to have adopted the wording and font of the ORIENT EXPRESS mark, except to benefit from a mistaken assumption by the consumer that there is a relationship or connection with SNCF and its famous ORIENT EXPRESS marks.

Opp. Br. at 21-22 (citation omitted). Nonetheless, we cannot consider this claim, because it was not pleaded as a ground for opposition, nor was it tried by express or implied consent. As the Court of Appeals for the Federal Circuit has explained, the elements of a false suggestion of a connection case under Trademark Act § 2(a) are "distinctly

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different" from those in a likelihood of confusion claim. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983); see also *In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1385-86 (TTAB 1993). While opposers' notices of opposition clearly set out a claim of likelihood of confusion, the same cannot be said for any claim arising under Trademark Act § 2(a). Accordingly, applicant was not on notice that opposers were pursuing a "false suggestion" claim, and thus had no opportunity to take discovery or present evidence in response to such a claim.

IV. Discussion

A. Standing and Priority

1. SNCF

Opposers introduced several registrations owned by SNCF into the record, thus establishing SNCF's 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 Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because SNCF's registrations are of record, SNCF's priority is not an issue with respect to opposers' likelihood of confusion claims. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

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2. VSOE

Ms. Pines' testimony, and the license agreement between SNCF and VSOE establish that VSOE holds an exclusive license to provide goods and services under the marks at issue here. As such VSOE has adequately established that it has a real interest in this proceeding, and that it has standing to pursue the opposition. *J.L. Prescott Co. v. Blue Cross Labs. (Inc.)*, 216 USPQ 1127, 1128 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing); *Chem. New York Corp. v. Conmar Form Sys., Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986).

We likewise find that VSOE has established its priority vis-à-vis the subject applications. VSOE does not currently own the pleaded registrations, having assigned them to SNCF. However, Ms. Pines' testimony and catalogues introduced by opposers clearly establish that VSOE originally began providing travel services and selling goods under the ORIENT-EXPRESS marks in the 1980's, and has continued do so under license after it transferred the registrations to SNCF. VSOE's use of the ORIENT-EXPRESS marks thus clearly predates the filing date of both subject applications.⁹

⁹ Application No. 74466150 was filed on November 30, 1993; Application No. 75253372 was filed on March 7, 1997.

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B. Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

1. The Fame Of The Prior Marks (Sales, Advertising, Length of Use)

We begin with a discussion of the fame of opposers' marks because fame, when found, is entitled to great weight in a likelihood of confusion analysis. *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner*

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Parker Toys, Inc. v. Rose Art Indus., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Opposers contend that their "ORIENT-EXPRESS" marks are famous and have received wide recognition. Opp. Br. at 9-12.

We find that opposers' evidence falls far short of what is necessary to establish that their marks are famous. In considering whether a trademark is famous, we consider all relevant evidence, typically focusing on the "volume of sales, advertising, and length of use" of the mark.¹⁰ *Giant Food, Inc. v. Nations Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983).

Ms. Pines testified that VSOE does not "advertise very much at the moment," although when its train service was launched in the 1980's, it advertised in a number of magazines of nationwide circulation. Pines Test. at 23-24. Ms. Pines also testified that opposer VSOE's annual revenue is approximately £12,000,000 per year. Pines Test. at 9.

Although VSOE's reported revenue figure is not insignificant, it is important to note that Ms. Pines'

¹⁰ While direct evidence of fame, usually in the form of a survey, can be highly relevant, such evidence is not required. Although applicant submitted the results of a customer questionnaire distributed on board its train in 1994, VENICE SIMPLON-ORIENT-EXPRESS 1994 RESEARCH RESULTS, Pines Test. Exh. 8, the data reported are not directly relevant to the issue of fame and are considerably out of date. We are thus unable to accord this evidence much probative weight on this or any other issue.

