

This Opinion is Not a
Precedent of the TTAB

Mailed: October 5, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Sazerac Brands, LLC
v.
Productores Mexicanos De Invernaderos Promex, S.C.
—

Opposition No. 91250997

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Cynthia Johnson Walden, Ryan Thomas and Vivian Cheng
of Fish & Richardson P.C. for Sazerac Brands, LLC.

Miguel Muñoz of Muñoz-Lopez & Associates PLLC
for Productores Mexicanos De Invernaderos Promex, S.C.

—
Before Adlin, Heasley and Hudis, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Productores Mexicanos De Invernaderos Promex, S.C. seeks to register
the mark shown below



Corazón del Cielo

for “mezcal” in International Class 33.¹ In its notice of opposition, Opposer Sazerac

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¹ Application Serial No. 88266450, filed January 17, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce.

Brands, LLC alleges prior use and registration of the mark CORAZON in various forms, including CORAZON DE AGAVE,² CORAZON EXPRESIONES³ and the mark shown below:



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all for tequila, in International Class 33. As grounds for opposition, Opposer alleges that use of Applicant's mark would be likely to cause confusion with Opposer's marks. In its answer, Applicant denies the salient allegations in the notice of opposition and asserts several "affirmative defenses" that are in fact merely amplifications of its

The application indicates that "[t]he English translation of 'CORAZÓN DEL CIELO' in the mark is 'heaven's heart.'" The application also includes this description of the mark: "The mark consists of a stylized design of a folk creature with curly tail, rounded ears, pointy nose, and incorporated agave cactus plant design above the wording 'CORAZÓN DEL CIELO'."

² Supplemental Register Registration No. 2460552, issued June 12, 2001 (in typed form) and Principal Register Registration No. 3287327, issued September 4, 2007 (in standard characters); both renewed. Both registrations disclaim "AGAVE" and indicate that "[t]he English translation of 'CORAZON DE AGAVE' is 'Heart of Agave.'" The Principal Register registration includes a claim of acquired distinctiveness as to the entire mark under Section 2(f) of the Act. There is no substantive difference between "standard character" marks and marks in "typed" form. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) ("until 2003, 'standard character' marks formerly were known as 'typed' marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks").

³ Registration No. 4969488, issued May 31, 2016. According to the registration, "[t]he English translation of 'CORAZON EXPRESIONES' in the mark is 'HEART EXPRESSION'."

⁴ Registration No. 2667817, issued December 31, 2002; renewed (the "817 Registration"). The registration indicates that "[t]he term 'CORAZON' means 'heart' in Spanish." This registration does not include a description of the mark.

denials; we do not treat them as separate defenses. *DeVivo v. Ortiz*, 2020 USPQ2d 10153 at *1 (TTAB 2020).

I. The Record and Opposer's Evidentiary Objections

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 Applicant's involved application. In addition, Opposer introduced:

Testimony Declaration⁵ of Duncan Hall, Records Request Processor at the Internet Archive (owner of the "Wayback Machine"), and the exhibits thereto ("Hall Dec."). 9 TTABVUE.⁶

Testimony Declaration of Megan Hurtuk, its Brand Director of Agave & Gin, including the CORAZON brand, and the exhibits thereto ("Hurtuk Dec."). 10-13 TTABVUE.

First Notice of Reliance ("NOR") on third-party registrations ("Opp. NOR 1"). 14 TTABVUE.

Second NOR on printed publications ("Opp. NOR 2"). 15 TTABVUE.

Third NOR on Applicant's responses to Opposer's discovery requests ("Opp. NOR 3"). 16 TTABVUE.

Fourth NOR on Internet printouts ("Opp. NOR 4"). 17 TTABVUE.

Fifth NOR on portions of the file history for one of Opposer's unpleaded registrations ("Opp. NOR 5"). 18 TTABVUE.

⁵ While captioned an "Affidavit of Authenticity," Mr. Duncan's testimony is in fact provided in the form of a declaration.

