

This Opinion is not a
Precedent of the TTAB

Mailed: June 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Altadis U.S.A. Inc.

v.

Garó Bouldoukian

Opposition No. 91218161

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

Cindy N. Tran of Law Offices of Cindy N. Tran
for Garó Bouldoukian.

Before Cataldo, Shaw, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Altadis U.S.A. Inc. (“Opposer”) has opposed Garó Bouldoukian’s (“Applicant’s”) application to register the following word and design mark for use on “cigars” in International Class 34:¹

¹ Application Serial No. 76714828, filed on August 26, 2013, claiming first use and first use in commerce since July 12, 2012.



According to the Application, “Color is not claimed as a feature of the mark. The mark consists of the word “GARO” and a picture of a man wearing a panama-style hat, smoking a cigar, with smoke ascending from the cigar, all on a rectangular background with repetitive fleur de lys design.”²

I. The Pleadings.

Opposer opposes the subject Application on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as well as dilution under Section 43(c) Trademark Act, 15 U.S.C. § 1125(c).³ In its Notice of Opposition, Opposer avers in pertinent part that:

- It is a “major United States manufacturer of cigars, tobacco, tobacco related products and smoker’s articles” based in Fort Lauderdale, Florida;⁴
- It is the successor-in-interest to Menendez y Garcia, a Cuban limited liability company that commenced use of a number of trademarks collectively referred to as the “MONTECRISTO and Fleur de Lis Design Trademarks” in the United States at least as early as July 25, 1935 in connection with premium MONTECRISTO cigars, and that continued to use those marks in the United

² Application Serial No. 76714828.

³ Notice of Opposition, 1 TTABVUE.

⁴ Notice of Opposition ¶¶ 1-2, 1 TTABVUE 12.

States until some time after the Castro government nationalized the Cuban cigar industry in 1960;⁵

- It “purchased Menendez y Garcia’s entire United States rights, interest and goodwill in the MONTECRISTO and Fleur de Lis Design Trademarks in 1976” and then reintroduced the brand in the United States;⁶
- It has a wholly owned subsidiary, Cuban Cigar Brands B.V. (“CCB”), which is the title owner of the trademarks and registrations on which the opposition is predicated;⁷ “Altadis brings this Opposition on behalf of itself and on behalf of its wholly owned subsidiary, CCB, the registered trademark owner ...; “Use of the MONTECRISTO and Fleur de Lis Design Trademarks and associated trademarks, trade names, trade dress, service marks and brand names is effectuated by Opposer and its licensees [and] [u]se of the MONTECRISTO and Fleur de Lis Design Trademarks inures to the benefit of CCB.”⁸
- Its opposition is based on the following trademarks and twenty-four U.S. registrations therefor, all owned by CCB:⁹

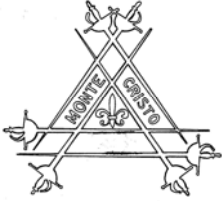

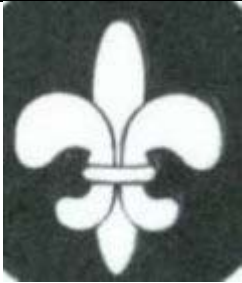
⁵ Notice of Opposition ¶¶ 6-8, 1 TTABVUE 17-18.

⁶ Notice of Opposition ¶ 7, 1 TTABVUE 17.

⁷ Notice of Opposition ¶¶ 3-4, 1 TTABVUE 12-17.

⁸ Notice of Opposition ¶¶ 5, 9-10, 1 TTABVUE 17-18.

⁹ TSDR printouts indicating the status and title of the registrations were attached as exhibits A through T to the Notice of Opposition, 1 TTABVUE 24-97, and exhibits A through X to Opposer’s first Notice of Reliance, 9 TTABVUE 14-99.

Registration	Mark	Goods & Services
No. 332324 Registered Feb. 11, 1935, renewed.		Cigars, cigarettes and cut tobacco.
No. 1459466 Registered Sept. 29, 1987, renewed.		Cigars.
No. 3805893 Registered June 22, 2010.		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.
No. 1173547 Registered Oct 13, 1981, renewed.	MONTECRISTO (typed drawing)	Cigars.
No. 2396980 Registered Oct. 24, 2000, renewed.	MONTECRISTO (typed drawing)	Hat ornaments not of precious metal; ashtrays not of precious metal; credit card services.
No. 2623858 Registered Sept. 24, 2002, renewed.	MONTECRISTO (typed drawing)	Cocktail lounge, bar and restaurant services; night clubs.
No. 2236889 Registered	MONTECRISTO (typed drawing)	Cologne, after-shave lotion. Cuff links. Wallets. Bathrobes, scarves, headwear.

Registration	Mark	Goods & Services
April 6, 1999, renewed.		
No. 2594564 Registered July 16, 2002, renewed.	MONTECRISTO (typed drawing)	Alcoholic beverages.
No. 2855557 Registered June 22, 2004, renewed.	MONTECRISTO (typed drawing)	Ground and whole bean coffee.
No. 1435633 Registered April 7, 1987, renewed.	MONTECRISTO (typed drawing)	Men's clothing, namely, suits, topcoats, overcoats, slacks, and sport jackets.
No. 2673772 Registered Jan. 14, 2003, renewed.	WORLD OF MONTECRISTO (typed drawing)	Cigars, little cigars, pipe tobacco, roll-your-own cigarette tobacco and smokeless tobacco.
No. 2872359 Registered Aug. 10, 2004, renewed.	MONTECRISTO CASINO (typed drawing)	Cigars.
No. 3665071 Registered Aug. 4, 2009.	CASA DE MONTECRISTO (standard character)	Cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco.
No. 3794996 Registered May 25, 2010.	MONTECRISTO CLASSIC COLLECTION (standard character)	Cigars, little cigars, pipe tobacco and smokeless tobacco.

