

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: June 17, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Cuban Cigar Brands, N.V.  
v.  
Valle Grande Limitada

—————  
Opposition No. 91165277

**MOTION FOR RECONSIDERATION**

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Charles W. Grimes of Grimes & Battersby for Cuban Cigar  
Brands, N.V.

David A. Weinstein, Esq. for Valle Grande Limitada.

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Before Walters, Walsh and Cataldo, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

On August 9, 2007, the Board issued a final decision in the above-captioned proceeding. Cuban Cigar Brands, N.V. had filed its opposition to the application of Valle Grande Limitada to register the mark MONTECRISTO for "olive

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oil," in International Class 29, and "vinegars and balsamic vinegar," in International Class 30.<sup>1</sup>

As grounds for opposition, opposer asserted priority and likelihood of confusion, under Section 2(d) of the Trademark Act, and dilution, under Sections 13 and 43(c) of the Trademark Act, based on opposer's previously used and registered marks MONTECRISTO and MONTE CRISTO, one with a design element, for a variety of goods and services, the most prominent of which is cigars. Opposer asserted that its MONTECRISTO mark is famous in connection with premium cigars; and that its mark has been distinctive and famous in the United States since before applicant acquired any rights in its mark.

In our August 9, 2007 decision, we dismissed the opposition. The Board concluded that, despite the identity of the marks, and because of the wide differences between applicant's identified goods and opposer's identified goods and services, opposer has not established that there is a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d); and that, because opposer has not established the threshold level of fame of its marks in connection with cigars or the identified goods and services

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<sup>1</sup> Application Serial No. 78392366, filed March 29, 2004, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

in its pleaded registrations in connection with its likelihood of confusion claim, opposer's dilution claim also fails. See *McCarthy on Trademarks and Unfair Competition*, § 24:104 (4<sup>th</sup> ed., database updated 2008).

On September 10, 2007, opposer timely filed a motion for reconsideration of that decision. See Trademark Rule 2.129(c). Applicant did not file a brief in opposition thereto. See *Id.* However, we will address opposer's motion on its merits. The Board regrets the delay in deciding this motion.

In its motion for reconsideration, opposer contends that "the Board committed legal error when it held that the parties' goods are not related and that there was not sufficient evidence in the record to find that opposer's MONTECRISTO mark is famous." (Request for Reconsideration, p. 2.) Opposer contends that the Board's findings are erroneous for the following reasons:

1. The Board found that the parties' goods are unrelated despite the fact that CCB has a registration for restaurant services and Applicant has indicated that it intends to sell its olive oil and vinegar to restaurants. Well-established TTAB case law provides that there is a likelihood of confusion when a registration includes restaurant services and an applicant seeks to register the same mark for goods likely to be sold by restaurants.
2. The Board inexplicably ignored the testimony of Opposer's Vice President that he had seen olive oil and vinegar sold in cigar stores that also sell

specialty goods and fancy foods, including coffee, and that cigar stores are increasingly selling such ancillary items. Therefore, Applicant's proposed MONTECRISTO olive oil and vinegar are likely to be sold in the same stores as CCB's MONTECRISTO cigars and coffee, and consumers are likely to believe that the parties' goods emanate from the same source.

3. The Board found that the parties' goods are unrelated even though CCB has a registration for coffee, licensed MONTECRISTO coffee is currently being sold in the marketplace and, in at least one other case, the TTAB held that coffee and olive oil are related goods.
4. The Board ignored a prior federal court decision which held that MONTECRISTO is a famous mark, and disregarded the uncontested testimony of Opposer's Vice President regarding the fame of the MONTE CRISTO mark.

It has often been stated that the premise underlying a request for rehearing, reconsideration, or modification under Trademark Rule 2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. See TBMP §544 (2d ed. rev. 2004) and the authorities cited therein. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. See *Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978). Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. See,

*for example, Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984). *Cf. In re Kroger Co.*, 177 USPQ 715, 717 (TTAB 1973).

In this motion, opposer disagrees with the result reached in our August 9, 2007 decision and argues, essentially, that the Board's findings that the goods are not related<sup>2</sup> and that opposer's mark is not famous are in error.

Of opposer's four numbered points above, we find that in numbered paragraphs one and three, opposer merely reargues points previously raised in support of its claims, which is not a proper basis for reconsideration. In numbered paragraph one, opposer argues that the Board erred by ignoring "well established" case law finding a likelihood of confusion between a registration including "restaurant services and an applicant seeking to register the same mark for goods likely to be sold by restaurants." (Reconsideration, p. 2.)

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<sup>2</sup> Opposer asserts that "the Board committed legal error in holding that the parties' marks are not related." (Reconsideration, p. 7.) First, we note that our finding that the opposer had not established a relationship pertained to the goods, not the marks. Second, we advise opposer that the determination of whether the record supports a finding that the goods are related is a factual determination.