⁶ Citations to the record refer to TTABVUE, the Board's online docketing system. Specifically, the number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

Rebuttal NOR on Internet printouts (“Opp. Reb. NOR”). 24 TTABVUE.

Rebuttal Testimony Declaration of Ms. Hurtuk, and the exhibits thereto (“Hurtuk Reb. Dec.”). 25 TTABVUE.

Applicant introduced:

First NOR on third-party registrations (“App. NOR 1”). 20 TTABVUE.

Second NOR on dictionary definitions (“App. NOR 2”). 21 TTABVUE.

Third NOR on Internet printouts (“App. NOR. 3”). 22 TTABVUE.

Opposer makes a number of objections to Applicant’s First and Third NORs. 27 TTABVUE 59-67. Applicant submitted this evidence to show widespread third-party registration of CORAZON, HEART or heart designs, and widespread third-party use of CORAZON-formative marks, for alcoholic beverages. Opposer argues that the evidence is “irrelevant.”

Opposer’s argument is not well-taken. This type of evidence is routinely introduced and considered in assessing the strength of a plaintiff’s mark. Here, Opposer relies, in large part, on the alleged strength of its pleaded marks, *id.* at 47-55, making this evidence relevant, whether or not it is ultimately found persuasive. Suffice it to say, “we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations.” *Hunt Control Sys. Inc. v. Koninkijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011). *See also Grote Indus., Inc. v.*

Truck-Lite Co., LLC, 126 USPQ2d 1197, 1200 (TTAB 2018) (“We also remind the parties that our proceedings are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum.”) (citing *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006)); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (quoting *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017)). We have kept Opposer’s objections in mind in considering and determining the probative value of Applicant’s evidence.⁷

II. Opposer and Its Pleaded Marks

Opposer “produces, imports, and sells alcoholic beverages, including tequila, mezcal, whiskies, liqueurs, shooters, vodka, gin, rum and brandy.” 12 TTABVUE 3 (Hurtak Dec. ¶ 6). Its brands include not only CORAZÓN,⁸ but also SOUTHERN COMFORT, BUFFALO TRACE and FIREBALL. *Id.* (Hurtak Dec. ¶ 7).

Opposer’s agave spirits include “two of the best known varieties – tequila and mezcal.” *Id.* at 4 (Hurtak Dec. ¶ 9). Tequila and mezcal share many characteristics,

⁷ Opposer misapprehends the evidentiary value of Applicant’s third-party registration evidence. While Opposer is correct to the extent it argues that third-party registrations cannot establish **commercial** weakness, Opposer has not accounted for the value of third-party registrations in assessing **conceptual** weakness. See *Juice Generation, Inc. v. GS Enter., LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

⁸ As indicated above, one of Opposer’s pleaded registrations includes an accent above the second “O” in CORAZÓN, and the others do not. Ms. Hurtak typically includes the accent in her declaration, except when discussing the registered marks that do not include it.

including: both are made from agave; both must be produced in Mexico; and both are categorized as Blanco, Reposado, Añejo or Extra Añejo. *Id.* (Hurtak Dec. ¶ 11). They differ in that mezcal may be produced from any type of agave, while tequila can only be made from blue agave; in addition, mezcal and tequila must each be produced in specific regions of Mexico. In any event, it is “commonly said” that “[a]ll tequilas are mezcals, but not all mezcals are tequilas.” *Id.* at 4, 59 (Hurtak Dec. ¶ 10 and Ex. OTX 4). Tequila and mezcal “are often sold in the same section in retail stores,” are used “interchangeably” in cocktails and are sometimes mixed together in cocktails. *Id.* at 6 (Hurtak Dec. ¶¶ 18-20).

Sazerac Company acquired the “CORAZÓN brand” from Sidney Frank Importing Co., Inc. in 2008, before “transferring” it to Opposer in 2015.⁹ Sidney Frank Importing had acquired it from Arcella Premium Brands LLC in 2002. *Id.* at 6, 8, 9; 10 TTABVUE 109-176 (Hurtak Dec. ¶¶ 21, 22, 27, 28, 30 and Ex. OTX 8).

