

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing: April 28, 2020

Mailed: July 22, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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Jean Leon, S.L.

v.

La Scala Restaurants, Corp.

—————
Opposition No. 91241804

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J. Scott Gerien and Joy L. Durand of Dickenson Peatman and & Fogarty,
for Jean Leon, S.L.

Larry Zerner of the Law Office of Larry Zerner,
for La Scala Restaurants, Corp.

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Before Cataldo, Pologeorgis, and Larkin,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

La Scala Restaurants, Corp. (“Applicant”) seeks to register the standard character mark JEAN LEON’S LA SCALA on the Principal Register for “Restaurant and café services; Restaurant services, including sit-down service of food and take-out

restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises” in International Class 43.¹

Jean Leon, S.L. (“Opposer”) opposes the registration of Applicant’s mark solely on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its pleaded mark JEAN LEON (in standard characters) registered on the Principal Register for “wines” in International Class 33.²

In its answer to the notice of opposition, Applicant denied most of the salient allegations.³ Applicant, however, did admit that Opposer is the owner of U.S. Registration No. 2054495 issued on April 22, 1997, for the mark JEAN LEON for “wines” in International Class 33, with an alleged first use date as early as June 8, 1993.⁴

Additionally, Applicant asserted various putative “affirmative defenses,” including the affirmative defense of estoppel. Insofar as Applicant did not pursue its estoppel affirmative defense in its brief, it is waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*,

¹ Application Serial No. 87136081, filed on August 11, 2016, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), claiming January 1, 1960 as both the date of first use and the date of first use in commerce. The application includes the following translation statement: “The English translation of ‘la scala’ in the mark is ‘the staircase’.” The application also includes the following statement: “The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.”

² Registration No. 2054495, issued on April 22, 1997; renewed. The registration includes the following statement: “JEAN LEON’ is the name of a living individual whose consent is of record.”

³ See Applicant’s Answer, 4 TTABVUE.


⁴ *Id.* at ¶ 2, 4 TTABVUE 2.

565 F. App'x 900 (Fed. Cir. 2014). With regard to the remaining “affirmative defenses,” we construe them as mere amplifications of the denials in Applicant’s answer. *See Order of Songs of It. in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

I. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s involved application file. The record also comprises the evidence summarized below.

A. Opposer’s Evidence

1. Testimony Declaration of Joy L. Durand, one of Opposer’s counsel, and the following accompanying exhibits: (a) copy of search results retrieved from the Trademark Electronic Search System (TESS) of live hits for the combination of the terms JEAN and LEON; (b) a status and title copy of Registration No. 4188534 for the mark JEAN LEON 3055 for “wines” owned by Opposer; and (c) a status and title copy of Registration No. 5706230 for the mark  also for “wines” owned by Opposer;⁵
2. Testimony Declaration of Àngels Rosell Pujol (“Pujol Decl.”), legal director of Opposer’s parent company, Miguel Torres, S.A. (“Torres”), and the following accompanying exhibits: (a) copy of Jean Leon’s written consent to permit the federal registration of the mark JEAN LEON for “wines;” (b) photographs depicting Opposer’s packaging for its JEAN LEON wines; (c) copies of “sell sheets” for Opposer’s JEAN LEON wines; (d) screenshots from Opposer’s website www.jeandleon.com; and (e) screenshots of Opposer’s YouTube, Twitter and Instagram accounts for its JEAN LEON wines;⁶ and
3. Opposer’s notice of reliance on the following: (a) status and title

⁵ 11 TTABVUE.

⁶ 12 TTABVUE (redacted version, including exhibits); 13 TTABUVE (confidential version of testimony declaration only).

copy of Opposer's pleaded Registration No. 2054495 for the mark JEAN LEON (in standard characters) for "wines;" (b) Applicant's responses to Opposer's first set of requests for admission; (c) Applicant's responses to Opposer's first set of interrogatories; (d) copies of documents produced by Applicant during discovery;⁷ (e) screenshots from the website www.lascalabeverlyhills.net; (f) copies of various third-party registrations purportedly demonstrating that a single entity has registered a mark for both wine and restaurant services; (g) screenshots from third-party websites demonstrating third-party use of the same mark for both wine and restaurant services; (h) screenshots of various Internet articles discussing the practice of some restaurants that offer private label or house brands of wine; (i) Internet articles purportedly demonstrating the practice of some restaurants that offer private label or house brands for wines; (k) screenshots from third-party websites of companies who offer to create private label beverage lines for restaurants; and (l) status and title copies of third-party registrations owned by purportedly well-known individuals that have registered their names for both alcoholic beverages and restaurant services.⁸

Opposer filed a trial brief and a reply brief.⁹

B. Applicant's Evidence

1. Testimony Declaration of Gigi Leon ("Leon Decl."), Applicant's president and daughter of the late Jean Leon, and the following accompanying exhibits: (a) a copy of an August 1962 Saturday Evening Post article about Jean Leon and the La Scala restaurant; (b) a photograph of the La Scala restaurant as it looked between 1962 to 1989; (c) copies of menus showing the use

⁷ Applicant has admitted that all the documents it produced in response to Opposer's requests for production of documents are true or correct copies of authentic documents. *See* Applicant's response to Opposer's Request for Admission No. 1 (9 TTABVUE 22). Thus, Opposer may introduce documents produced by Applicant via a notice of reliance. Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii) ("A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.").

⁸ 9-10 and 16 TTABVUE.

