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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

In re Application Serial No. 85/652,496,
filed June 14, 2012 for CICAR

XIKAR, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91209617
	)	
DEBRA WISEBERG	)	
D/B/A BRAM WARREN COMPANY,	)	
	)	
Applicant.	)	
	)	

REPLY TO APPLICANT'S RESPONSE
TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Opposer, Xikar, Inc. ("Xikar"), hereby files its reply to Applicant Debra Wiseberg's ("Ms. Wiseberg" or "Bram Warren Company" or "BWC") Response to Opposer's Motion for Summary Judgment.

I. INTRODUCTION

Ms. Wiseberg is not an attorney but has nonetheless advocated for her company throughout this proceeding. She has done an admirable job navigating the complexities of trademark law up to this point. However, BWC's latest response reveals a significant misunderstanding of substantive trademark law as well as procedural matters.

The response presents few meritorious arguments and BWC does not expressly dispute any of Opposer's material facts. In light of Applicant's response, Opposer submits that

summary judgment is appropriate because there is no genuine dispute as to any material facts and Xikar is clearly entitled to judgment under the law.

II. ANALYSIS

a. Xikar's Material Facts Remain Undisputed

BWC does not specifically dispute any of Xikar's undisputed facts. In a motion for summary judgment, if the nonmoving party does not specify which material facts are in dispute, the facts should be considered undisputed. *See* Trademark Trial and Appeal Board Manual of Procedure § 528.01 ("The nonmoving party, in turn, should specify, in its brief in opposition to the motion, the material facts that are in dispute."). While BWC does generically "deny" a few of the facts, it does not expressly dispute any facts. Even if the "denied" facts are considered disputed, the remaining undisputed facts are more than sufficient to support Xikar's motion for summary judgment. Furthermore, the evidence offered by BWC does nothing to advance its case. If anything, the evidence helps the Opposer by showing that the XIKAR mark is at least arbitrary if not fanciful. BWC's evidence also shows that the highly distinctive mark is widely recognized by consumers.

BWC objects to Xikar's use of interrogatory answers based on 37 CFR § 2.120(j)(5) which is listed in the Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 704.10. Rule 2.120(j)(5) states that generally interrogatory answers may be submitted into the record only by the inquiring party. However, the rule only applies when information is made part of the case record – not when submitting exhibits with a summary judgment motion. *See* TBMP § 528.05(a)(1) ("Evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion."). Any evidence not part of

the case record, "which a party wishes to have considered upon summary judgment, must be submitted in connection with the summary judgment motion." *Id.*; *See also Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ 2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ 2d 1142 (Fed. Cir. 1991).

The Board undoubtedly understands that it is common practice to submit interrogatory answers in support of a summary judgment motion regardless of whether the submitting party is the interrogatory inquirer or answerer. Applicant assertion to the contrary is simply incorrect.

b. XIKAR is Not Generic

Opposer admits that its trademark XIKAR was inspired by the word "sikar," which the Opposer understands to be the first Spanish spelling of the Taino word for cigar. The "X" in XIKAR was selected to replace the "s" in sikar because the shape of the "x" was easily adapted to form the crossing blades of a cigar cutter. This allows the mark to be used as standard characters (for which Opposer holds U.S. Trademark Registration No. 2,200,215) or as a design mark with the "X" tilted to look like it is cutting the adjacent "I" like a cigar.

BWC's continues to argue that XIKAR is generic and should be cancelled, but the argument has a couple of fatal defects. First, XIKAR cannot be generic because there is no product generically referred to as a "xikar". Second, Xikar's federal registration carries a presumption that the mark is valid (i.e., not generic) and BWC has not met its burden proving otherwise.

A mark is generic if it is the name of the product itself. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:1 (4th ed. 2014) (providing examples such as: APPLE would be generic for the edible fruit of an apple tree; HARP would be generic

for a stringed musical instrument). XIKAR is an entirely made-up word created by the Opposer for the sole purpose of representing the goods sold by the Opposer.[1] Because the word is made-up and has no meaning, there is no product or object called a "xikar". Accordingly, it would be impossible for the mark XIKAR to be generic because no product uses it as a name. *Id.*

Even if the Board were to construe XIKAR as meaning "cigar" due to its admitted connection to "sikar,"[2] the case cited in Opposer's motion, *General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ 2d 1481 (S.D.N.Y. 1997), summarily rejected the idea that this would be enough to invalidate the mark. "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)). BWC's argument that XIKAR is generic because it purportedly means cigar must fail.[3]

BWC's argument actually does it more harm than good. If we were to accept its argument and assume that XIKAR is a Mayan word meaning "cigar", and combine this with the

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[1] BWC tries to rebut this by pointing to an online message board purportedly showing the president of Xikar stating that the word "Xikar" was thought to be one of two spellings for the Spanish translation of the Mayan word for cigars. Regardless of who posted the misinformed message, the statement is incorrect. XIKAR is a completely fabricated word and not part of any language.

[2] BWC spends nearly three pages in its response discussing how "sikar" is actually a Mayan word rather than the Spanish spelling of a Taino word. It is unclear why it would matter whether XIKAR was inspired from the Spanish spelling of a Taino word or a Mayan word because under either scenario "sikar" is a foreign word meaning cigar, which presumably is the point of BWC's narrative.

