

This Opinion is Not a
Precedent of the TTAB

Mailed: April 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Nemiroff Intellectual Property Establishment

v.

RAM Development Associates LLC

—
Opposition No. 91244891
—

Marie Anne Mastrovito and Anthony A. Coppola of Womble Bond Dickinson (US) LLP for Nemiroff Intellectual Property Establishment.

RAM Development Associates LLC, pro se.

—

Before Wellington, Greenbaum and Lebow, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

RAM Development Associates LLC (“Applicant”) filed two applications wherein it seeks to register the mark NEMIROFF, in standard characters, on the Principal Register for use on “cigars, cigarettes,”¹ and various other tobacco-related products and accessories,² all in International Class 34. Both applications are based on

¹ Application Serial No. 87513305 was filed on June 30, 2017, based on a claim of first use of the mark anywhere and in commerce in 2005, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

² Application Serial No. 87526864, filed July 13, 2017, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The identification of goods includes: “Tobacco, raw or manufactured, namely, cigars,

Applicant's claim that the mark has acquired distinctiveness, under Section 2(f) of the Trademark Act ("the Act"), 15 U.S.C. § 1052(f).

Nemiroff Intellectual Property Establishment ("Opposer"), opposes registration of Applicant's mark in each application, under Section 2(d) of the Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with its previously-used and registered marks composed of or including NEMIROFF for various alcoholic beverages, including:³

NEMIROFF, in standard characters, for "alcoholic beverages, namely, brandy, vodka, liqueurs and distilled spirits featuring honey," in International Class 33.⁴

Applicant denied the salient allegations in the Notice of Opposition.⁵

Opposer filed a trial brief.⁶ Applicant did not.

cigarettes, cigarillos, little cigars, cigars with pre-cut ends, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, tobacco substitutes not for medical purposes, liquid tobacco and electronic cigarette liquid (e-liquid) comprised of propylene glycol, smoking spices, namely, herbs for smoking, electronic cigarettes; smokers' articles, namely, cigarette paper and tubes, cigarette filters, tobacco tins, cigarette and cigar cases and ashtrays not of precious metals, their alloys or coated therewith, electric and non-electric cigar lighters, not for automobiles, cigar and cigarette tubes, cigar and cigarette cases, humidors for tobacco products; smoking pipes, pocket apparatus for rolling cigarettes, lighters not of precious metals, [and] matches."

³ In all, Opposer pleaded ownership of thirty-five registrations. Of these, twenty-seven have been cancelled. The eight pleaded (live) registrations are: Reg. Nos. 3006780, 5567389, 5366953, 5298792, 5298790, 3845336, 3543905, and 3021093,

⁴ Registration No. 3006780 ("Reg. No. '780") issued October 18, 2005, renewed. The registration is based on a claim of acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).

⁵ 6 TTABVUE (Answer).

⁶ 60-61 TTABVUE ("confidential" and public versions of Opposer's brief).

I. Preliminary Matters

In addition to the likelihood of confusion claim, Opposer alleged fraud as a ground for opposition to each application based on Applicant's allegedly false averments of use in connection with its Section 2(f) claims of acquired distinctiveness.⁷ However, Opposer did not argue the fraud claim in its trial brief, so we consider this forfeited or waived and do not further address it. *See, e.g., Weapon X Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, Opp. No. 91221553, 2018 WL 1326374, at *2 (TTAB 2018) (precedential) ("Opposer did not pursue this claim at trial or argue it in its trial brief, and it is accordingly waived.") (citations omitted); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, Can. No. 92050879, 2013 WL 5407315, at *2 (TTAB 2013) (precedential) (same), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014); *see generally In re Google Techs. Holdings, LLC*, 980 F.3d 858, 862-63 (Fed. Cir. 2020) (argument not pursued is forfeited).

Separately, Opposer argues a ground for opposition in its trial brief that was not pleaded in the Notice of Opposition. Specifically, Opposer asserts that Applicant's mark should be refused registration because it falsely suggests a connection with Opposer, under Section 2(a) of the Act.⁸ Opposer cannot prevail on this unpleaded allegation and we give it no further consideration. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007) (unpleaded allegations will not be heard).

