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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91228479
Party	Plaintiff Chatam International Incorporated
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHATAM INTERNATIONAL INCORPORATED	:	
	:	
Opposer	:	
	:	
v.	:	Opposition No. 91228479
	:	
M CHAPOUTIER	:	
	:	
Applicant	:	Mark VIA SAINT JACQUES

OPPOSER'S REPLY BRIEF

Chatam International Incorporated

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INTRODUCTION

Opposer, Chatam International Incorporated, submits its reply brief in rebuttal to Applicant's, M Chapoutier's, trial brief on the merits of this case.

Applicant has argued: (1) that there is no likelihood of confusion between the marks VIA SAINT JACQUES and JACQUIN'S (U.S. Registration No. 1,245, 562) or the word and design mark JACQUIN (U.S. Registration No. 453,863; (2) Opposer has failed to establish that the "Jacquin's Marks" (as Applicant refers in his Trial Brief to the two U.S. Trademark Registrations set forth immediately above) are well-known and entitled to broad protection; (3) Opposer has failed to establish that the letter combination element of the Jacquin's Marks (JACQU) is a strong source indicator and (4) Opposer has failed to demonstrate the standing of Opposer. In making these arguments, Applicant has parsed all of Opposer's evidence to spin it in the most favorable way to support Applicant's position. However, the simple truth is that the main issue is the confusing similarity of the commercial impression of the respective signs of the Applicant and Opposer,

VIA SAINT JACQUES and

JACQUIN and JACQUIN'S

both for goods in International Class 33 and for goods sold in channels of trade that are identical.

All of the Applicant's arguments, dissecting the respective marks with a scalpel and, then, supporting each segment slice with authority, belies the central premise and reality that the Opposer's evidence supports that substantial volumes of goods bearing the JACQUIN'S and JACQUIN trademarks have been sold throughout the United States for

almost 40 years by Opposer (and longer by tacking Opposer's' predecessors' use of these marks), such evidence supporting the broader protection that is due to be afforded to the JACQUIN'S and JACQUIN marks. Further, that notwithstanding Applicant's dissection of the respective marks of the parties, the dominant portion of Applicant's mark is substantially identical to Opposer's long-established, well-known mark and does create a likelihood of confusion on the basis of commercial impression under all authorities.

For these reasons, Opposer respectfully requests that the Board sustain the Opposition and enter judgment in favor of Opposer.

ARGUMENT

Opposer has Standing to Oppose

First, to dispose of Applicant's argument that Opposer failed to demonstrate standing to oppose in this proceeding, the Board must only look to the evidence of Opposer, Affidavit of Norton J. Cooper, the President of Opposer (as to the acquisition and ownership of the Jacquin's Trademarks by Opposer and the ownership by Opposer of Charles Jacquin et Cie., Inc., to which the Jacquin's Trademarks are licensed) and the Affidavits of Norton J. Cooper, Kevin O'Brien, Vice-President, Sales of Charles Jacquin et Cie., Inc., and Emma King, Liquor Sales and Billing Coordinator of Charles Jacquin et Cie., Inc., to support not only the continuous use of the Jacquin's Trademarks inuring to the benefit of the Opposer but also the extensive use of the Jacquin's Trademarks inuring to the benefit of Opposer. As standing requires only that a party believe that it is likely to be damaged by the registration and a belief in likely damage can be shown by establishing a direct commercial interest, *See, International Order of Job's Daughters v. Lindeburg & Company,* 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984), it cannot be

seriously argued nor considered that Opposer does not have standing to oppose in this case based upon Opposer's evidence.