While the specific figures are confidential, Sidney Frank Importing’s sales and advertising figures for the CORAZÓN brand from 2002-2007 are quite substantial. 12 TTABVUE 8 (Hurtak Dec. ¶¶ 24, 26). Opposer’s confidential advertising figures from 2010-2020 are much less so,¹⁰ but they are not insignificant, and they increased

⁹ The relationship between Sazerac Company and Opposer is unexplained, but given the context and testimony we assume these to be related companies. Indeed, Ms. Hurtak refers to Sazerac Company, the brand’s owner between 2008 and 2015, as simply “Sazerac,” and refers to Opposer, the brand’s owner after 2015, the same way. 12 TTABVUE 6, 8, 9, 12-13 (Hurtak Dec. ¶¶ 21, 22, 27, 28, 30, 35-37). Thus, for the period 2008-2015, “Opposer” may refer to Sazerac Company.

¹⁰ A New York Magazine article about Mr. Frank, entitled “The Cocktail Creationist,” reports that Mr. Frank was skilled at liquor branding, having “invented [GREY GOOSE vodka] from

greatly in the last several years to a fairly impressive level in 2019 and 2020. *Id.* at 30 (Hurtak Dec. ¶ 71). While Opposer’s average annual sales from 2010-2020 are also less than Sidney Frank Importing’s earlier average annual sales, Opposer’s sales increased significantly in recent years, to levels equaling and later exceeding Sidney Frank Importing’s average annual sales, at least without adjusting for inflation. 12 TTABVUE 37 (Hurtak Dec. ¶ 81). Furthermore, total sales of CORAZÓN tequila from 2010-2020 are impressive by any measure, and in the recent past CORAZÓN products have enjoyed substantial growth exceeding that of competitors. *Id.* at 38 (Hurtak Dec. ¶ 84).

In addition to promoting itself via the Internet and social media, and at food festivals, other events and trade shows, *id.* at 15-27 (Hurtak Dec. ¶¶ 42-65), Opposer has entered and won a number of industry competitions, winning gold and silver medals, “Great Value Awards,” and the titles “2016 World’s Best Tequila” (Corazón Reposado), “2019 World’s Best Blanco” (Corazón Blanco) and “2020 World’s Best Añejo” (Corazón Expressiones (Extra Añejo)). *Id.* at 27-29, 217-218, 233-36, 259-68 (Hurtak Dec. ¶¶ 66-67 and Exs. OTX 16 and OTX 18).

One of Opposer’s sales promotions through “a cash back mobile app called Ibotta” resulted in a confidential but quite large number of “brand impressions for

thin air” in the 1990s. 15 TTABVUE 6. The article further reports that after selling the GREY GOOSE brand, Sidney Frank Importing planned to “spend at least \$3 million on Corazón marketing in 2005 and make it available to all sorts of influential crowds – at a VIP tailgate party at the Super Bowl, at the victory dinner for the Indy 500, and at the Junior League’s Winter Ball in New York.” *Id.* at 7. *See also id.* at 17-23 (San Diego Union-Tribune article entitled “The Taste of Success: He Made His Billions With Grey Goose, But Sidney Frank Still Has a Lot Cooking – Including Several Personal Chefs”).

CORAZÓN in just a few months of the promotion.” *Id.* at 24 (Hurtak Dec. ¶ 58). Opposer also has received a great deal of unsolicited media attention, in publications including Forbes, Men’s Journal, The Wall Street Journal, Marie Claire, The Houston Chronicle, The Chicago Tribune and Maxim. *Id.* at 35-37; 13 TTABVUE 3-143; 15 TTABVUE 6-47 (Hurtak Dec. ¶ 79 and Exs. OTX 21A-C; Opp. NOR 2).

Years after acquiring the CORAZON brand, but well before the involved application’s filing date, Opposer began using its pleaded CORAZON EXPRESIONES mark in connection with a “new line” of tequila aged in “barrels that were previously used to produce bourbon for [Opposer’s] George T. Stagg ... Old Rip Van Winkle, and Buffalo Trace brands ... to provide unique flavor and characteristics.” 12 TTABVUE 11-12 (Hurtak Dec. ¶ 33).