Registration	Mark	Goods & Services
No. 3759106 Registered March 9, 2010.	MONTECRISTO OPEN (standard character)	Cigars. Organizing and conducting a golfing event the proceeds of which are donated to charity.
No. 3679724 Registered Sept. 8, 2009.	MONTECRISTO CUP (standard character)	Cigars. Organizing and conducting a golfing event the proceeds of which are donated to charity.
No. 3791093 Registered May 18, 2010.	CASA DE MONTECRISTO (standard character)	Retail store services featuring fine cigars, tobacco products, smokers' articles, smokers' accessories, men's gifts, logo apparel, and beverages, including coffee and rum.
No. 3897792 Registered Dec. 28, 2010.	MONTECRISTO (standard character)	Retail store services, featuring cigars. Cigar smoking lounge services.
No. 3947902 Registered April 19, 2011.	MONTECRISTO (standard character)	Desk sets; desk pads; pens; stands for pens and pencils. Golf balls. Cigar cases not of precious metal.
No. 4260181 Registered Dec. 18, 2012.	MONTECRISTO (standard character)	Watches.
No. 4618258 Registered Oct. 7, 2014	MONTE (standard character)	Cigars
No. 4773311 Registered July 14, 2015.	MONTECRISTO SOCIAL CLUB (standard character)	Electronic publications. Advertising, promotional, and marketing services. Providing on-line forums. Entertainment services. Providing on-line non-downloadable software which

Registration	Mark	Goods & Services
		enables users to access a database relating to tobacco, tobacco products and smokers. Provision of internet forums and social media sites relating to tobacco, tobacco products and smokers.
No. 4614578 Registered Sept. 30, 2014	ESPADA BY MONTECRISTO (standard character)	Cigars
App. Serial No. 86604604, Registration No. 4942835 Issued April 19, 2016.	ESPADA BY MONTECRISTO (standard character)	Cigars

Applicant’s Answer denied the salient claims made in the Notice of Opposition and amplified upon those denials, pleading that the Fleur de Lis is a national symbol of France, that it has been used and registered by numerous third parties, and that it has become generic.¹⁰

II. Evidentiary Issues.

Both parties have filed briefs.¹¹ Opposer contends that parts of Applicant’s brief rest upon factual assertions consisting of nothing more than attorney argument, unsupported by record evidence—e.g., assertions that the fleur-de-lis symbol is

¹⁰ Answer, ¶¶ 30-35, 5 TTABVUE 6-7.

¹¹ 11 TTABVUE, 14 TTABVUE.

generic, and that extensive third-party use renders the fleur-de-lis mark extremely weak. Opposer maintains that such unsupported arguments should be afforded little weight or disregarded entirely.¹² We take note of Opposer's objections, and address these points in turn as they appear in the course of the parties' arguments.

III. Evidence of Record.

The trial record includes the following testimony and evidence.

A. Opposer's evidence.

1. The testimony deposition of Janelle Rosenfeld, Vice President of Marketing and Trade Marketing for Opposer, and exhibits thereto.¹³
2. Notice of reliance on TSDR printouts showing the status and title of Opposer's pleaded registrations of MONTECRISTO and Fleur de Lis marks; Applicant's Answer to the Notice of Opposition; certain of Applicant's discovery responses; publications and advertisements showing use and public exposure to the MONTECRISTO and Fleur de Lis marks; published articles offered to show how MONTECRISTO cigars are considered top-brand cigars; Internet printouts showing Opposer's use of a repetitive Fleur de Lis pattern on tubes for MONTECRISTO cigars.¹⁴
3. Notice of Reliance on certain publications offered to show the perception of the MONTECRISTO brand among consumers; the Board's decision in

¹² Opposer's brief, pp. 51-53, 13 TTABVUE 53-55.

¹³ 15-16 TTABVUE.

¹⁴ 9 TTABVUE.

Altadis U.S.A. Inc. v. Global Servs. 1939 LLC, Opp. No. 91213902, 2015 WL 7307952 (TTAB Nov. 3, 2015); certain of Applicant's discovery responses.¹⁵

4. Exhibits A through T to the Notice of Opposition, consisting of TSDR printouts showing the status and title of Opposer's pleaded registrations of MONTECRISTO and Fleur de Lis marks.¹⁶ Trademark Rule 2.122(d).

B. Applicant's evidence.

1. The testimony deposition of Applicant, Garo Bouldoukian, and exhibits thereto.¹⁷
2. The file of the subject Application, Serial No. 76714828. Trademark Rule 2.122(b).

IV. Standing and Priority.

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1061-62 (Fed. Cir. 2014) cert. denied, 135 S. Ct. 1401, 191 L. Ed. 2d 360 (2015); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187-89 (CCPA 1982). "Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution blurring... under section 43(c), may...

¹⁵ 13 TTABVUE.

¹⁶ 1 TTABVUE 24-97.