⁹ 17 TTABVUE (confidential version); 18 TTABVUE (redacted version); 21 TTABVUE (reply brief).

of the designation “Jean Leon’s La Scala;” (d) copy of a wine list for La Scala restaurant from approximately 1990 that uses the designation “Jean Leon’s La Scala;” (e) copy of a current menu for La Scala restaurant that uses the designation “Jean Leon’s La Scala;” (f) photographs of matches for La Scala restaurant that use the designation “Jean Leon’s La Scala” for various years between 1970 until the present day; (g) photographs of napkins for La Scala restaurant that use the designation “Jean Leon’s La Scala” for various years between 1970 until the present day; (h) photograph of a container of olive oil with the designation “LA SCALA JEAN LEON” that has been used since 1990; (i) an American Express advertisement from 1981 which features Jean Leon as well as other restaurateurs in Los Angeles; (j) copy of a 1990 article from Gourmet Magazine about Jean Leon and the La Scala restaurant; and (k) copy of the August 13, 1996 sales contract between Jean Leon and Opposer’s owner, Torres, by which Jean Leon sold all shares in his company “Jean Leon, S.A.” and by which Torres obtained ownership of the Jean Leon vineyard and wine business.¹⁰

2. Applicant’s Notice of Reliance on (a) Opposer’s responses to Applicant’s first set of interrogatories; (b) status and title copy of Applicant’s involved application;¹¹ (c) status and title copies of Applicant’s registrations for the marks LA SCALA and LA SCALA BEVERLY HILLS; (d) a screenshot of a photograph of a street sign from Santander Spain for “Calle Jean (Resaurador)” purportedly demonstrating that Jean Leon is recognized in Spain as a restaurant owner, not as an owner of a vineyard or wine producer; (e) screenshots from Opposer’s website detailing the biography of Jean Leon; and (f) copies of articles from the Hollywood Reporter titled The Hollywood Reporter’s Top 25 Lunch Spots of 2014, 4 Iconic Restaurant Dishes First Created in L.A., and Hollywood’s 5 Favorite Salads, submitted to demonstrate the purported continuing fame of the La Scala restaurant and its founder Jean Leon.¹²

Applicant filed a trial brief.¹³

¹⁰ 14 TTABVUE 61-99.

¹¹ It was unnecessary for Applicant to submit a status and title copy of its involved application since it is automatically of record. *See* Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

¹² 14 TTABVUE 1-60.

¹³ 19 TTABVUE (redacted version); 20 TTABVUE (confidential version).

We note that some of the evidence proffered by Opposer has been designated confidential and filed under seal. We have discussed only in general terms the relevant evidence submitted under seal, if necessary and appropriate. However, to the extent Opposer has improperly designated testimony and evidence as confidential, we have disregarded the confidential designation when appropriate. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”); *see also Kohler Co. v. Honda Giken K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (citing *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016)); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014).

We additionally note that the parties have submitted printouts from various websites downloaded from the Internet. Although admissible for what they show on their face, *see* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), these webpages also contain hearsay that may not be relied upon for the truth of the matters asserted unless supported by testimony or other evidence. Fed. R. Evid. 801(c); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039-40 (TTAB 2010); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 704.08(b) (2020) (“The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face. However, documents obtained

through the Internet may not be used to demonstrate the truth of what has been printed.”).

II. Background

The founder of Applicant’s restaurant was born in Santander, Spain in 1928 as Ángel Ceferino Carrión Madrazo.¹⁴ In 1948, he immigrated to the United States and legally changed his name to Jean Leon. After arriving in the United States, Jean Leon moved to Los Angeles.¹⁵

On April 1, 1956, Jean Leon opened a restaurant called La Scala in Beverly Hills, California. La Scala quickly became a gathering spot for the era’s most influential names in Hollywood, the music industry, politics and high society, including Marilyn Monroe, Zsa Zsa Gabor, John Fitzgerald Kennedy, Marlon Brando, Robert Wagner, and many others.¹⁶

In 1962, Jean Leon bought 150 hectares of land in the Penedès region of Spain and started a winery to fulfill his dream of making a wine on par with his select clientele at La Scala.¹⁷ In 1969, the Jean Leon winery harvested its first grapes which were used to produce a Cabernet Sauvignon wine known as JEAN LEON Gran Reserva.¹⁸ In 1971, Jean Leon offered the entire first vintage of JEAN LEON Gran

¹⁴ Leon Decl., ¶ 2; 14 TTABVUE 61.

¹⁵ *Id.*

¹⁶ *Id.* at ¶ 5; 14 TTABVUE 62.

¹⁷ Pujol Decl., ¶ 3; 12 TTABVUE 3.

¹⁸ *Id.*

Reserva wine for sale in the United States.¹⁹

In 1994, after being diagnosed with cancer, Jean Leon sold his Jean Leon winery to Torres.²⁰ Since that time, Torres has continued to operate the Jean Leon winery under its legal business name, Jean Leon, S.L., Opposer in this proceeding.²¹

Jean Leon passed away in 1996 and was survived by two children, Jean Leon (also known as Jean Antoine to distinguish him from his father) and Gigi.²² Gigi is the president of Applicant, owner of La Scala Beverly Hills.²³ Prior to his death, Jean Leon provided Opposer with his written consent to register the mark JEAN LEON for “wines.”²⁴

III. Standing

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, 1062 (Fed. Cir. 2014); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing . . . must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading].”). The U.S. Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing, namely

¹⁹ *Id.* at ¶ 4; 12 TTABVUE 3.

²⁰ *Id.* at ¶ 7; 12 TTABVUE 3.