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testimony was to revenue from sales *worldwide*, and not solely to U.S. customers. Moreover, Ms. Pines did not indicate what specific year or years to which the cited revenue figure pertains.¹¹

The question at hand is whether opposer's marks are famous in the United States, not elsewhere. Opposer's vague testimony and worldwide sales figures are inconclusive of whether its marks are currently famous in this country. This is especially so in a case such as this one, where opposer's primary activities are admittedly performed outside the United States, and a significant portion of applicant's patrons are non-U.S. customers.¹² Likewise, opposer's activities and public recognition of its marks in the 1980's and 1990's is of little relevance in proving the current fame of its marks.

Moreover, even giving generous credit to Ms. Pines' testimony, opposers have not provided a meaningful context

¹¹ Parties seeking to demonstrate fame based on sales typically provide revenue figures for the most recent several years, and often support oral testimony with documentary evidence. By contrast, the testimony in this case consists simply of one figure from an undetermined year (and stated in a foreign currency), with no corroborating documentation.

¹² Ms. Pines testified that "[a]t this point in time I would say probably in the neighborhood of 15 percent of the total worldwide passengers are American. In the earlier days that number was probably more about 40 percent, back in the 1980s when we first started service, and probably that high through the early 1990s, as well." Pines Test. at 7.

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for their current annual sales figure, such as evidence of their market share for the services provided or goods sold in connection with its marks. As the Federal Circuit has stated, "[r]aw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading.... Consequently, some context in which to place raw statistics is reasonable." *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002).

Opposers also introduced a number of articles from the popular press about the quality and luxury of its travel services. While the articles are admissible, such evidence may not be considered as proof of the statements therein. *Life Zone*, 87 USPQ2d at 1956 n.5; *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007). Thus, while the statements in the articles are not proof of their truth, the fact that a number of such articles have been written can be used to demonstrate some public recognition of opposers and their services. Nonetheless, even that conclusion is seriously undercut by the age of the articles in question.¹³

In view of the extreme deference that is accorded to a

¹³ Six of the articles are from 1998-2001, one each from 2003 and 2004, and two from 2006.

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famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of a plaintiff asserting that its marks are famous to clearly prove it. Opposers fall far short of that standard on this record.

2. The Similarity or Dissimilarity Of The Marks

In comparing marks to ascertain whether confusion is likely, we consider the marks' appearance, sound, meaning and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008).

While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed,

in 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

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conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.

In re Nat'l Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).


In the two subject applications, applicant seeks to register a mark comprising the words ORIENT-EXPRESS and a *fleur de lis* design:



As noted above, opposers rely on the marks in several registrations. Each of these marks includes the terms ORIENT-EXPRESS or VENICE SIMPLON-ORIENT-EXPRESS:

Reg. No.	Mark	Goods/Services	Issue Date
1487834	VENICE SIMPLON-ORIENT-EXPRESS	Travel services, namely, railway passenger services. Class 39.	5/10/1998
2815925	COLLECTION VENICE SIMPLON-ORIENT-EXPRESS	Silverplated flatware, Class 8; Electric table lamps, Class 11; Silverplated ice buckets, trays, bud vases, sorbet dishes, teapots, coffee pots, creamers, Class 14; Playing cards, posters and diaries, Class 16; Handbags, Class 18; Glass beverage ware and dinnerware, Class 21; Towels, bedsheets, blankets, tablecloths, textile napkins, Class 24; Silk scarves, foulards, leather belts, bathrobes, neckties, kimona robes, Class 25; Toy miniature trains, Class 28; Champagne, Class 33; Ashtrays, Class 34.	2/24/2004

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Reg. No.	Mark	Goods/Services	Issue Date
2898412		Travel services, namely, railway passenger services. Class 39	11/2/2004
3077997	ORIENT EXPRESS HOTELS	Hotel services, restaurant and bar services, catering services, and hotel resort services. Class 43	4/11/2006
3185141	ORIENT-EXPRESS	Vehicles, namely trains. Class 12 Transportation of persons and goods by rail and air; tourism, namely arranging excursions for tourists, tourist agency services, organizing sight-seeing tours and excursions. Class 39	8/26/1991
3197807	ORIENT-EXPRESS	Transportation services of passengers by ship and travel information and agency services in connection therewith. Class 39	1/14/1998