¹⁷ 12 TTABVUE.

file an opposition in the Patent and Trademark Office, stating the grounds therefor....” 15 U.S.C. § 1063. In order to meet the standing requirement, a plaintiff need only show that it has a real interest, *i.e.*, a personal stake, in the outcome of the proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727(Fed. Cir. 2012). A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

In this case, Opposer has pleaded that it is the parent company of the wholly owned subsidiary CCB, the title owner of the pleaded marks and registrations, and that Opposer uses those registered marks in commerce in the United States on cigars and related products, in direct competition with Applicant. As such, Opposer’s use of the marks in commerce inures to its subsidiary’s benefit, 15 U.S.C. § 1055. Both Opposer and its subsidiary have a legitimate commercial interest in the registered marks, *see Empresa Cubana Del Tabaco*, 111 USPQ2d at 1061-62, and any confusion or dilution resulting from Applicant’s registration would damage the financial interests of both. Hence, Opposer has standing to bring and maintain this opposition proceeding. *See Universal Oil Products Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972) (parent corporation has standing to protect interests of wholly owned subsidiary). *Accord Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987); *British-Am. Tobacco Co. Ltd. & Tabacalera Ist Mens, S.A. v. Philip Morris Inc.*, 55 USPQ2d

1585, 1591 (TTAB 2000). *See also* 3 McCarthy on Trademarks and Unfair Competition § 20:7 (4th ed., June 2016 update). Opposer is not an intermeddler.

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). Applicant does not contest Opposer's standing or priority.

V. Likelihood of Confusion.

The issue before us is whether Applicant's applied-for mark so resembles one or more of Opposer's registered marks as to be likely, when used on or in connection with the goods identified in Applicant's registration, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). In determining this issue, based on the evidence and arguments presented, we consider the relevant factors bearing on likelihood of confusion enunciated in *In re E.I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) and in *In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 1314-15, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). We treat as neutral any *DuPont* factors for which there is no evidence or argument of record.

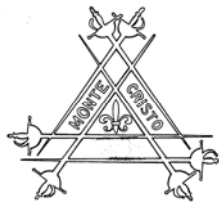
In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc.*

v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016). We focus our analysis primarily on three of Opposer’s registered marks:

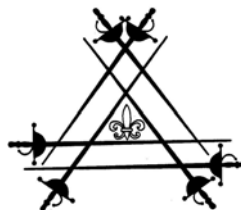
- Registration No. 3805893, the Fleur de Lis design mark, for cigars and related goods in International Class 34:



- Registration No. 332324, the “crossed swords” word and design mark, for cigars and related tobacco goods in International Class 34:



- Registration No. 1459466, the “crossed swords” design mark, for cigars in International Class 34:



If there is no likelihood of confusion with these registered marks, then there would be no likelihood of confusion with the other pleaded registrations, which consist of

variations on the MONTECRISTO word mark. *See North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Opposer must bear the burden of proving likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844. As detailed below, we conclude that a likelihood of confusion has not been established.

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

We evaluate the relatedness of the parties' goods based on their identification in the subject application and registrations. *Octocom Sys., Inc. v. Houston Computers Servs. 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"). *See also Paula Payne Prods. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). Here, it is apparent that cigars, the goods identified in the subject application, are identical to or overlapping with those identified in Opposer's cited registrations.¹⁸

¹⁸ Admitted by Applicant in response to Request for Admission no. 29, Opposer's notice of reliance at 9 TTABVUE 126.

Because the parties' goods are identical in part, and because the application and registrations contain no restrictions on their marketing, we must presume that their cigars would pass through the same channels of trade, primarily retail tobacconists, to the same class of consumers—purchasers and smokers of cigars. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). Applicant admits as much about his cigars:

Q. Are they considered premium cigars?

A. Yes, my opinion.

Q. You previously mentioned they're sold in retail stores. Are you aware whether they're sold in the same retail stores as Montecristo?

A. I think so. ...

Q. ... What are your target consumers?

A. Anybody who enjoys good cigars.¹⁹

Consequently, the second, third and fourth *DuPont* factors favor Opposer.

B. Fame of Opposer's Marks.

Opposer claims that its MONTECRISTO, Fleur de Lis, and crossed swords marks are famous.²⁰ “[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of consumers and potential consumers of a

¹⁹ Bouldoukian dep. 92:1-6, 12 TTABVUE 94, 9:12-13, 12 TTABVUE 11.

²⁰ Opposer's brief, p. 36 et seq., 14 TTABVUE 38 et seq.

product or service, and not the general public.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). So Opposer must clearly prove that its marks are famous among cigar purchasers and smokers. *See Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (“It is the duty of the party asserting that its mark is famous to clearly prove it.”) (quoting *Leading Jewelers Guild Inc. v. LJOH Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

“Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, ‘the length of time those indicia of commercial awareness have been evident,’ widespread critical assessments, notice by independent sources of the products identified by the marks, and the general reputation of the products and services.” *In re Mr. Recipe, LLC*, 118 USPQ2d at 1084 (quoting *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305-06, 1309 (Fed. Cir. 2002)).

According to the record evidence, in 1935 the Cuban Menendez family created the MONTECRISTO brand.²¹ MONTECRISTO cigars were marketed and distributed for sale in the United States from 1935 until the early 1960’s, when their importation was blocked by the Cuban embargo. After a period of excusable non-use,²² Opposer

²¹ Rosenfeld dep., 16 TTABVUE, 38, 273; see *The Illustrated History of Cigars* (1999), Opposer’s notice of reliance, 9 TTABVUE 277.

