

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: May 21, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cuban Cigar Brands, N.V.

v.

Inter America Cigar Co.

Opposition No. 91169391

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

Jesus Sanchelima of Sanchelima and Associates, P.A., for Inter America Cigar Co.

Before Quinn, Taylor, and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark Judge:

Inter America Cigar Co. filed an application for the mark PRIMO DEL CRISTO, with design, for "cigars" in International Class 34¹ as follows:

¹ Application No. 78470957, filed August 20, 2004, under Section 1(a) of the Trademark Act of 1946, 15 U.S.C. §1051(a), with the disclaimer: "No claim is made to the exclusive right to use 'HAND MADE IMPORTED CIGARS LONG FILLER' apart from the mark as shown."



Cuban Cigar Brands, N.V., opposed the registration of applicant's mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d); and dilution under Sections 13(a) and 43(c), 15 U.S.C. §1063(a) and 1125(c). Specifically, opposer alleged that applicant's mark is likely to cause confusion with opposer's MONTECRISTO mark for "cigars"² and for opposer's other marks as follows (collectively, the "MONTECRISTO MARKS"):

² Registration No. 1173547, issued on October 13, 1981 for MONTECRISTO in typed drawing, for "cigars" in International Class 34, claiming July 25, 1935 as the date of first use and first use in commerce. Renewed.

<u>Mark</u>	<u>Registration No.</u>	<u>Filing Date</u>	<u>Int'l Class(es)</u>
MONTE CRISTO and Crossed-Sword Design	332,324	08/22/35	34
MONTECRISTO	1,173,547	02/27/78	34
Crossed-Sword Design	1,459,466	02/05/87	34
MONTE CRISTO	2,304,416	03/03/92	16, 28, 34
MONTE CRISTO	2,236,889	03/03/92	3, 14, 18, 25
MONTECRISTO	2,396,980	12/10/98	26, 34, 36
MONTECRISTO	2,623,858	03/05/01	42
MONTECRISTO	2,594,564	04/14/98	33
MONTECRISTO	2,855,557	07/03/02	30
MONTECRISTO	3,154,457	07/02/02	34
MONTE CRISTO	1,435,633	05/24/85	25
THE WORLD OF MONTECRISTO and Design	2,555,239	08/11/2000	34
WORLD OF MONTECRISTO	2,673,772	08/11/2000	34
MONTECRISTO LE CIGARE DES ARTS	2,423,694	01/21/98	34
MONTECRISTO CASINO	2,872,359	11/26/2002	34

Applicant denied the essential allegations in the notice of opposition, and asserted the affirmative defense of laches and equitable estoppel. Both parties filed briefs. For the reasons discussed herein, we sustain the opposition.³

³ We note that applicant raised for the first time in its brief an alternative prayer for leave to convert its application to a concurrent use application if the opposition is sustained. Applicant's request was improperly submitted and will not be considered. See Trademark Rule 2.42, 37 CFR §2.42. Further, in the event of a final decision adverse to applicant, there is no authority to reopen the application. See TBMP §807 (2d ed. rev. 2004). Concurrent use rights may be determined only in the context of a concurrent use proceeding. See TBMP §1112 (2d ed. rev. 2004).

Evidentiary Issues

Opposer filed various unauthenticated Internet printouts as Exhibit AA to its Notice of Reliance. This evidence is not properly submitted. There is no provision in the Trademark Rules of Practice for filing copies of web pages through a notice of reliance. See Trademark Rule 2.122(e), 37 CFR §2.122(e), which provides for the filing of printed publications and official records through a notice of reliance. Accordingly, these documents and their contents will not be considered except to the extent they may also have been properly submitted and authenticated through other means, such as via exhibits to the testimonial depositions.

The Record

By operation of law, the record includes the pleadings and the application file. Trademark Rule 2.122(b), 37 CFR §2.122(b). The record also includes the following testimony and evidence:

A. Opposer's Evidence.

1. Notice of Reliance on:
 - a. Applicant's responses to certain of opposer's discovery requests.
 - b. Various advertisements, articles, and excerpts from printed publications, discussing the MONTECRISTO cigar brand.

c. Various dictionary translations of the foreign term "primo."

d. Status and title copies of opposer's MONTECRISTO MARKS.

2. Rebuttal Notice of Reliance on various advertisements, articles, and excerpts from printed publications, discussing the MONTECRISTO cigar brand.

3. The testimony deposition of Eric Workman, Vice-President of Marketing and National Accounts for Altadis U.S.A. Inc., together with exhibits thereto.

