

This Opinion is Not a  
Precedent of the TTAB

Mailed: October 23, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Martinez Hand Rolled Cigars, Inc.*

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Serial No. 97479082  
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Sergei Orel of Nolte Lackenbach Siegel,  
for Martinez Hand Rolled Cigars, Inc.

Thomas Young, Trademark Examining Attorney, Law Office 120,  
David Miller, Managing Attorney.

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Before Lykos, Pologeorgis and Stanley,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Martinez Hand Rolled Cigars, Inc. (“Applicant”) seeks to register on the Principal Register the composite mark below for “cigars” in International Class 34:<sup>1</sup>

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<sup>1</sup> Application Serial No. 97479082, filed June 28, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging 1999 as the date of first use anywhere and in commerce.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system in .pdf format. Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).



The description of the mark is as follows:

The mark consists of a cigar band with a brown and tan border and yellow stitching. Overlaying the top of the cigar band is an eagle design with an orange and yellow beak, white and gray face, black and white eye, and black eyebrow with several tan diagonal lines above the eagle. The eagle has brown and gray wings and tail and yellow and brown feet. Above the eagle's head is an obscured oval in black with the wording "PASIÓN" in orange, red, and tan. The eagle has a red banner in its mouth with the wording "HAND MADE IN NEW YORK CITY, USA" in tan. The interior of the cigar band has a brown and tan scroll of the Constitution with the wording "WE THE" legible and the rest of the wording illegible. The area behind the scroll is dark brown. The eagle is holding an ornament that has a yellow, tan and brown border. The interior of the ornament contains a gold and white oval with the wording "SINCE 1974 MARTINEZ HAND ROLLED CIGARS" in gold and white and outlined in brown. To the left of the ornament is the image of a tan man outlined in brown and tan with a blue shirt and brown and black hair and features in front of a brown curtain, yellow curtain rod and white wall. The man is smoking a white implement and there is gray smoke. To the right of the ornament is an image outlined in brown and tan of a storefront and sidewalk in gray, yellow, red, black, brown,

white and orange that depicts a window, chairs, table, awning, and building sign.

The colors red, orange, brown, blue, white, yellow, black, tan, gray, and gold are claimed as features of the mark. Applicant has disclaimed the wording “HAND MADE IN NEW YORK CITY, USA”, “SINCE 1974”, and “HAND ROLLED CIGARS” apart from the mark as shown. According to the translation statement, “[t]he English translation of ‘PASIÓN’ in the mark is ‘PASSION.’”<sup>2</sup>

In its application, Applicant claimed ownership of Registration No. 4450000 for the composite mark displayed below for “Cigar boxes; Cigar boxes not of precious metal; Cigar boxes of precious metal; Cigar cases; Cigar cutters; Cigar holders; Cigar humidifiers; Cigar tubes; Cigar wraps; Cigars; Tobacco, cigars and cigarettes” in in International Class 34:<sup>3</sup>



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<sup>2</sup> The application also includes a statement that the name “Martinez” shown in the mark does not identify a particular living individual.

<sup>3</sup> Registered December 17, 2013 on the Principal Register; alleging February 1, 2005 as the date of first use anywhere and in commerce; renewed under Trademark Act Sections 8 and 9 on April 20, 2024. Applicant has disclaimed the wording “SINCE 1974”, “HAND ROLLED CIGARS” and “NEW YORK, NEW YORK” apart from the mark as shown.

USPTO records show that Jesus Martinez, an individual residing in New York City, New York is the owner of that registration.

Registration was initially refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered standard character mark PASON for "cigars" in International Class 34, that it is likely to cause confusion or mistake or to deceive.<sup>4</sup> The Examining Attorney also refused registration under Section 2(d), citing Registration No. 4450000; however, that basis for refusal was withdrawn following Applicant's submission of an acceptable declaration showing unity of control.<sup>5</sup>

Following issuance of the final refusal, Applicant timely filed a notice of appeal and request for reconsideration which was denied. Applicant and the Examining Attorney filed briefs.<sup>6</sup> For the reasons explained below, we reverse the refusal to register.