⁷ 1 TTABVUE 40-44 (Not. of Opp. ¶¶ 54-85).

⁸ 61 TTABVUE 31-32.

Finally, Applicant did not introduce any evidence during its testimony period and, as noted, it did not file a trial brief. It was not required to do either. Only Opposer was required to file a brief, Trademark Rule 2.128(a)(1), 37 C.F.R. § 2.128(a)(1), and to submit evidence because Opposer, as plaintiff, ultimately bears the burden of proving that Applicant is not entitled to registration “even in the absence of contrary evidence or argument.” *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at *21 (TTAB 2022) (citing *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010)).

We now address the opposition solely on the pleaded ground of priority and likelihood of confusion, and for the reasons explained below, we sustain the opposition.

II. Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Applicant’s application files.

During its trial period, Opposer filed the following:

- Testimonial Declaration of Yurii Sorochynskyi, Director of LVN Limited, a Ukrainian company, with accompanying exhibits;⁹ and
- Notices of Reliance on various materials, including Opposer’s pleaded registrations.¹⁰

⁹ 52-53 TTABVUE (public and “confidential” versions of the declaration, hereinafter “Soro. Dec.”). Mr. Sorochynskyi avers that LVN Limited is “part of the privately held NEMIROFF group of companies and the manufacturer of NEMIROFF branded products – which consist of vodkas that are manufactured in the Ukraine.” *Id.* at 2 (Soro. Dec. ¶ 2).

¹⁰ 54 TTABVUE (“NOR 1”) and 55 (“NOR 2”).

III. Opposer's Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, we find that Opposer has shown that it is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. Opposer owns and has made of record several registrations for the same mark that Applicant seeks to register, including Reg. No. '780.¹¹ Opposer's registrations, along with the testimony of its witness, Mr. Sorochnyskyi, and other evidence, are sufficient to support Opposer's direct interest and its allegation that "registration of Applicant's Mark is

¹¹ 54 TTABVUE (NOR 1 Ex. 1).

likely to cause confusion” with Opposer’s NEMIROFF mark.¹² *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ...direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *11 (TTAB 2023) (valid and subsisting pleaded registration made of record establishes entitlement to oppose).

IV. Priority of Use

Because Opposer’s pleaded registrations are of record and Applicant has not brought a counterclaim against any of them, priority is not an issue with respect to the goods identified in the pleaded registrations. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“DuPont”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*,

¹² 1 TTABVUE 39 (¶ 53).

544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

We focus our likelihood of confusion analysis on Opposer’s pleaded Reg. No. ’780 for the standard character mark NEMIROFF that, as outlined above, covers “alcoholic beverages, namely, brandy, vodka, liqueurs and distilled spirits featuring honey.” Because we find confusion is likely based on the goods covered by this registration, we need not consider a likelihood of confusion based on the marks and goods in the other pleaded registrations. On the other hand, if we had ultimately determined that there is no likelihood of confusion based on this registration, we would not have found confusion likely based on Opposer’s other pleaded registrations for marks that are not as similar to Applicant’s mark. *See, e.g., Monster Energy*, 2023 USPQ2d 87 at *12 (confining likelihood of confusion analysis to most similar pleaded mark) (citing *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *6 (TTAB 2020)) (subsequent history omitted); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Identical Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)).

Here, Applicant seeks to register the same standard character mark, NEMIROFF, as that registered by Opposer in Reg. No. '780. Thus, the marks are identical in all means of comparison. Accordingly, the first *DuPont* factor “weighs heavily in favor of a likelihood of confusion because identity of the marks is likely to lead to the assumption that there is a common source” for the goods identified in the application and registration. *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 2022 USPQ2d 513, at *8 (Fed. Cir. 2022).