²¹ *Id.*

²² *Id.* at ¶ 8; 12 TTABVUE 3.

²³ *Id.*

²⁴ *Id.* at Exh. 1, 12 TTABVUE 7-8.

that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). To prove a “real interest” in this case, Opposer must show that it has a “direct and personal stake” in the outcome herein and is more than a “mere intermeddler.” *See Ritchie v. Simpson*, 50 USPQ2d at 1026; *see also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988).

Opposer has demonstrated through the USPTO electronic database printouts made of record that it is the owner of its pleaded Registration No. 2054495 for the standard character mark JEAN LEON and that this registration is valid and subsisting.²⁵ Because Opposer’s registration is of record, Opposer has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus.*, 213 USPQ at 189.

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove,

²⁵ Opposer’s Notice of Reliance, Exh. A; 9 TTABVUE 16-20.

by a preponderance of the evidence, that it has priority in the use of its mark and that use of Applicant's mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant's identified services, *Cunningham*, 55 USPQ2d at 1848.

A. Priority

The record demonstrates that Applicant first used its JEAN LEON'S LA SCALA mark for restaurant services in U.S. commerce at least as early as 1962,²⁶ a date prior to any use that can be established by Opposer for its pleaded JEAN LEON mark for wines in U.S. commerce. Applicant is therefore the prior user of its involved mark for restaurant services. However, this does not aid Applicant with regard to the issue of priority of use in this opposition. Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark **registered** in the Patent and Trademark Office ... as to be likely ... to cause confusion ..." 15 U.S.C. § 1052(d) (emphasis added). Thus, although Applicant is actually the prior user at common law, such fact is irrelevant to the question of the registrability of Applicant's mark. As the U.S. Court of Customs and Patent Appeals, the predecessor of the U.S. Court of Appeals for the Federal Circuit, stated in *King Candy Co., v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110-11 (CCPA 1974):

In an opposition, the board must consider existing registrations of subsequent-user opposers, because (1) the statute, 15 U.S.C. §§ 1051-1127, requires such consideration; (2) the basic question in an opposition is applicant's right to register (not merely, as the board says, whether the opposer "will be damaged"); (3) in determining applicant's right to register, the entire statute, including *Section 2(d)*, must be considered;

²⁶ Leon Decl., ¶ 9, 14 TTABVUE 62.

(4) *Section 2(d)* says an applicant can register, *unless* his mark is likely to cause confusion with a mark “**registered** in the Patent Office or ... previously used ...” (emphasis added); (5) the board’s requirement that the registrant-opposer also be a prior user impermissively negates the statutory distinction (“or”) in Section 2(d) between a registered mark and a previously-used-but-unregistered mark, would permit simultaneous registration of the same mark for the same goods to different parties, and disregards--in effect conflicts with--Patent Office Rule 2.106(b), which forbids any attack (other than a request for cancellation) on the validity of a registration in an opposition; (6) the board’s position is unsupported by either statutory or definitive decisional authority; and (7) an opposer who, in the language of Section 13, “believes he would be damaged,” may in fact suffer damage to his registration, (Sec. 7(b)), if the applicant’s mark is registered.

As the board emphasized, registration is not compulsory. We recognize that an applicant-prior user may by delay lose the opportunity to effect cancellation. The answer to that concern resides in the statute. The effect of the entire statute in such instances is to upgrade the register and, so far as registration is concerned, to balance the equities, favoring the long-standing, non-fraudulent registration against the prior user who delays too long in electing to seek registration. The right to exclusive use, in such cases, may be determined in an appropriate action in a district court. We do not regard that result as undesirable. If it were, its correction would be grist for the Congressional mill, not for ours or the board’s.

(emphasis added). *See also Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1704 (Fed. Cir. 1992) (“Opposer’s right to prevail in this proceeding arises from the particular provisions of the Lanham Act that are designed to encourage registration of marks. Opposer took advantage of those provisions. Applicant did not. Applicant, as the prior user, could and should have taken steps to prevent registration by Opposer of the mark LINCOLN. It had an opportunity to oppose or petition to cancel Opposer's registration during a period of more than five years and failed to avail itself of that opportunity.”).

In view of the foregoing and because Opposer's pleaded registration for the mark JEAN LEON is of record, priority is not an issue with respect to the goods identified in Opposer's pleaded registration. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy, Inc.*, 182 USPQ at 110).

B. Likelihood of Confusion

As noted, to prevail on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, it is Opposer's burden to prove by a preponderance of the evidence both priority of use and likelihood of confusion. *Cunningham*, 55 USPQ2d at 1848; *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008). Our determination under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (*DuPont*). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

1. Similarity of the Goods and Services

We first address the second *DuPont* likelihood of confusion factor focusing on the comparison of the services identified in Applicant's application vis-à-vis the goods identified in Opposer's pleaded registration for the standard character mark JEAN LEON. *See e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317,

110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant's services are identified as "Restaurant and café services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises." The goods identified under Opposer's pleaded registration for the standard character mark JEAN LEON are "wines."

It is settled that it is not necessary that the respective goods and services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective goods and services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that goods [and services] emanate from the same source." *Coach Servs. Inc., v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); see also *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or offered by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both Opposer's goods and the

services identified in Applicant's application. *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). The issue is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to their source. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

However, we point out that in cases, such as this one, where restaurant services are being compared to actual food or drink items, there is no per se rule that those goods and services are related. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993) (no per se confusion, where similar marks are used in connection with restaurant services and food products). Rather, when it comes to restaurant services and food or beverages, including alcoholic beverages, "something more" is required (over and above a showing that the goods and services are offered together) because the relatedness of the parties' respective goods and services is not evident. *In re Opus One Inc.*, 60 USPQ2d 1812, 1813 (TTAB 2001).