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<sup>4</sup> Registration No. 5027321 registered August 23, 2016 on the Principal Register; alleging December 5, 2015 as the date of first use anywhere and in commerce; Sections 8 and 15 combined declaration accepted and acknowledged on August 31, 2022.

Registration was also refused under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127 for failure to demonstrate use of the applied-for mark in commerce based on Applicant's illegible specimen of use. *See* April 17, 2023 Office Action. The Examining Attorney withdrew that basis for refusal in the Final Office Action dated August 3, 2023 following Applicant's submission of an acceptable substitute specimen on July 17, 2023.

<sup>5</sup> Response to Office Action dated July 17, 2023 at TSDR 182-188 (Declaration of Jesus Martinez dated July 17, 2023).

<sup>6</sup> Applicant's initial brief filed March 19, 2024 exceeded the 25-page limit set forth in Trademark Rule 2.142(b)(2), 37 C.F.R. § 2.142(b)(2). 8 TTABVUE. Applicant filed an acceptable substitute brief on April 3, 2024. 10 TTABVUE.

I. Applicant's Arguments Regarding Prior Use

At the outset, we address Applicant's argument that it is entitled to registration of its applied-for mark because its date of first use in commerce allegedly predates the date of first use in commerce of the cited mark.

Applicant's claim of prior use is irrelevant in an ex parte appeal. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971). Trademark Act Section 7(b), 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. Applicant's argument amounts to a collateral attack on the cited registration, and the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. *See In re Charger Ventures LLC*, 64 F.4th 1375, 1383, 2023 USPQ2d 451, at \*7 (Fed. Cir. 2023) (citing *In re Detroit Athletic Co.*, 903 F.3d 1297, 1308-09, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (noting that applicant's objection to the breadth of the goods or trade channels described in the cited registration "amounts to an attack on the registration's validity" and that "the present ex parte proceeding is not the proper forum from which to launch such an attack," which is "better suited for resolution in a cancellation proceeding"); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) ; *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d

2012, 2014-15 (TTAB 1988). We therefore have given no consideration to this line of argumentation.

## II. Likelihood of Confusion

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 of the applicant, to cause confusion, or to cause mistake, or to deceive.

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“[T]he various evidentiary

factors may play more or less weighty roles in any particular determination”). “Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”). These factors, and the others, are discussed below.

- A. The relatedness of the goods and the similarity or dissimilarity of established, likely-to-continue trade channels and classes of consumers

We commence by comparing the goods as they are identified in the involved application and cited registration, the second *DuPont* factor. *See Detroit Athletic Co.*, 128 USPQ2d at 1050; *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also B & B Hardware*, 113 USPQ2d at 2049 (recognizing that an “applicant’s right to register must be made on the basis of the goods described in the application”). To state the obvious, the goods identified in the application and cited registration each

consist of the same single item, “cigars.” The goods are therefore identical, meaning that the second *DuPont* factor strongly favors a likelihood of confusion.

This brings us next to the third *DuPont* factor, the established, likely-to-continue channels of trade and classes of consumers. *See Detroit Athletic Co.*, 128 USPQ2d at 1051 (citing *DuPont*, 177 USPQ at 567). As with the second *DuPont* factor, we look to the language of the identification of goods. *See B & B Hardware*, 113 USPQ2d at 2049 (explaining that “if an application does not delimit any specific trade channels of distribution, no limitation will be applied”) (cleaned up).

Applicant contends that its website “shows that Applicant only sells its cigars at its physical brick and mortar store in Manhattan, New York, and online on its [www.martinezcigars.com](http://www.martinezcigars.com) website” whereas Registrant “sells cigars at its two stores in Philadelphia, Pennsylvania, and on its [www.holts.com](http://www.holts.com) website.”<sup>7</sup> Applicant further emphasizes that the websites look different insofar as the respective brand names are prominently displayed in different color schemes.<sup>8</sup> Based on this evidence, Applicant maintains that the trade channels are “different and no reasonable consumer would confuse the two sources of the cigars.”<sup>9</sup>

Applicant is impermissibly reading limitations into both its own and Registrant’s identification. We are required to make our determination based on the identifications as written and not based on extrinsic evidence. *Stone Lion*, 110

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<sup>7</sup> Applicant’s Brief, p. 22; 10 TTABVUE 23.