B. Relatedness of the Goods and Their Trade Channels

We turn now to the second *DuPont* factor, involving the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

In making our comparison, we keep in mind that “even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, at 1689 (Fed. Cir. 1993). *See also Amcor, Inc. v. Amcor Indus., Inc.*,

210 USPQ 70, 78 (TTAB 1981) (When both parties are using or intend to use the identical designation, “the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar”).

Here, both of the opposed applications include “cigars” and “cigarettes” in the identifications of goods.¹³ Opposer’s goods, as identified in Reg. No. ’780, are “alcoholic beverages, namely, brandy, vodka, liqueurs and distilled spirits featuring honey.”

Opposer argues that these goods are related because they are “complementary” in that they are marketed together for “simultaneous consumption.”¹⁴ In support, Opposer submitted evidence showing an association between the goods.¹⁵ For example:

- A third-party cigar retail website describing the “Top 10 Alcoholic Beverage Pairings for Cigars,” specifically mentioning vodka and other spirits;¹⁶

¹³ Although Application Ser. No. 87526864 contains goods other than cigarettes and cigars (see Note 2), we confine our analysis to these goods that are common to both opposed applications. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed in the identification of goods in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6 (TTAB 2019); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015).

¹⁴ 61 TTABVUE 24.

¹⁵ 52 TTABVUE (Soro. Ex. 10).

Opposer also submitted copies of eight third-party registrations for marks that cover alcoholic beverages and tobacco products, including cigars and cigarettes to show that these are the types of goods that may emanate from a single source. 55 TTABVUE (NOR 2). See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). However, four of these registrations are based on foreign registrations and do contain dates of use in U.S. commerce. Accordingly, those four registrations lack probative value. *Id.*

¹⁶ *Id.*

- A printout from the website for “Court Liquors” with a photograph of the storefront appearing as follows:¹⁷



- A screenshot from the Total Wine & More retail website touting the sale of alcoholic beverages, including “Spirits,” and the sale of cigars;¹⁸ and

¹⁷ *Id.*

¹⁸ *Id.*

- An article from the Cigar World website describing “How to Pair Cigars and Drinks” that specifically mentions spirits like whiskey, rum, bourbon, and scotch.¹⁹

In addition, Opposer submitted evidence showing that Applicant’s tobacco products include alcohol-infused cigarettes and cigarillos (small cigars). For example, screenshots from Applicant’s website tout “Rum” and “Cognac” flavored cigarillos.²⁰

In terms of the third *DuPont* factor, involving “the similarity or dissimilarity of established, likely-to-continue trade channels,” *DuPont*, 177 USPQ at 567, the aforementioned evidence showing cigars being sold in stores that sell alcoholic beverages is pertinent. In addition, Opposer submitted printouts from Applicant’s “Duty Free - Nemiroff USA” website showing Applicant’s cigarettes and cigars for sale in duty-free shops in proximity to alcoholic beverages.²¹ Indeed, screenshots from Applicant’s website contains photographs showing “Applicant’s NEMIROFF cigarette products on a high shelf just a few feet away from a table covered with bottles of alcoholic beverages” and “the alcoholic beverages on the table in the image are two of Opposer’s NEMIROFF branded vodka products ... placed just in front of Applicant’s NEMIROFF cigarettes.”²²

The aforementioned evidence demonstrates a complementary relationship between the parties’ goods, namely, alcoholic beverages, including vodka and spirits,

¹⁹ *Id.*

²⁰ *Id.*, Soro. Ex. 11.

²¹ *Id.*, Soro. Dec. ¶¶ 58-61, Exs. 15-16.

²² *Id.*, Soro Dec. ¶ 59, referring to photographs in Ex. 15.

and tobacco products, including cigarettes and cigars. These goods are marketed and touted as goods that can be “paired” with each other, and they may be found in the same trade channels, such as liquor stores and duty-free shops.

Accordingly, the *DuPont* factors involving relatedness of the goods and their trade channels weigh in favor of likely confusion.