In *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063-64 (Fed. Cir. 2003), the Federal Circuit assessed whether "something more" showed the relatedness of beer and restaurant services. The court explained why more evidence than just showing that restaurants sell beer is required to prove that beer and restaurant services are related:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the

restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case [*Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982)] stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

Id. at 1064.

The Board has found the “something more” requirement to be met under the following circumstances:

- Applicant’s mark made clear that its restaurant specialized in registrant’s type of goods. *See In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services confusingly similar to GOLDEN GRIDDLE for table syrup); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services confusingly similar to AZTECA for Mexican food items);
- The record showed that registrant’s wines were actually sold in applicant’s restaurant. *See Opus One*, 60 USPQ2d at 1815 (“the record in this case reveals that registrant’s OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant.”); or
- Registrant’s mark was found to be “a very unique, strong mark.” *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988) (“the Examining Attorney has indicated that he has been unable to find, in the records of the Patent and Trademark Office, any registration, other than the cited registration, for a mark containing the expression ‘Mucky Duck,’” nor has applicant offered any evidence of third-party use of marks containing the expression.).

Opposer argues that it has demonstrated the “something more” requirement. In

support of its argument, Opposer submitted 37 active third-party, use-based registrations that identify both wine and restaurant services under a single mark.²⁷ Opposer also submitted evidence of six third-party, use-based registrations purportedly demonstrating that well-known individuals have registered their names for both alcoholic beverages and restaurant services.²⁸ Additionally, Opposer submitted screenshots of numerous websites belonging to third-party dining establishments demonstrating that these eateries use a single mark as a source indicator not only for the wines they serve on premise at their restaurants but also for the dining services they provide.²⁹ Moreover, Opposer submitted evidence showing that it is not uncommon for restaurants to provide “private label” wines at their eating establishments and provided numerous examples of restaurants offering private label or house brand wines under the same mark as their restaurant services.³⁰ Lastly, the record demonstrates that Applicant concedes that Opposer’s wines were historically served at Applicant’s restaurant.³¹

The relevant evidence here is significantly similar to that in *Opus One, supra*. In that case, the applicant was seeking to register the mark OPUS ONE for restaurant services, which was identical to the cited registered mark for wine. The Board also relied on evidence showing that “it is an increasingly common practice in the industry

²⁷ Opposer’s Notice of Reliance, Exh. G; 9 TTABVUE 46-167.

²⁸ *Id.* at Exh. RR; 16 TTABVUE 5-33.

²⁹ *Id.* at Exhs. H-II; 9 TTABVUE 168-359; 10 TTABVUE 2-341.

³⁰ *Id.* at Exhs. JJ-QQ; 10 TTABVUE 342-417.

³¹ *Id.* at Exhs. B-F; 9 TTABVUE 21-45.

for restaurants to offer and serve to their patrons ‘private label’ wines which are named after the restaurant, i.e., wine which is specially-made for the restaurant and served in bottles labeled with the restaurant’s service mark.” *Opus One*, 60 USPQ2d at 1815. Furthermore, the Board noted that the applicant’s OPUS ONE restaurant was actually selling the cited registrant’s OPUS ONE wine. *Id.*

Here, Opposer’s pleaded JEAN LEON mark, as discussed more fully below, is conceptually strong and inherently distinctive and is similar to Applicant’s involved mark for likelihood of confusion purposes. Further, the fact that Applicant’s restaurant historically served the actual goods offered by Opposer under its JEAN LEON mark is certainly probative evidence which supports a finding under the second *DuPont* factor that Applicant’s services and Opposer’s goods are related. *See, e.g., Azteca Rest. Enters.*, supra; *Golden Griddle Pancake House*, supra; *Mucky Duck Mustard*, supra.

Further, the Internet articles submitted by Opposer inform their readers, who may include potential purchasers of wine and of restaurant services, that a restaurant may in fact have a private-label wine named after itself. Being aware of that possibility, purchasers are more likely to assume, upon encountering a wine and a restaurant bearing the same or similar mark, that the wine is the restaurant’s private label wine or that some other source connection between the wine and the restaurant exists, and they are less likely to assume that it is a mere coincidence that the restaurant and the wine use the same or similar mark.

In view of the foregoing and based on the totality of the evidence on this issue, we

find that Opposer has satisfied the “something more” requirement and, as a consequence, we find that Opposer’s wine and Applicant’s restaurant services are related for likelihood of confusion purposes. Thus, the second *DuPont* factor favors a finding of likelihood of confusion.

2. Similarity of Trade Channels/Classes of Purchasers

The third *DuPont* factor considers “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. Since neither Applicant’s JEAN LEON’S LA SCALA application nor Opposer’s pleaded registration for the standard character mark JEAN LEON provides any limitations on the channels of trade and classes of purchasers, we must presume that Opposer’s goods and Applicant’s services are sold/rendered through all the normal and usual trade channels for such goods and services and that they are offered to all usual purchasers of such goods and services. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

Moreover, it is undisputed that restaurants commonly serve wines by the bottle, and that patrons of a restaurant are exposed to both the restaurant’s service mark and to the trademarks with which the wines are labeled and by which they are listed on the restaurant’s menu or wine list. To that extent, Applicant’s restaurant services and Opposer’s wine clearly are complementary goods and services which may be encountered together by the same purchasers. Indeed, the record in this case reveals

that Opposer's JEAN LEON wine was offered and served by Applicant at its JEAN LEON'S LA SCALA restaurant for a period of time and as recently as 2015.

