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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209617
Party	Plaintiff XIKAR, INC.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

XIKAR, INC.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91209617
	)	Application Serial No. 85/652,496
BRAM WARREN COMPANY	)	Mark: CICAR
	)	
Applicant.	)	
	)	

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Federal Rule of Civil Procedure 56 and Trademark Rule of Practice 2.127, Opposer, Xikar, Inc. ("Xikar"), hereby moves the Board for entry of summary judgment on Xikar's opposition to Applicant's application for trademark registration as well as Applicant's counterclaim for cancellation of Xikar's U.S. Trademark Registration No. 2,200,215. In support of this motion, Xikar incorporates by reference its Brief in Support and accompanying fifty-five (55) exhibits, filed and served concurrently herewith. Because there is no genuine dispute as to any material fact and Xikar is entitled to judgment as a matter of law, Xikar's motion should be granted.

WHEREFORE, Xikar respectfully requests that summary judgment be entered in its favor on its opposition to Applicant's application for trademark registration and Applicant's counterclaim for cancellation of Xikar's U.S. Trademark Registration No. 2,200,215. Additionally, Xikar requests the suspension of the Opposition and the Cancellation proceedings, pursuant to Trademark Rule of Practice 2.127(d) pending resolution of this Motion.

Respectfully submitted,

Dated: 3-13-2014

By _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION FOR SUMMARY JUDGMENT has been served upon Debra Wiseberg d/b/a Bram Warren Company, 18100 S.W. 50 Street, Southwest Ranches, Florida 33331 by deposit in the United States Mail with first class postage thereon fully prepaid, this 13th day of March 2014.

Ginnie C. Derusseau

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

XIKAR, INC.	)	
	)	
Opposer,	)	
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BRAM WARREN COMPANY	)	Mark: CICAR
	)	
Applicant.	)	
	)	

OPPOSER'S BRIEF IN SUPPORT OF
ITS MOTION FOR SUMMARY JUDGMENT

Xikar, Inc. opposed Bram Warren Company's application for registration of the trademark CICAR on the ground that use and registration of CICAR is likely to be confused with Xikar's XIKAR mark. Bram Warren responded to Xikar's Opposition and counterclaimed for cancellation of Xikar's registration for XIKAR. On October 21, 2013, Bram Warren Company filed a motion to substitute Debra Wiseberg as party applicant/counterclaim plaintiff. The motion went unopposed and was granted on January 8, 2014. Now, pursuant to Federal Rule of Civil Procedure 56 and Trademark Rule of Practice 2.127, Xikar submits this Brief in Support of its Motion for Summary Judgment. In this brief, Xikar, Inc. will be referred to as Xikar or Opposer. Debra Wiseberg will be referred to as Wiseberg or Applicant and Bram Warren Company will be referred to as "BWC".

Xikar requests summary judgment as a matter of law on both its Opposition to Wiseberg's application for trademark registration as well as Wiseberg's Counterclaim for cancellation, pursuant to Federal Rule of Civil Procedure 56 and Trademark Rule of Practice 2.127.

I. INTRODUCTION

This case arises out of the Opposition filed by Xikar, the owner of an incontestable registration for the mark XIKAR, on the ground that the Applicant's mark is likely to cause confusion in the marketplace if allowed to register. Xikar put its XIKAR mark into use in commerce thirteen (13) years before Applicant used its mark and obtained its registration for XIKAR more than thirteen (13) years before Applicant filed its registration. Over the years, through continuous use, production of high quality products and excellent customer service, XIKAR has acquired considerable good will and secondary meaning in the marketplace.[1]

The XIKAR mark registered on February 6, 1997 and designated use of the XIKAR mark for cigar cutters. The XIKAR mark and trade name have also been in continuous use on a variety of cigar accessory products. In 2009, Xikar began selling ashtrays under its XIKAR mark. Xikar also owns a registration for the mark XIKAR FOR LIFE for cigars, cigar cutters, humidors, cigar carrying cases, cigar storage devices, and cigar lighters. This mark was used as early as January 31, 2010, which also precedes Applicant's use of its mark.

BWC applied to register the mark CICAR on June 14, 2012 for use on ashtrays for smokers. Within the period provided for filing an Opposition, Xikar investigated the matter and determined that use and registration of CICAR was likely to cause confusion with its XIKAR mark. Xikar duly filed a motion to obtain additional time to file its Opposition. Additional time was granted and Xikar attempted to negotiate an amicable resolution with BWC. Ultimately, the parties were not able to reach an accommodation and Xikar filed its Opposition.

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[1]Xikar is not required to demonstrate that the mark, XIKAR, has acquired secondary meaning because an incontestable mark is presumed to have a secondary meaning. However, with regard to the likelihood of confusion analysis, the viability and strength of the senior mark is a relevant consideration. This will be discussed in greater detail in Section IV-B, *infra.*

In response to the Opposition, Wiseberg filed a counterclaim to cancel the senior registered mark, XIKAR, even though that mark has become incontestable, has developed good will and secondary meaning in the market and is a strong, fanciful mark that is not generic. Because Wiseberg has no viable legal theory to support her claim for cancellation and because the marks XIKAR and CICAR are likely to cause confusion in the market as a matter of law, Opposer is entitled to summary judgment on its Opposition and Applicant's Petition for Cancellation.