C. Strength of Opposer’s NEMIROFF Mark

We now consider the strength of Opposer’s NEMIROFF mark under the fifth *DuPont* factor, “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. Opposer may submit evidence proving the commercial strength of its mark in order to expand the scope of protection afforded its mark commensurate with that strength. *See, e.g., Monster Energy*, 2023 USPQ2d at *19-20.

Opposer argues that “the extensive sales and promotion of [its] goods establish that the Opposer’s mark is well known to consumers and should be afforded a wide ambit of protection.”²³ As support, Opposer points to “use in the United States for over 20 years”; the fact that its “NEMIROFF brand is the third best-selling vodka in duty free shops and ranks as the 21st highest selling spirit brand by volume in the world”; and substantial sales of NEMIROFF vodka in the U.S.²⁴

In further support, Opposer’s witness, Mr. Sorochynskyi, avers:

²³ 61 TTABVUE 30.

²⁴ *Id.*

- “NEMIROFF vodka has been sold in the United States since 2000.”²⁵
- “Nemiroff vodka was ranked as the third (3rd) best-selling vodka brand in the ‘Duty-Free’ category in 2016-2020 and is one of the ten best-selling brands of vodka in the world. In 2021 Nemiroff was named as the Fastest Growing International Spirits Brand worldwide by IWSR (the International Wine and Spirits Review).”²⁶
- “During the period from 2018 to 2021 in the United States, Opposer participated in many exhibitions/competitions and received a number of notable awards for NEMIROFF products that are currently sold in the U.S. market, including but not limited to the following: [listing 13 different competition awards].”²⁷
- “NEMIROFF branded vodka is actively advertised and promoted in numerous ways, in a broad range of national media – through social media (Facebook, Instagram, YouTube, internet web pages, the web site www.nemiroff.vodka/en-ua), print media (press releases, magazines, newspapers) and event sponsorships (such as music and sports sponsorships).”²⁸
- “In 2020, NEMIROFF was recognized as the fastest growing worldwide spirit brand at the International Wine and Spirit Competition.”²⁹
- “Between 2011 and 2022, sales of NEMIROFF branded products have increased significantly in the global duty free and travel retail markets. In 2011 Nemiroff was the 69th highest selling spirit brand by volume in the world. In 2021, it was ranked 21st. Between 2017 and 2021, Nemiroff Vodka was ranked as the third best-selling vodka in the global duty free and travel retail market sector.”³⁰

²⁵ 52 TTABVUE; Soro. Dec. ¶ 19.

²⁶ *Id.*; Soro. Dec. ¶ 17.

²⁷ *Id.*; Soro. Dec. ¶ 18.

²⁸ *Id.*; Soro. Dec. ¶ 29.

²⁹ *Id.*; Soro. Dec. ¶ 33.

³⁰ *Id.*; Soro. Dec. ¶ 36.

Mr. Sorochynskyi also testified as to the amount Opposer spent on “advertising, marketing, and promotion of the NEMIROFF brand in the United States” for the years 2018-2021,³¹ as well as sales of NEMIROFF branded vodka products in the U.S. (in dollar value and the number of cases) for 2022.³² Although this information was designated “confidential,” we can divulge that the amount spent on advertising and marketing is particularly impressive.³³

Based on the record, we find Opposer’s NEMIROFF mark is commercially strong and should be accorded a broader scope of protection than marks without any demonstrated commercial strength. Thus, the fifth *DuPont* factor weighs in Opposer’s favor.

VI. Conclusion

All factors for which we have argument and evidence favor a finding of likelihood of confusion or are neutral. Because Applicant seeks to register a mark that is identical to Opposer’s registered and commercially strong mark, and the parties’ goods are related in a complementary manner and may be offered for sale in the same trade channels, we find confusion is likely and judgment should be entered in favor of Opposer on its Section 2(d) claim.

Decision: The opposition is sustained on the ground of priority and likelihood of confusion under Section 2(d) of the Act.

³¹ *Id.*; Soro. Dec. ¶ 38.

³² *Id.*; Soro. Dec. ¶ 42.

³³ 53 TTABVUE (“confidential” version of Soro. Dec.).