The record also demonstrates that the ordinary trade and distribution channels for wine include restaurants.³² Applicant operates a restaurant. Additionally, the evidence of record shows that wine is served at restaurants³³ and that Applicant sells wine at its own restaurant.³⁴ More significantly, the record demonstrates Opposer's wines were historically served at Applicant's restaurant.³⁵ Thus, the trade channels and classes of purchasers for both Opposer's wines and Applicant's restaurant services have overlapped. Even though Opposer's wines under the JEAN LEON mark ceased being offered at Applicant's restaurant in 2015,³⁶ it is possible that patrons of Applicant's restaurant services, upon seeing the JEAN LEON mark on Opposer's wines at liquor stores or at online retailer websites, would make a reasonable assumption that the producer of Opposer's wines is somehow associated with Applicant or its restaurant and purchase the wine on that assumption.

Thus, the third *DuPont* factor also favors a finding of likelihood of confusion.

3. Strength of Opposer's JEAN LEON Mark

"In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition." *Bell's Brewery*,

³² Opposer's Notice of Reliance, Exhs. B-F, Q-AA; 9 TTABVUE 21-45 and 305-359; 10 TTABVUE 1-204.

³³ *Id.* at Exhs. B, E-F, H-II; 9 TTABVUE 2-11.

³⁴ *Id.* at Exhs. B-F; 9 TTABVUE 21-45.

³⁵ *Id.*

³⁶ Leon Decl., ¶ 24, 14 TTABVUE 64.

Inc. v. Innovation Brewing, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc.*, 110 USPQ2d at 1476); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). The fifth *DuPont* factor, the “fame” or strength of the prior mark, and the sixth *DuPont* factor, the number and nature of similar marks in use for similar goods, *DuPont*, 177 USPQ at 567, may be considered in tandem to determine the strength of Opposer’s mark and the scope of protection to which it is entitled. *Bell’s Brewery, Inc.*, 125 USPQ2d at 1345.³⁷

Conceptual Strength

With regard to the conceptual strength of Opposer’s JEAN LEON mark, we note that Opposer’s Registration No. 2054495 for the mark JEAN LEON issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. Accordingly, because no challenge to the lack of inherent distinctiveness of Opposer’s JEAN LEON mark has been made, we find Opposer’s mark JEAN LEON is inherently distinctive and, therefore, is entitled to the normal scope of protection accorded an inherently distinctive mark.³⁸

³⁷ The Federal Circuit has held that “[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)).

³⁸ We additionally note that Opposer’s JEAN LEON mark consists of a person’s given name. We have previously found that personal names are inherently distinctive and registrable on the Principal Register. *See Christopher Brooks v. Creative Arts by Calloway, LLC*, 93 USPQ2d

Fame of Opposer’s JEAN LEON Mark – 5th *DuPont* Factor

We next determine the alleged fame or commercial strength of Opposer’s JEAN LEON mark under the fifth *DuPont* factor. In determining the commercial strength of Opposer’s JEAN LEON mark under this factor, such strength “may be measured indirectly by the volume of sales and advertising expenditures in connection with the [goods] sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods] identified by the mark []; and the general reputation of the [goods].” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017).

To demonstrate the commercial strength of its JEAN LEON mark in connection with wines, Opposer submitted a variety of evidence. The evidence of record shows: (1) that Opposer itself has used its JEAN LEON mark in association with wine throughout the United States since at least as early as June 8, 1993;³⁹ (2) Opposer’s confidential annual U.S. gross sales and number of cases of wine sold for the years 2014-2018 under the JEAN LEON brand, which may be characterized as modest

1823, 1830 (TTAB 2010) (“We hold that when a plaintiff is asserting prior rights based on a personal name, not a surname, the personal name trademark is inherently distinctive.”), *rev’d on other grounds*, 2012 WL 6732907 (S.D.N.Y. 2012).

³⁹ Pujol Decl. (redacted version), ¶ 10, 12 TTABVUE 4. Although Opposer’s witness has testified regarding Opposer’s use of the JEAN LEON mark for wine since at least as early as June 8, 1993, the record demonstrates earlier use of the mark by Opposer’s predecessor-in-interest, i.e., first use of JEAN LEON for wine in U.S. commerce in 1971 by Mr. Jean Leon (Pujol Decl., ¶ 4; 12 TTABVUE 3), use of the JEAN LEON mark for wine on menus at La Scala restaurant sometime in the 1970s, and service of JEAN LEON wine at President Ronald Reagan’s inauguration in 1981 (Leon Decl., ¶ 17; 14 TTABVUE 63). These earlier uses inure to the benefit of Opposer as the successor-in-interest of the JEAN LEON mark for wine. *See Hylco Co., Inc. v. Jean Patou, Inc.*, 103 USPQ 52 (CCPA 1954).

sales at best;⁴⁰ (3) that Opposer has advertised its JEAN LEON mark in magazines, point of sale materials in retail outlets, on the Internet and through social media outlets such as YouTube, Twitter, Facebook, and Instagram;⁴¹ and (4) that Opposer has garnered high marks and recognition by various organizations, publications, and wine critics for its wines.⁴²

“In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it.” *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), *rev’d on other grounds*, 2008 WL 6862402 (D.D.C. Apr. 3, 2008). When viewing Opposer’s “fame” evidence in its totality, we find that the evidence is insufficient to demonstrate that Opposer’s JEAN LEON mark falls on the very strong end of the fame spectrum for likelihood of confusion purposes. We initially note that the length of time Opposer has used its JEAN LEON mark in commerce, standing alone, is not sufficient to establish that its mark has achieved such commercial renown that it may be considered a very strong mark. Moreover, while Opposer’s confidential dollar amount of sales slightly increased for each year between the years 2013 and 2017, we find the gross annual sales to be extremely modest. Moreover, Opposer did not submit any evidence concerning the dollar

⁴⁰ Pujol Decl. (confidential version), ¶ 14, 13 TTABVUE 4. While Opposer states that it began use of its JEAN LEON mark for wine as early as June 8, 1993, Opposer did not submit any sales or volume data for the years 1993-2013, a twenty-year period.