[3] BWC's position is also weakened by its own statement that only "6,832 people speak Mayan languages at home in the US." *See* Plaintiff's Response to Opposer's Motion for Summary Judgment, p. 9. Even if the Board somehow found that XIKAR is a Mayan word recognizable by modern Mayan language speakers, only six thousand people out of the hundreds of millions of people in the United States would be able to recognize the word. There are far more XIKAR consumers that do not speak the Mayan language than those that do. Therefore, only an extremely small percentage of XIKAR consumers would even recognize a Mayan word. This would make it nearly impossible for such a word to ever gain generic status among consumers.

fact XIKAR is not used to sell cigars, the only possible conclusion would be that XIKAR is an arbitrary and inherently strong trademark.[4] *See McCarthy*, § 11:11 (Arbitrary means the ordinary meaning of the trademark is applied to goods in a totally arbitrary and nondescriptive manner. For example, "IVORY soap is not made of ivory."). "It is a fallacy that a 'common' word found in the dictionary cannot be a trademark. Thus, even a 'common' word such as 'apple' can be used as an arbitrary and inherently strong trademark on a product such as personal computers." *Id.* Both arbitrary and fanciful marks are given a broad degree of trademark protection. *See Stork Restaurant v. Sahati*, 166 F.2d 348, 76 USPQ 374 (9th Cir. 1948).

Finally, BWC's genericness argument fails due to the strong presumption of validity created by XIKAR's trademark registration. *See McCarthy*, § 12:12 (A federal trademark registration "constitutes a strong presumption that the term is not generic and defendant bears the burden of overcoming the presumption."). "[A] party seeking cancellation of a registration on the ground that the mark has become generic must carry the burden of proving that fact by a preponderance of the evidence." *Glover*, 74 F.3d at 59. BWC has not proven its case by a preponderance of the evidence. The bulk of BWC's genericness argument focuses on the background of the word "sikar", rather than the real issue of the supposed meaning of XIKAR. BWC has failed to meet its burden of proof.

c. BWC's Response Presents Several Nonsensical and Irrelevant Arguments that should be Ignored

BWC's response is an example of the old adage "throw it all against the wall and see what sticks." BWC tries to attack the XIKAR mark from every possible angle, not hesitating

[4] Opposer, however, still contends that Xikar is fanciful because it is a completely original, made-up word. *See McCarthy*, § 11:5 (Fanciful marks consist of words "that have been invented or selected for the sole purpose of functioning as a trademark.").

to use strange and frivolous arguments. For example, BWC suggests that Opposer "falsely suggests a connection to the Mayans and also falsely suggests that [it] is somehow connected to the origins of the smoking industry." *See* Plaintiff's Response to Opposer's Motion for Summary Judgment, p. 13. In support of this, BWC references a Xikar press release that jokingly referred to cigars as "xikars".[5] BWC's ambiguous allegation does not even make sense. What are the "origins of the smoking industry"? Why would the Opposer want to be affiliated with the Mayans? This allegation does not even warrant a response other than to say it is false.

BWC also alleges that the XIKAR mark was fraudulently obtained from the Trademark Office because Opposer did not provide a translation for its non-English wording. As discussed numerous times, XIKAR is a fictitious word and does have a meaning. As such, there was no translation that could be given to the Trademark Office. BWC's assertion that the mark contains "deceptive matter" or that it was fraudulently obtained is nonsense.

d. A Likelihood of Confusion Exists Between the Marks

BWC presents very little substance in its likelihood of confusion rebuttal. Most of the rebuttal comprises statements of how the fact patterns of Opposer's cited cases differ from the present case. BWC does not appear to refute any of the legal principles cited by the Opposer, and therefore Opposer's legal arguments stand unopposed. Of course, BWC adds additional irrelevant facts to many topics, but Opposer trusts the Board can sift through the obviously irrelevant information.

BWC apparently still misunderstands the concept of common law trademark rights. BWC claims that CICAR and XIKAR are not used for identical products because the

[5] The press release was clearly written as a pun between the word "cigar" and "xikar". To ensure readers understood the pun, quotation marks were used anytime "xikar" was used in place of "cigar."

XIKAR registration only lists cigar cutters. As stated in its motion, Opposer has common law trademark rights in XIKAR for ashtrays because it has used the mark to sell ashtrays for several years. The fact that Opposer uses the mark with ashtrays is sufficient to show that the marks are used on identical products. Contrary to BWC's assertion, the products for the marks are not limited to only those listed in a trademark registration.

Opposer feels compelled to briefly highlight a passage from page 18 of BWC's response. The following excerpt illustrates the fundamental misunderstanding Applicant has regarding trademark law:

> No one should be allowed to register a trademark containing an "X" (which is known by the public to represent an unknown value) and be allowed to use such "X" to represent any letter they choose at the time and further be allowed to bar others from any pronunciation of choosing. The Opposer states in their MSJ and on their website that the "X" in their mark represents two blades of a cigar cutter, which shows they have tried to use their mark to represent an unknown value instead of the actual letter "X". What letter and sound is represented by "two blades of a cigar cutter", none.

It appears that BWC misunderstands the difference between a word mark and a design mark. BWC also appears to be confused by the idea that trademark rights can exist apart from and in addition to a federal registration. The Opposer's only purpose in presenting this passage is to provide a frame of reference for the rest of BWC's arguments. Opposer urges the Board to take any and all comments made by BWC "with a grain of salt" as the company is speaking solely through its non-attorney owner Ms. Wiseberg rather than through counsel.

III. CONCLUSION

For the foregoing reasons, Defendants respectfully request that the Court grant their Motion for Summary Judgment. The motion asked for judgments on two separate issues:

the first being the opposition to BWC's trademark application, and the second being BWC's counterclaim for cancellation. Opposer feels that it is entitled to summary judgment on both issues, but should the Board feel that one issue warrants judgment in favor of one party and the other in favor of the other party, the issues can and should be bifurcated.

Respectfully submitted,

Dated: 5-1-2014

By Ginnie C. Derus

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REPLY TO APPLICANT'S RESPONSE TO 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 1st day of May 2014.

Ginnie C. Derusseau