²² The Trademark Manual of Examining Procedure (“TMEP”) § 1604.11 provides, in pertinent part: “*Trade Embargo or Other Circumstance Beyond Owner’s Control*. Nonuse may be considered excusable where the owner of the registration is willing and able to continue use of the mark in commerce, but is unable to do so due to a trade embargo.”

reintroduced the MONTECRISTO brand in the United States in 1978, and has used the brand on premium cigars in this country ever since.²³ MONTECRISTO is one of the top selling cigar brands in the United States, with sales of over four million cigars, worth tens of millions of dollars, annually.²⁴ Opposer spends between half a million and a million dollars a year in advertising,²⁵ including glossy advertisements in *Cigar Aficionado* and *Wine Spectator*, among other publications, such as *Forbes* and *Travel & Leisure*, that would tend to catch the attention of cigar connoisseurs.²⁶

Over the years, independent sources, such as newspapers and reference books, have traced the brand to its origins in Havana. In 1993 the *Chicago Tribune* observed, “Montecristo, most famous of Cuban cigars, evokes smoky images of old Havana with its pungent scent and rich flavor.”²⁷ In 2003, the *New York Times* wrote of “the world’s most famous cigar, the Montecristo.”²⁸ And in 2006, the *San Francisco Chronicle* referred to “famous Cuban brands such as Montecristo....”²⁹ Similarly, according to *The Ultimate Cigar Book* (1993), [A] Dominican-made Montecristo cigar was launched by Consolidated Cigar Corporation [Opposer’s predecessor] as a continuation of one of the most famous brand names in cigar smoking history.³⁰

²³ Rosenfeld dep. pp. 33:4-24, 15 TTABVUE 38.

²⁴ Rosenfeld dep. p. 51:4-11, 15 TTABVUE 56.

²⁵ Rosenfeld dep. p. 51:12-15, 15 TTABVUE 56.

²⁶ Opposer’s brief, p. 38, 14 TTABVUE 40.

²⁷ *Chicago Tribune*, June 14, 1993, Opposer’s notice of reliance, 9 TTABVUE 251.

²⁸ *New York Times*, Jan. 26, 2003, Opposer’s notice of reliance, 9 TTABVUE 241.

²⁹ *San Francisco Chronicle*, Aug. 10, 2006, Opposer’s notice of reliance, 9 TTABVUE 235-237.

³⁰ *The Ultimate Cigar Book* (1993), Opposer’s notice of reliance, 9 TTABVUE 261. In some of the reference works to which Opposer alludes, such as *The Cigar Companion* (2d ed. 1995) and *The Ultimate Cigar Encyclopedia*, 9 TTABVUE 265, 271-272, it is unclear whether the

And the Christmas 2015 *Cigars International* catalog refers to it simply as “MONTECRISTO The world’s most iconic brand.”³¹

Applicant agrees that cigar smokers in general recognize the MONTECRISTO word mark as Opposer’s brand, but not the Fleur de Lis.³² Opposer tries to extend the fame of its word mark to its Fleur de Lis mark, pointing out that it has been continuously displayed in the center of a circle on the MONTECRISTO cigar bands, in a repetitive pattern on MONTECRISTO CLASSIC COLLECTION cigar tubes, in the center of the crossed swords mark, on the MONTECRISTO cigar boxes, and in MONTECRISTO advertising and promotional materials.³³ These examples, though, tend to show the Fleur de Lis used in conjunction with the MONTECRISTO word mark, not by itself.

Opposer argues that a recent nonprecedential decision by the Board, *Altadis U.S.A. Inc. v. Global Servs. 1939*, 2015 WL 7307952 (TTAB Nov. 3, 2015) supports its position. But that decision, reviewing substantially the same evidence Opposer presented in this case, found that:

text refers to Opposer’s MONTECRISTO cigars, which have been made in the Dominican Republic and sold in the United States since the 1970’s, or to the MONTECRISTO cigars that have been made in Cuba and sold in other parts of the world since the Cuban embargo began in the 1960’s. For that reason, we have focused on newspaper articles and reference works from the United States. However, even if we include all of the sources on which Opposer relies to establish the fame of its MONTECRISTO marks, that would not affect the analysis regarding the Fleur de Lis design.

³¹ *Cigars International* catalog, Christmas 2015, Opposer’s notice of reliance, 13 TTABVUE 7.

³² Bouldoukian dep. 43:8-12, 49:22-49:7, 12 TTABVUE 45, 50-51.

³³ Rosenfeld dep. pp. 33:19-35:3, 73:20-74:2, 15 TTABVUE 38, 78-79; Opposer’s notice of reliance, 9 TTABVUE 158-172, 176-283.

[S]uch 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 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.

Id. at * 5.

We agree. Based on the record evidence, Opposer failed to carry its burden of demonstrating fame in any marks other than its MONTECRISTO-formative word marks. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. The fifth *DuPont* factor of fame is neutral as to the Fleur de Lis.

C. Use on a Variety of Goods and Services.

Similarly, under the ninth *DuPont* factor, Opposer contends that its use of its marks on a wide variety of goods and services (such as cigars, coffee, alcoholic beverages, clothing, ashtrays, cigar cases, humidors and cigar lounge services) evidences the marks' strength. *See Kenner Parker Toys, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed Cir. 1992).³⁴ Although its registrations evince use of its MONTECRISTO-formative word marks on a variety of goods and services, its three marks consisting of or containing a Fleur de Lis are limited to cigars and related products. The ninth *DuPont* factor thus is neutral as to the Fleur de Lis.

D. Comparison of the Marks.

We next consider the similarity or dissimilarity of the parties' marks in their

³⁴ Applicant's brief, p. 43, 14 TTABVUE 45, *citing* Rosenfeld Dep. 55-59, exhibit 14; notice of reliance Exhibits DD, JJ-KK.

entireties as to appearance, sound, connotation and commercial impression. *In re E. I. DuPont De Nemours & Co.*, 177 USPQ at 567. *Palm Bay Imports*, 73 USPQ2d at 1692. When trademarks appear on substantially identical goods, the degree of similarity needed to support a conclusion of likelihood of confusion declines. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722.