III. Opposer’s Entitlement to Statutory Cause of Action¹¹

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 an application when doing so is within its zone of interests protected by the statute and it has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d

¹¹ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

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, Opposer's pleaded registrations, 1 TTABVUE 11-38, which Applicant acknowledges are registered and owned by Opposer, 16 TTABVUE 19, establish its entitlement to a statutory cause of action. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Applicant does not contest Opposer's entitlement to a statutory cause of action. 16 TTABVUE 19.

IV. Priority


Because Applicant has not counterclaimed to cancel any of Opposer's pleaded registrations, priority is not at issue with respect to the marks and goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In any event, Opposer has established prior common law use of its pleaded marks. 12 TTABVUE 6, 8-9 (Hurtak Dec. ¶¶ 21, 22, 27, 28).

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. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (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. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 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.”).

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We focus our analysis on Opposer’s pleaded  mark in the ’817 Registration. If we find confusion likely between that pleaded mark and Applicant’s involved mark, we need not consider the likelihood of confusion between Applicant’s mark and Opposer’s other pleaded marks. On the other hand, if we find no likelihood of confusion between the mark in the ’817 Registration and Applicant’s mark, we would not find confusion likely between Applicant’s mark and Opposer’s other pleaded marks. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Goods, Their Channels of Trade and Classes of Consumers

The parties’ goods are so similar as to be almost identical. In fact, tequila, which is identified in Opposer’s pleaded registrations, and mezcal, which is identified in the involved application, are both agave spirits made in Mexico. 12 TTABVUE 4 (Hurtak Dec. ¶¶ 9-11). Tequila and mezcal are used “interchangeably” and may be mixed together in cocktails. *Id.* at 6 (Hurtak Dec. ¶¶ 18-20).

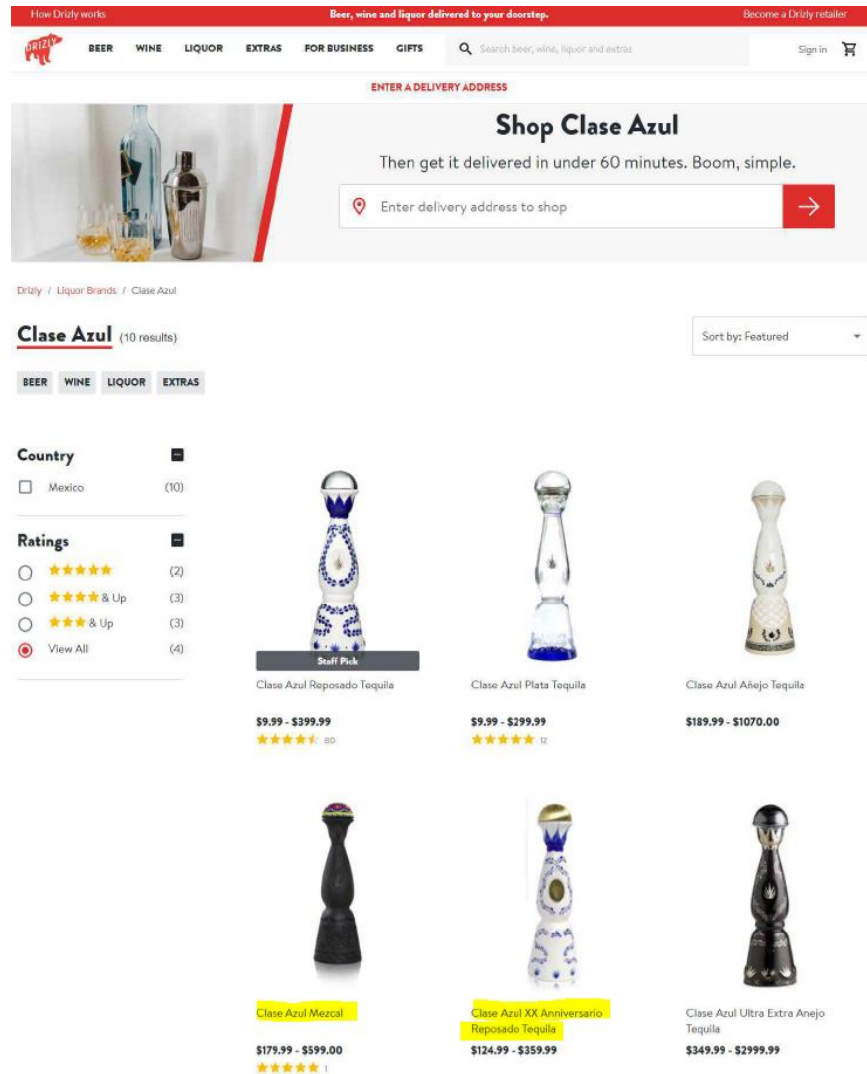
Moreover, Opposer introduced 17 third-party registrations for marks registered for both tequila and mezcal. 14 TTABVUE. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998).