II. EXHIBIT LISTING

Xikar submits the following Exhibits in support of its Uncontroverted Material Facts. These are comprised of status and title copies of the registrations and application for registration involved in this proceeding, documents produced throughout discovery and answers to interrogatories of both parties.

Exhibit 1: USPTO printout showing status and title of XIKAR Reg. No. 2,200,215

Exhibit 2: USPTO printout showing status and title of XIKAR FOR LIFE Reg. No. 4,375,111

Exhibit 3: Specimens of use submitted with application for registration of XIKAR

Exhibit 4: Specimen of use submitted with § 8 and 15 affidavit for application for registration of XIKAR

Exhibit 5: May 1, 1997 Xikar Press Release and website

Exhibit 6: Letter evidencing early use of XIKAR

Exhibit 7: Printout of Xikar website as it appeared in 1999

Exhibit 8: Printout showing evolution of Xikar website since 1999

Exhibit 9: FujiPub.com letter confirming Xikar advertising as early as June 1997

Exhibit 10:	Printout showing use of Xikar in advertising on Fujipub.com website as early as February 1998
Exhibit 11:	Xikar 1999 Catalog
Exhibit 12:	Early Xikar Catalog
Exhibit 13:	Xikar 2005 Catalog
Exhibit 14:	Xikar Spring 2007 Catalog
Exhibit 15:	Xikar Fall 2008 Catalog
Exhibit 16:	Xikar Fall 2009 Catalog
Exhibit 17:	Xikar Fall 2010 Catalog
Exhibit 18:	Xikar Fall 2011 Catalog
Exhibit 19:	Xikar Fall 2012 Catalog
Exhibit 20:	Xikar Fall 2013 Catalog
Exhibit 21:	Sample Xikar Wholesale Price Lists from Summer 2013, Fall 2012, Fall 2011, Fall 2010, and Fall 2008
Exhibit 22:	Excerpt from current Xikar Website
Exhibit 23:	Sample Xikar advertisements 2002-2013
Exhibit 24:	Sample Xikar products as sold from Xikar website currently
Exhibit 25:	Photographs of sample Xikar punch cutter and lighter and packaging
Exhibit 26:	Sample Xikar press releases from 2003-2012
Exhibit 27:	Fall 2007 article in Cigar Magazine entitled "Reinventing the Cigar Accessory" about Xikar
Exhibit 28:	February 27, 2007 article from the Kansas City Star Newspaper entitled "Seeing Your Invention Through" about Xikar's development
Exhibit 29:	July 2010 "Behind the Scenes" article in Cigar Nut about Xikar
Exhibit 30:	January 2012 Xikar interview in Cigar Press Magazine

Exhibit 31: August 30, 2012 article entitled "XIKAR: The Story Behind the Blades"

Exhibit 32: A print-out listing a sampling of the blogs forums on which Xikar is featured

Exhibit 33: Samples of Xikar product reviews

Exhibit 34: Google Analytics showing the popularity of the Xikar website

Exhibit 35: Xikar website print-out showing where Xikar products are sold

Exhibit 36: Sample of internet retailers that sell Xikar products

Exhibit 37: Sample of invoices showing sales of Xikar products since 2008

Exhibit 38: Xikar testimonials from Cigarfamily.com from 2001

Exhibit 39: September/October 2002 review of Xikar cigar cutter from Cigar Aficionado

Exhibit 40: Xikar testimonials from its website posted since 2004

Exhibit 41: Xikar Facebook testimonials since June 2012

Exhibit 42: Xikar customer service review on Youtube.com: http://www.youtube.com/watch?v=Yp0sRs3hiE0

Exhibit 43: Xikar product reviews and testimonials from Puff.com since 2006

Exhibit 44: Xikar testimonials from Cigaraficionado.com since 2009

Exhibit 45: Xikar cigar cutter review from Cigarsinternational.com

Exhibit 46: Xikar cigar cutter reviews and testimonials from Amazon.com

Exhibit 47: Xikar cigar lighter review from SeriousCigars.com

Exhibit 48: Xikar cigar cutter review from TechMarking.com

Exhibit 49: Excerpt from Oxford Dictionary

Exhibit 50: Opposer's Answers and Supplemental Answers to Applicant's First Set of Interrogatories

Exhibit 51: Opposer's Answers to Applicant's Second Set of Interrogatories

Exhibit 52: USPTO printout showing status and title of CICAR application Serial No. 85/652,496

Exhibit 53: Applicant's Responses and Objections to Opposer's First Set of Interrogatories

Exhibit 54: Applicant's Supplemental Answers and Objections to Opposer's First Set of Interrogatories

Exhibit 55: The Cigar Lounge Online Forum

III. STATEMENT OF UNDISPUTED MATERIAL FACTS

1. Opposer's predecessor in interest filed an application for federal registration of the mark XIKAR for cigar cutters on August 19, 1996 based on an intent to use the mark, and began using the mark XIKAR on cigar cutters as early as February 6, 1997. Exs. 1, 3.