With respect to appearance, Opposer claims that “the fleur de lis designs contained in Applicant’s mark are nearly identical to the fleur de lis design that Altadis has registered and used in the center of cigar bands for MONTECRISTO cigars for decades.”³⁵ E.g.:



Applicant responds that “[A]ny comparison, albeit detailed or cursory, is a comparison between apples and oranges. In such a comparison, the only similarity is that both are round and a fruit. This is exactly what Opposer is arguing: there is a round element in both marks and both marks use the widely-used Fleur-de-Lis.”³⁶



³⁵ Opposer’s brief, pp. 29-30, 14 TTABVUE 31-33.

³⁶ Applicant’s brief, p. 4, 11 TTABVUE 5.

Opposer insists that, as in Applicant's mark, it has "long used a repetitive fleur de lis pattern on cigar tubes for its MONTECRISTO CLASSIC COLLECTION cigars," and that Applicant has not only chosen to replicate that pattern, but to use the colors red and yellow/gold on its cigar bands—"colors that have traditionally been used in connection with MONTECRISTO cigars."³⁷



Applicant rejoins:

In any analysis, the focal point of Applicant's Garo mark is the word Garo and the Silhouette of a Man with a Panamanian-Style Hat Smoking. ... The foil is eye-catching and pulls the attention of viewers to the word Garo and the Silhouette of a Man with a Panamanian-Style Hat Smoking. More specifically, applicant's mark is a cigar band that is 3 inches long and about 1 inch in height. The silhouette of the man and the word GARO appears in the center of the band, expands the height of the band making it the most prominent feature of the mark, and is the only focal point. In comparison, the fleur-de-lis is simply a repetitious speck in the background which unless viewed within inches of the band cannot be discerned as the fleur-de-lis. The attention grabber is the silhouette and the prominently displayed word GARO that tells viewers this is a Garo's cigar. Plain and simple.³⁸

³⁷ Opposer's brief, pp. 30-31, 14 TTABVUE 32-33.

³⁸ Applicant's brief, p. 7, 11 TTABVUE 8.

Furthermore, color is not claimed as a feature of Applicant's mark.³⁹ Although it can appear in red and yellow/gold, Applicant testified that it also appears in different colors, such as green and black; "it has nothing to do with the colors."⁴⁰

As we consider the parties' arguments back and forth, we are mindful that our analysis cannot be based on a dissection of the involved marks into their various components. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA v. New Millenium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015).

As the Federal Circuit has declared:

The relevant *DuPont* factor requires examination of "the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression." *DuPont*, 476 F.2d at 1361. As is apparent from the plain language of this factor, marks must be viewed "in their entirety," and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 [26 USPQ2d 1687] (Fed. Cir. 1993) ("The marks are considered in their entirety, words and design."). Although the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, the ultimate conclusion nonetheless must rest on consideration of the marks in total.

In re Viterra, 101 USPQ2d at 1908.

Here, the dominant portions of Applicant's mark, viewed in its entirety, are his silhouette and first name, Garo.⁴¹ We agree that the mark's design draws the eye to the central silhouette, a Panama-hatted man nonchalantly bearing a lighted cigar, from which a plume of smoke wafts upward. *See In re Coors Brewing Co.*, 343 F.3d

³⁹ Bouldoukian dep. 104:19-25, 12 TTABVUE 106.

⁴⁰ Bouldoukian dep. 20:10-23, 12 TTABVUE 22-23.

⁴¹ Bouldoukian dep. 104:9-11, 12 TTABVUE 106.

1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003) (designs differentiate marks). The viewer's eye is then drawn downward to the word component, GARO, displayed in large capital letters. The Fleur de Lis pattern appears as wallpaper—an incidental design, which, if it is discerned at all, is nothing more than background to the more source-identifying dominant components of Applicant's mark. The parties' marks may appear in a variety of colors, some of which may indeed overlap, *see Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011), but Opposer has not established a protectable trade dress in the combination of red and yellow/gold as used on cigars. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (green-gold color of dry cleaning press pads protectable as trademark). On the whole, then, taken in their entireties, the parties' marks are very dissimilar in appearance.

With regard to sound, Opposer contends that “MONTECRISTO and the GARO portion of Applicant's mark are similar inasmuch as both marks end in the letter ‘O’ and both marks contain the letter ‘R’.” In addition, the ending ‘O’ sound is pronounced exactly the same in both marks.”⁴² Applicant states “There is absolutely no similarity at all between the pronunciation of Garo and Montecristo.”⁴³ We agree. Prospective purchasers tend to focus on the first word, prefix, or syllables of a trademark. *See Palm Bay Imports*, 73 USPQ2d at 1692. Here, there is simply no overall similarity in sound between the four-syllable MONTECRISTO and the two-syllable GARO, despite

⁴² Opposer's brief, p. 32, 14 TTABVUE 34.

⁴³ Applicant's brief, p. 6, 11 TTABVUE 7.

the shared “O” suffix and the common letter “R”. This phonetic dissimilarity is important because “the verbal portion of a word and design mark likely will be the dominant portion.” *In re Viterra*, 101 USPQ2d at 1911. It is the portion consumers use in remembering and asking for the brand. *Id.*; *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013). Here, based on the difference in sound, there is no likelihood that prospective purchasers seeking a MONTECRISTO cigar would ask for a GARO, or vice versa.

