

This Opinion is not a
Precedent of the TTAB

Mailed: November 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Altadis U.S.A. Inc.
v.
Global Services 1939 LLC

Opposition No. 91213902
to Application Serial No. 85650486

Charles W. Grimes and Russell D. Dize of Grimes LLC,
for Altadis U.S.A. Inc.

Leon F. Hirzel of Hirzel & Dreyfuss PA,
For Global Services 1939 LLC.

Before Bucher, Ritchie and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Global Services 1939 LLC

(“Applicant”) seeks registration on the
Principal Register of the mark






displayed on the right for “cigar boxes; cigars” in International Class 34.¹

¹ Application Serial No. 85650486 was filed on June 13, 2012, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The application includes the following description of the mark: “The mark

Altadis U.S.A. Inc. (“Opposer”) opposes registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when applied to Applicant’s goods, the mark so resembles Opposer’s previously used, registered and famous marks which comprise or include the term MONTECRISTO, and designs that comprise or include a fleur de lis for, *inter alia*, cigars, cigar boxes, retail cigar stores and cigar smoking lounges, as to be likely to cause confusion. Opposer pleaded ownership of twenty registrations, all on the Principal Register. The most relevant registrations are set forth below:

Mark	Reg. No.	Goods/Services
MONTECRISTO	1173547 (registered 10/13/1981, renewed)	Cigars
MONTECRISTO	2396980 (registered 10/24/2000, renewed)	Hat ornaments not of precious metal; ashtrays not of precious metal; and credit card services
MONTECRISTO	3897792 (registered 12/28/2010)	Retail store services featuring cigars; cigar smoking lounge services
MONTECRISTO	3947902 (registered 4/19/2011)	Desk sets; desk pads; pens; stands for pens and pencils; golf balls; and cigar cases not of precious metal

consists of fleur de lis designs surrounding an ‘M’ and the number ‘1939.’ The wording ‘MONTERO 1939 TOTALMENTE A MANO’ is on both sides of the center ‘M’ design.” The colors black and silver are claimed as features of the mark. The wording “TOTALMENTE A MANO” and “1939” have been disclaimed. In addition, the application includes the following translation: “The English translation of ‘totalmente a mano’ in the mark is ‘entirely by hand.’”

Mark	Reg. No.	Goods/Services
	332324 ² (registered 2/11/1936, renewed)	Cigars, cigarettes, and cut tobacco
	1459466 (registered 9/29/1987, renewed) ³	Cigars
	3805893 (registered 6/22/2010) ⁴	Cigars, little cigars, roll-your-own tobacco, pipe tobacco, smokeless tobacco, ashtrays, cigar boxes, cigar cutters, cigar cases, cigar holders, lighters for smokers, tobacco pipes, tobacco pouches, tobacco tins, match boxes and cigar tubes

Opposer also alleges that Applicant's mark is likely to dilute Opposer's famous pleaded marks pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

Applicant, in its answer, denied the salient allegations in the notice of opposition. Applicant also asserted as "affirmative defenses" that "Opposer has no rights in or to the 'fleur de lis' as it is an internationally-recognized symbol that is in the public domain," that Opposer's "Fleur de lis" mark is weak and "afforded a limited scope of protection," and that, as used by Applicant, "the fleur de lis symbol

² The registration does not contain a description of the mark. However, in the Notice of Opposition, Opposer describes this mark as the "MONTE CRISTO Crossed Swords and Fleur de Lis Design." We refer to this registration and Reg. No. 1459466 collectively as the "crossed swords" marks.

³ The registration does not contain a description of the mark. However, in the Notice of Opposition, Opposer describes this mark as the "Crossed Swords and Fleur de Lis Design." We refer to this registration and Reg. No. 332324 collectively as the "crossed swords" marks.

⁴ The registration includes the following description of the mark: "The mark consists of a design of a fleur de lis." We refer to this registration as the "fleur de lis" mark.

... is only an insignificant portion of Applicant's overall mark, which is dominated by other features.”⁵

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of application Serial No. 85650486. During its assigned testimony, Opposer filed a Notice of Reliance upon Opposer's Requests for Admission and Interrogatories and Applicant's responses thereto,⁶ publications, advertisements, printed articles, and TSDR printouts of Opposer's twenty pleaded registrations.⁷ Opposer also submitted the testimony deposition, with accompanying exhibits, of Janelle Rosenfeld, Opposer's Vice President of Marketing and Trade Advertising. Applicant submitted no testimony or other evidence. Both parties filed briefs on the case.