We find that the dominant portion of both applicant's marks and those of opposers is the term "ORIENT-EXPRESS." Ms. Pines testified that although several of the marks include the words "VENICE SIMPLON,"¹⁴ its services are most frequently known and referred to as simply "Orient-Express." Pines Test. at 25. This is consistent with previous cases in which we have noted the propensity of consumers to shorten trademarks. See e.g., *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992) ("companies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck..., Ward's for Montgomery Ward's, and Bloomies for Bloomingdale's");

¹⁴ Ms. Pines' testimony indicates that "Venice" is where the ORIENT-EXPRESS trains are based and "Simplon" is the name of a

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Big M. Inc. v. United States Shoe Corp., 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks....”). Further, although we recognize that applicant’s marks and one of opposers’ include design elements, we find that the literal portions of both of these marks dominate their figurative components. See *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (if a mark “comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services”).

In this case, the wording in applicant’s mark is identical or highly similar to the marks in each of opposers’ registrations at issue here. Two of the registrations, for the marks ORIENT-EXPRESS (typed), Reg. Nos. 3185141 and 3197807, are identical to the wording in applicant’s mark, and another registration, for the mark ORIENT EXPRESS HOTELS, Reg. No. 3077997 (HOTELS disclaimed), is for virtually identical wording combined with a descriptive term. Finally, three of opposer’s registrations include the wording VENICE SIMPLON-ORIENT-EXPRESS, by itself, Reg. No. 1487834, with a design, Reg. No. 2898412,

tunnel in the Alps through which the original Orient-Express trains passed. Pines Test. at 24.

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or with the addition of the descriptive term "COLLECTION,"
Reg. No. 2815925 (COLLECTION disclaimed).

While we consider the marks in their entireties, and we have not ignored the design element included in applicant's mark,¹⁵ the visual and aural similarities between applicant's mark and opposers' are undeniable. Both prominently feature the term "ORIENT-EXPRESS," and thus look and sound substantially alike.¹⁶

We further find that the marks at issue have similar meanings. In considering the meaning of a mark, we consider the context in which it is used, including the goods or services on or in connection with which it is used. In this

¹⁵ As noted, we find that the wording is the dominant portion of applicant's mark. We further find that the design element in applicant's mark does not significantly distinguish it from opposer's marks. Nonetheless, we cannot agree with opposer's argument that the inclusion of the *fleur de lis* element in applicant's mark actually makes confusion more likely because (1) the *fleur de lis* is associated with France and SNCF is a French entity; or (2) because the fleur-de-lis is an element of the trademark of an unrelated association, Relais & Chateaux, see Reg. No. 2658201, of which opposer is an honorary member. Opp. Br. at 22. Such contentions rely on several unsupported and tenuous assumptions about what the relevant consumer would know about the parties and their marks.

¹⁶ Opposer makes much of the fact that the typeface used in applicant's mark is identical to that used in opposer's '412 Registration. Opp. Br. at 16-17. This is not, as applicant argues, an attempt by opposers to monopolize a particular typeface or font, App. Br. at 12, but simply one point of similarity between the parties' marks. While we agree with opposer that the typeface is identical or very nearly so, this fact is entitled to relatively little weight because the typeface at issue is not particularly distinctive, and is unlikely to make a strong impression upon the relevant consumers.

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regard, the "ORIENT-EXPRESS" portion of some of SNCF's marks (those registered for transportation services) connotes rapid transportation to the "orient," i.e., the east. This was undoubtedly the origin of the term "Orient-Express" as used in connection with the original rail service begun in 1883.

