

**THIS OPINION
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THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cuban Cigar Brands, N.V.
v.
Valle Grande Limitada

Opposition No. 91165277
to Application No. 78392366
filed on March 29, 2004

Charles W. Grimes of Grimes & Battersby for Cuban Cigar
Brands, N.V.

David A. Weinstein, Esq. for Valle Grande Limitada.

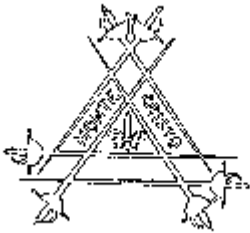
Before Walters, Walsh and Cataldo, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Cuban Cigar Brands, N.V. filed its opposition to the
application of Valle Grande Limitada to register the mark
MONTECRISTO for "olive oil," in International Class 29, and
"vinegars and balsamic vinegar," in International Class 30.¹

¹ Application Serial No. 78392366, filed March 29, 2004, based upon an
allegation of a bona fide intention to use the mark in commerce in
connection with the identified goods.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered marks shown below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

MARK	GOODS and NOTATIONS	REGISTRATION NO.
MONTECRISTO	Cigars	1173547
	Cigars, cigarettes, and cut tobacco	0332324
MONTE CRISTO	Cologne, after-shave lotion, cuff links, wallets, bathrobes, scarves, headwear. "The English translation of Monte Cristo is Mountain of Christ."	2236889
MONTE CRISTO	Desk sets, desk pads, pens, stands for pens and pencils, golf balls, cigar cases not of precious metal.	2304416

	"The English translation of Monte Cristo is Mountain of Christ."	
MONTECRISTO	Hat ornaments not of precious metal, ashtrays not of precious metal, credit card services	2396980
MONTECRISTO	Cocktail lounge, bar and restaurant services; night clubs	2623858
MONTECRISTO	Alcoholic beverages	2594564
MONTECRISTO	Ground and whole bean coffee "The English translation of Monte Cristo is Mountain of Christ."	2855557

As an additional ground of opposition, opposer asserts that its MONTECRISTO mark is famous in connection with premium cigars; that its mark has been distinctive and famous in the United States since before applicant acquired any rights in its mark; and that registration of the opposed mark will dilute the distinctive quality of opposer's famous marks.

Applicant, in its answer, admitted that it has not made use of MONTECRISTO as a trademark in the United States; that applicant's mark "is exactly similar in appearance and sound" to opposer's pleaded MONTECRISTO marks in Registrations Nos. 1173547, 2396980, 2623858, 2594564 and 2855557; and that opposer submitted copies of its pleaded registrations with its notice of opposition. Otherwise, applicant denied the salient allegations of opposer's claims.

Preliminary Matters

There are several procedural and evidentiary matters to address before we turn to the merits of this opposition. First, opposer submitted with its notice of opposition photocopies of its pleaded registrations; but, it did not submit status and title copies of these registrations as required by Trademark Rule 2.122(d)(1), 37 C.F.R. §2.122(d)(1). See TBMP §§704.03(b)(1) and 704.05. However, applicant, in its brief, does not challenge the competence of the photocopies of opposer's pleaded registrations and, in fact, states that "[b]ased upon opposer's evidence and the constructive use effect of its federal registrations, opposer's priority date is earlier than applicant's priority date" and that "opposer's evidence in support of its claims must be limited to (1) the constructive use effect applicable to its pleaded registrations for priority

purposes and, (2) only the goods and services recited in those registrations" (brief, pp. 8 and 22, respectively). Therefore, we deem applicant to have conceded the ownership and subsistence of the pleaded registrations.

Second, opposer submitted its own responses to applicant's interrogatories as an exhibit to the testimony of Mr. Workman. Other than to acknowledge their identity and sign a verification that the answers are true and correct, Mr. Workman did not discuss the interrogatory responses document. Interrogatory responses may be made of record only by the inquiring party, except under the provisions of Trademark Rule 2.120(j)(5), 37 C.F.R. §2.120(j)(5), or upon the stipulation of the parties. See TBMP §704.10 and cases cited therein. Applicant, in its brief, has not objected to this submission, has listed these interrogatory responses as being part of the record before the Board, and has relied extensively on these responses in arguing its position. Therefore, we deem applicant to have stipulated to the submission by opposer of its responses to applicant's interrogatories.