⁵ Applicant's "affirmative defense" of failure to state a claim was not pursued at trial, and therefore is deemed waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013).

⁶ Opposer submitted Applicant's response to Opposer's Requests for Admission in its entirety, even though the response included denials. Requests that have been denied have no probative value and, in fact, the rules do not provide for submission of such denials by Notice of Reliance. *See Trademark Rule 2.120(j)(3)(i); Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 (TTAB 2008). Thus, we have only considered the admissions. We also note that in its brief, Opposer only relies on the admissions.

⁷ Opposer also submitted a TSDR printout of Opposer's unpleaded registration for the mark MONTE. We need not and do not consider this registration in order to reach a decision on the merits of Opposer's claims, and therefore do not engage in an analysis of whether the pleadings have been amended by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b).

II. Findings of Fact

Opposer manufactures and distributes premium cigars.⁸ Through its wholly owned subsidiary Cuban Cigar Brands B.V., Opposer owns the twenty MONTECRISTO, fleur de lis and crossed swords marks pleaded in the Notice of Opposition and made of record under Opposer's Notice of Reliance, including those listed in the chart above.⁹

MONTECRISTO is Opposer's best known brand of premium cigars.¹⁰ With annual sales in the millions, and annual dollar volume of sales in the tens of millions, MONTECRISTO is Opposer's top selling cigar and among the best known and top selling brands of cigars in the United States, similar in popularity to other premium cigar brands such as Davidoff, Cohiba and Padron.¹¹ Opposer sells MONTECRISTO cigars to approximately 3000 brick and mortar stores via a 32 person premium cigar sales force, the largest such sales force in the United States, and also markets the cigars through wholesale distributors, catalogs and the Internet.¹² In the past, Opposer has licensed the MONTECRISTO brand for use in connection with a variety of ancillary goods and services, such as cigar lounges, watches, credit cards, coffee and ashtrays.¹³

⁸ 11 TTABVUE 13.

⁹ 11 TTABVUE 13; 7 TTABVUE 14-87.

¹⁰ 11 TTABVUE 25, 30.

¹¹ 11 TTABVUE 48-49, 58.

¹² 11 TTABVUE 19-20.

¹³ 11 TTABVUE 55.

Opposer spends at least several hundred thousand dollars each year to advertise the MONTECRISTO brand.¹⁴ Opposer advertises MONTECRISTO cigars in cigar-oriented magazines such as *Cigar Aficionado*, *Cigar Snob* and *Cigar & Sprints* and on the radio, and in the past, has advertised them in *Gourmet* and *Travel & Leisure* magazines.¹⁵ Opposer promotes the MONTECRISTO brand on its website, through the Montecristo Social Club, a consumer private membership website with approximately 50,000 members, and through Cigar Life, a Facebook page with over 130,000 members.¹⁶ Opposer also promotes the MONTECRISTO brand through in-store events that allow consumers to sample MONTECRISTO cigars and buy them at a discount (such as buy three get one free promotions), and to receive MONTECRISTO branded promotional items such as cutters, matches, lighters, clothing and humidors.¹⁷ In addition, Opposer hosts direct-to-consumer promotional events in various cities, often associated with the Montecristo Social Club, where Opposer rents a smoking area in a bar or lounge and invites consumers to enjoy a MONTECRISTO cigar.¹⁸ Articles in the cigar press often have referred to MONTECRISTO to denote a high quality or prestigious product, similar to Rolex watches and Pierre Cardin suits.¹⁹

¹⁴ 11 TTABVUE 50.

¹⁵ 11 TTABVUE 22.

¹⁶ 11 TTABVUE 25-27.

¹⁷ 11 TTABVUE 24, 29.

¹⁸ 11 TTABVUE 29.

¹⁹ 11 TTABVUE 50-51.

Opposer's predecessor sold MONTECRISTO cigars in the United States from 1935 until 1960, when the Cuban trade embargo was imposed.²⁰ Opposer purchased the MONTECRISTO brand in 1978, and continuously has sold MONTECRISTO cigars in the United States since that time.²¹ From 1935 to 1960, and from 1978 to the present, the fleur de lis continuously has appeared on Opposer's MONTECRISTO cigars.²² The fleur de lis is part of Opposer's MONTECRISTO logo.²³ The fleur de lis virtually always is displayed prominently in the center of MONTECRISTO cigar bands and on packaging for MONTECRISTO cigars.²⁴ The fleur de lis also appears in the center of Opposer's crossed swords logo, which logo is displayed on cigar boxes and in advertisements and promotional materials that reference MONTECRISTO.²⁵

Based on Applicant's admissions and its answers to Opposer's Interrogatories, we find that Applicant selected its mark in 2012,²⁶ and that Applicant was aware of Opposer's use of its MONTECRISTO and fleur de lis marks when it chose its mark.²⁷ We also note Applicant's assertion that it chose its mark based on the

²⁰ 11 TTABVUE 16.

