

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA/mb

Mailed: March 9, 2010

Cancellation No. 92050296

Altadis U.S.A. Inc.

v.

Wentworth E. Miller

**Before Bucher, Zervas, and Bergsman, Administrative Trademark
Judges:**

By the Board:

Wentworth E. Miller ("respondent") owns a registration for the mark CIGARETTESAVER (typed form) for "cylindrical tube with removable caps at one or both ends for enclosing and extinguishing by oxygen deprivation a lighted cigarette, cigar, or similar smokable product" in International Class 34 (the "Registration").¹ Altadis U.S.A. Inc.

("petitioner") filed a petition for cancellation of the registration, setting forth the ground of priority and likelihood of confusion, and pleading ownership by its wholly-owned subsidiary and licensor, Max Rohr, Inc., of a registration for the mark CIGAR SAVOR (typed form; CIGAR

disclaimed), for "smoker's articles, namely, tubes not of precious metal for extinguishing and storing cigars; cigar canisters not of precious metal; lighters; ashtrays not of precious metal; cigar humidors; cigar trimmers; cigar punches; and cigar cutters" in International Class 34.²

This proceeding is before the Board for consideration of petitioner's motion (filed September 28, 2009) and respondent's cross-motion (filed December 3, 2009) for summary judgment under Fed. R. Civ. P. 56, both on the ground of priority and likelihood of confusion. Both motions are fully briefed.³

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v.*

¹ Registration No. 3233835, issued on April 24, 2007, from an application filed on March 3, 2003, alleging first use of the mark anywhere and in commerce in November 2003.

² Registration No. 2414999, issued December 26, 2000 from an application filed July 6, 1998, asserting first use anywhere and first use in commerce on August 31, 1987. Ownership was most recently assigned to Max Rohr, Inc. per Reel 2196 Frame 0069 of the Office's Assignment Division after a series of assignments. (Workman Dec., Ex. B).

³ Respondent's untimely papers supplementing his response and cross-motion for summary judgment, filed on February 16, 2010 and February 24, 2010, after the permitted time for filing a reply brief, will be given no consideration. *See* TBMP § 517 (2d ed.

Catrett, 477 U.S. 317, 106 S.Ct. 2548 (1986). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

As previously noted, petitioner seeks summary judgment on its claim of priority and likelihood of confusion.⁴ To prevail on this claim, petitioner must establish that there is no genuine issue of material fact that (1) it has standing to maintain this proceeding, (2) it has priority of use, and (3) contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Standing and Priority

To establish standing, petitioner must show that it has a "real interest" in the outcome of the proceeding; that is, it must show a direct and personal stake in the outcome of the cancellation. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999); *Jewelers Vigilance*

rev. 2004); Board's order of December 16, 2009. Petitioner's motion to strike, filed February 12, 2010, is moot.

⁴ Petitioner's fraud arguments have been given no consideration because petitioner has not pled fraud. *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994).

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Committee, Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

Petitioner relies on the Declaration of its Senior Vice President of Marketing, Eric Workman ("Workman Dec."), who testified that the owner of the pleaded CIGAR SAVOR registration is Max Rohr, Inc., petitioner's wholly-owned subsidiary. (Workman Dec., ¶3). Attached as Exhibit A to the Workman Declaration is a true and correct copy of the CIGAR SAVOR registration obtained from the Office's TARR system, which, according to Mr. Workman, accurately reflects that the registration is valid and subsisting. Mr. Workman further claimed that petitioner, as the exclusive licensee of the CIGAR SAVOR trademark, markets and sells a line of tobacco-related products and that petitioner and its predecessors-in-interest "have been using the CIGAR SAVOR mark continually in commerce since at least as early as August 31, 1987." (Workman Dec., ¶¶ 5, 7). Given this use and petitioner's registration, there is no genuine issue of material fact that petitioner has standing. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009).

Petitioner also made of record a copy from TARR of respondent's CIGARETTESAVER registration, which issued from an application filed on March 3, 2002. (Declaration of Susan M. Schlesinger, petitioner's attorney, dated September 26, 2009 ("Schlesinger Dec."), Ex. A)). Respondent did not

submit evidence to establish an earlier date of first use in commerce.