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In numbered paragraph 3, opposer notes that the record established that its MONTECRISTO mark is used in connection with coffee and argues that the Board erred by ignoring "at least one other case [in which] the TTAB held that coffee and olive oil are related goods." (Id.) We are not persuaded by opposer's arguments in numbered paragraphs one and three that our decision is in error. Not only is there no *per se* rule establishing a relationship between either restaurants or coffee and olive oil and vinegar, but we remind opposer that each case must be decided on its merits. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

In opposer's above-numbered paragraph two, opposer argues that the Board misread and ignored the statement of opposer's witness that "he had seen olive oil and vinegar sold in cigar stores that also sell specialty goods and fancy foods, including coffee, and that cigar stores are increasingly selling such ancillary items." We carefully considered this deposition and accompanying exhibits in reaching our decision. However, to avoid the misconception that we ignored Mr. Workman's statement the he had seen olive oil and vinegar sold at cigar retailers, we review some of Mr. Workman's testimony to clarify our finding that

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a relationship between the subject goods has not been established.

Mr. Workman stated that opposer markets its cigars along with other goods, such as hats, shirts, etc., bearing the MONTECRISTO brand name, on its website (Workman Dep. p. 26); that historically premium cigar shops sold only cigars, cigar accessories and pipe tobacco, but when sales of cigars peaked in 1997 and then began to decline, these shops began selling additional items (Id., p. 29); that opposer's premium cigar sales force sells to between 2000 and 2500 retail accounts and these accounts handle a variety of additional products, including many gift items and fine coffees and teas, and many of these accounts are exploring expanding into fine foods (Id., p. 28); and that Mr. Workman was not seeing as much brand expansion from cigars to other goods such as high-end foods and beverages as he had hoped, although opposer is continuing to explore this (Id., p. 30).

Mr. Workman stated that opposer does a great deal of cooperative advertising with its retailers and its MONTECRISTO cigars are often advertised in these retailers' catalogs (Id., pp. 34-36); that other items advertised by the better retailers include perfumes, knick knacks, nuts, chocolates, coffee mugs, beer steins, knife sets and,

occasionally, other fancy foods (Id.); and that sometimes, but not often, these other items are branded with the retailer's private cigar label (Id., p. 37). Mr. Workman stated that its retailers also have websites on which they advertise cigars and other products; that the majority do not offer products found in the kitchen or edibles on these sites, but he noted that he believed that this is a direction in which the industry is heading. (Id., p. 38.) Mr. Workman stated that he has visited many retailers across the country and many of them carry many items, noting that some "look like Hallmark Stores." (Id.) Mr. Workman gave an example of one store that he had visited in Florida, ABC Liquors, and stated that, in addition to liquor and cigars, it has "fancy foods and gift items" and that "I've seen imported cookies, I've seen -- I hate to say it, but I have seen olive oil, I've seen vinegar, crackers. In some stores I've seen cheese, fresh cheeses." (Id., p. 39.)

The mere fact that goods may be sold in the same stores or advertised in the same catalogs or websites does not establish, per se, that the goods sold are related. Of most significance, is the fact that there is no evidence that the goods identified herein have ever been identified by the same or similar marks. Nor is there any information

as to the manner in which the various goods noted by Mr. Workman as being sold in the same stores are presented or marketed in those stores. We remain of the view that any relationship that may have been established in this record between opposer's and applicant's goods is simply too tenuous to justify finding that the goods are related for the purpose of determining likelihood of confusion.

We have not considered and are not persuaded by opposer's above-numbered paragraph four to the extent that it merely re-argues that the record, in particular the testimony of Mr. Workman, establishes opposer's fame. This mere reargument is not proper matter for reconsideration.

Opposer also contends that the Board should, essentially, give collateral estoppel, or issue preclusion, effect to the finding of fame in a prior decision involving opposer's predecessor-in-interest and a third party, *Consolidated Cigar Corp. v. Monte Cristi de Tabacos, c.x.a.*, 58 F. Supp. 2d 188 (S.D.N.Y., 1999), *aff'd as modified*, 2000 U.S. Dist. LEXIS 21017 (S.D.N.Y. 2000). The doctrine of issue preclusion, which serves to bar the revisiting of "issues" that have already been fully litigated, requires four factors:

- (1) identity of the issues in a prior proceeding;
- (2) the issues were actually litigated;

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- (3) the determination of the issues was necessary to the resulting judgment; and,
- (4) the party defending against preclusion had a full and fair opportunity to litigate the issues.

See *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1858-59 (Fed. Cir. 2000); and *Mother's Restaurant, Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1569, 221 USPQ 394, 397 (Fed. Cir. 1983). Since the prior proceeding involved a different defendant, issue preclusion is inapplicable in this case and we give no consideration to the findings in the prior proceeding. We add that because such issues as the strength/weakness and fame of a mark must be determined on the record in each case, the Board is not precluded from reaching a finding on fame that is different from that of the District Court in the noted proceeding based on the different parties and record herein.

Opposer argues that applicant did not contest opposer's evidence of fame. However, applicant did not admit that opposer's marks are famous and, further, the burden is upon opposer to establish its fame, which it did not do in this case.

Finally, we note opposer's statement that doubt should have been resolved in its favor (Reconsideration, p. 6). However, we did not have doubt in reaching our decision;

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rather, we remain firmly of the opinion that opposer did not establish either likelihood of confusion or the fame of its mark so as to warrant proceeding with the dilution claim.

In conclusion, we remain of the opinion that our August 9, 2007 decision is correct. Accordingly, opposer's motion for reconsideration is denied.