²¹ 11 TTABVUE 16.

²² 11 TTABVUE 31.

²³ 11 TTABVUE 30-31.

²⁴ 11 TTABVUE 33, 45.

²⁵ 11 TTABVUE 33, 45.

²⁶ Applicant's Responses to Requests for Admission Nos. 2 and 5, 7 TTABVUE 109-110.

²⁷ Applicant's Answers to Interrogatory Nos. 14 and 15, 7 TTABVUE 137-138.

surname of Applicant's principal rather than any attempt to trade on Opposer's good will in its marks.²⁸

III. Standing and Priority

Because Opposer has made the pleaded registrations properly of record, Opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc., v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Moreover, because the registrations are properly of record, priority is not in issue as to the goods and services identified therein. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, Applicant does not dispute Opposer's priority.

IV. Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper*

²⁸ Applicant's Answers to Interrogatory Nos. 2 and 3. 7 TTABVUE 134.

Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors in the proceeding now before us, are discussed below.

A. Fame of the Marks

Opposer claims that its MONTECRISTO, fleur de lis, and crossed swords marks are famous. Fame of the prior marks plays a dominant role in likelihood of confusion cases featuring famous marks. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Because of the extreme deference accorded to famous marks in terms of the wide latitude of legal protection they receive, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); and *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Accordingly, we consider the fame factor first.

In its brief, Applicant “acknowledges that MONTECRISTO is a famous mark recognized in the tobacco/cigar industry,”²⁹ and that “the MONTECRISTO mark is famous and easily recognizable by the average cigar consumer.”³⁰ However, Applicant contends that the fleur de lis symbol in Opposer’s fleur de lis and crossed swords marks is generic. As noted above, Applicant has presented no evidence or

²⁹ 15 TTABVUE 11.

³⁰ 15 TTABVUE 13.

testimony in this proceeding. Accordingly, Applicant's argument that the fleur de lis is generic is unsubstantiated. Moreover, the argument is an impermissible collateral attack against Opposer's registrations, as Applicant has not filed a counterclaim or a separate petition seeking the cancellation of such registrations. Trademark Rule 2.106(b)(2), 37 CFR § 2.106(b)(2). We therefore focus solely on whether Opposer has established that its fleur de lis and crossed swords marks are famous.

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods identified by the marks at issue, "the length of time those indicia of commercial awareness have been evident," widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as by the general reputation of the products. *Bose*, 63 USPQ2d at 1305-06.

The gist of Opposer's argument is that the fleur de lis and crossed swords marks are famous because they have been displayed and promoted with Opposer's famous MONTECRISTO mark for cigars since 1935.³¹ We accept for purposes of this decision Applicant's concession that Opposer's MONTECRISTO mark is famous for cigars, and therefore need not decide whether the record supports such a finding. However, Opposer's evidence that the fleur de lis and crossed swords marks are famous is minimal, consisting of the aforementioned general sales and advertising figures, promotional materials and advertising in several publications, a side-bar

³¹ 11 TTABVUE 59. This excludes the period after the imposition of the Cuban trade embargo mentioned above.

description of the crossed swords mark in *The Ultimate Cigar Encyclopedia* (1998) (“[t]he Montecristo logo is one of the best known of the Cuban cigars”),³² and Ms. Rosenfeld’s testimony that consumers think of Opposer when they see a fleur de lis on a cigar (e.g., “If consumers see a fleur-de-lis, I believe they associate it with Montecristo, and they therefore associate that product with quality and luxury”)³³ because of Opposer’s consistent use of the fleur de lis in connection with MONTECRISTO cigars since 1935.³⁴

While Opposer’s sales and advertising figures are appreciable, raw numbers alone are not necessarily sufficient to prove fame, since such figures may be misleading. *See Bose*, 63 USPQ2d at 1309. For example, without context, Opposer’s sales figures, and Ms. Rosenfeld’s testimony that “Montecristo is a top selling cigar for our company and a top selling cigar in the U.S. market,”³⁵ could represent a somewhat limited market share. Similarly, the evidence shows that Opposer has engaged in print advertisement of its MONTECRISTO cigars since at least the mid-1990s, and that the crossed swords design (with a fleur de lis in the middle) appears in virtually all such advertisements. However, such evidence falls short of demonstrating the extent to which such marketing efforts translate into widespread recognition of Opposer’s fleur de lis and crossed swords marks among purchasers and smokers of cigars. Notably, other than the description of Opposer’s crossed

³² 7 TTABVUE 256.