Because Mr. Workman's Declaration and the accompanying exhibits establish that petitioner first used CIGAR SAVOR on August 31, 1987, there is no genuine issue of material fact that petitioner has priority of use. See *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008) (relying on declaration testimony of opposer's chairman to establish date of first use).

Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks, and the similarities or dissimilarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of

differences in the essential characteristics of the goods and differences in the marks").

Petitioner argues that the parties' goods are legally identical because both parties' identified goods include tubes used for storing and extinguishing cigars. Petitioner made of record copies from TARR of both parties' registrations (Workman Dec., Ex. A; Schlesinger Dec., Ex. A) as well as a copy of respondent's advertisement which shows that his goods are "also available for cigars." (Schlesinger Dec. ¶ 5, Ex. B).

For his part, respondent argues, inter alia, that his goods differ from petitioner's goods, because respondent's goods are used only for cigarettes. (Miller Dec. ¶¶ 2-3). The identification of goods in respondent's registration certificate is: "cylindrical tube with removable caps at one or both ends for enclosing and extinguishing by oxygen deprivation a lighted cigarette, cigar, or similar smokable product." Respondent asserts that the identification of goods is not correct, and that respondent amended the identification in a response to an office action to "an aluminum tube, capped at both ends, used for the purpose of extinguishing and preserving cigarettes." (Miller Dec. ¶2, Ex. 1, p.4). The examining attorney did not acknowledge the proposed amendment. The Office published the mark for opposition and the mark registered without entry of the

amendment. At no time did the Office receive a request for a correction of the identification. Thus, for purposes of this opposition, we consider the identification of goods to be that set forth in the registration.

The question of likelihood of confusion must be determined on the basis of the goods identified in the parties' registrations. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Respondent's mark is registered for a "cylindrical tube with removable caps at one or both ends for enclosing and extinguishing by oxygen deprivation a lighted cigarette, cigar, or similar smokable product," and petitioner's pleaded mark is registered for "smoker's articles, namely, tubes not of precious metal for extinguishing and storing cigars; cigar canisters not of precious metal..." Because petitioner's tubes not of precious metal for extinguishing and storing cigars encompass respondent's cylindrical tube with removable caps at one or both ends for enclosing and extinguishing by oxygen deprivation a lighted cigar, which may also be made of a material that is not precious metal, we find no genuine issue of material fact as to the similarity of the parties' goods, which are legally identical, at least in part.

Because the parties' goods are legally identical in part, we must assume that the goods travel in the same

channels of trade, such as tobacco shops, to the same class of purchasers, namely, smokers. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1598 (TTAB 2009) ("Because the goods described in the application and the registration are identical, we must presume that the channels of trade and classes of purchasers are the same."); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003).

Respondent argues that there are differences in price between the products. Specifically, respondent states that his products cost under ten dollars (Schlesinger Dec., Ex. G) while petitioner's goods start at twenty-five dollars and may exceed two hundred dollars (Miller Dec., Ex. 9, Requests for Admission Nos. 42 and 43). However, as discussed above, the parties' goods are legally identical and presumed to include all goods of the type identified. See *Genesco Inc. at 1268*. Moreover, as the parties' goods are available to the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. See *Giersch*, 90 USPQ2d at 1027.

Accordingly, in light of the identity of the goods, we find no genuine issue of material fact that the channels of trade and classes of consumers are similar or identical.

With respect to the similarities of the marks, petitioner argues that the marks are similar as to appearance, sound, connotation and commercial impression.

According to petitioner, the spelling differences between SAVOR and SAVER are inconsequential, because the words would be pronounced the same and appear similar. Petitioner also asserts that its mark is a double entendre which conveys both "savoring" and "saving," or storing, a cigar. Dictionary definitions of "save" and "store," were made of record by petitioner to support its contention that consumers would understand that its tubes are for "storing" cigars. (Schlesinger Dec. dated December 14, 2009 ("Schlesinger Dec. 2"), Ex. BB). Petitioner also argues that the words CIGAR and CIGARETTE are descriptive words which should be accorded less weight in the likelihood of confusion analysis. Finally, petitioner asserts that the degree of similarity between the marks necessary to find a likelihood of confusion is reduced because the parties' goods are highly similar or identical.