But in addition to opposer's transportation services, the marks on which opposers rely are also registered in connection with other goods and services. In particular, the '925 Registration (COLLECTION VENICE SIMPLON-ORIENT-EXPRESS), is registered for a variety of goods in eleven International Classes. As to these goods, the term ORIENT-EXPRESS is purely arbitrary, and identical to applicant's arbitrary usage of the term in connection with its goods.

After consideration of the relevant evidence, we find that the mark in the subject applications is substantially similar to opposers' marks. This factor thus supports a finding of likelihood of confusion.

3. The Similarity or Dissimilarity and Nature of the Goods and Services

It is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion.

Rather, it is enough that goods or services are related in some manner or that some circumstances

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surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991)
(citations omitted).

In this case applicant seeks registration of its mark for use on "cigars and smoking tobacco," in International Class 34, and "perfume, cologne, eau de toilette, eau de parfum, and eau de cologne" in International Class 3. As set out above, opposer has introduced registrations covering a variety of goods and services. In addition to its transportation and hotel services (and services directly related thereto), opposer's '925 Registration (COLLECTION VENICE SIMPLON-ORIENT-EXPRESS) covers goods in International Classes 8, 11, 14, 16, 18, 21, 24, 25, 28, and 33. Of particular note is opposer's registration for "ashtrays," in International Class 34.

As explained by Ms. Pines, goods are offered under the "COLLECTION" mark to travelers on board opposer's trains and in hotels operated by a related company. Pines Test. at 9, 16. In connection with Ms. Pines' testimony, opposer introduced into evidence the 1989, 1990, and 1991 versions

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of a catalogue bearing the COLLECTION VENICE SIMPLON-ORIENT-EXPRESS trademark and containing most of the goods recited in the '925 Registration, as well as a number of other luxury and gift items, such as wristwatches, decorative boxes, key rings, luggage, and briefcases. Such goods can and are shipped to the United States when requested by customers, and sales of such goods to U.S. customers are also available through applicant's web site. Pines Test. at 9-13.

Although not the subject of any of opposers' registrations of record, Ms. Pines also testified that opposer sells - or has sold - perfume atomizers:

Q. Do they sell any type of atomizers or have they ever?

A. I am not sure if atomizers are still being sold, but I know they had been sold sometime in the past.

Q. Okay.

I am going to show you a document and ask you if you recognize what type of document it is and can you identify it.

.

A. This is an invoice submitted from the collection Venice Simplon Orient Express in London to the Windsor Court Hotel, dated April the 13th of 1992, lists a variety of items that have been sent to the Windsor Court Hotel.

Q. And could you please describe those items?

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A. There is a tie clip, belt, compact, mirror, atomizer handbag, atomizer - variety of atomizers, conductor bags, Champagne glasses, enamel boxes corkscrew, luggage labels, Teddy bear, playing cards, cufflinks, money clips, card case, and cashmere scarf again.

Pines Test. at 16-17. Ms. Pines also identified documents titled "Windsor Court Hotel Stock On-Hand As Of: 10/31/93" and "Gift Shop Inventory October 1993."¹⁷ Pines Test. at 17-18; Exh. 6, 7.

As plaintiffs, opposers bear the burden of proof in this proceeding, including the burden to establish any trademark rights upon which they rely. We find that opposers' testimony and evidence do not establish that they have any current common-law trademark rights to the COLLECTION VENICE SIMPLON-ORIENT-EXPRESS mark as used on or in connection with perfume atomizers or any of the other items listed in the 1992 invoice or 1993 inventories. Unlike the case of a registered trademark, see Trademark Act § 7(b); 15 U.S.C. § 1057(b), there is no presumption of validity which attaches to "common-law" trademark rights. Even assuming opposers' evidence is sufficient to

¹⁷ While the 1992 invoice bears the words "COLLECTION VENICE SIMPLON-ORIENT-EXPRESS LTD.," neither of the 1993 Windsor Court Hotel inventories include any of opposers' marks at issue here. At best, such evidence indicates that atomizers and other items were in stock in October 1993. It does not demonstrate that such goods were branded with any of opposers' marks, or even that they were the subject of retail services offered under opposers' marks.