Third, opposer submitted by notice of reliance documents characterized as having been produced in response to applicant's document production request. It is immaterial that such documents were part of opposer's document production to applicant and applicant has not

objected to this material. Each of the documents in Exhibits B through G is an excerpt from a print publication in general circulation and, thus, has been properly submitted by notice of reliance. Exhibits H and J are excerpts from print publications obtained online and, as such, are also properly submitted by notice of reliance. However, Exhibit I consists of excerpts of advertisements from Internet websites. Contrary to opposer's statement in its notice of reliance, these Internet excerpts are not self-authenticating in nature and thus not admissible by notice of reliance. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). It appears that some if not all of these exhibits are also submitted as exhibits to Mr. Workman's testimony. However, Mr. Workman does not authenticate these exhibits during his testimony. Despite applicant's failure to object to this evidence, it is of no probative value due to its lack of authentication and, thus, the Board has not considered this Internet evidence.

Fourth, applicant objects to the testimony deposition by opposer of Mr. Workman, stating that "a certified copy of the Workman Tr. Dep. ... does not appear to have been filed in this proceeding as required under 37 CFR §2.125 [TBMP §703.01(k)]." (Applicant's Brief, p. 9.) Applicant does not specify any deficiency it perceives in the filing of the deposition other than the alleged lack of certification.

However, except that it is not signed by the witness as required under 37 CFR §2.123(e)(5), all requirements for filing the deposition, including certification, have been met. With regard to the lack of signature, we refer to 37 CFR §2.123(j), which provides, in part, that "[n]otice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule." Generally, procedural objections to testimony depositions must be raised promptly or they are waived. See TBMP §707.03(c). In this case, applicant has not alleged any injury from this procedural irregularity. Further, this is an irregularity that could have been cured if promptly presented, but applicant waited until its final brief to raise the alleged lack of certification and did not raise the lack of signature at all. Therefore, we find applicant's objection to be waived. In any event, applicant has not challenged the substance of the deposition and, thus, we find the deficiency sufficiently insignificant in this instance to permit us to consider Mr. Workman's testimony deposition herein.

Finally, we address a substantive issue raised by applicant for the first time in its brief. Applicant makes a number of arguments that are essentially the same

argument, namely, that opposer is not the proper plaintiff in this case or the proper owner of the pleaded marks and registrations because it does not use the marks or otherwise control the use of the marks or the quality of the products and services identified hereunder. Despite the fact that applicant devoted a substantial amount of its briefing to this argument, it is not well taken. Opposer is the wholly owned subsidiary of Altadis U.S.A., and Altadis U.S.A. clearly controls the licensing and use of the involved marks and the manufacture of the identified goods and rendering of the identified services. We note the following statements in this regard by Mr. Workman during his testimony deposition:

Q What is your current place of employment? Who is your employer?

A Altadis U.S.A.

. . .

Q Has the company always been known as Altadis U.S.A. ?

A No. It used to be known as Consolidated Cigar, who I started with. In 2000 Consolidated Cigar merged with HavaTampa Cigars and formed Altadis U.S.A.

Q What is Cuban Cigar Brands, N.V.?

A That is a trademark company that is a subsidiary of Altadis U.S.A.

Q Do you know if it is a wholly owned subsidiary of Altadis?

A To the best of my knowledge, yes, sir.

Q So for the balance of this deposition, whenever I refer to quote, Altadis, close quote, I would like to have you understand that I'm referring not only to Altadis U.S.A. Inc., but also to its predecessor, Consolidated Cigar Corporation and to its wholly owned subsidiary Cuban Cigar Brands, N.V. Is that understandable to you?

A Yes.

We note that, in any event, applicant's claims of non-use and abandonment by opposer of its marks are unavailing because they constitute impermissible collateral attacks on opposer's registrations in the absence of counterclaims to cancel those registrations.

The Record

The record consists of the pleadings; the file of the involved application; the pleaded registrations; various specified responses of applicant to opposer's interrogatories and requests for admissions and excerpts from printed publications, all made of record by opposer's notice of reliance; and the testimony deposition by opposer of Eric Workman, vice president, marketing and national accounts at Altadis U.S.A., opposer's parent company, with accompanying exhibits. Applicant submitted no testimony or other evidence. Both parties filed briefs on the case.

Factual Findings

Opposer is the wholly owned subsidiary of Altadis U.S.A. (hereinafter referred to together as "opposer"), which primarily manufactures and sells premium and mass-

market cigars. The MONTECRISTO brand, one of opposer's brands, primarily identifies a premium cigar. It is sold to approximately 2000 premium retailers by its thirty-five person premium cigar sales force (Workman Dep. p. 7-8, 15), although one of its five types of MONTECRISTO cigars is aimed at the mass market and distributed in convenience stores, Walgreens and CVS, among others (id. at p. 27, 34).