2. Opposer's predecessor in interest obtained U.S. Trademark Registration No. 2,200,215 for XIKAR for cigar cutters in International Class (IC) 034 on October 27, 1998. Ex. 1.

3. The XIKAR registration was assigned to Opposer on March 25, 2004. Ex. 1.

4. Opposer's mark attained incontestable status on May 25, 2004 when its Section 15 Affidavit of Incontestability was accepted by the Trademark Office. Ex. 1.

5. Opposer also uses its XIKAR mark on a variety of cigar accessories, including ashtrays. Exs. 11-21, 24, 25, 27, 37, 50 (Ans. Nos. 10, 26).

6. Opposer began using its XIKAR mark in connection with ashtrays in 2009. Exs. 16-21, 24, 37, 50 (Ans. Nos. 26, 28).

7. Opposer and its predecessor in interest have used the XIKAR mark continuously since 1997. Exs. 4, 4-48, 50 (Ans. Nos. 23, 26, 28, 29), 51 (Ans. Nos. 17, 18).

8. Opposer also owns U.S. Trademark Registration No. 4,375,111 for the mark XIKAR FOR LIFE, in IC 034 for cigars, cigar cutters, humidors, cigar carrying cases, cigar storage devices, and cigar lighters and began using the mark as early as January 31, 2010. Ex. 2.

9. Opposer's XIKAR mark is a made-up word, not found in the dictionary. Ex. 49.

10. Opposer's mark was inspired by the first Spanish spelling of the Taino word for cigar, which is "sikar." The Tainos were the indigenous populations of Hispaniola and Cuba. The "X" represents two blades of a cigar cutter. Exs. 22, 31.

11. Opposer has advertised and promoted products sold under its XIKAR marks extensively. Exs. 9, 10, 23.

12. XIKAR is a renowned mark within its product category and has developed a reputation as a reputable brand of high quality. Exs. 7, 8, 22, 26-36, 38-48, 55.

13. Opposer sells several lighters and cutters with art inspired by Mayan designs. Opposer has also stated in past marketing materials that its name was inspired by the Mayan word for cigar, namely "sicar". Exs. 26, 27, 30.

14. On June 14, 2012 Applicant applied for registration of the mark CICAR in IC 034 for ashtrays for smokers. Ex. 52.

15. The only product currently sold in connection with Applicant's mark is a vehicle ashtray for tobacco products. Ex. 53 (Ans. Nos. 7, 8).

16. The difference in spelling and alleged difference in pronunciation are the sole factors identified by Applicant to support its position that XIKAR and CICAR are not confusingly similar. Ex. 54 (Ans. No. 21).

17. Applicant claims first use of the mark CICAR as of June, 2011. Ex. 52.

18. Opposer's mark and Applicant's mark are capable of identical pronunciations. Exs. 27, 31, 38, 50 (Ans. No. 4), 51 (Ans. No. 4).

19. Although Opposer has developed its preferred pronunciation for its XIKAR mark, customers use a variety of pronunciations. Exs. 22, 26, 27, 31, 38, 44.

20. Opposer's mark and Applicant's mark both have five letters. Both end in a strong "AR" sound. Both begin with letters that indicate an initial sound of "zih," "sih," or "sai." Both contain a middle letter that would indicate a "hard K" sound. Both have the same number of letters in each syllable and the same number of syllables. Ex. 51 (Ans. No. 4).

21. Opposer's mark and Applicant's mark are used on ashtrays and both Applicant and Opposer market and sell ashtrays that are designed to fit in automobile cup-holders. Exs. 24, 53 (Ans. Nos. 7, 8).

22. Opposer's first use of its mark on ashtrays (2009) predates Applicant's alleged first use on ashtrays (June 2011). Exs. 16, 37, 52.

23. Opposer's cigar accessory products associated with Opposer's registered marks, XIKAR and XIKAR FOR LIFE, are sold world-wide through retail establishments and the internet. Exs. 35, 36, 50 (Ans. No. 36).

24. Applicant's CICAR ashtrays are sold through the internet via its website and retail cigar stores. Ex. 53 (Ans. No. 11).

IV. STANDARD OF REVIEW

Summary judgment shall be granted "if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); Trademark Trial and Appeal Board Manual of Procedure § 528.01, 3d Ed.

(June 2013). The movant bears the initial burden of demonstrating that no genuine issue of material fact exists. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). A factual dispute is genuine only if, based upon the evidence in the record, a reasonable fact finder could resolve the matter in favor of the nonmovant. *See e.g., Opryland USA, Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 850, 23 U.S.P.Q. 2d 1471, 1472 (Fed. Cir. 1992). The Board need not try issues of fact when considering a motion for summary judgment; it need only determine whether there exist any genuine issues of material fact. *See e.g., Dyneer Corp. v. Automotive Prods. PLC*, 37 U.S.P.Q. 2d 1251, 1254 (TTAB 1995).