⁴¹ Pujol Decl. (redacted version), ¶ 15, 12 TTABVUE 4.

⁴² *Id.* at ¶ 17, 12 TTABVUE 4.

amount of yearly advertising expenditures for its JEAN LEON wine. Further, while the record demonstrates that Opposer has placed advertisements in magazines, Opposer fails to identify in which magazines the advertisements appear, whether these magazines have national circulations, or how often the advertisements were placed.⁴³

As to Opposer's social media platforms, i.e., Facebook, Twitter and Instagram, such evidence falls short of demonstrating the extent to which the number of followers translates into widespread recognition of Opposer's JEAN LEON mark among the relevant consuming public, and also lacks context. We are simply without enough information to determine the degree to which Opposer's social media followers are significant.

Finally, the amount of accolades received by Opposer is not so extensive so as to demonstrate widespread recognition of Opposer's JEAN LEON mark used in connection with wines. *Cf. Joseph Phelps Vineyards, LLC*, 122 USPQ2d at 1734-35.

Based on the totality of the evidence submitted by Opposer which the Board may consider, including the evidence submitted under seal, we find that Opposer has demonstrated that its JEAN LEON mark has attained limited commercial success and renown when used in association with wines. Therefore, Opposer's JEAN LEON

⁴³ Opposer also failed to submit any evidence to demonstrate (1) how its sales compare to its competitors in the industry, (2) how many times consumers encounter its JEAN LEON mark for wines, or (3) any context for its achievements in the wine business, e.g., market share. Without comparative numbers or market share percentages, it is difficult to place the apparent success or renown of Opposer's JEAN LEON mark into context. *Bose Corp.*, 63 USPQ2d at 1309.

mark would not fall on the strong end of the spectrum of fame for purposes of the likelihood of confusion analysis. Thus, the fifth *DuPont* factor is neutral.

Similar Marks on Similar Goods – 6th *DuPont* Factor

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods. *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). There is no evidence of record demonstrating third-party uses of marks containing the wording JEAN LEON or similar variations thereof for wine or other alcoholic beverages other than the uses by Opposer. In light of the lack of any evidence of record demonstrating third-party use that employ the designation JEON LEON for wines, we find that Opposer's JEAN LEON mark has not been weakened and accordingly, the sixth *DuPont* factor is neutral.

In sum, although the evidence of record does not demonstrate that Opposer's JEAN LEON mark would fall on the very strong end of the fame spectrum for likelihood of confusion purposes, it nonetheless is not weakened by third-party uses of similar marks for similar goods and, as noted, is inherently distinctive and thus deserves the normal scope of protection afforded inherently distinctive marks.

4. Similarity of the Marks

We next consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 73 USPQ2d at 1691. "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial

impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs.*, 101 USPQ2d at 1721 (internal quotation marks omitted)).

Opposer’s pleaded mark is JEAN LEON in standard characters. Applicant’s involved mark is JEAN LEON’S LA SCALA also in standard characters. Here, the parties’ respective marks are similar in appearance, sound, connotation and commercial impression in light of the shared term JEAN LEON. Indeed, Applicant’s mark encompasses the entirety of Opposer’s mark, and uses the name that comprises Opposer’s mark in the possessive case with respect to the words LA SCALA. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER confusingly similar to BENGAL); *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT confusingly similar to CONCEPT); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY confusingly similar to EBONY DRUM for cosmetic products); *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY’S PIZZA confusingly similar to PERRY’S for restaurants); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (MACHO COMBOS confusingly similar to MACHO).

Furthermore, because Applicant has appropriated the entirety of Opposer’s mark as the first portion of its mark, the marks are aurally and visually similar. It is well

accepted that the lead element of a mark is most likely to be impressed upon the mind of a purchaser and remembered. *See Palm Bay Imps.*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead term); *Presto Prods Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

In fact, the Board has found that marks that include and share given names, as is the case here, may be confusingly similar even if they also include additional terms or features because consumers encountering such marks are more likely to focus on the common given name and mistakenly believe that the goods or services of the parties emanate from or are sponsored by the same source. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137-39 (TTAB 2015) (finding H HUGHES FURNITURE MOTION EAZE RECLINERS and Design confusingly similar to BRADLEY HUGHES); *In re H&H Prods.*, 228 USPQ 771, 772 (TTAB 1986) (HARTLEY’S and Design confusingly similar to WM. P. HARTLEY’S “because they might easily be thought to differentiate two product lines of same producer . . . rather than to distinguish source”); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446 (TTAB 2014) (BRUCE WINSTON confusingly similar to WINSTON and HARRY WINSTON because “[a] surname preceded by a given name is a common, highly conventional combination of word elements, and the mark BRUCE WINSTON could well be interpreted as a more specific reference to a person

or company that is otherwise identified by the designation WINSTON”).