Opposer also markets its MONTECRISTO cigars through wholesale distributors, who resell the cigars to consumers via the Internet or to restaurants, nightclubs and golf courses designated by opposer (id. at p. 15) (see also Exhibit 2 to Workman Deposition, Opposer's Answer to Interrogatory No. 2, hereinafter "Workman Dep. Ex. 2, No. 2").

Opposer has licensed the MONTECRISTO brand for use in connection with coffee (id. at p. 30) and alcoholic beverages (Workman Dep., Ex. 2, No. 2). Opposer has licensed the mark for use on a variety of ancillary items, including coffee mugs, ashtrays, hats, and ashtrays, all prior to the filing date of the application herein. During Christmas 2004, opposer promoted a package combining MONTECRISTO cigars, coffee and a demitasse cup to approximately 1200 retailers (id. at p. 30). Opposer has also licensed the MONTECRISTO brand for use in connection with, for example, rum and credit cards (id. at p. 47).

Historically, premium cigar retailers sold only cigars and tobacco, but they have branched out to include a variety of items including fine coffees (*id.* at p. 28-29).

Retailers' catalogs and websites that include opposer's cigars also include clothing items, hats and items such as coffee cups, beer steins, golfing accessories and, occasionally, fancy food items such as chocolates and nuts (*id.* at p. 36). Most of these retailers do not include edibles or products found in the kitchen (*id.* at p. 38).

MONTECRISTO cigars were first sold in the United States in 1935 as a Cuban handmade cigar by opposer's predecessor (*id.* at p. 13). Sales in the United States occurred regularly until 1960, at which time sales were interrupted by the Cuban Embargo (*id.*). In 1978, opposer purchased the brand and has sold MONTECRISTO brand cigars in the United States since that time (*id.* at p. 14). Opposer advertises these cigars in men-oriented magazines, particularly cigar-oriented magazines (*id.* at 15-16). Opposer also conducts cooperative advertising with its retailers and sends retailers promotional items such as shopping bags, humidors, ashtrays and coffee cups to be given away and/or sold (*id.* at p. 17). The vast majority of cigar smokers are men, although Mr. Workman testified that these ancillary items may be purchased and/or used by women (*id.* at 20). Opposer's Montecristo Foundation features the cigars at

charity events and opposer promotes the MONTECRISTO brand and ancillary items on its website (id. at p. 26).

Mr. Workman stated that opposer's MONTECRISTO premium cigars are among the best-known and top-selling brands of cigars in the United States, comparing it to Cohiba, Fuente and Macanudo cigars (id. at p. 41). In the deposition of Mr. Workman, opposer's counsel indicated that the deposition would resume at later date under a protective order. However, the deposition was not continued nor was a protective order entered in this case. The record contains no evidence of sales or advertising dollar amounts either for opposer or the industry as a whole.

Based on its responses to opposer's requests for admissions and interrogatories, we find that applicant selected its mark in August 2000; that applicant has used its mark only in Chile in connection with olive oil since November 2002 and in connection with vinegars since August 2004; that applicant has not used or advertised its mark in the United States in connection with the identified goods; and that applicant intends to sell its goods in the United States directly to restaurants and, through supermarkets and specialty stores, to consumers. Applicant admits that it was aware of opposer's use of its mark in connection with cigars at the time it chose its mark (Admission No. 1); although, applicant asserts that it chose its mark based on

a Bible passage rather than any attempt to trade on opposer's good will in its marks (Answer to Interrogatory No. 2). Applicant admits that "opposer's trademark MONTECRISTO is a well-known trademark specifically in connection with 'cigars'; [but states that] consumers do not identify the opposer's trademarks with other goods different from 'cigars'" (Answer to Interrogatory No. 6).

Analysis

Because opposer's pleaded registrations are of record, and because opposer's likelihood of confusion claim is not frivolous, we find that opposer has established its 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 Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods and services covered by said registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be 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. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA

1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor we consider is the fame of opposer's marks. As our primary reviewing Court has made clear, fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. "Famous or strong marks enjoy a wide latitude of legal protection" and a famous mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); and *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). We consider opposer's claim of fame herein to pertain to its cigars, as this is its primary product by its own admission.