"When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial." *Hurley Int'l LLC v. Paul Volta et al.*, 82 U.S.P.Q. 2d 1339, 1343 (TTAB 2007). "The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial." *Id.* Failure to carry this burden justifies the entry of summary judgment for the moving party. *See e.g., Celotex Corp.*, 477 U.S. at 322-24.

V. ARGUMENTS AND AUTHORITIES

A. Applicant's petition to cancel the registration of the senior and incontestable mark, XIKAR, should be denied.

Pursuant to 15 U.S.C. § 1064, within five years of the issuance of a registration, a cancellation proceeding may be brought for any reason that would have precluded the mark from registration at the time of its registration. However, once a registered mark has achieved

incontestable status, the grounds for cancellation narrow to only those permitted in §§ (3), (4) or (5) of 15 U.S.C. § 1064. The registration for XIKAR achieved that status on May 25, 2004 when its Section 15 Declaration was accepted by the Trademark Office. (Fact No. 4.) In the instant case, Applicant's attack on the Xikar registration appears to lack a logical nexus to the facts and the law. Based on the record, as a matter of law, there is no legal theory available to Applicant that could result in the cancellation of XIKAR.

1. Xikar's trademark registration is incontestable.

Xikar's predecessor in interest obtained the registration for XIKAR on October 27, 1998, and the Xikar Section 15 Declaration was accepted by the U. S. Trademark Office on May 25, 2004, at which time the registration became incontestable. (Fact Nos. 2-4.)

An incontestable trademark is subject to cancellation on limited and narrow grounds. It can no longer be attacked on the basis that the lacks distinctiveness or creates a likelihood of confusion with a senior mark. Although it is difficult to ascertain Wiseberg's specific grounds for seeking cancellation, a review of Wiseberg's pleadings and responses reveals three plausible possible claims: (1) genericness; (2) fraud; and (3) disparagement or false connection with persons, institutions, beliefs or national symbols. 15 U.S.C. § 1115(b). As further elaborated below, all of these grounds for cancellation are not just invalid, they are frivolous.

2. XIKAR is not generic.

Applicant seems to argue that because Opposer's inspiration for the word XIKAR was the Taino word for cigar, namely *sikar*, or Mayan word for cigar, namely *sicar* (Fact Nos. 10, 13), XIKAR is rendered generic. As noted in TMEP 1209.01(c), a two-part test is used to determine whether a term is "generic:"

> (1) What is the genus of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that genus of goods or services? *H. Marvin Ginn Corp. v. Intl. Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public.

First, the mark in question is XIKAR and not *sikar*, *sicar* or *cigar*. XIKAR is a made-up word. It does not appear in the dictionary. (Fact No. 9.) XIKAR therefore cannot (and does not) refer to any genus or class of goods. To the contrary, the mark XIKAR is fanciful. The protection accorded trademarks is directly related to the mark's distinctiveness. "Fanciful," "arbitrary," and "suggestive" marks are inherently distinctive, and thus receive the greatest protection against infringement. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11.4. Fanciful marks are, in essence, made-up words expressly coined for serving as a trademark. Some examples of fanciful marks are Clorox®, Kodak®, Polaroid®, and Exxon®. *Id.* at § 11.8; *see also Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996). There is absolutely no basis for cancellation on the ground that XIKAR is generic.

Applicant is not able to make the leap from *sikar* (or *sicar*) as an inspiration for the made-up word XIKAR to the argument that the inspired mark XIKAR is generic because the inspirational antecedent has the meaning "cigar" in an ancient and obscure language. Applicant's "genericness" theory is flawed, facially frivolous and has, in fact, been rejected in *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 U.S.P.Q. 2d 1481 (S.D.N.Y. 1997) (applicant had no obligation to disclose that the term COHIBA for cigars means "tobacco" in the language of the Taino Indians in the Dominican Republic, because cigar smokers in the United States would not be aware of such a meaning). The Court referenced a Second Circuit holding which stated "A word which is not in general or common use, and is unintelligible and non-descriptive to the general public, although it may be known to linguists and scientists may be

properly recognized as arbitrary and fanciful and capable of being used as a trademark or trade-name." *Id* (citing *Le Blum Import Co. v. Coty*, 293 F. 344, 358 (2d Cir. 1923)). As applied to this case, one cannot read or hear the word XIKAR and read it to mean "cigar." As a result, the consumer's ability to associate XIKAR with cigar accessories is largely the result of Xikar's continuous efforts and investment in quality and customer service with regard to its business. This is the opposite of a generic mark.[2]

3. Use of the trademark XIKAR does not falsely suggest a connection to the Mayan culture.

Use of the mark XIKAR does not falsely suggest a connection to the Mayan culture. Other cultures and languages are a source for trademark names. The use of a term to inspire adoption and use of a fanciful mark is not a basis for cancelling an incontestable registration. *See id.* As a matter of law, this is no basis for cancellation.