Applicant concedes that the parties’ goods are similar. 16 TTABVUE 21 (response to Request for Admission No. 20). Opposer markets tequila and mezcal together, as revealed by its promotion of CORAZÓN tequila and LOS VECINOS mezcal at the same festival:



12 TTABVUE 30-31, 276 (Hurtak Dec. ¶ 72 and Ex. OTX 20-A). In short, the goods are highly similar to the point of being nearly identical.

The channels of trade and classes of consumers for the goods also overlap. Indeed, the channels of trade for mezcal are the same as those for tequila. Tequila and mezcal are sold in the same sections of the same stores, often side-by-side. For example, Drizly offers CLASE AZUL mezcal on its website, right next to CLASE AZUL tequila:



17 TTABVUE 10; *see also id.* at 12-35 (other online listings of mezcal on the same page as, and often right next to, tequila, sometimes under the same brand). And Applicant admits that its mezcal will be sold in the same channels of trade to the same consumers as Opposer's tequila. *Compare* 16 TTABVUE 20, 38 (responses to Requests for Admission Nos. 10 and 11 and Interrogatory No. 19) *with* 12 TTABVUE 14 (Hurtak Dec. ¶ 39). Thus, these factors also weigh in favor of finding a likelihood of confusion.

B. The Strength of Opposer's Mark

There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength ... and its marketplace strength"). Here, Applicant argues that Opposer's pleaded marks are weak, both conceptually and commercially.

1. Commercial Strength

As for commercial strength, we must determine where to place Opposer's mark on the "spectrum" of marks, which ranges from "very strong to very weak." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). *See also, Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017).

The record in this case amply demonstrates that Opposer's pleaded CORAZÓN marks are at the very least commercially strong.¹²

While Opposer has not introduced any consumer surveys showing fame or strength, they are not necessary; indeed, they "rarely appear." *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Rather, fame or strength "may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Id.* Other relevant factors include "length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

By each of these measures, Opposer's CORAZÓN marks are commercially strong. While Opposer's sales and advertising expenses have fluctuated since Sidney Frank Importing acquired the mark, the totals over the past 19 years are impressive by any measure, and the annual figures appear to be peaking in the past two or three years.

12 TTABVUE 8, 30, 37, 38 (Hurtak Dec. ¶¶ 24, 26, 71, 81, 84).

¹² As Ms. Hurtak testified, "[i]t is common practice for customers of alcoholic products to shorten the names of products. For example ... consumers ... often refer to tequila sold under the CORAZÓN Marks as simply 'Corazón' or 'Corazón tequila.'" 12 TTABVUE 43, 239, 243, 286, 294, 307, 315, 332, 340; 13 TTABVUE 22-32 (Hurtak Dec. ¶ 92 and Exs. OTX 18, 20 and 21-A). See *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1961 (TTAB 2016) ("we also keep in mind the penchant of consumers to shorten marks"); *United Rum Merchs. Ltd. v. Fregal, Inc.*, 216 USPQ 217, 220 (TTAB 1982); *Big M, Inc. v. U.S. Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) ("we cannot ignore the propensity of consumers to often shorten trademarks"). Ms. Hurtak's testimony on this point is un rebutted. Thus, we are not concerned that Opposer's evidence is undifferentiated by pleaded mark, because all of Opposer's pleaded CORAZÓN marks include the term CORAZÓN and would likely be abbreviated by some consumers to CORAZÓN.