Applicant has admitted that opposer's MONTECRISTO mark is "well-known" in connection with cigars. However, opposer has not submitted evidence that would establish that this renown rises to the level of "fame," as that term is understood in the law. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) ("Because fame plays such a dominant role in the confusion

analysis, ... those who claim fame for product marks that are used in tandem with a famous house mark can properly be put to tests to assure their entitlement to the benefits of fame for the product marks"); *Opryland USA, Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992) ("a well-known mark enjoys an appropriately wider latitude of legal protection, for similar marks tend to be more readily confused with a mark that is already known to the public"); and *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984).

Opposer's allegation of fame, asserted in its brief and by its employee, Eric Workman, is self-serving. Further, its evidence in support of this claim is minimal, consisting of promotional materials, advertising in a several publications, and two publication excerpts, from *The Cigar Connoisseur* and *Pittsburg Business Times*, that make reference to opposer's MONTECRISTO cigars. Opposer has submitted no dollar amounts for its sales or advertising, no indication of the breadth of exposure that it receives by advertising in the aforementioned publications, and no evidence of its sales ranking vis-à-vis other cigar brands. There is no direct evidence of consumer recognition of its MONTECRISTO marks in connection with cigars and insufficient indirect evidence of the nature and extent of consumer

recognition from which to conclude that MONTECRISTO is famous in connection with cigars.² Therefore, while it is clear from applicant's concession that opposer has established a certain degree of renown for its MONTECRISTO cigars, we conclude that opposer has not established that its mark is famous in connection therewith.

In considering the evidence of record on the remaining *du Pont* 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 and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Regarding the parties' marks, as applicant admits, its mark is identical to opposer's five pleaded and established single-word MONTECRISTO marks. We also conclude that applicant's mark is essentially the same as opposer's two pleaded and established two-word MONTE CRISTO marks because the space creating the two words in these marks is insignificant and does not distinguish it from the single-word mark MONTECRISTO, which consists of the two

² Opposer emphasizes that its MONTECRISTO cigars are of premium quality. However, the fact that the mark may identify a high quality and/or exclusive product does not mean that it is a famous mark.

independently identifiable Spanish words MONTE and CRISTO. Applicant's mark is likewise substantially similar to opposer's pleaded and established design mark, which consists of the two separate words MONTE and CRISTO within a crest consisting of crossed swords. Certainly, the word portion of opposer's mark is dominant because it is the word portion of the mark that is used to call for the goods and because the shield is more in the nature of a border or carrier for the words than a highly distinctive design. Therefore, this factor weighs strongly in opposer's favor.

There is no indication that the purchasers of the respective goods and services are other than general consumers, encompassing all levels of sophistication and purchasing discretion. Thus, this factor also weighs in opposer's favor.

We turn now to the goods and services of the parties. There is no evidence that cigars and olive oil and vinegar are related items or items that may be perceived by consumers as coming from the same source. For example, there is no evidence that such items may be used together or that they are complementary products; nor is there evidence that they would be sold in the same stores or in close proximity in the same stores. Mr. Workman testified that tobacco and cigar stores have expanded to include sales of specialty items such as coffee, nuts and chocolate.

However, it is mere speculation to conclude that this would also include sales of olive oil and vinegar, especially in view of Mr. Workman's testimony that most of these retailers do not include edibles or products found in the kitchen. Opposer indicates that its cigars are available at some restaurants and nightclubs and opposer indicates that it will sell its products to restaurants. However, there is no evidence indicating, even if these goods did appear in the same stores and restaurants, that consumers encountering these products would believe that these disparate items come from the same source.

The additional items identified in the pleaded registrations include smoking accessories, such as, cigar cases and ashtrays; personal items, such as, cologne, after-shave lotion, cuff links, wallets, bathrobes, scarves, headwear and hat ornaments, desk sets, desk pads, pens, stands for pens and pencils, golf balls; as well as Alcoholic beverages and ground and whole bean coffee. Opposer's identified services include credit card services; and nightclub, cocktail lounge, bar and restaurant services. There is no evidence that these goods and services, either individually or considered as a group, have any relationship to olive oil and/or vinegar. Many of opposer's products, as well as its credit card services, are logical ancillary items which service to promote opposer's primary product

under its mark - cigars. There is no evidence in the record that olive oil or vinegar logically fall into that category. In view of the great differences between opposer's goods and services and applicant's goods, we find that this factor is determinative.

Therefore, in view of the wide differences between applicant's identified goods and opposer's identified goods and services, and despite the identity of the marks, we conclude that there is no likelihood of confusion.

Opposer has not established the fame of its marks in connection with cigars or the identified goods and services in its pleaded registrations and, thus, its dilution claim must fail.

Decision: The opposition is dismissed.