4. The testimony deposition of Edward McVey, cigar purchasing agent, together with exhibits thereto.

B. Applicant's Evidence.

1. Notice of Reliance on opposer's responses to certain of applicant's discovery requests.

2. The testimony deposition of Benjamin Gomez, Jr., President of Inter America Cigar Co., together with exhibits thereto.

3. The testimony deposition of Juan Del Cerro, licensed customs broker, together with exhibits thereto.

Standing

A party has standing to oppose a registration under Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063 if that party can demonstrate that it has a real interest in the proceeding (*i.e.*, a direct and personal stake in the

outcome of the proceeding). *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-1026 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Opposer has submitted status and title copies of its pleaded registrations, the MONTECRISTO MARKS. Opposer has also testified as to the continuous use of its MONTECRISTO mark since at least 1978. (Workman dep. at 16:6-8). Therefore, opposer has established its standing to oppose applicant's registration. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 at 189.

Laches

Prior to our consideration of opposer's pleaded claim of likelihood of confusion, we must first address applicant's affirmative defense of laches and equitable estoppel to determine whether opposer's claim is barred thereby. The defense of laches is not generally available in an opposition proceeding, but under certain circumstances it may be considered based upon an opposer's failure to object to an applicant's earlier registration of substantially the same mark for substantially the same goods. *Aquion Partners Limited Partnership v. Envirogard Products Ltd.*, 43 USPQ2d 1371 (TTAB 1997) (affirmative defense of laches not available without showing of material

prejudice); *Barbara's Bakery Inc. v. Landesma*, 82 USPQ2d 1283, 1292 n. 14 (TTAB 2008) (affirmative defense of equitable estoppel not properly pled or proven). Applicant owned two prior registrations, now expired, for essentially the same mark covering essentially the same goods.⁴ Therefore, we give due consideration to applicant's affirmative defense of laches, which subsumes applicant's argument regarding equitable estoppel.

In order to prevail on the affirmative defense of laches, a defendant must establish that there was undue or unreasonable delay by the plaintiff in asserting its rights, and that prejudice to the defendant resulted from the delay. *See Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001). "Mere delay in asserting a trademark-related right does not necessarily result in changed conditions sufficient to support the defense of laches. There must also have been some detriment due to the delay." *Id.*, 58 USPQ2d at 1463. With regard to delay, the focus is on reasonableness and the Board must consider any excuse offered for the delay. *See A. C. Aukerman Co. v. R. L. Chaides Construction Co.*, 960 F.2d 1020, 22 USPQ2d 1321, 1329 (Fed. Cir. 1992). With regard to prejudice, there must

⁴ Registration Nos. 883186 and 1244746, both claiming first use and first use in commerce July 1, 1968, and both expired for failure to file Section 8 affidavit.

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also have been some detriment due to the delay such as evidentiary prejudice or economic prejudice, and respondent must show that its prejudice resulted from the delay. *Id.* The mere passage of time does not constitute laches. See *Aquion Partners L.P. v. Envirogard Products, Ltd.*, 43 USPQ2d 1371, 1373, citing *Advanced Cardiovascular Systems v. SciMed Life Systems*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Applicant has not evidenced any reliance or harm due to opposer's nonaction regarding applicant's prior-registered PRIMO DEL CRISTO mark. Although applicant has twice before registered the PRIMO DEL CRISTO mark for "cigars," both times it has abandoned the registration due to applicant's failure to file Section 8 affidavits. Applicant has testified only as to very low level sales of its cigars under the PRIMO DEL CRISTO mark at any time, with no current advertising or promotions (Gomez dep. at 142:5-142:25; 143:1-143:5). Meanwhile, opposer has testified as to its lack of knowledge of applicant's use of the PRIMO DEL CRISTO mark at any time. (Workman dep. at 12:7-15). An experienced cigar purchasing agent with over 20 years in the business also testified as to his lack of lack of knowledge of applicant's use of the PRIMO DEL CRISTO mark at any time. (McVey dep. at 8:19-22) With no apparent reliance upon, or harm done to applicant, by opposer's lack of action

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regarding the PRIMO DEL CRISTO mark, we deny applicant's affirmative defense of laches and equitable estoppel.

Priority

Because opposer's registrations for the MONTECRISTO MARKS have been made of record, Section 2(d) priority is not an issue with respect to the goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1506 (TTAB 2007). In any event, as indicated *supra*, opposer has introduced testimony regarding its prior use of the marks. (Workman dep. at 16:6-8). Applicant has raised priority as an issue in its answer to the opposition as well as in its brief. However, as the Board has already pointed out to applicant when denying applicant's motion for summary judgment:

"Any attack on the validity of opposer's pleaded registrations is a compulsory counterclaim that will not be heard unless a counterclaim or separate petition seeking the cancellation of such registrations is filed."

