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**UNITED STATES PATENT AND TRADEMARK
OFFICE**
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

wellington

Mailed: June 17, 2004

Opposition No. 91152686

THE DREAM MERCHANT COMPANY,
KFT.

v.

FREMONSTER THEATRICAL

Before Simms, Bucher and Rogers, Administrative Trademark
Judges.

By the Board:

On August 4, 1999, Fremonster Theatrical
("applicant") filed an application (Serial No. 78088051)
to register the mark CIRQUE DE FLAMBE for "entertainment
in the nature of circuses" in International Class 41. The
application alleges a date of first use anywhere and in
commerce on March 9, 1999. The application also contains
a disclaimer of the term "CIRQUE" and a statement that the
English translation of the proposed mark is "ring of
fire."

On August 6, 2002, the application was published for
opposition in the Official Gazette.

On August 13, 2002, The Dream Merchant Company, Kft. ("opposer") filed its notice of opposition to registration of applicant's proposed mark on the grounds of likelihood of confusion and dilution. Specifically, opposer alleges, *inter alia*, that it and its predecessors in interest and related companies have marketed, and continue to market, entertainment and theatrical services and a wide variety of associated merchandise in the United States, commencing at least as early as 1987; that it is the owner of the following registrations for the mark CIRQUE DU SOLEIL: Registration Nos. 1883432, 1888436, 1888385, 1884981, 1887187, 1883632, 1888561, 1885382, 1947480, 1947481, 1959271, 1959272, 1964559, 2006591, 1947479, and 1885095; that it is the owner of the following registrations for the mark CIRQUE DU SOLEIL and Design: Registration Nos. 1887079, 1925400, 2027426, 1947478, 1895119, 1885062, 1947477, 1959269, 1959270, and 2072102; that it is the owner of Registration No. 2442014 for the mark CIRQUE DU MONDE; that the aforementioned registrations owned by opposer "cover entertainment and theatrical services and a wide variety of associated merchandise"; that it has "actively and extensively used and promoted [the aforementioned marks] in the United States for many years prior to the filing date of Applicant's application (October 12, 2001) and Applicant's claimed first use of

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the mark in commerce in the United States (March 9, 1999)"; that the aforementioned marks were "famous prior to the filing of applicant's application on October 12, 2001, and prior to applicant's claimed first use of the mark CIRQUE DE FLAMBE in commerce in the United States on March 9, 1999"; that applicant's proposed mark "so resembles opposer's [aforementioned marks as] to be likely to cause confusion, or to cause mistake, or to deceive"; and that applicant's proposed mark "dilutes the distinctive quality of opposer's famous marks."

Status and title copies of opposer's pleaded registrations were not filed with the notice of opposition.

On October 7, 2002, applicant filed a paper captioned "answer" without any proof of service of a copy thereof on opposer. Essentially, the paper contained arguments on the merits of this case and did not specifically admit or deny the allegations in the notice of opposition. While applicant's communication contained numbered paragraphs, they did not correspond in substance to the numbered paragraphs in the notice of opposition.

On November 21, 2002, the Board issued an order finding that applicant's October 7, 2002 "answer" did not comply with Fed. R. Civ. P. 8(b) and allowed applicant

time to file an answer that complies with the rule. In the order, we informed applicant that the notice of opposition "consists of eight (8) paragraphs setting forth the basis of opposer's claim of damage" and that "it is incumbent on applicant to answer the notice of opposition by admitting or denying the allegations contained in each paragraph."

On December 10, 2002, applicant filed an answer wherein it admitted or denied the allegations in the notice of opposition. Specifically, applicant's answer contains admissions as to paragraph nos. 1-3 and 5, and denials as to paragraph nos. 4 and 6-8 of the notice of opposition. The answer contained proof of service on opposer. Also, in a cover letter attached to this answer, applicant states, in part:

"Thank you for the opportunity to represent our answer to the claims made by the opposer. We have attempted to reply in the manner prescribed, but as of yet, we have not found a copy of Title 37 of the Code of Federal Regulations to guide us. We are ordering one by email now.

We are seeking legal counsel to continue this application and we will hopefully, be presenting an attorney soon, to take over our application process. If we can request a 30-day extension to this filling or the next filling [sic], we wish to do so now, to allow any new attorney to catch up on the issues involved."

At trial, neither opposer nor applicant introduced evidence.¹ Also, neither opposer nor applicant filed a trial brief.²

On February 10, 2004, the Board issued an order allowing opposer time to show cause why the Board should not treat its failure to file a brief as a concession of the case under Trademark Rule 2.128(a)(3).