³³ 11 TTABVUE 61.

³⁴ 11 TTABVUE 59. Again, this excludes the period of the Cuban trade embargo.

³⁵ 11 TTABVUE 48.

swords mark in *The Ultimate Cigar Encyclopedia*, which is nearly two decades old, there is no evidence of consumer recognition of Opposer's fleur de lis or crossed swords marks in connection with cigars. Moreover, there is no evidence that *The Ultimate Cigar Encyclopedia* was ever sold or read (except, perhaps, to and by Opposer), let alone the number of copies that have been sold, and no indication that this book continues to be in circulation.

Because of the extreme deference that we accord a 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, we reiterate, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012); *Edward Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010). On this record, we find that Opposer has not met its burden of establishing that Opposer's pleaded fleur de lis and crossed swords marks are famous for purposes of our likelihood of confusion determination.

The *du Pont* factor of fame favors Opposer as to the MONTECRISTO mark, and is neutral as to the fleur de lis and crossed swords marks.

B. Strength of the Fleur De Lis and Crossed Swords Marks/Third Party Uses

Although the record does not support a finding that Opposer's pleaded fleur de lis and crossed swords marks are famous, the record reflects that the marks are arbitrary with respect to the goods, as well as longevity of use of the marks, appreciable sales and advertising figures, and the absence of third-party use of

similar marks for similar goods.³⁶ The record also reflects Opposer's efforts to stop others from using the fleur de lis on cigars without Opposer's consent.³⁷ We therefore find the marks to be strong, and entitled to a broad scope of protection.

C. Relatedness of the Goods, Channels of Trade and Conditions of Purchase

We turn next to the *du Pont* factors of the relatedness of the goods, channels of trade and conditions of purchase. We base our evaluation on the goods as they are identified in the application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

In this case, the "cigars" identified in Reg. No. 1173547 for MONTECRISTO and in the three registrations for the fleur de lis and the crossed swords marks are identical to the "cigars" identified in the application, the "cigar boxes" identified in Reg. No. 3805893 for the fleur de lis mark are identical to the "cigar boxes" identified in the application, and the "ashtrays" listed in Reg. No. 2396980, the "retail store services featuring cigars; smoking lounge services" listed in Reg. No. 3897792, the "cigar cases not of precious metal" listed in Reg. No. 3947902, the

³⁶ In its brief, Applicant points to evidence not in the record of third party uses of fleur de lis designs on "countless cigar products" and other goods in Class 34. 15 TTABVUE 11. As with Applicant's argument that Opposer's fleur de lis mark is generic, this claim is unsubstantiated and will be given no further consideration.

³⁷ 11 TTABVUE 60-61.

“cigarettes and cut tobacco” listed in Reg. No. 332324, and the other goods listed in Reg. No. 3805893 are closely related to the “cigars” and “cigar cases” identified in the present application. Applicant does not dispute this.

In addition, because the goods identified in the application and registrations are identical in part, and otherwise closely related, we must presume that the channels of trade and classes of purchasers also overlap. *See In re Viterro*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in an application or registration, the identified goods are “presumed to travel in the same channels of trade to the same class of purchasers.”) (quoting *Hewlett-Packard*, 62 USPQ2d at 1001). *See also Stone Lion*, 110 USPQ2d at 1161; *In re Linkvest*, 24 USPQ2d 1716, 1716 (TTAB 1992). Moreover, in its responses to Opposer’s Requests for Admission, Applicant has admitted that the channels of trade for Applicant’s and Opposer’s cigars are the same,³⁸ and that they will be sold to the same types of customers.³⁹

Notwithstanding the well-established legal presumptions and Applicant’s admissions, Applicant argues in its brief that the channels of trade are different because “Applicant sells directly to consumer[s] via its website and Opposer does not sell directly to consumer[s].”⁴⁰ However, as we have noted, Applicant submitted no evidence or testimony in this proceeding. Applicant’s argument, therefore, is without support, and in light of the legal presumptions and Applicant’s admissions, unconvincing.

³⁸ Applicant’s Response to Request for Admission No. 30, 7 TTABVUE 113.