4. There is no evidence in the record that Xikar obtained its registration deceptively.

Finally, although there is no evidence anywhere to support it, Applicant seems to argue that the registration for XIKAR was obtained deceptively. In its petition, Applicant implies that somehow Xikar had an obligation to actively inform the examining attorney that XIKAR was inspired by the Mayan word *sikar* (or *sicar*) which translates to mean cigar in English. Xikar was not required to explain its inspiration for its made-up name at the time of its registration. *Id.* And, once again, XIKAR and the Mayan word *sikar* (or *sicar*) are not the same.

[2]*See* discussion regarding the strength of the XIKAR mark and its secondary meaning at B-3, *infra.* Proof of secondary meaning is not required as part of this discussion regarding cancellation because the XIKAR mark is incontestable and incontestable marks are presumed to have secondary meaning. Consumers' ability to associate qualities of quality and high-level customer service with a made up name like XIKAR is a testament to the strength of this fanciful mark.

5. Xikar is entitled to summary judgment on Applicant's petition for cancellation.

Applicant cannot meet any of the requirements for cancellation of an incontestable mark. No material facts are in dispute. As a matter of law Xikar is entitled to judgment on Applicant's counterclaim for cancellation of the incontestable registered mark XIKAR.

B. Opposer's opposition should be granted because a likelihood of confusion exists between the marks.

Opposer has the right to exclude others from using any name, mark or designation confusingly similar thereto, including CICAR. *See* 15 U.S.C. § 1114(1)(a); *Beer Nuts, Inc. v. Clover Club Foods Co.,* 805 F.2d 920, 924 (10th Cir. 1986). Because a likelihood of confusion exists between the marks, the opposition should be granted.

The *du Pont* test is applied to determine whether two marks are confusingly similar. *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Although multiple factors apply under *du Pont*, certain factors are traditionally prominent. *Mattel, Inc. v. Funline Merchandise Co.,* 81 U.S.P.Q. 2d 1372 (TTAB 2006). Those factors are: 1) similarity of the marks, and 2) the relatedness of the goods on which the marks are used. Another factor to consider is overlap in trade channels. *Id*; *See generally* TMEP 1207.01. In the instant case the strength and fame of the XIKAR mark also factor into the analysis. *See* TMEP 1207.01(d)(ix). As noted in many cases, the *du Pont* test is appropriately tailored to the factors raised in the record and the relevant issues pertaining to the marks. *See, e.g., In re Majestic Distilling Co.,* 315 F.3d 1311, 65 U.S.P.Q. 2d 1201, 1204 (Fed. Cir. 2003) ("Not all of the du Pont factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case.'").

Applying these principles to the instant case, four factors are worthy of consideration:

(i) the degree that the two marks are identical or similar;

(ii) the relatedness of the goods in connection with which the marks are used;

(iii) the overlap in channels of trade; and

(iv) the strength and fame of the XIKAR mark.

1. CICAR and XIKAR are similar.

Although not identical, the marks have a similar appearance. Differences in spelling are generally insufficient to avoid a finding of likelihood of confusion. In fact, it has long been recognized that the substitution of one or two letters may be insufficient to support a finding of dissimilarity when the marks are similar in sound and meaning, especially where the goods and services are closely related. As stated in TMEP 1207.01(b)(ii):

> Marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. *See, e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 U.S.P.Q. 2d 1840 (Fed. Cir. 1990) (finding TMM confusingly similar to TMS); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 U.S.P.Q. 2d 1813 (Fed. Cir. 1987) (affirming Board's holding that source confusion is likely where COMMCASH and COMMUNICASH are used in connection with identical banking services); *Ava Enters. v. Audio Boss USA, Inc.*, 77 U.S.P.Q. 2d 1783 (TTAB 2006) (finding AUDIO BSS USA and design similar in appearance to BOSS AUDIO SYSTEMS (stylized)); *In re Lamson Oil Co.*, 6 U.S.P.Q. 2d 1041 (TTAB 1987) (finding TRUCOOL and TURCOOL confusingly similar in appearance); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (finding NEWPORTS and NEWPORT to be essentially identical in appearance); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (finding MILTRON and MILLTRONICS (stylized) to be highly similar in appearance); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (finding difference between marks LUTEX and LUTEXAL insufficient to avoid source confusion).

XIKAR and CICAR are similar in appearance and sound, even though they have slightly different spellings. It is worth noting that in *Canadian Imperial Bank, Ava Enters., Pellerin Milnor*, and *BASF*, the spellings were found to be confusingly similar even though the marks had different numbers of syllables and letters. In the *Canadian Imperial Bank* case, the Federal Circuit explicitly recognized that in the context of the similarity of the relevant market and the relatedness of the goods and services, COMMCASH and COMMUNICASH were similar enough in appearance to cause confusion in the marketplace, even among sophisticated customers. 811 F.2d 1490. The marks in the instant case are even more similar that the marks in *Canadian Imperial Bank* case, because XIKAR and CICAR have the same number of letters, have the same number of letters in each syllable and the same number of syllables. Furthermore, they both contain a middle "hard k" sound and end in "AR". (Fact No. 20.) As a result, as in *Canadian Imperial Bank*, the marks in this case are more than similar enough in appearance to cause confusion in the market.