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demonstrate use of the COLLECTION VENICE SIMPLON-ORIENT-EXPRESS trademark in connection with the sale of perfume atomizers in 1992, the record is entirely devoid of evidence showing such use in the ensuing seventeen years. This record is clearly insufficient to support a claim to any current trademark rights with respect to such goods.¹⁸

Turning to the particular goods identified in the subject applications, we find that "cigars and smoking tobacco," in International Class 34 (App. No. 74466150), are clearly related to the "ashtrays" identified in opposers' '925 Registration. Ashtrays are related in purpose to cigars and smoking tobacco, and are intended to be used at the same time for complementary purposes.

However, based on the evidence of record, we are unable to find a significant relationship between "perfume, cologne, eau de toilette, eau de parfum, and eau de cologne" in International Class 3 (App. No. 75253372), and any of the goods or services set out in opposers' registrations.

¹⁸ In reaching this conclusion, we have given no weight to applicant's argument, App. Br. at 2, that VSOE abandoned any trademark rights it may have had in connection with International Class 3 goods when it abandoned two applications for different marks (VSOE and design), covering Class 3 goods. See App. Nos. 74108655 (abandoned Oct. 23, 1992), 74340418 (abandoned Jan. 3, 1998). Abandonment of a trademark application does not mean the same as abandonment of trademark rights. But even if it did, abandonment of VSOE's rights to the VSOE and design mark would have nothing to do with any rights it may have to the ORIENT-EXPRESS marks at issue in this proceeding.

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Although opposers argue that applicant's Class 3 goods are within their natural zone of expansion, Opp. Br. at 17, they have presented no evidence that would tend to indicate that other makers of the goods and services set out in its registrations have produced perfume and cologne, or that potential purchasers would view opposers as a likely source of such goods. We must base our decision on the evidence in the record, and not on mere argument of counsel. *See United States Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1542 (TTAB 2006).

Similarly, opposers introduced a number of registrations in an attempt to demonstrate that applicant's goods on the one hand, and opposer's goods and services on the other, are of a type which commonly emanate from a single source and would thus be related in the mind of the public. Notice of Reliance, September 11, 2007; Opp. Br. at 19. While third-party registrations which individually cover a number of different items may serve to suggest that the listed goods are of a type that may emanate from a single source, *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* (unpublished) No. 88-1444 (Fed. Cir. Nov. 14, 1988), opposers' evidence again misses the mark.

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Of the seven registrations submitted by opposers for this purpose, five were registered under the provisions of Trademark Act § 44, 15 U.S.C. § 1126, and are thus entitled to little or no weight in proving the relationship of the goods at issue. *Mucky Duck*, 6 USPQ2d at 1470, n.6. One (Reg. No. 2644906) has been cancelled, and is thus proof of nothing. The final registration (Reg. No. 1514562) is based on use in commerce. However, while the '562 Registration includes "hotel services" - as does opposers' '997 Registration - it does not include any goods such as perfume or cologne (or cigars and smoking tobacco, for that matter).

We conclude that applicant's "cigars and smoking tobacco" are closely related to the "ashtrays" identified in opposers' '925 Registration, but that applicant's "perfume, cologne, eau de toilette, eau de parfum, and eau de cologne" are unrelated to the goods and services recited in opposer's registrations. The relationship (or lack thereof) weighs in favor of a finding of likelihood of confusion in the '150 Application, but does not weigh in favor of such a finding in the '372 Application.

4. The Variety of Goods on Which a Mark Is Or Is Not Used

In this case, opposer has made of record six registrations for the mark ORIENT-EXPRESS or variations.

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These registrations cover a number of goods and services in fourteen International Classes. Opposer argues that "[i]f a mark is used on a wide variety of goods and services, the public is more likely to be confused by the use of the mark on different goods and services." App. Br. at 18.