³⁹ Applicant’s Response to Request for Admission No. 31, 7 TTABVUE 113.

⁴⁰ 15 TTABVUE 11.

The *du Pont* factors of the similarity of the goods, channels of trade and the conditions of purchase strongly favor a finding of likelihood of confusion.

D. The Variety of Opposer's Goods on Which the Marks are Used

Under the ninth *du Pont* factor, Opposer argues that the MONTECRISTO, fleur de lis and crossed swords marks are used with a large variety of goods and services. The registrations Opposer asserts, including ones not specifically mentioned in this decision, are sufficient to establish that Opposer has used the MONTECRISTO mark on a wide variety of goods and services. *Chicago Bears Football Club Inc. v. 12th Man/Tennessee LLC*, 83 USPQ2d 1073, 1075 (TTAB 2007). However, nothing in the record supports a similar finding for Opposer's design marks. This factor favors Opposer as to the MONTECRISTO mark, and is neutral as to the fleur de lis and crossed swords marks.

E. Comparison of the Marks

We next consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild*, 82 at 1905). The focus is on the recollection of the average purchaser, who normally retains a general rather than a


specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entireties. *Id.* See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, 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 conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161. For instance, as our principle reviewing court has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.” See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Moreover, in comparing the marks, we are mindful that where, as here, Applicant’s goods are identical to Opposer’s goods in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

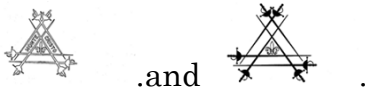
In this case, the central and most visually prominent portion of Applicant's mark



comprises six fleur de lis surrounding a large letter “M,” which also resembles two mountains, and the year 1939.⁴¹ Applicant points to minor differences in the leaves and tips of Applicant's six fleur de lis compared to Opposer's mark  in an attempt to distinguish the marks. However, we find that the six fleur de lis in Applicant's mark are virtually identical in appearance to Opposer's fleur de lis mark. Applicant's mark essentially incorporates the entirety of one of Opposer's marks. In similar cases, a likelihood of confusion frequently has been found. *See, e.g., Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant's mark BENGAL LANCER for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (applicant's mark EBONY DRUM for hairdressing and conditioner is likely to cause confusion with EBONY for cosmetics); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (applicant's mark HEAD START COSVETIC for vitamins for hair conditioners and shampoo is likely to cause confusion with HEAD START for men's hair lotion and after-shaving lotion).

⁴¹ As noted above, the year 1939 has been disclaimed.

The central portion of Applicant's mark also evokes a triangle, and therefore is very similar in appearance to Opposer's triangular shaped crossed swords marks



In addition, although the literal portions of the marks are not identical, the word MONTERO, which appears twice in Applicant's mark, is similar to Opposer's famous mark MONTECRISTO in that they share the first five letters (MONTE), they include the letter "R," and they end with the letter "O."

To the extent the letter "M" in the central portion of Applicant's mark resembles two mountains, it reinforces the MONTE portion of Applicant's mark, which Opposer's mark also shares. In this regard, we note that MONTERO is a word of Spanish origin meaning "mountaineer."⁴² Similarly, Opposer's mark MONTECRISTO is registered with the translation "Mountain of Christ."⁴³ Applicant's mark and Opposer's mark MONTECRISTO therefore have very similar meanings.

Even if consumers view the central portion of Applicant's mark as containing a capital letter "M" as Applicant intends, the fact remains that the letter is

⁴² We take judicial notice of the following entry for "montero" from Dictionary.com Unabridged, based on the RANDOM HOUSE DICTIONARY (2015): "a Spanish hunter's cap, round in shape and having an earflap." Under the title "Origin of Montero," the entry reads as follows: "1615-1625; < Spanish, special use of *montero* huntsman, literally, mountaineer, equivalent to monte *mount*+ -ero < Latin - arius - ary" (italics in original). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁴³ See, for example, Reg. Nos. 2236889 (7 TTABVue 36) and 2855557 (7 TTABVue 44).

surrounded by six fleur de lis that are nearly identical to Opposer's fleur de lis mark. Given the strength of Opposer's fleur de lis mark, and the fame of the MONTECRISTO mark for cigars, we find that it is more likely than not that purchasers of cigars will view Opposer as the source of a mark that contains six fleur de lis in the center of the cigar band, and that the letter "M" identifies Opposer, whose name begins with that letter.