Furthermore, Opposer actively promotes its marks online and at in-person events including festivals and trade shows. *Id.* at 15-27 (Hurtak Dec. ¶¶ 42-65). Opposer's CORAZÓN tequilas also have won their share of competitions, including several "World's Best" awards. *Id.* at 27-29, 217-18, 233-36, 259-68 (Hurtak Dec. ¶¶ 66-67 and Exs. OTX 16 and OTX 18). Opposer has received significant unsolicited media attention and "brand impressions," including in publications such as The Wall Street Journal and on interactive media such as the Ibotta app. *Id.* at 24, 35-37; 13 TTABVUE 3-143; 15 TTABVUE 6-47 (Hurtak Dec. ¶¶ 58, 79 and Exs. 21A-C; Opp. NOR 2). In recent years Opposer's CORAZÓN products have enjoyed substantial growth exceeding that of Opposer's competitors. 12 TTABVUE 38 (Hurtak Dec. ¶ 84).

Applicant counters Opposer's evidence of commercial strength with a fairly large number of third-party registrations and third-party uses of marks which it considers to be similar to Opposer's. The registration evidence, however, is not probative on the question of commercial, as opposed to conceptual, weakness (unless it is supported by evidence that the registered marks are actually in use in the United States). Indeed, "third-party registrations are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth *du Pont* factor." *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). *See also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of these registrations is not evidence of what happens in the market place or that customers

are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”).

As for the third-party uses of allegedly similar marks, 22 TTABVUE, this evidence is admissible and probative. It shows that alcoholic beverages bearing CORAZÓN-formative marks are listed on the Internet. However, the value of this evidence is limited because Applicant introduced it through notice of reliance alone, without accompanying testimony concerning, for example, how many United States consumers have been exposed to these listings.

Even if we were to assume without evidence that an appreciable number of United States consumers have encountered displays of third-party CORAZÓN-formative marks in connection with alcoholic beverages, the probative value of most of Applicant’s third-party use evidence is diminished because the goods displayed are not tequila, mezcal or other agave spirits. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-95 (Fed. Cir. 2018); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017) (“Symbolic has not pointed to any record evidence to support a finding that multiple third parties use the mark I AM for the listed goods in its class 3 and 9 applications.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (“The relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on *similar goods*’ ... It is less relevant that ‘Century is used on unrelated goods or services such as ‘Century Dental Centers’ or ‘Century Seafoods.’”)

(quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)); *In re Inn at St. Johns, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018). For example, a number of the marks from the printouts appear to be used for wine. 22 TTABVUE 7, 11-19, 21, 23-25, 27-29, 33, 35-36, 40. Another appears to be used for rum. *Id.* at 20. These third-party uses do not establish public exposure to CORAZÓN marks for agave spirits, which are the specific goods at issue in this case and the goods offered by both Opposer and Applicant.

Of the marks which appear to be used for agave spirits, several have “0 ratings,” calling into question whether they have been sold or encountered at all. *Id.* at 8, 22, 26, 31. Other listings specifically indicate that the displayed product is unavailable. *Id.* at 9, 37. One listing is entirely in Spanish, calling into further question whether it is directed to or has been viewed by United States consumers. *Id.* at 31. Another apparently is a truncated page which omits additional information uncovered by Opposer, specifically that the page was last revised in 2010 and “can’t be reached” in 2021. 24 TTABVUE 84-85. Similarly, Opposer introduced evidence that some of Applicant’s other listings are inactive today. *Id.* at 14, 23, 54, 68. Finally, Opposer has successfully asserted its trademark rights against the owners of several of the third-party agave spirit marks, *id.* at 31, 32, 37, through opposition proceedings. 12 TTABVUE 41, 43 (Hurtak Dec. ¶¶ 89(d) and 90(b) and Exs. 40 and 47); 13 TTABVUE 249-260, 329-333; 23 TTABVUE 4-5, 46-57 (Hurtak Reb. Dec. ¶ 10 and Ex. OTX 84).