On March 11, 2004, opposer filed a response to the Board's show cause order and a motion to reopen discovery and the testimony periods. In its response and in support of its motion, opposer states that its "failure to submit testimony and a brief in this case did not result from willful conduct or gross neglect, but was instead the result of [opposer's] reliance on applicant's explicit request for an extension of time to file an answer and obtain counsel, and [opposer's] good faith belief that applicant had not submitted a proper answer to the notice of opposition, and was planning on abandoning its mark." In support of its motion, opposer filed the declaration of its counsel, Monica R. Talley, Esq.

¹ Opposer's testimony period closed on June 16, 2003 and applicant's testimony period closed on August 15, 2003.

² On January 26, 2004, applicant filed a status request letter with the Board. The letter does not contain proper proof of service, as required under Trademark Rule 2.119, but contains a "carbon copy" line that indicates a copy was sent to counsel for opposer.

Turning to the Board's show cause order, we accept opposer's response as establishing that it has not lost interest in this matter. Accordingly, the show cause order is hereby discharged.

We now turn to opposer's motion to reopen discovery and reset testimony periods. Under Fed. R. Civ. P. 6(b)(2), the moving party on a motion to reopen must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. See TBMP § 509.01(b) (2d ed. June 2003), including cases and authorities cited therein. Although we found that opposer has not lost interest in this case, we do not find that opposer has made the necessary showing that its failure to take discovery, testimony or otherwise file a trial brief in this case was the result of excusable neglect. See *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000).

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of

prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith.

It has been held that the third *Pioneer* factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. See *Pumpkin Ltd. v. The Seed Corps*, *supra* at n.7 and cases cited therein. See also *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000). In this case, opposer's stated reasons for failing to take any discovery or testimony are not well taken and do not rise to the excusable neglect standard.

In her declaration, Ms. Talley avers that opposer "reasonably believed that Applicant did not consider the submission to be an answer, but merely a request for an extension of 30 days in which to obtain counsel who would file a proper answer." Opposer also argues that the answer filed on December 10, 2002, was like applicant's previous attempt to file an answer and "once again contained additional discussion and argumentative language." Ms. Talley states that, as counsel for opposer, she therefore docketed the case "to monitor for the filing of a proper answer by counsel, or

issuance of a Notice of Default." As to the length of time that passed, Ms. Talley further states that it took the Board sixteen months to enter a default judgment in a different proceeding involving opposer and "it therefore did not strike me as unusual for the Board to take a number of months to issue a notice of default in a case such as this, in which the applicant has sought an extension of time to file an answer, but then failed to do so."³

As noted previously, a review of applicant's answer (filed December 10, 2002) reveals that, unlike its first attempt to answer the notice of opposition, it contains admissions and denials of the allegations contained in the notice of opposition. Thus, it complies with Rule 8(b), and we do not see how opposer could conclude it was not, at least, a much better attempt at making an answer. The Board in fact concluded it was an acceptable answer. Furthermore, a review of applicant's attached cover letter (pertinent language recited above) reveals that it is not an "explicit" extension request for additional time to file its answer, as characterized by opposer. Instead, a more logical reading of

³ Although not relevant to this proceeding, the Board notes that opposer refers to opposition proceeding no. 91124365 and has misrepresented the occurrence of events. Specifically, in that proceeding, on August 6, 2003, a withdrawal of application, dated September 5, 2002, was filed by applicant with the Board for the first time. On January 28, 2004, the Board noted the withdrawal, noted the absence of opposer's written consent, and entered judgment against applicant pursuant to Trademark Rule 2.135. Thus it was not a default judgment situation and did not take the Board sixteen months to take action.

this cover letter is that applicant is requesting additional time to find legal counsel, and making a contingent request that, if any other filing deadline should be imminent that it be extended. In any case, it is certainly not responsible for opposer to receive a paper captioned as "ANSWER" [all capital lettering in original], filed by applicant within the time (as reset by the Board) for filing an answer, that contains admissions/denials of the allegations in the notice of opposition, and, in view of these circumstances, to construe this paper as not being an answer but "merely a request for an extension of time..."⁴

As to the length of delay, opposer's motion to reopen was filed nearly one year after discovery closed and was in response to the Board's show cause order. Certainly, during this time, opposer could have inquired as to the status of this case and/or viewed the Board's online proceeding status website. Had it done the latter, it would have noticed that applicant's pleading was entered in the proceeding docket by the Board as an "answer", unlike applicant's previous attempt which was entered as an "informal answer."

⁴ In its motion to reopen, opposer states that it had concluded applicant was planning to abandon its mark. There is utterly no indication of this in applicant's answer or cover letter therefor. Moreover, we do not see how opposer could have concluded both that applicant was seeking an extension of time to obtain counsel who would file a better answer and that applicant was planning on abandoning its mark.

Turning to the other two factors for determining whether opposer has made the necessary showing of excusable neglect to reopen discovery and testimony periods, even if we conclude that applicant will not be substantially prejudiced by the delay and that opposer acted in good faith, these factors do not overcome the aforementioned factors which are not in opposer's favor; nor do they otherwise demonstrate excusable neglect.