<sup>8</sup> Applicant’s Brief, p. 19; 10 TTABVUE 20.

<sup>9</sup> *Id.*



USPQ2d at 1161; *Octocom*, 16 USPQ2d at 1787. Because the scope of the registration Applicant seeks would be defined by the identification of goods and not by actual use, it is the identification of goods in the application and cited registration, and not their actual use in commerce, that we use as our guide. *Octocom*, 16 USPQ2d at 1787; *see also Detroit Athletic Co.*, 128 USPQ2d at 1051 (“The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration, and not on real-world conditions.”).

As noted above, Applicant’s goods are identical to Registrant’s goods. Because these items are identical and unrestricted as to trade channels and consumers classes, we must presume that these identical goods travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law [under *Viterra*] and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child*

*Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Thus, the third *DuPont* factor also weighs in favor of finding a likelihood of confusion.

B. The marks

Keeping in mind that where the goods are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines, *Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012), we now consider the first *DuPont* factor, which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.<sup>10</sup> See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*,

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<sup>10</sup> Applicant urges the Board to compare its mark and Registrant’s mark as they are actually used in commerce, including the design and phrase “LA AROMA DE CUBA” with Registrant’s mark. Applicant’s Brief, pp. 6-12; 10 TTABVUE 7-13 (citing Applicant’s website, <https://www.martinezcigars.com/shop/pasion-654/>, and Registrant’s website, <https://www.holts.com/cigars/all-cigar-brands/la-aroma-de-cuba-pasion.html>, both submitted with Applicant’s July 17, 2023 Response to First Office Action). Unlike federal infringement claims, as an administrative tribunal charged with determining the right to register, the Board compares each mark as it appears in the drawing of the application and in the registration and does not consider how an applicant and registrant actually use their marks in the marketplace. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1324, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“Similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). The proper test regarding similarity “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.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)).

Moreover, the marks at issue “must be considered ... in light of the fallibility of memory ....” of consumers. *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *see also In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). Here, the average purchasers are members of the general public seeking cigars.

Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of

the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *Nat'l Data Corp.*, 224 USPQ at 751.

The Examining Attorney argues that the marks are similar because the applied-for composite mark begins with PASIÓN, the entirety of the cited mark PASION. The Examining Attorney maintains that the disclaimed wording and design elements of Applicant's composite mark are of lesser significance, focusing on the fact that both Applicant's and Registrant's mark share the same letter string P-A-S-I-O-N. Thus, the position that the marks are similar in sight, sound, meaning and commercial impression is predicated on the determination that PASIÓN is the dominant portion of Applicant's composite mark.

The Examining Attorney's arguments amount to an improper dissection of Applicant's composite mark. Applicant's composite mark incorporates the cited word mark, but the similarities stop there. We are mindful of the often cited principles that disclaimed matter and design elements are generally considered subordinate, *see, e.g., Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011) (disclaimed matter) and *Viterra*, 101 USPQ2d at 1911 (design elements), but we are also guided by the anti-dissection rule. *See Nat'l Data Corp.*, 753 224 USPQ at 751. "While it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case." *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014). *See also In re Electrolyte Labs.*, 16 USPQ2d at 1240 ("There is no general rule as to whether letters or design will dominate in composite marks").

We find that this is a situation where the overall design creates such a "strong visual impact" that it dominates Applicant's composite mark over any wording. *See Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) ("Because of the strong visual impact of the design element, which also includes a cape with the initials BM, reminiscent of a super hero costume, we find that in appearance applicant's mark BM BODYMAN and design differs from opposer's marks BOD and BOD MAN."). The whimsical design of the scalloped medallion flanked on the left by the photo of a man smoking a cigar and on the right by the photo of a storefront superimposed on the Preamble of the U.S. Constitution "catches the eye." *See id.* at 1016 ("...the design is very noticeable and has the effect of catching the eye and

engaging the viewer before the viewer looks at the word BODYMAN.”). PASIÓN as it appears in Applicant’s composite mark blends harmoniously in the eagle depicted above the medallion, making it less perceptible to prospective consumers. That is to say, PASIÓN is “difficult to notice” vis-à-vis the overall commercial impression of made by the design elements. *See Covalinski*, 113 USPQ2d at 1168. We therefore reject the Examining Attorney’s finding that PASIÓN is the dominant element in Applicant’s composite mark.