This leaves less than a handful of potential third-party United States uses of relevant marks against which Opposer has not asserted its trademark rights. Such a

small number of relevant third-party uses falls well short of the volume of evidence found convincing in *Juice Generation* and *Jack Wolfskin Ausrüstung Fur Draussen, GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), and would not be enough to diminish the scope of protection to which Opposer’s pleaded marks are entitled.

In short, while Opposer has not shown that its CORAZÓN marks are famous, they are well-known for tequila and have enjoyed significant commercial strength for two decades. This also weighs in favor of finding a likelihood of confusion.

2. Conceptual Strength

The mark in Opposer’s pleaded ’817 Registration consists of the stylized word CORAZÓN above a design of a heart superimposed on an agave plant:



. Because the mark evokes the “heart” or core of agave, which is harvested to make agave spirits, 12 TTABVUE 128, it is somewhat suggestive¹³ of agave spirits such as tequila and mezcal.¹⁴ It is not merely descriptive, however,

¹³ Applicant’s third-party registration evidence, 20 TTABVUE, tends to support our finding that HEART/CORAZÓN may have a suggestive meaning in connection with the parties’ goods.

¹⁴ Applicant argues that “[t]he part of the agave plant used for tequila is the heart [i.e. core] of the agave.” 28 TTABVUE 25. The labels used on Opposer’s CORAZÓN tequila bottles indicate that the product “is produced in the ‘heart’ of the Blue Agave growing area of Mexico.” 12 TTABVUE 110 (Hurtak Dec. Ex. OTX 9). Whether the tequila comes from the heart of the plant or the heart of the Blue Agave region, the term CORAZÓN is somewhat suggestive.

because several mental steps would be required to connect the word CORAZÓN with a heart and agave plant design to tequila or mezcal.¹⁵

In any event, because Opposer's mark is registered on the Principal Register without a claim of acquired distinctiveness, we must presume that it is inherently distinctive, i.e., that it is at worst suggestive of the identified goods. 15 U.S.C. § 1057(b) (registration is "prima facie evidence of the validity of the registered mark"); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, "we must assume that it is at least suggestive"). In short, while Opposer's mark is commercially strong, it is conceptually somewhat weak.

Overall, we find that the mark's commercial strength is more significant than its slight conceptual weakness. Therefore, we find that overall, Opposer's pleaded marks are entitled to no less than an average scope of protection.

C. The Marks

The marks are similar in "appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Indeed, CORAZÓN is the dominant feature of both marks, which are reproduced below:

¹⁵ Applicant's argument about conceptual weakness concerns the CORAZON DE AGAVE mark, 28 TTABVUE 25, but here, because we are focusing on the pleaded '817 Registration, that argument is not directly relevant, though we have considered the conceptual strength of the '817 Registration's literal (CORAZÓN) and design (heart superimposed on agave plant) components.



While we have displayed the marks side-by-side here for ease of comparison, “[t]he 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., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). Indeed, we must consider whether the differences between the marks are “likely to be recalled by purchasers seeing the marks at spaced intervals,” i.e. consumers who encounter one party’s mark and do not encounter the other’s until later. *Grandpa Pidgeon’s of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

In both parties’ marks, as is typically the case, the literal element is dominant notwithstanding the accompanying design. *See also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it

would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”). In fact, if a consumer seeking an agave spirit requested it by mentioning a “folk creature” with “incorporated agave cactus plant design,” or a heart superimposed on an agave plant, we question whether the quest would be successful.