In addition, the marks are similar in sound because they are capable of the same pronunciation. (Fact No. 18.) The law is clear that the Trademark Office should not seek to find the "correct" or intended pronunciation of a trademark term to determine if the words are pronounced in exactly the same manner. Section 1207.01(b)(iv) of the TMEP specifically points out that consumers may pronounce a mark in any number of ways:

> Similarity in sound is one factor in determining whether the marks are confusingly similar. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re White Swan, Ltd.*, 8 U.S.P.Q. 2d 1534, 1535 (TTAB 1988). For purposes of the §2(d) analysis, there is no "correct" pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark; therefore, "correct" pronunciation cannot be relied on to avoid a likelihood of confusion. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 U.S.P.Q. 2d 1905, 1912 (Fed. Cir. 2012) (upholding the Board's affirmance of a Section 2(d) refusal to register XCEED for agricultural

> seed based on a likelihood of confusion with the registered mark X-SEED and design, SEED disclaimed, for identical goods);

This Board has held that "correct pronunciation" of a term "cannot be relied upon" by an applicant seeking to avoid a finding of likelihood of confusion. *In re Lamson Oil Co.*, 6 U.S.P.Q. 2d 1041, 1042 n.3 (TTAB 1987) ("[C]orrect pronunciation as desired by the applicant cannot be relied upon to avoid a likelihood of confusion."); *see also Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*, 77 U.S.P.Q. 2d 1698, 1701 (TTAB 2006) (acknowledging that "there is no correct pronunciation of a trademark" and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985) (holding SEYCOS and design for watches, and SEIKO for watches and clocks, likely to cause confusion); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (holding CAYNA (stylized) for soft drinks, and CANA for, *inter alia*, canned and frozen fruit and vegetable juices, likely to cause confusion); *In re Energy Telecomms. & Elec. Ass'n,* 222 USPQ 350 (TTAB 1983) (holding ENTELEC and design for association services relating to telecommunications and other electrical control systems for use in the energy related industries, and INTELECT for promoting, planning, and conducting expositions and exhibitions for the electrical industry, likely to cause confusion).

Xikar knows from experience that its customers do not stick to one set pronunciation. (Fact No. 19.) XIKAR and CICAR may both be pronounced SIH KAR or SAI CAR. Evidence in the record shows that, in fact, Opposer's original intent was that the mark would be pronounced SIH CAR but that some customers read the mark as ZIH CAR. (Fact No. 20.) Other customers continue to pronounce the name as SIH KAR or SAI CAR. (Fact No. 19.) Furthermore, in the tobacco accessory context, both marks are quite likely to be pronounced SIH

KAR due to the way that Americans pronounce "cigars" and "cigarettes." This indicates a very high likelihood of confusion.

Even if the pronunciations are slightly different, they are still so close as to cause a likelihood of confusion. *See In re Veterra*, and *Centraz Indus., supra.* In this Opposition proceeding, the question is not what is the "right" pronunciation for XIKAR and CICAR. The Board must take the registered mark XIKAR and the proposed mark CICAR as it finds them. There is no material issue of fact that the two marks are similar enough to cause confusion in the marketplace.

2. XIKAR and CICAR are used to sell identical and related products through the same channels of trade.

Opposer and Applicant both sell accessories for smoking products in IC 034. (Fact Nos. 1-6, 14, 15.) Both Opposer and Applicant sell ashtrays and specifically, ashtrays for use in vehicles. (Fact Nos. 21, 22.) In addition to ashtrays, Opposer sells cigar cutters and other cigar-related items. (Fact Nos. 2, 5, 7.)

Just like Xikar, Wiseberg sells ashtrays for use in vehicles. (Fact Nos. 14, 15.) She seeks registration in IC 034, the same class in which the XIKAR mark has been registered for over 15 years, for CICAR for ashtrays for smokers. (Fact Nos. 2, 14.) Registration of CICAR by Wiseberg would enable her to leverage the hard-gained recognition and good will Xikar has obtained after many years of effort by confusing customers as to the origin of goods and diluting the XIKAR brand. At its essence, this is precisely what the Trademark Act is designed to prevent.

The goods or services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. TMEP 1207.01(a)(i) (citing *In re Iolo Techs., LLC,* 95 U.S.P.Q. 2d 1498, 1499 (TTAB 2010)). The inquiry is whether

the goods are related, not identical. *Safety-Kleen Corp. v. Dresser Indus.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (CCPA 1975). The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. *See* TMEP 1207.01(a)(i) (citing *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 U.S.P.Q. 2d 1894, 1898 (Fed. Cir. 2000). For example, the Federal Circuit has determined that wheat bran and honey bread are sufficiently related to run afoul of the likelihood of confusion test. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). Vehicles and pneumatic tires were sufficiently related so that the mark presented by applicant was found by the TTAB as likely to cause confusion. *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984). In the instant case, Applicant admits to selling ashtrays, a product also sold by Opposer under its XIKAR mark. (Fact Nos. 5, 15, 22.)