Accordingly, opposer's motion to reopen discovery and its testimony period is hereby denied. Also, allowing the parties to file briefs at this point would be of little value in view of the scant record before us.

We therefore decide this case on the merits as follows.

We first address the record of evidence before us in this case. As noted previously, opposer did not submit current status and title copies of its pleaded registrations with its notice of opposition, and thus did not make them of record under Trademark Rule 2.122(d)(1). Nor did it make them of record during its testimony period by notice of reliance, under Trademark Rule 2.122(d)(2). See 37 CFR § 2.122(d); see also *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken*

GmbH, 14 USPQ2d 1487 (TTAB 1990); and *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984).

Notwithstanding opposer's failure to submit status and title copies of the pleaded registrations, we note that applicant's answer to the complaint contains admissions that obviate opposer's need to prove the admitted matters. See TBMP § 704.03(b)(1)(A) (2d ed. June 2003) and cases cited therein. Specifically, applicant has admitted the following: that opposer and its predecessors in interest and related companies have marketed, and continue to market, entertainment and theatrical services and a wide variety of associated merchandise in the United States since at least as early as 1987 [Answer, ¶ 1]; that opposer is the owner of the pleaded registrations [Answer, ¶ 2]⁵; that opposer's mark CIRQUE DU SOLEIL is famous [Answer, ¶ 2]; that opposer's mark CIRQUE DU SOLEIL was in use prior to applicant's mark and, consequently, opposer has priority [Answer, ¶ 5]; and that opposer's marks "were famous prior to the filing of applicant's application on October 12, 2001, and prior to

⁵ In its answer and with reference to this admission, applicant states that it "reserves the right to challenge this in any later hearing." Applicant has not filed a withdrawal of this admission and, consequently, the allegation stands admitted.

applicant's claimed first use of the mark CIRQUE DE FLAMBE in commerce in the United States on March 9, 1999."⁶

Although applicant also admitted that opposer is the owner of its pleaded registrations, the Board finds this admission alone to be insufficient for purposes of considering these registrations to have been stipulated into the record. See TBMP § 704.03(b)(1)(A) (2d ed. June 2003) and cases cited therein. Specifically, the admission does not establish the pleaded registrations' current status necessary to make them of record. That is, applicant had not admitted that opposer's registrations are still in existence.

Thus the record before us consists solely of the pleadings, including the particular admissions we have discussed, and the file of the involved application which is automatically of record under Trademark Rule 2.122(b).

In view of applicant's aforementioned admissions in its answer, priority is not in issue and we can now turn to the opposer's likelihood of confusion claim. In determining the issue of likelihood of confusion, we must analyze all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont*

⁶ Applicant did not deny these allegations which were contained in opposer's notice of opposition. Accordingly, the averments are deemed admitted under Fed. R. Civ. P. 8(d).

de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Because the evidence of record before us is limited to the application file and applicant's admissions in its answer, we have no evidence which bears on certain of the factors. Nonetheless, the two key considerations in any likelihood of confusion analysis are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the parties' services, they are, in part, identical. Applicant has admitted that opposer's services include "entertainment and theatrical services" and the application covers "entertainment in the nature of circuses." Because of the identical nature of the services, and the absence of any restrictions in the recitation of the involved application, they must also be deemed to be offered in the same channels of trade to the same groups of consumers. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's

goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

In comparing the parties' marks, we note the fact that opposer's mark CIRQUE DU SOLEIL is translated from French into English as "circus of the sun", and applicant's mark CIRQUE DE FLAMBE is translated from French into English as "circus of fire" or "circus of blaze." CASSELL'S FRENCH-ENGLISH ENGLISH-FRENCH DICTIONARY (fifth edition, 1959).⁷ As to the identical term that the parties' marks have in common, "cirque," we note that this word is synonymous in English with the word "circus." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (unabridged) 410 (1993).⁸ Given the parties' self-described nature of the services rendered in connection with their marks, the term "cirque" is descriptive, if not generic. Indeed, as noted previously, applicant disclaimed in its application any exclusive right to use the term "cirque," apart from its mark. Applicant's disclaimer was in response to a Trademark Office Action (dated February 14, 2002) wherein the

⁷ The Board may take judicial notice of the dictionary definition of a word. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). As noted previously, applicant provided a translation of its mark in the prosecution of the application as "ring of fire." Given applicant's identified services, we find the more appropriate definition to be "circus of fire (or blaze)."