The connotation conveyed by the parties’ marks is also dissimilar. Opposer’s registrations indicate that MONTECRISTO means “mountain of Christ.”⁴⁴ According to some reference works, the Cuban Menendez family created the MONTECRISTO brand in 1935 “as a tribute to the fictional hero, the Count of Montecristo, whom the novelist Alexandre Dumas had portrayed as a great connoisseur of cigars.”⁴⁵ This would account for the Cuban brand’s use of crossed swords and the French Fleur de Lis.⁴⁶ But there is no record evidence, aside from fairly arcane reference works, to indicate that this particular connotation is in any way appreciated by ordinary cigar smokers or purchasers.

Applicant’s mark, containing his first name, Garo, under his silhouette, connotes, if anything, that he is the source of his brand of cigars. His use of the Gallic Fleur de

⁴⁴ See, e.g., TSDR printout for Registration No. 2236889 for MONTE CRISTO, 1 TTABVUE 46.

⁴⁵ *The Illustrated History of Cigars*, Opposer’s notice of reliance, 9 TTABVUE 277, Rosenfeld dep., 16 TTABVUE 273.

⁴⁶ See J. Holland, *The Ultimate Cigar Encyclopedia* (1998), Opposer’s notice of reliance, 9 TTABVUE 265.

Lis pattern in the background of the mark may evoke some vague French connection, as a symbol of royalty,⁴⁷ but it does not connote a connection with Opposer, much less the Count of Monte Cristo.

In terms of overall commercial impression, Opposer argues that

[C]onsumers are likely to believe that Applicant's cigars are an extension of Altadis' line of MONTECRISTO cigars because it is commonplace for Altadis and other cigar brand owners to create line extensions. ... In some instances, Altadis uses an entirely new word in connection with a line extension....” For example, Altadis currently sells MONTECRISTO cigars under approximately twelve different line extensions, including: MONTECRISTO CLASSIC COLLECTION, MONTECRISTO PLATINUM, MONTECRISTO EPIC, ESPADA BY MONTECRISTO, MONTECRISTO 80TH ANNIVERSARY, MONTECRISTO WHITE, MONTE BY MONTECRISTO, MONTE, and ESPADA BY MONTECRISTO ESTOQUE.⁴⁸

Each of Opposer's line extensions, however, expressly identifies itself to consumers as a MONTECRISTO cigar.⁴⁹ Each line may contain a Fleur de Lis, as does Applicant's mark, but the marks' overall commercial impression must be compared to determine whether confusion is likely. *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (“It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.”). If Applicant's mark is considered in its entirety, with all design and word elements taken together—especially the dominant components, Applicant's silhouette and first name—it creates a wholly different commercial impression from Opposer's marks.

⁴⁷ See Bouldoukian dep. 15:21-24, 21:2-10, 12 TTABVUE 17, 23.

⁴⁸ Opposer's brief, p. 33, 14 TTABVUE 35, *citing* Rosenfeld dep. 52-53, 15 TTABVUE 57-58.

⁴⁹ *Id.*

In sum, the parties' marks are dissimilar in their entireties as to appearance, sound, connotation, and commercial impression. This weighs heavily against Opposer's claim of likelihood of confusion. *Palm Bay Imports*, 73 USPQ2d at 1692. A single *DuPont* factor "may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed Cir. 1998), quoted in *Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010).

E. Third Party Use.

The sixth *DuPont* factor concerns the number and nature of similar marks in use on similar goods. *E. I. DuPont*, 177 USPQ at 567. See also *Lloyd's Food Prods., Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993). Evidence of third-party use or registration bears on the conceptual or commercial strength of an opposer's mark. "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). See also *Palm Bay Imports.*, 73 USPQ2d at 1693 ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.").

Applicant asserts that "A quick search on the USPTO's TESS site reveals that there are over 60 trademarks using the fleur-de-lis symbol in relation to cigars in International Class 34," and that the symbol has been used throughout the cigar

industry.⁵⁰

As Opposer points out, though, Applicant did not submit any documentary evidence, either by notice of reliance or by deposition, proving such third-party use or registrations.⁵¹ See TBMP § 704.03(b)(1)(B) (Third party registrations may be introduced by notice of reliance, as an exhibit to testimony, or by stipulation. “On the other hand, a party may not make a third-party registration of record simply by ... referring to the registration in its brief...”). Applicant testified that Tatuaje cigars once bore a Fleur de Lis, but was unsure whether they currently bore that symbol,⁵² and was unable to name any other third parties’ cigars bearing a Fleur de Lis.⁵³

Applicant has failed to demonstrate common registration or use of Fleur de Lis marks by third parties for cigars. In view thereof, this factor is neutral.⁵⁴

F. Actual Confusion.

The seventh and eighth *DuPont* factors concern the extent of actual confusion during concurrent use of the parties’ marks. *E. I. DuPont*, 177 USPQ at 567. Applicant testified that no one had ever told him they mistook his brand for someone else’s, or that his brand looked like the MONTECRISTO brand.⁵⁵ However, the absence of evidence of actual confusion under the seventh *DuPont* factor is entitled

⁵⁰ Applicant’s brief, p. 10, 11 TTABVUE 11.

⁵¹ Opposer’s brief, p. 42, 14 TTABVUE 44.

⁵² Bouldoukian dep. 61:23-62:5, 12 TTABVUE 63-64.

⁵³ Bouldoukian dep. 62:24-63:2, 12 TTABVUE 64-66.

⁵⁴ For the same reason, lack of evidence, Applicant fails to establish that the Fleur de Lis symbol is generic.