Moreover, with respect to sound, the apostrophe before the “s” in the JEAN LEON’S portion of Applicant’s mark is unlikely to be noticed by consumers and does not change the pronunciation; even if noticed, it merely indicates the possessive form of JEAN LEON and would have little effect in countering the overall similarity of the marks and indeed might exacerbate it by suggesting that the JEAN LEON associated with wine now owns or operates a restaurant, as did the historical Jean Leon. *See In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (noting that “[t]he absence of the possessive form in applicant’s mark ... has little, if any, significance for consumers in distinguishing it from the cited mark”); *In re Curtice-Burns, Inc.*, 231 USPQ 990, 992 (TTAB 1986) (finding the marks McKENZIE’S and McKENZIE “virtually identical in commercial impression”); *Winn’s Stores, Inc. v. Hi-Lo, Inc.*, 203 USPQ 140, 143 (TTAB 1979) (noting that “little if any trademark significance can be attributed to the apostrophe and the letter ‘s’ in opposer’s mark”).

While we have not overlooked the wording LA SCALA in Applicant’s involved mark, we nonetheless conclude that Applicant’s JEAN LEON’S LA SCALA mark and Opposer’s JEAN LEON mark, when considered in their entirety, are more similar than dissimilar in sound, appearance, connotation and commercial impression for the reasons explained above.

Thus, the first *DuPont* factor also favors a finding of likelihood of confusion.

5. Bad Faith Adoption Under the Thirteenth *DuPont* Factor

Opposer argues that Applicant adopted its JEAN LEON’S LA SCALA mark in bad

faith and with the intention of trading on Opposer's goodwill in its JEAN LEON mark.⁴⁴ Specifically, Opposer maintains that Applicant was aware of Opposer and Opposer's JEAN LEON mark prior to filing its involved application.⁴⁵ Moreover, Opposer contends that Applicant has registered domain names related to the JEAN LEON mark used in association with wine, i.e., www.jeanleonlascalawines.com, www.jeanleon-torres.com, www.jeanleonvinyards.com, www.jeanleonwines.com, www.bodegasjeanleon.com, and www.bodegajeonleon.com, thereby further demonstrating Applicant's intent to interfere with and trade on Opposer's goodwill.⁴⁶

Bad faith, or intent to confuse, falls under the thirteenth *DuPont* factor, "any other established fact probative of the effect of use." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). "[A] party which knowingly adopts a mark similar to one used by another for related goods should not be surprised to find scrutiny of the filer's motive." *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012). "[W]here there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First Int'l Servs. Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988). However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc.*

⁴⁴ Opposer's Trial Brief, pp. 17-18; 18 TTABVUE 23-24.

⁴⁵ *Id.* at p. 18; 18 TTABVUE 24; *see also* Opposer's Notice of Reliance, Exh. B, 9 TTABVUE 2.

⁴⁶ *Id.*; *see also* Opposer's Notice of Reliance, Exh. B, 9 TTABVUE 24-25.

v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See, e.g., Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) (“[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.”) (quotation omitted).

After careful consideration of Opposer's arguments and the evidence on this factor, we are not persuaded that Applicant adopted its mark in bad faith or that Applicant's intent weighs against Applicant in our likelihood of analysis in this case. As noted above, the evidence of record clearly shows that Applicant commenced use of its involved mark long prior to any established use by Opposer of its pleaded mark. The fact that Applicant may have known that Opposer was using its JEAN LEON mark and that it had obtained a federal trademark registration for the mark JEAN LEON for “wines” at the time Applicant filed its involved application does not amount to bad faith. As noted above, mere knowledge of the existence of Opposer's mark does not, in and of itself, constitute bad faith. *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989); *Ava Enters., Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006).

With regard to the domain name registrations, there is no evidence of record that any websites associated with these domain names are currently operable and, if they were, whether the websites direct consumers to Applicant's own website. Moreover, there is no evidence showing that Applicant has attempted to sell these domain

names to Opposer for some nefarious reason. While Applicant's registration of these domain names may raise an eyebrow, we do not find that the act of registering these domain names, standing alone, amounts to a bad faith adoption of Applicant's involved mark. In order to demonstrate that Applicant's application was filed in bad faith, Opposer must show that Applicant intentionally sought to trade on Opposer's good will, and the record evidence is insufficient to support this contention.

Thus, the thirteenth *DuPont* factor based on bad faith adoption is neutral.

6. Nature and Extent of Any Actual Confusion/Length of Time During and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion.

DuPont factor 7 considers the “nature and extent of any actual confusion.” *DuPont*, 177 USPQ at 567. *DuPont* factor 8 considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Id.* Applicant argues that “the fact that there have been no instances of actual confusion in over 25 years between Opposer's allegedly strong mark and Applicant's destroys any claim by Opposer that there is any likelihood of confusion between the marks.”⁴⁷ Applicant further maintains that Opposer has conceded that it is unaware of any instances of actual confusion between the parties' respective marks.⁴⁸

The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant

⁴⁷ Applicant's Trial Brief, pp. 10; 19 TTABVUE 11.

⁴⁸ *Id.*; see also Applicant's Notice of Reliance, Exh. 1, 14 TTABVUE 12 (“Response to Special Interrogatory No. 15: Opposer is not aware of any instances of confusion as between ‘JEAN LEON’ products and applicant.”).

period of time in the same markets as those served by Opposer under its mark. *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enterps. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”). Further, the similarity of the goods and services, as well as trade channels, is relevant when assessing whether the absence of actual confusion is indicative of likelihood of confusion. *See In re Guild Mortg.*, 129 USPQ2d at 1164.