⁸ *Id.*

examining attorney stated the word "cirque" is descriptive because "it is the term for 'circus', which is the generic name for the services rendered [by applicant]." Although a descriptive portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (holding that DELTA is the dominant portion of the mark THE DELTA CAFÉ where the disclaimed word "café" is descriptive of applicant's services); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). We find that the dominant portions of the parties' respective marks are the terms "DU SOLEIL" and "DE FLAMBE," which again are translated as meaning "of the sun" and "of fire" or "of blaze," respectively. The dominant portions of the marks clearly provide a different sound, appearance and meaning which help distinguish the marks as a whole. While a

substantial number of Americans are familiar with the French language, we recognize that most are not and may not immediately make the proper translation of the dominant portions of the marks. However, whether consumers are able to translate the marks or not, they will certainly be able to discern between the two significantly different dominant portions of the marks. In other words, without the benefit of a translation, the dominant portions are easily distinguishable in sound and appearance. Furthermore, if consumers are able to translate the dominant portions of the marks, the differences are even greater because consumers will perceive opposer's mark as having a solar or celestial connotation while applicant's mark connotes a connection with fire, flames or torches.

When viewed as a whole, opposer's mark CIRQUE DU SOLEIL and applicant's mark CIRQUE DE FLAMBE may be perceived by consumers as consisting of the same descriptive or generic term, CIRQUE, but also consisting of the two very different terms, DU SOLEIL and DE FLAMBE, and referring to two different sources of entertainment services.

The fact that opposer's mark is famous, as admitted by applicant, is certainly a probative factor in our likelihood of confusion analysis. *In re E. I. du Pont de*

Nemours & Co., supra. However, while opposer's mark is entitled to a broad scope of protection in view of this admission, we must also realize that the only identical element of the marks is the descriptive, if not generic term, "cirque." Thus, notwithstanding this factor, or that the parties' services are identical, or that the parties presumptively use the same channels of trade and market to the same classes of consumers, we do not find a likelihood of mistake, confusion or deception of consumers. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (The Board, in finding no likelihood of confusion between mark "CRYSTAL CREEK" for wine and marks "CRISTAL" for wine and "CRISTAL CHAMPAGNE" for champagne, did not err in relying solely on dissimilarity of marks in evaluating likelihood of confusion and failing to give surpassing weight to other *du Pont* factors, all of which favored a likelihood of confusion; court noted that "we have previously upheld Board determinations that one DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks"); and *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (differences in marks dispositive of question of likelihood of confusion).

Finally, we turn to opposer's second ground for opposition, i.e., that under Section 43(c) of the Lanham Act, the use of opposer's mark CIRQUE DE FLAMBE would cause dilution of the opposer's famous mark, CIRQUE DU SOLEIL.

The Board has previously allowed plaintiffs alleging dilution to proceed on a theory of likelihood of dilution, when the subject application was not based on use in commerce, i.e., was based on intent-to-use in commerce or Section 44 of the Lanham Act. *The Nasdaq Stock Market, Inc. v. Antartica, S.R.L.*, 69 USPQ2d 1718 (TTAB 2003). However, we have not had occasion in a case involving a use-based application to rule whether the plaintiff may make the likelihood of dilution showing or must make the arguably more difficult showing of actual dilution.⁹ We need not, however, make such a determination in this case, notwithstanding that the involved application is based on use in commerce, because plaintiff's claim would fail regardless of the showing required. Specifically,

⁹ We are mindful of the Supreme Court's decision that the Federal Trademark Dilution Act, 15 U.S.C. § 1127, "unambiguously requires a showing of actual dilution, rather than a likelihood of dilution." *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 123 S. Ct. 1115, at 1124; and the Federal Circuit's decision, *Nitro Leisure Products, L.L.C. v. Acushnet Co.*, 341 F.3d 1356 (Fed. Cir. 2003) [affirming district court's denial of preliminary injunction based on trademark dilution because there was no basis to conclude that moving party met the requirement of "a showing of actual dilution," citing *Moseley*].

plaintiff has not proven other elements necessary for it to prevail on the ground of dilution.

Although applicant has conceded the fame of plaintiff's mark prior to applicant's filing date, there is no concession regarding any blurring or tarnishment or any sort of lessening of the distinctiveness of plaintiff's famous mark, and nor is there proof of this. See *Nasdaq*, *supra*; and *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001), regarding elements required to establish a dilution ground. Moreover, the Board has previously held that the parties' marks must be virtually identical, which they are clearly not in this case, in order for a plaintiff to prevail on the dilution ground. *Id.*

In view of the above, the dilution claim must fail. Trademark Act Section 43(c)(1); See also *Toro Co.*, *supra*.

Because opposer is the plaintiff herein, it is the party who bears the burden of proof in this proceeding. In this respect, opposer has failed to prove its allegations in the notice of opposition (which have been denied by applicant) by a preponderance of the evidence. Consequently, it is adjudged that the notice of opposition fails on both claims.

Decision: The opposition is dismissed.