⁵⁵ Bouldoukian dep. 19:18-23, 23:3-6, 37:11-15, 12 TTABVUE 21, 25, 38.

to little weight in our analysis unless it is coupled with evidence under the eighth *DuPont* factor of a significant opportunity for actual confusion to have occurred. *Citigroup v. Capital City Bank Group*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*. 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007).

Here, Applicant only claims to have used his mark in commerce since July 2012, and his sales, undertaken as a part time hobby, have been minimal.⁵⁶ Due to the brevity of his use and the paucity of his sales, the absence of actual confusion is insufficient to negate the likelihood of its occurrence. *Id.* These *DuPont* factors are therefore neutral.

G. Right to Exclude Others.

Opposer states that it has aggressively policed its MONTECRISTO and Fleur de Lis trademarks, excluding others from using identical or confusingly similar marks.⁵⁷ The eleventh *DuPont* factor, however, concerns “the extent to which applicant has a right to exclude others from use of its mark on its goods.” 177 USPQ at 567 (emphasis added).⁵⁸ Opposer argues, more appropriately, that Applicant, as the owner of an application filed in 2013, has virtually no right to exclude others from the use of

⁵⁶ Bouldoukian dep., 21:21-22:16, 12 TTABVUE 23-24.

⁵⁷ Opposer's brief, p. 44, 14 TTABVUE 46.

⁵⁸ The Board has previously reminded opposers that their right to exclude is not the subject of the eleventh *DuPont* factor. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 2012 WL 2588576, at * 9 (TTAB 2012)(nonprecedential) *aff'd* 759 F.3d 1327, 111 USPQ2d 1649 (Fed. Cir. 2014); *American Century Serv. Corp. v. Vista Investment Advisors LLC*, 2002 WL 2022691, at * 9n.10 (TTAB 2002)(nonprecedential).

similar marks.⁵⁹ That is correct. Applicant's recent use of the subject mark, coupled with its minimal sales, "are not sufficient to establish an appreciable level of consumer recognition. Importantly, there is no evidence that Applicant, in fact, has successfully asserted its rights so as to 'exclude' anyone else from using [the same mark] or any similar mark." *McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014). Applicant testified that for ten years he owned a Fleur de Lis word and design mark registration (Registration No. 2417226) for use on cigars:⁶⁰



But this registration, which issued in January 2001, was cancelled in August 2011. "[A]pplicant's ownership of a now-cancelled registration of the mark ... does not establish applicant's right to exclude others from use of the mark." *In Re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1205 (TTAB 2009). This factor is neutral.

H. Applicant's Intent in Adopting its Mark.

Opposer argues that Applicant's adoption of the Fleur de Lis pattern was made in bad faith in an effort to trade off the goodwill associated with Opposer's marks.⁶¹ It bases this allegation on Applicant's familiarity with MONTECRISTO cigars, as well

⁵⁹ Opposer's brief, p. 44, 14 TTABVUE 46.

⁶⁰ Bouldoukian dep. 59:4-24, 12 TTABVUE 61.

⁶¹ Opposer's brief, pp. 47-48, 14 TTABVUE 49-50.

as his display of a single Fleur de Lis in a circle, instead of a repetitive pattern, on his website and Facebook page, at trade shows, and on cigar cutters and cigar box lids.⁶²

However, “an inference of ‘bad faith’ requires something more than mere knowledge of a prior similar mark.” *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1565, 4 USPQ2d 1793 (Fed. Cir. 1987). For over a decade, Applicant owned a registration for a single Fleur de Lis word and design mark, depicted above, for use on cigars, with no objection voiced by Opposer. During his testimonial deposition, Applicant was asked on cross-examination:

Q. Mr. Bouldoukian, do you know that my client knew about you? Are you aware that my client knew about you for the ten years that you used the original mark?

A. Yes, your client knew about me because -- ... I don't know. Maybe they knew, I have no recollection. I don't know if they knew, but I was there all the time.

Q. Okay.

A. They could have come and told me “You can't use it.”⁶³

Now the only mark before us is the one Applicant has applied to register, and that, we have found, is significantly different from Opposer's in appearance, sound, connotation, and commercial impression. On the whole, there is no persuasive evidence of bad intent on Applicant's part. We accordingly treat this factor as neutral.

⁶² *Id.*

⁶³ Bouldoukian dep. 75:6-16, 12 TTABVUE 77.

I. Balancing the Factors.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *DuPont* factors. Although the parties' goods, channels of trade, and classes of customers are the same, Opposer has failed to show that the marks are so similar in appearance, sound, connotation, and commercial impression as to be likely to cause confusion. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive.").⁶⁴ On balance, and taking into account the totality of the evidence of record, we find that Opposer has failed to prove by a preponderance of the evidence that the parties' marks so resemble one another as to be likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

VI. Dilution.

Opposer, relying on the same evidence of fame it offered under Section 2(d) of the Trademark Act, contends that:

[T]he record establishes that the MONTECRISTO Trademark has long been and currently is famous. In addition, because the fleur de lis has been consistently and prominently displayed on MONTECRISTO cigars and packaging since 1935, the Fleur de Lis Design Trademarks have become famous for cigars by virtue of such use.