Opposer is correct that this is a factor to be considered in a likelihood of confusion analysis, at least to the extent probative evidence has been offered in support of it. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (Fed. Cir. 1973) (factor #9); *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1195 (TTAB 2007). Indeed, "this factor may favor a finding that confusion is likely even if the goods are not obviously related." *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (TTAB 2003). This *du Pont* factor quite reasonably assumes that if the purchasing public is so accustomed to seeing a wide variety of goods in the marketplace emanating from a single source and sold under the same trademark, that they will likely assume (correctly or not) that other goods sold under the same mark share the same source - even if they are not closely related goods.

We emphasize, however, that this *du Pont* factor addresses the plaintiff's actual use of its mark, not merely its registration. The public becomes aware of trademark use

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in the marketplace, not by perusing the Principal Register. The relatively few cases which have significantly relied upon this *du Pont* factor are typically marked by evidence of a very high level of actual use of the plaintiff's marks in commerce. *E.g. Nike Inc.*, 85 USPQ2d at 1191-92; *Genesco*, 66 USPQ2d at 1267-68; *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1789-1790 (TTAB 2001).

By contrast, opposers have provided little evidence of the level of their current actual use of their marks in U.S. commerce. As discussed above, Ms. Pines testified that opposers do not currently advertise, and provided only vague testimony about opposer's worldwide annual revenue. While her testimony indicated generally that certain items were for sale on board ORIENT-EXPRESS trains, in ORIENT-EXPRESS hotels, and on opposers' web site, no sales figures were provided. Finally, it does not escape notice that the catalogues introduced to illustrate sales of opposer's goods were dated 1989, 1990, and 1991. This vague and decades-old evidence is clearly insufficient to establish that opposer's ORIENT-EXPRESS branded goods and services are currently so well-known in the market for a broad range of goods that potential purchasers would mistakenly assume that applicant's goods emanated from opposers.

We find this factor to be neutral in our analysis.

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5. Balancing the Factors

To summarize, we find that the wording ORIENT-EXPRESS is the dominant element of both applicant's mark and those of opposers' and that applicant's mark is substantially similar to opposers' marks. Further, we find that applicant's "cigars and smoking tobacco" are closely related to the "ashtrays" recited in opposers' '925 Registration, although we do not find applicant's "perfume, cologne, eau de toilette, eau de parfum, and eau de cologne" to be meaningfully related to any of the goods or services set out in opposers' registrations.

After carefully considering all of the record evidence and arguments of the parties, we conclude that use of applicant's mark on or in connection with the identified goods in Application No. 74466150 (for "cigars and smoking tobacco") would pose a likelihood of confusion in view of opposers' registrations.

On the other hand, we find that confusion is not likely with respect to the goods identified in Application No. 75253372 (for "perfume, cologne, eau de toilette, eau de parfum, and eau de cologne"). While applicant's mark is substantially similar to the mark in opposers' registrations, we find the lack of evidence demonstrating any meaningful relationship between applicant's goods and

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the goods and services of opposers is determinative in this case in the absence of other factors strongly supporting opposers' claim of likelihood of confusion.

C. Dilution

As noted, VSOE alleged that applicant's marks were likely to "dilute the distinctiveness of [o]pposer's trade name and marks." Notice of Opp. 91095769, ¶ 5; see also Notice of Opp. 91109552, ¶ 4.

In order to prevail on a claim of dilution, opposer must prove, as a threshold matter, that its mark is famous, and that it became famous prior to applicant's first use. Trademark Act § 43(c)(1); 15 U.S.C. § 1125(c)(1). As we have noted in other cases, "[f]ame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving "fame" for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

As discussed above, we do not find opposer's mark

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famous for likelihood of confusion purposes. Since it is even harder to prove fame for dilution purposes, we need go no further; because opposer has not established that its mark is famous, it cannot prevail in its dilution claim.

Decision: The oppositions to Application No. 74466150 are sustained pursuant to Trademark Act § 2(d). The oppositions to Application No. 75253372 are dismissed.