In response, respondent argues that SAVOR and SAVER and CIGAR and CIGARETTE differ in sound and meaning.⁵

Respondent argues that the wording "SAVOR" in petitioner's

⁵ In his response and cross-motion for summary judgment, respondent requests that the Board take judicial notice, under Fed. R. Evid. 201(b) and TBMP § 704.12(a), that OR and ER do not sound the same and that CIGAR and CIGARETTE are different words with different meanings. However, the Board may only take judicial notice of a fact that is not subject to reasonable dispute because it is generally known within the Board's territorial jurisdiction or capable of being determined by sources whose accuracy cannot reasonably be questioned. See TBMP § 704.12(a) and cases cited therein. Respondent's contentions do not qualify, and therefore respondent's request for judicial notice is denied.

mark will convey enjoyment or delight rather than saving or storing. In support of his claim that CIGAR SAVOR does not convey the same meaning as CIGARETTESAVER, respondent cites petitioner's response to respondent's Request for Admission No. 1, in which petitioner admits that it "intended to suggest that its CIGAR SAVOR product allows one to savor a cigar now and later." (Miller Dec., Ex. 4).

We consider the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in terms of their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are legally identical in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

We also note that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1857 (TTAB 2008); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1725 (TTAB 2007). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980). Since the goods at issue are products for extinguishing and storing cigarettes and cigars, the average consumers of the parties' goods are smokers.

We do not find respondent's attempts at distinguishing the marks persuasive. The marks both consist of a combination of two words, where the first word of each mark is the name of a smokeable item, and the second words, SAVER and SAVOR, are similar in sound and appearance. The first words, CIGAR and CIGARETTE, are highly descriptive, if not generic, and serve to indicate a use of the goods. Consumers would view the source of the goods as the same due

to the similarities in the marks, with one being for cigarettes and one for cigars. Moreover, to the extent that consumers notice the difference between the words CIGAR and CIGARETTE, they may mistakenly believe that CIGARETTESAVER is a variation of CIGAR SAVOR.

Contrary to respondent's assertions that the words "savor" and "saver" would be pronounced differently, there is no "correct" pronunciation of a trademark because it is impossible to determine how the public will pronounce a particular mark. Thus, in this case, arguments regarding a particular pronunciation of a term cannot be relied on to avoid a likelihood of confusion. *See, e.g., Centraz Industries Inc. v. Spartan Chemical Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985).

We also agree with petitioner that its mark is a double entendre which conveys to consumers that the goods would be used for saving a cigar, and thus the parties' marks convey similar meanings. Petitioner's goods are identified as tubes for "extinguishing and storing cigars." According to the MSN Encarta (2009) on-line dictionary (Schlesinger Dec. 2, Ex. BB), "store" means "to put something away for use in the future," and "save" means "keep something back for later: to set something aside, keep something back, or protect something so that it can be used later." As the

words SAVER and SAVOR are phonetically similar, the mark CIGAR SAVOR immediately conveys both saving and savoring a cigar when viewed in the context of the goods which store, or save, cigars. Accordingly, the meaning and commercial impression of the marks are similar.

Respondent argues that petitioner provided no evidence of actual confusion. However, evidence of actual confusion is not required in order to find a likelihood of confusion under Trademark Act Section 2(d). *See, e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

Viewing the evidence of record in a light most favorable to respondent as the non-moving party, and drawing all justifiable inferences therefrom in respondent's favor, we conclude that there are no genuine issues of material fact with respect to priority and likelihood of confusion, and that the parties' marks are likely to cause confusion. In view thereof, petitioner has established that it is entitled to judgment as a matter of law, and its motion for summary judgment is accordingly granted. Respondent's cross-motion for summary judgment is denied.

DECISION: The petition for cancellation is granted and Registration No. 3233835 will be cancelled in due course.