Importantly, a recent decision by the TTAB, and a prior decision by a federal court, have bearing on fame. In a recent case involving a third party's attempt to register a mark containing several fleur de lis designs in the center of a cigar band, the Board found that Altadis' Fleur de Lis Design trademarks are "***strong, and entitled to a broad***

⁶⁴ Although Opposer's Vice President of Marketing and Trade Marketing opined that the extent of potential confusion was substantial, *see* Opposer's brief, pp. 44-46, 14 TTABVue 46-48, that conclusion was not supported by the applicable *DuPont* factors.

scope of protection.” *Altadis U.S.A. Inc. v. Global Services 1939 LLC*, Opposition No. 91213902 (TTAB 2015) (emphasis added) ...

In addition, at least one federal court has held that Altadis’ MONTECRISTO trademark as used in connection with cigars and licensed goods and services is an inherently distinctive mark that has achieved significant commercial strength for purposes of assessing likelihood of confusion, and a famous mark for purposes of the federal anti-dilution statute. See *Consolidated Cigar Corp. v. Monte Cristi de Tabacos, c.x.a.*, 58 F.Supp.2d 188, 200 (S.D.N.Y. 1999), *aff’d as modified*, 2000 U.S. Dist. LEXIS 21017 (S.D.N.Y. 2000).⁶⁵

Applicant responds that while the MONTECRISTO mark has achieved some measure of public recognition, Opposer has not proven that the Fleur de Lis mark, standing alone, is as strong, distinctive or famous as the MONTECRISTO mark or that the public associates Applicant’s GARO word and design mark with the MONTECRISTO or Fleur de Lis marks.⁶⁶

Based on the record evidence, we find that Opposer has not proven that its Fleur de Lis mark has attained a level of fame entitling it to protection against dilution under 15 U.S.C. § 1125(c). The Board decision on which it relies, *Altadis U.S.A. Inc. v. Global Services 1939*, 2015 WL 7307952 (TTAB 2015), found that Opposer failed to prove its Fleur de Lis mark was famous for 2(d) purposes, *id.* at *5, and did not address the issue of dilution. Based on substantially the same evidence in the present record, we have agreed that Opposer’s Fleur de Lis mark is not famous under Section 2(d) of the Trademark Act. *Supra*. The standard for fame under Section 1125(c) is even higher. *Coach Servs., v. Triumph Learning*, 101 USPQ2d at 1724; *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007). 4 J. Thomas McCarthy, McCarthy

⁶⁵ Opposer’s brief, pp. 49-50, 14 TTABVUE 51-52.

⁶⁶ Applicant’s brief, pp. 11-14, 11 TTABVUE 12-15.

on Trademarks and Unfair Competition § 24:104 (4th ed., June 2016 update) (“The standard for the kind of ‘fame’ needed to trigger anti-dilution protection is more rigorous and demanding than the ‘fame’ which is sufficient for the classic likelihood of confusion test.”). So if Opposer could not meet the lower standard of proving “widespread recognition of Opposer’s fleur de lis ... mark[] among purchasers and smokers of cigars,” *Altadis v. Global Services*, 2015 WL 7307952 at *5, it cannot meet the higher standard of proving that the mark is “widely recognized by the general consuming public of the United States as a designation of source of the goods,” under the dilution statute, 15 U.S.C. § 1125(c)(2)(A).⁶⁷

Furthermore, even if we were to assume *arguendo* that Opposer’s Fleur de Lis mark was famous for purposes of protection against dilution under 15 U.S.C. § 1125(c)(2)(A), Applicant’s mark is not likely to dilute it by blurring. “Dilution by blurring” is defined as “association arising from the similarity between a mark ... and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). *See Coach Servs.*, 101 USPQ2d at 1724; *ProMark Brands v. GFA*, 114 USPQ2d at 1250; *McDonald’s v. McSweet*, 112 USPQ2d at 1286; *Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

Dilution by blurring occurs when “a substantial percentage of consumers, on seeing the junior party’s use of a mark on its goods, are immediately reminded of the

⁶⁷ The District Court decision on which Opposer relies, *Consolidated Cigar Corp. v. Monte Cristi de Tabacos, c.x.a.*, 58 F. Supp.2d 188, 200 (S.D.N.Y. 1999), *aff’d as modified*, 2000 U.S. Dist. LEXIS 21017 (S.D.N.Y. 2000), dealt with counterfeits of the MONTECRISTO word marks and crossed-swords mark, not the Fleur de Lis mark alone. *Id.* That decision, moreover, equated fame under Section 2(d) with fame under Section 1125(c), which is inconsistent with prevailing authority, cited above.

famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner." *N.Y. Yankees Partnership v. IET Prods. & Servs. Inc.*, 114 USPQ2d 1497, 1506 (TTAB 2015).

In determining whether a mark or trade name is likely to cause dilution by blurring, the Board may consider the following six non-exhaustive factors:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi). *McDonald's v. McSweet*, 112 USPQ2d at 1289. Some statutory dilution factors may be given more weight than others, depending on the evidence of record. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d at 1667, *aff'd on other grounds*, 98 USPQ2d 1253.

Here, even if we credited Opposer's Fleur de Lis mark with some degree of inherent distinctiveness and substantially exclusive use under the second and third factors, the remaining factors simply outweigh them. Under the first factor, a party must prove more than confusing similarity; it must show that the marks are 'identical

or very substantially similar.’ *Id.* at 1666 (quoting *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005)). Applicant’s mark is profoundly dissimilar to Opposer’s mark in both its word and design components. Under the remaining factors, the record evidence fails to establish the degree to which Opposer’s mark is recognized, any intention on Applicant’s part to create an association with it, and any actual association between the parties’ marks. For these reasons, Opposer has not carried its burden of proving a likelihood of dilution under 15 U.S.C. § 1125(c).

Decision: The opposition is dismissed.