Opposer's Marks are Well-Known and Entitled to Broader Protection

Next, it is submitted that the Opposer's evidence, the Affidavits referred to immediately above as well as the Confidential Sales Information, part of the Affidavit of Emma King, but redacted and filed under seal, both in terms of sales volumes of goods sold bearing the Jacquin's Trademarks, and aggregate amount of sales support the extensive use and penetration of the market by Opposer, through its licensee of goods, all as are described in the two U.S. Registrations of the Jacquin's Trademarks, notwithstanding Applicant's attempt to call into question the identity of such goods. The Confidential Sales Information clearly identifies all of such goods (Vodka, Rum, Brandy (plain and flavors), Cordials and Liqueurs – Anisette, Banana, Crème de Cacao, Crème de Menthe, Triple Sec, Schnapps of all sorts -- Whiskey (carried as Premium Blend) , among others. The testimony of Kevin O'Brien, in the Affidavit of Kevin O'Brien, makes it clear that the sales of goods bearing the Jacquin's Trademarks are made "to all customers of Jacquin throughout the United States in the majority of States" and that of Norton J. Cooper in his Affidavit makes it clear that this has been continuous for at least almost 40 years. It is submitted that the Jacquin's Trademarks are, therefore, under the law, well-known and entitled to broader protection.

There Exists a Likelihood of Confusion between Applicant's Mark and Opposer's Marks

However, in this case, it is submitted that broader protection is not even necessary. Notwithstanding the dissection of the two marks by Applicant's counsel in Applicant's Trial Brief, it is submitted that the case is clear that there exists a likelihood

of confusion between Applicant's applied for mark, VIA SAINT JACQUES and Opposer's Jacquin's Trademarks, JACQUIN and JACQUIN'S, on the basis of similarity of the marks. As Opposer has made clear in its Notice of Opposition and in its evidence filed in this case, it is, first, the commercial impression to the ordinary consumer of confusing similarity between the respective marks of the parties and, then, the identity of the portion of the respective marks of the unusual in English combination of letters JACQU in each (and in the case of the JACQUIN'S mark, the identity of essentially all letters, except for the "UI" in the one and "E" in the other). And this element, of course, is the entire mark in each of the Jacquin's Trademarks, but is the dominant element of the Applicant's applied for mark.

It is well-established, that in any likelihood of confusion analysis, two key considerations 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 USP@Q 24 (CCPA 1976). In making this analysis, the emphasis is not on a side by side comparison but, rather must be on the recollection of the *average* purchaser, who normally retains a general rather than a specific impression of a trademark. (Emphasis added), *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller,* 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.,* 23 USPQ2d 1735 (TTAB 1991), recognizing 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 (TTAB 1975). The test is whether the marks are sufficiently similar in terms of overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely. See, *Recot, Inc. v. M.C. Becton,* 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed.

Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Industries, Inc.,* 209 USPQ 179, 189 (TTAB 1980). Marks may be confusingly similar in appearance where similar terms or phrases or similar *parts of terms or phrases* appear in the compared marks and create a similar overall commercial impression. (Emphasis added). See, *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce,* 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n,* 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works,* 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Collegian Sportswear, Inc.,* 224 USPQ 174 (TTAB 1984) (finding COLLEGIAN OF CALIFORNIA and COLLEGIENNE confusingly similar). It is, further, a well-established principle that if there are any doubts on the issue of likelihood of confusion, they must be resolved against the newcomer and in favor of the prior user, because the newcomer has the opportunity and obligation to avoid confusion with existing marks. *Hewlett-Packard Co. v. Packard Press, Inc.,* 281 F.2d 1261, 1265 (Fed. Cir. 2002). See, also, *J&J Snack Foods Corp. v. McDonald's Corp.,* 923 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Marin's Famous Pastry Shoppe, Inc.,* 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

In fact, the line of reasoning by the Board in *In re Collegian Sportswear, Inc., supra.,* is particularly apropos to the instant matter where likelihood of confusion was found despite the differences in spelling and the number of letters of the two elements of the two marks, "Collegian" and "Collegienne", and the fact that there were additional terms included in the opposed mark, "Collegian of California", the Board finding there

that customers familiar with the registrant's mark might believe that the applied for mark there was a new line of the goods subject of the registered mark. It has been held that marks may be confusingly similar in appearance where there are similar terms or phrases or *similar parts of terms or phrases* appearing in both applicant's mark and registrant's mark. (Emphasis added). See, *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce, supra.; In re Corning Glass Works, supra.; In re Collegian Sportswear Inc., supra; In re Pellerin Milnor Corp.,* 221 USPQ 558 (TTAB 1983); *In re BASF A.G.,* 189 USPQ 424 (TTAB 1975). As in *In re Collegian Sportswear, Inc., supra.,* there is no issue that the goods are not similar as both are alcoholic beverages in IC 33 and travel in the same or similar channels of trade. It is well-established that goods of the parties need not be identical or directly competitive to find a likelihood of confusion. See S*afety-Kleen Corp. v. Dresser Industries, Inc.,* 581 F.2d 1399, 186 USPQ 476 (CCPA 1975). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *In re Total Quality Group, Inc.,* 51 USPQ2d 1474 (TTAB 1999). That exists in this case.