Turning to the literal element of Applicant’s mark, CORAZÓN is dominant because it comes first. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also, Palm Bay Imps. Inc.*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). We also keep in mind Opposer’s testimony that consumers tend to shorten trademarks such as these, as well as the caselaw which is consistent with that testimony. 12 TTABVUE 43, 239, 243, 286, 294, 307, 315, 332, 340; 13 TTABVUE 22-32 (Hurtak Dec. ¶ 92 and Exs. OTX 18, 20 and 21-A). *In re Bay State Brewing*, 117 USPQ2d at 1961; *United Rum Merchs.*, 216 USPQ at 220; *Big M, Inc.*, 228 USPQ at 616. As Ms. Hurtak testified, “[i]t is common practice for customers of alcoholic products to shorten the names of products. For example ... consumers ... often refer to tequila sold under the CORAZÓN Marks as simply ‘Corazón’ or ‘Corazón tequila.’” 12 TTABVUE 43-44, 239, 243; 13 TTABVUE 22-32 (Hurtak Dec. ¶ 92 and Exs. OTX 18, OTX 21-A). Here, some consumers would be likely to abbreviate Applicant’s mark as CORAZÓN.

In addition, while Applicant claims the literal element of its mark refers to “the most divine part of heaven,” 28 TTABVUE 16, we must consider the term’s meaning and commercial impression in the context of the goods, mezcal. In the context of agave products, including mezcal, heaven has no specific relevance or meaning, at least not according to the record. However, the record indicates that mezcal is produced from the “heart” or core of the agave plant. Thus, the term “heart” could convey to some consumers, especially those familiar with how agave spirits are made, the “heart” or core of the agave plant. This is especially true because Applicant describes its design as containing an “incorporated agave cactus plant design.”¹⁶ The shared term CORAZÓN therefore has particular significance in the context of agave spirits.

The word CORAZÓN is the only literal element of Opposer’s mark. It is dominant not just because, as is typical, the word is entitled to greater weight than the design. It is also dominant because the design element of Opposer’s mark prominently features a drawing of a heart, reinforcing the word CORAZÓN in Opposer’s mark (and calling to mind Applicant’s mark). *Cf. In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018) (“in this case, the house design in Applicant’s mark may be interpreted as a large estate home or ‘chateau’ that would correspond to, or at least call to mind, the word CHATEAU in Registrant’s mark”).

¹⁶ Applicant’s argument that confusion is unlikely because its mark is “unitary,” 28 TTABVUE 15-16, is not well taken. As Applicant points out, a unitary mark “has a distinct meaning of its own, independent of the meaning of its constituent elements.” *Id.* at 16. In the context of agave spirits, however, many consumers will not perceive Applicant’s mark as having a meaning independent of the meaning of its constituent elements, because those constituent elements could easily refer to the “heart” of a “heavenly” agave plant (which is depicted in the design element of Applicant’s mark). In any event, even if Applicant’s mark is unitary, it will still convey the “heart” of an agave plant to many consumers.

The similarities between the marks do not end at CORAZÓN, the dominant literal element of both. While the parties' designs are different in many ways, there is also an important similarity between them. Applicant's design features the folk creature with, as Applicant describes it, "an incorporated agave cactus plant design," while Opposer's design also features a prominent agave plant. Thus, the parties both combine the word CORAZÓN with a design featuring an agave plant.

These similarities between the marks outweigh the differences, especially when we keep in mind: (1) "the fallibility of memory over a period of time;" and (2) that the "average" purchaser "normally retains a general rather than a specific impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). *See also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) ("marks must be considered in light of the fallibility of memory") (citation, internal quotation marks, and ellipsis omitted). Therefore this factor also weighs in favor of finding a likelihood of confusion.

VI. Conclusion

On balance, the likelihood of confusion factors about which there is evidence and argument weigh in Opposer's favor. Confusion between the parties' marks and their associated goods is likely. 15 U.S.C. § 1052(d).

Decision: The opposition to registration of Applicant's mark on the ground of likelihood of confusion is sustained.