If any literal element dominates at all, it would be the stylized surname MARTINEZ in Old English style font displayed in the medallion. Prospective consumers would be more naturally drawn to this relatively larger and prominently depicted term in the center of the design. The surname MARTINEZ sounds completely different than the cited mark PASION. As a surname, it also evokes a distinct connotation and commercial impression.

Considering the marks in their entireties, *see Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), we find that they are dissimilar in sight, sound, appearance and connotation. The unique multi-element design of Applicant’s composite mark contributes to these differences. This *DuPont* factor strongly weighs against finding a likelihood of confusion.

C. Conditions under which the goods are likely to be purchased

Next we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any,

of sophistication of the consumers, the fourth *DuPont* factor. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant contends that because “[c]igars are not trivial cheap goods,”<sup>11</sup> prospective consumers are likely to exercise an elevated degree of care when making purchasing decisions. The record shows that Applicant’s cigars cost from \$60 to \$210 and that Registrant’s cigars cost \$273.95 and \$285.95 for boxes of 25 cigars.<sup>12</sup> However, neither Applicant’s nor Registrant’s identification of goods is limited to high-end cigars, meaning they include cigars sold at all price ranges and quality. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Moreover, there is no evidence in the record to indicate that cigar customers, in general, are sophisticated or careful in selecting the goods, and we must base our analysis “on the least sophisticated potential purchasers.” *Stone Lion*, 110 USPQ2d at 1163 (internal quotation marks omitted). For these reasons, the fourth factor weighs in favor of

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<sup>11</sup> Applicant’s Brief, p. 20; 10 TTABVUE 21.

<sup>12</sup> Response to Office Action dated July 17, 2023 at TSDR 100-125, 153-154, 161-164 (Exhibit I - excerpt from <https://www.martinezcigars.com/shop/pasion-550/> accessed on July 17, 2023) and (Exhibit J - excerpt from <https://www.holts.com/cigars/all-cigarbrands/la-aroma-de-cuba-pasion.html> accessed on July 17, 2023).

finding a likelihood of confusion.

D. Lack of actual confusion and concurrent use

We now address the seventh *DuPont* factor, the “nature and extent of any actual confusion,” and the eighth *DuPont* factor, “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 177 USPQ at 567 — requires us to look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020). *See also In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

Applicant argues that the parties’ concurrent use of their respective marks for approximately eight years without any known instance of actual confusion creates a strong inference that confusion is unlikely.<sup>13</sup> Applicant points to Applicant’s website showing that Applicant only sells its cigars at its physical brick and mortar store in Manhattan, New York, and online on its [www.martinezcigars.com](http://www.martinezcigars.com) website while Registrant only sells its cigars at its two stores in Philadelphia, Pennsylvania, and on its [www.holts.com](http://www.holts.com) website.<sup>14</sup>

We do not have in the record specifics regarding the extent of Applicant’s and Registrant’s sales and advertising. This prevents us from determining whether there has been a reasonable opportunity for confusion to occur. “The fact that an applicant

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<sup>13</sup> Applicant’s Brief, p. 22; 10 TTABVUE 23.

<sup>14</sup> *Id.* None of this evidence is accompanied by a declaration or affidavit.



in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.” *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001). “In this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story.” *Guild Mtg.*, 2020 USPQ2d 10279, at \*7.

We hasten to add that “[t]he relevant test is likelihood of confusion, not actual confusion.” *Detroit Athletic Co.*, 128 USPQ2d at 1053. Indeed, “a showing of actual confusion is not necessary to establish a likelihood of confusion.” *Herbko*, 64 USPQ2d at 1380. We therefore deem the seventh and eighth *DuPont* factors neutral.