The Opposer has pointed out in its Opposition and its evidence submitted in support thereof that the common to the two marks combination of letters "JACQU" in each is uncommon in the English language. Opposer's evidence of dictionary search of the letter combination JACQU shows exactly two words, one of which is "jacques", the precise term of the applicant's mark which has been opposed, and the other being "jacquard". Both terms containing this letter combination have French derivation as does

the Opposer's registered marks JACQUIN and JACQUIN'S and applicant's mar VIA SAINT JACQUES. Further, even beyond the asserted confusing similarity between the applicant's mark, VIA SAINT JACQUES, and Opposer's Jacquin's Trademarks on the basis of the combination of letters JACQU, there is even more confusing similarity between applicant's mark and Opposer's JACQUIN'S mark with the existence of the "S" at the end so that such mark and the applicant's mark contain the almost identical element with the exception of an "E" in applicant's mark in place of "IN" in Opposer's registered mark, JACQUIN'S. It has been held that in comparing two marks to determine whether they are confusingly similar . . . "if one word or feature of a composite trademark is the salient portion of the mark, it may be given greater weight than the surrounding elements." *Meridian Mutual Insurance Company v. Meridian Insurance Group Inc.,* 128 F.3d 1111, 44 USPQ2d 1545 (7th Cir. 1997), citing, *International Kennel Club of Chicago, Inc. v. Mighty Star Inc.,* 846 F.2d 1079, 6 USPQ2d 1977 (7th Cir. 1988). In *Meridian, supra.,* the Court recognized that "the principal, eye-catching word is "Meridian . . ." as an element in finding a likelihood of confusion between the two marks in that case. Based upon the unusual in English language of the letter combination JACQU as demonstrated by Opposer's evidence, the term "Jacques" is the eye-catching, salient portion of applicant's mark which is almost identical with Opposer's marks for goods in the same channels of trade and is the basis of a likelihood of confusion between applicant's mark and Opposer's marks.

Applicant's Evidence of Third-Party Registrations Does Not Establish Use of Marks

Finally, Applicant has made much of its argument dependent upon the existence of third-party registrations that incorporate the term "Jacques" to argue that this supports

its argument that there is no issue of likelihood of confusion. However, it is well-established that the existence of third-party registrations is not evidence of use of those marks in the marketplace or that consumers are familiar with them. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark. *In re J.M. Originals,* 6 USPQ2d 1393, 1394 (TTAB 1988).

CONCLUSION

As Opposer is the senior user of its mark "JACQUIN" and "JACQUIN'S" in the alcoholic beverage industry and all doubts about likelihood of confusion should be resolved against the newcomer and in favor of the prior user, that the common portions of the two parties' marks are the unusual in English language combination of the letters JACQU (and in the case of the JACQUIN'S mark of Opposer, being almost identical, including the ending "S"), is the dominant, eye-catching element of the marks, that Opposer has demonstrated standing and its extensive use of its marks in the marketplace, with the applicant not being able to provide competent evidence to the contrary, a finding of likelihood of confusion between Opposer's "JACQUIN" and "JACQUIN'S" trademarks and Applicant's "VIA SAINT JACQUES" trademarks is dictated and a determination sustaining Opposer's Opposition is respectfully requested.

Respectfully submitted,
CHATAM INTERNATIONAL INCORPORATED

Dated: August 14, 2018

By: _____

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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing OPPOSER'S REPLY BRIEF was served on August 14, 2018 via email to Applicant's attorney of record to the correspondence address of record as maintained by the Trademark Office as follows:

Lpavento@mcciplaw.com