The other elements of Applicant's mark do little to distinguish it from Opposer's marks. More specifically, the year "1939" is informational, and the additional wording "TOTALMENTE A MANO" (which, as noted above, means "entirely by hand"), is merely descriptive of Applicant's handmade cigars. Both elements appropriately have been disclaimed, and therefore are entitled to less weight in our analysis. *See National Data Corp.*, 224 USPQ at 751. Further, although Applicant has claimed the colors silver and black as a feature of its mark, none of Opposer's marks include a color claim. Opposer therefore may use all of its pleaded marks in any colors it wishes, including the colors that Applicant has claimed. *In re Data Packaging Corp.*, 453 F.2d 1300, 1302, 172 USPQ 396, 397 (CCPA 1972). Rather than favoring Applicant as Applicant contends, Opposer's lack of color claim supports a finding that the marks are confusingly similar.

When we compare the marks in their entirety, we find that the similarities in sound, appearance, meaning and overall commercial impression outweigh the differences. We further find that the differences in Applicant's mark are more likely to be viewed as identifying a variation or line extension of cigars offered by the

source identified as MONTECRISTO. In making this finding, we have taken into account Applicant's concessions that MONTECRISTO is a famous mark and the parties' goods are, at least in part, identical. Thus, consumers are likely to be mistaken that Applicant's goods are licensed or sponsored by, or are in some way connected, related or associated with Opposer.

The similarity between Applicant's mark and Opposer's marks is a factor that weighs in Opposer's favor.

F. Extent of Concurrent Use and Actual Confusion

Applicant contends that there is no evidence of actual confusion, and that this favors Applicant. However, proof of actual confusion is not necessary to show a likelihood of confusion, and its absence is not dispositive. *See Herbko Int'l Inc. v. Kappa Books Inc.*, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). A showing of actual confusion would of course be highly probative, if not conclusive, of a likelihood of confusion. Yet the opposite is not true; the lack of evidence of actual confusion generally carries little weight. *See J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965).

Moreover, it is unclear whether Applicant has sold any cigars under its applied-for mark. In response to Interrogatory No. 4, Applicant states that "its first use of the Mark was approximately February 2012."⁴⁴ However, because Applicant submitted no evidence or testimony, this statement is unsubstantiated. In addition,

⁴⁴ 7 TTABVUE 134.

the statement does not specifically indicate that the claimed use was “in commerce.” Moreover, Ms. Rosenfeld testified that she has never seen Applicant’s cigar for sale in retail stores, although it appears that Applicant is selling cigars directly to consumers through Applicant’s website.⁴⁵ She also testified that she is “not aware of any consumer that’s ever seen the Montero brand.”⁴⁶

The *du Pont* factor of the length of time during and conditions under which there has been concurrent use without evidence of actual confusion also is neutral.

G. Applicant’s Intent

Finally, Opposer argues that the element of “bad faith” weighs in its favor because Applicant knew of Opposer’s MONTECRISTO mark and Opposer’s use of a fleur de lis on MONTECRISTO cigars before Applicant “deliberately and willfully adopted a mark for cigars that includes six fleur de lis designs in the center of a cigar band and the confusingly similar term ‘MONTERO.’”⁴⁷ Under the thirteenth *du Pont* factor, the Board may consider evidence of Applicant’s bad faith adoption of its mark. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1441 (TTAB 2012). To put it simply, however, without more, we cannot make such a finding as to Applicant’s intent, good or bad. This is not a record where an inference of bad faith may be made. Accordingly, we see no bad faith in Applicant’s adoption of its mark, and find this factor to be neutral.

⁴⁵ 11 TTABVUE 58.

⁴⁶ 11 TTABVUE 105.

⁴⁷ 13 TTABVUE 45.

H. Conclusion

We conclude, after considering all evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments that we have not specifically discussed herein, that there is a likelihood of confusion between Opposer's MONTECRISTO, fleur de lis and crossed swords marks and Applicant's mark



for identical cigars, cigar boxes and otherwise closely related goods.

As a final note, with regard to Opposer's MONTECRISTO mark, the case law is clear that famous marks enjoy a wide latitude of protection. "Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark When an opposer's trademark is a strong, famous mark, it can never be of little consequence." *Recot*, 54 USPQ2d at 1897 (quoting *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984)). The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 22 USPQ2d at 1456.

V. Dilution

Having determined that Opposer is entitled to prevail in this opposition proceeding based upon its Section 2(d) claim of likelihood of confusion, we need not

reach the merits of Opposer's dilution claim. *See American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Decision: The opposition is sustained, and registration to Applicant is refused.