Thus, in the instant case, both parties already sell identical and other closely related goods which will cause confusion as to the source of the goods. As is the case in this proceeding, when the marks are similar and the goods are closely related, a likelihood of confusion exists. *In Re White Swan Ltd.*, 8 U.S.P.Q. 2d 1534 (TTAB 1988) (finding SHAKE-N-GROW for grass seed and SHAKE SCATTER & GROW for flower seeds would likely cause confusion among consumers). This is an even stronger case than *White Swan* because Opposer and Applicant use their respective marks on exactly the same type of product (i.e., ashtrays) rather than just related products. (Fact No. 21.) Moreover, Opposer started using its XIKAR mark on ashtrays years before the Applicant used its mark. (Fact No. 22.) "It is axiomatic in trademark law that the standard test of ownership is priority of use." *Sengoku Works Ltd. v. RMC Intern., Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996). This is true regardless of whether the

trademark is registered. *Vita-Mix Corp. v. Basic Holding, Inc.*, 581 F.3d 1317, 1330 (Fed. Cir. 2009) ("An unregistered mark is entitled to protection as a trademark if it is inherently distinctive or has acquired secondary meaning."); *Gen. Healthcare Ltd. v. Qashat*, 364 F.3d 332, 335 (1st Cir. 2004) ("Trademark rights may arise under either the Lanham Act or under common law, but in either circumstance, the right is conditioned upon use in commerce.").

Next, Opposer has developed a following on-line and has also established relationships with tobacco shops and other specialty retail stores through which its products are distributed. (Fact Nos. 12, 23.) Like Xikar, Wiseberg markets its products through her website on the internet and selected retail shops. (Fact No. 24.) In essence, Xikar's and Wiseberg's channels of trade and customer base are the same. (Fact Nos. 23-25.) Accordingly, the channels of trade through which Opposer and Applicant directly overlap. Moreover, because neither Applicant's product description in its application for registration nor Opposer's product descriptions in its registrations specify a channel of trade, it is presumed that the parties sell their respective goods in all of the usual trade channels for goods of this type. *Mattel,* 81 U.S.P.Q. 2d 1372.

3. XIKAR is entitled to broad protection.

A mark that is famous in its industry sector is entitled to greater protection than a weak mark. XIKAR is a unique mark that is associated with a very high level of quality and customer satisfaction. (Fact Nos. 11, 12.) Under *du Pont*, the fame of the XIKAR mark is a factor militating in favor of broader than normal protection. TMEP 1207.01(d)(ix); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 at 567. Fame for purposes of dilution is an "either or" concept but fame for purposes of likelihood of confusion is a sliding scale that is

considered as a factor under *du Pont.* [3]

The unique and valuable qualities of XIKAR in the marketplace are discernible through even a casual search of the internet. Numerous customer testimonials lauding the quality of Xikar products and the responsiveness of its customer service are readily available. (Fact Nos. 11, 12.)

Exhibits 33 and 38-48 include postings, articles, videos and reviews from satisfied Xikar, Inc. customers. Many of these are independent and not affiliated with Xikar. Xikar's reputation for quality and customer service is a unique asset and an important factor for Xikar in the marketplace, which is attached to an equally unique and distinctive name. Exhibits 22 and 23 include examples of the extensive marketing, advertising, warranty protection, customer service and brand promotion engaged in by Xikar over an extended period of time to support the XIKAR brand.

The likelihood of confusion analysis protects unique and strong marks that have gained fame among customers likely to purchase the product with which the mark is associated. Famous marks enjoy wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 U.S.P.Q. 2d 1303 (Fed. Cir. 2002) (Trademark Trial and Appeal Board erred in discounting the fame of opposer's marks ACOUSTIC WAVE and WAVE); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 U.S.P.Q. 2d 1894, 1897 (Fed. Cir. 2000) (Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark);

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[3]Fame for likelihood of confusion purposes and fame for dilution purposes, 15 U.S.C. 1125(c), are distinct concepts. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1374-75, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Fame for dilution purposes is an either/or proposition, whereas the "fame" factor in the likelihood of confusion analysis varies along a spectrum. *Id.* In this case, XIKAR is an arbitrary and fanciful mark. It is unique in the trademark registry and, quite simply, there is no other mark like it – especially in its own product sector. Furthermore, as indicated below, XIKAR is highly regarded and "famous" among cigar aficionados.

Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 353, 22 U.S.P.Q. 2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH).