#### E. Market interface

We close by addressing the tenth *DuPont* factor, the market interface between Applicant and Registrant, which in this case involves an evaluation of Applicant’s purported “consent agreement” with Registrant. According to the assertions in Applicant’s brief:<sup>15</sup>

The undersigned attorney Sergei Orel spoke to David Rivera, a manager at the Applicant’s Cigar Factory Store yesterday, on November 2, 2023, by telephone, and Mr. Rivera informed the undersigned that they at Martinez Cigars are aware of Holt’s LA AROMA DE CUBA PASION cigars and mark, but Holt’s mark is junior to Applicant’s

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<sup>15</sup> Applicant’s Brief, p. 23; 10 TTABVUE 24.

mark, because Applicant began selling its branded cigars 16 years prior to Holt's first use of its cigars, and neither party, not Martinez Cigars the Applicant, not Holt's, have any objection to one another's using their respective marks. Mr. Rivera said that he sees Holt's people at industry fairs and expos routinely, where each of them display their respective branded cigars, and no one ever has objected to the other, not Martinez Cigars to Holt, nor Holt to Martinez Cigars. Both parties are well aware of each other's cigars, but because their respective cigars are branded so differently, in such different colors of the cigar bands, that neither the trademark owners concerned, nor customers at fairs and expos are confused. There was no time to submit a signed Declaration by David Rivera this time around, as Mr. Rivera was not at the store today when the undersigned visited the store to take more photos as specimens of use of Applicant's cigars, but the undersigned will make sure that such Declaration is submitted in evidence to the TTAB on Appeal.

No written consent agreement between Applicant and Registrant is of record in this appeal. While examining attorneys may consider written consent agreements, *see In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985), they have no authority to consider mere allegations of consent. Accordingly, this tenth *DuPont* factor is neutral.

### III. Conclusion – Balancing the *DuPont* Factors

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto.

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument; “explain the results of that weighing;” and “the weight [we] assigned to the relevant factors.” *Charger Ventures*, 2023 USPQ2d 451, at \*7. “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.”

*Mighty Leaf Tea*, 94 USPQ2d at 1260. *See also Naterra Int'l, Inc. v. Bensalem*, 92 F.4th 1113, 2024 USPQ2d 293, at \*2 (Fed. Cir. 2024).

The critical first *DuPont* factor weighs strongly against a likelihood of confusion because when we compare the marks as a whole, we find them to be dissimilar in sound, appearance, connotation and commercial impression. However, the second *DuPont* factor weighs strongly in favor of a likelihood of confusion because the goods are identical. As a result, we can invoke the presumptions that these goods will travel in the same trade channels to the same classes of consumers, meaning that the third factor weighs in favor of finding a likelihood of confusion. The fourth *DuPont* factor also weighs in favor of finding a likelihood of confusion. The seventh, eighth, and tenth *DuPont* factors are neutral.<sup>16</sup>

Any of the *DuPont* factors may play a dominant role. *DuPont*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The dissimilarity of the marks in appearance, meaning and commercial impression is so great as to outweigh the second, third, and fourth *DuPont* factors. *See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (U.S. Court of Appeals for the Federal Circuit affirmed Board finding of no

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<sup>16</sup> Applicant argued that its mark is famous thereby implicating the fifth *DuPont* factor. That factor, however, pertains to the fame of the cited mark, not applied-for mark. In any event, the record is devoid of any evidence of fame of the registered mark. The absence of such evidence has minimal significance in an ex parte appeal, as neither Applicant nor the Examining Attorney is in a position to accurately determine and prove the extent to which Registrant's mark has been noted by customers. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). This factor is therefore neutral.

likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks); *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35, 37 (CCPA 1974) (reversing the Board's holding that confusion was not likely between SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices). This is despite the principle that because the goods are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *Bridgestone Americas Tire Operations*, 102 USPQ2d at 1064. Here, the first *DuPont* factor is pivotal, and we conclude that confusion is unlikely between Applicant's applied-for composite mark and the cited mark.

**Decision:** The Section 2(d) refusal is reversed.