Here, the record demonstrates that Opposer's JEAN LEON wine has been sold at Applicant's restaurant.⁴⁹ Although the evidence of record does not show that Jean Leon sold his wine under his JEAN LEON mark at his restaurant from the time he acquired his vineyard in Spain until the time he sold all rights to the vineyard and the JEAN LEON mark for wine to Opposer, one could reasonably assume that he did. However, subsequent to the purchase of the vineyard and the rights to the mark

⁴⁹ Opposer's Reply Brief, p. 7; 21 TTABVUE 12; *see also* Opposer's Notice of Reliance, Exhs. B-F, 9 TTABVUE 21-45.

JEAN LEON by Opposer, when the JEAN LEON mark for wine and the JEAN LEON'S LA SCALA mark for restaurant services became separately owned, the record is silent as to whether Opposer's sales of its JEAN LEON wine to Applicant were continuous and appreciable. As noted above, Opposer's total sales have been quite modest and the record does not delineate which of those sales were to Applicant. Indeed, the only evidence of record is the testimony of Gigi Leon, Applicant's president, who testified that Applicant ceased to sell JEAN LEON wine at the La Scala restaurant in 2015. What this testimony does not reveal, however, is when Opposer began selling its JEAN LEON wine to Applicant to be served at Applicant's restaurant, whether such sales were continuous from that point until 2015, and the amount of such sales.

In light of the lack of evidence of evidence regarding the length of time Opposer sold its JEAN LEON wine to Applicant and the extent of such sales, there is no way for us to determine that there has been any significant opportunity for actual confusion to have occurred. Here, the evidentiary record is much more lacking than the record in *Opus One*, where we rejected the argument under the eighth *DuPont* factor that the sale of 600 bottles of OPUS ONE wine a year to a restaurant operating under the identical mark over a thirteen-year period was sufficient to demonstrate that the lack of any actual confusion precluded a finding that confusion is likely. *See Opus One*, 60 USPQ2d at 1818-19; *see also In re Majestic Distilling*, 65 USPQ2d at 1203 (court considered 16 years of concurrent use with no evidence of confusion, but still found confusion likely); *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, *5-8 (TTAB

2020) (40 years of concurrent use insufficient to find that lack of actual confusion supported a finding that confusion is unlikely because the evidence of record did not demonstrate any specific geographical areas of overlap between the consumer markets for the business conducted by the respective parties).

We are also not persuaded on this record that the absence of any reported instances of actual confusion on the part of Opposer's wine purchasers and Applicant's restaurant customers is necessarily attributable to any assumption or understanding by those customers that there is no source connection between Opposer and Applicant, or to any belief on their part that it is a mere coincidence that Applicant's restaurant and Opposer's wine have similar names. Rather, we find it to be at least plausible that if Applicant's restaurant customers have not inquired as to the existence of any source relationship between Applicant and Opposer, it is because they already assume that there is some sort of relationship between Opposer and Applicant. Indeed, the evidence of record does demonstrate that both parties tout their relationship to the historical person Jean Leon.⁵⁰

In summary, we are not persuaded on this record that the absence of any evidence of actual confusion is entitled to significant weight in our likelihood of confusion analysis,⁵¹ and we therefore find that the seventh and eighth *DuPont* factors to be

⁵⁰ Pujol Decl., Exh. 4; 12 TTABVUE 18-34; Opposer's Notice of Reliance, Exh. F, 9 TTABVUE 44-45; Leon Decl., ¶¶ 6-7 and accompanying Exh. 10; 14 TTABVUE 62 and 65-66; Applicant's Notice of Reliance, Exhs. 6-9, 14 TTABVUE 24-60.

⁵¹ If the record had demonstrated that Opposer had sold its wine to Applicant to be served at Applicant's restaurant from the time it acquired rights in the JEAN LEON mark and that such sales were continuous and appreciable, then the lack of reported instances of actual confusion during such time would have been entitled to greater weight in the balancing of

essentially neutral in this case.⁵²

V. Conclusion

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors of which there is argument and evidence. We have found that (1) Opposer's pleaded JEAN LEON mark is inherently distinctive and has some commercial strength, and is entitled to the normal scope of protection for inherently distinctive marks; (2) the marks at issue are similar; (3) Opposer's goods and Applicant's services are related; and (4) the parties' respective trade channels and classes of purchasers overlap. We further find that there simply is insufficient evidence of record to convince us that the seventh and eighth *DuPont* factors, which consider the "nature and extent of any actual confusion" and the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion," would weigh against finding a likelihood of confusion, much less outweigh the other countervailing factors that weigh in favor of finding a likelihood of confusion. Thus, we find that Opposer has established by a preponderance of the evidence that confusion is likely under Section 2(d) of the Trademark Act.

Decision: The opposition is sustained and registration to Applicant is refused.

the *DuPont* factors and possibly could have weighed in favor of a finding that confusion is not likely.

⁵² Opposer also argues, under the twelfth *DuPont* factor, that the potential for confusion is substantial. *See* Opposer's Trial Brief, p. 21; 18 TTABVUE 27. We disagree. Although we have found that Opposer's pleaded JEAN LEON mark is inherently distinctive, the marks at issue are similar, the goods and services are related, and the trade channels and classes of purchasers overlap, the facts that Opposer's sales have been relatively modest and that no reported instances of actual confusion have occurred leads us to the conclusion that the potential for confusion is not substantial.