As stated by the Court of Appeals for the Federal Circuit in *Kenner*, 963 F.2d at 353, 22 U.S.P.Q. 2d at 1456 (as quoted in TMEP 1207.01(d)(ix)):

> [A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. ... Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Furthermore, the law is clear that the mark in question need not be famous in the "global sense" – it need only have notoriety within the class of customers likely to purchase the product. *Palm Bay Imports,* 396 F.3d at 1375, 73 U.S.P.Q. 2d at 1695 (VEUVE CLICQUOT found to be famous within the sector of high-end wines and refusal to register VEUVE ROYALE affirmed). In this regard, the numerous customer testimonials, articles, videos and website references above demonstrate that within the market of users of tobacco accessories, the products associated with the name XIKAR are highly regarded for their quality, beauty, utility, and the customer service that stands behind the products.

The strength and the distinctiveness of the XIKAR mark is a critical factor that influences the likelihood of confusion analysis in this case in favor of Opposer. The fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." *Recot,* 214 F.3d at 1328, 54 U.S.P.Q. 2d at 1898 (emphasis added). The *Recot* case is interesting and quite analogous to the

case at bar. In *Recot*, the applicant attempted to register FIDO LAY for dog treats. Similar to this case, FIDO LAY was a clever mark that was highly suggestive of the type of product Applicant was trying to sell (FIDO LAY is a snack for dogs; CICAR is an ashtray especially designed for use in cars). According to the Federal Circuit, however, the Applicant for FIDO LAY was required to resist the "lure of undercutting ... the fame of a mark," because a famous mark casts a long shadow which competitors are required to avoid. *Id.* at 1327-28. Importantly, the applicant in *Recot* attempted to argue that the FRITO LAY mark was not registered to be associated with dog treats and therefore any fame associated with FRITO LAY was irrelevant for dog treats. The court made short work of this argument and noted:

> [T]his court and its predecessor court have consistently stated that fame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods. *See, e.g., American Sugar Refining Co. v. Andreassen*, 296 F.2d 783, 784, 132 USPQ 10, 11 (CCPA 1961) (concluding that DOMINO for sugar is confusingly similar to DOMINO for pet food); *Hunt Foods & Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 435, 151 USPQ 350, 352 (CCPA 1966) (holding that HUNT'S for canned food products is confusingly similar to HUNT for cleaning products); *Kenner Parker*, 963 F.2d at 354-56, 22 U.S.P.Q. 2d at 1457-58 (treating fame of mark and relatedness of products as separate inquiries).

Recot, 214 F.3d at 1328, 54 U.S.P.Q. 2d at 1898. In its field, the XIKAR mark is a strong, famous, and distinctive mark, just like the FRITO LAY or VEUVE CLICQUOT marks. Like VEUVE CLICQUOT, Xikar has been selling categories of products under the XIKAR name for years that are in the same product category as those that Wiseberg seeks to associate with CICAR. (Fact Nos. 2, 5-7, 14, 15.) Against this legal backdrop, as a matter of law, CICAR is confusingly similar to XIKAR on the basis of the strength, fame, distinctiveness, and incontestability of the XIKAR mark.

4. Registration of the CICAR mark should be denied.

Although the likelihood of confusion test under *du Pont* is multi-factored and rooted in the realities of economic markets, a certain amount of practical and reasonable judgment must be applied. And although each case may involve distinct considerations, the cases provide reliable guideposts that establish legal principles and structure to the likelihood of confusion analysis. In this case, the marks are similar. They are both used to sell the identical and closely related products through identical channels of trade. As a matter of law, Applicant's attempt to register CICAR in the same class for the same type of goods creates a likelihood of confusion. In this case, Applicant is undeniably attempting to associate its product under a banner that is extremely similar to Opposer's famous, senior and incontestable mark.

VI. CONCLUSION AND PRAYER FOR RELIEF

As stated at the outset of this motion and brief in support, this case arose out of a sincere interest of an owner to protect its reputable, incontestable, and famous mark – XIKAR – obtained after hard work and substantial investment. Wiseberg's counterclaim to cancel XIKAR is frivolous and fails as a matter of law because it meets none of the statutory tests for the cancellation of an incontestable mark. Furthermore, Wiseberg's application to register CICAR must be denied as a matter of law because the mark is too similar to XIKAR, is used on identical goods that are sold through identical trade channels. This is especially so given the strength, distinctiveness and fame of XIKAR in the cigar accessories industry.

Therefore, Xikar requests judgment as a matter of law against Wiseberg on its Opposition to the CICAR registration and the counterclaim for cancellation of XIKAR.

Respectfully submitted,

Dated: 3-3-2014

By Ginnie C. Derusseau

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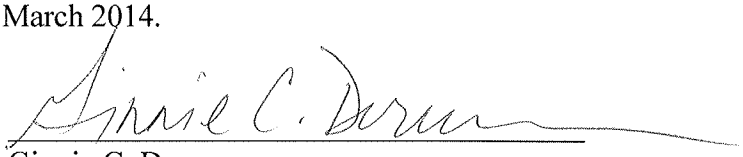
CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT and accompanying fifty-five (55) Exhibits have been served upon Debra Wiseberg d/b/a Bram Warren Company, 18100 S.W. 50 Street, Southwest Ranches, Florida 33331 by deposit in the United States Mail with first class postage thereon fully prepaid, this 13th day of March 2014.



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