Board's Order, December 4, 2006, quoting Trademark Rule 2.106(b)(2); 37 CFR §2.106(b)(2).

Accordingly, applicant may not collaterally attack opposer's registrations, or opposer's priority, via this opposition proceeding.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on 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, 1203 (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 or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The similarity or dissimilarity
and nature of the goods

Applicant is seeking to register PRIMO DEL CRISTO for "cigars." Opposer has, among its MONTECRISTO MARKS, several registrations for "cigars." Therefore, the goods are identical. This *du Pont* factor weighs heavily toward finding a likelihood of confusion.

The similarity or dissimilarity of established,
likely-to-continue trade channels

Applicant seeks to sell cigars under the proposed PRIMO DEL CRISTO mark. Opposer sells cigars under its MONTECRISTO MARKS. In the absence of specific limitations in either opposer's pleaded registrations or in the application, we must presume that the goods at issue will travel in all

normal and usual channels of trade and methods of distribution and be sold to all classes of consumers, which in this case may overlap. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). Accordingly, this *du Pont* factor weighs in favor of finding that there is a likelihood of consumer confusion.

The Strength of Opposer's Marks

Opposer's mark "MONTECRISTO" is registered with the translation "Mountain of Christ."⁵ This mark, as applied to "cigars," is arbitrary, and therefore inherently strong. Opposer has also demonstrated a significant degree of market strength of the MONTECRISTO mark, testifying that its cigars sold thereunder are "in the top ten" among sales of cigars in the United States, "perhaps in the top five or six." (Workman dep. at 40:7-8) Opposer has further testified as to sales of "millions" of cigars annually (Workman dep. at 39:23-24), with revenues in the "tens of millions" of dollars (Workman dep. at 40:2), and advertising in the "hundreds of thousands," sometimes "millions" of dollars per year (Workman dep. at 52:17-20). The record is devoid of third-party uses or registrations of the same or similar marks in the industry. While the Board is not prepared on this record to call the MONTECRISTO mark "famous," the

⁵ See Opposer's Registration No. 2304416, for "MONTECRISTO."

strength of the mark does weigh in favor of finding a likelihood of confusion.

The similarity or dissimilarity of the marks
in their entirety.

Preliminarily, we note that the more similar the goods at issue, the less similar the marks need to be to find a likelihood of confusion. *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957 (TTAB 1981). Here, the goods are identical, thereby requiring a lesser showing of similarity between the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Both marks have foreign translations. Opposer's MONTECRISTO mark, as discussed previously, is registered with the translation "Mountain of Christ." Applicant has submitted a translation of its PRIMO DEL CRISTO as "Cousin of Christ." Opposer disputes applicant's submitted translation, contending rather that "primo" is best translated as "first," "leading," "excellent," or "superior." Opposer has submitted several dictionary definitions to support its proffered translations. (Opp.'s Not. of Reliance, Ex. K). We accept the definitions submitted by opposer in accordance with Trademark Rule 2.122(e), 37 CFR §2.122(e), and we find it inapposite that "primo" may also be translated as "cousin." Therefore, we

find it likely that U.S. consumers will understand PRIMO DEL CRISTO to mean "the Best of Christ."

This is highly relevant to the commercial impression created by applicant's proposed mark. Opposer's MONTECRISTO MARKS include several registrations for embellishments of its MONTECRISTO mark, including WORLD OF MONTECRISTO,⁶ MONTECRISTO LE CIGARE DES ARTS,"⁷ and MONTECRISTO CASINO,⁸ all for "cigars." Furthermore, opposer has testified that it is common practice in the industry for cigar makers to create derivatives of their signature cigar lines as opposer has already done (Workman dep. at 38:19). The clear implication is that consumers will likely be confused into thinking that PRIMO DEL CRISTO is a new brand offered by opposer as a "first," "leading," "excellent," or "superior" line of MONTECRISTO cigars. *Id.*; (McVey dep. at 22:25).

Applicant's proposed mark includes a design element. Where a mark consists of words as well as a design however, the words are generally considered dominant. *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983). We thus find that the design does not distinguish applicant's mark from opposer's marks. Furthermore, applicant's design contains elements reminiscent of designs already registered by opposer in its MONTECRISTO MARKS. We also take note that since opposer owns several registrations for MONTECRISTO in

⁶ See Opposer's Registration Nos. 2555239, 2673722.

⁷ See Opposer's Registration No. 2423694.

⁸ See Opposer's Registration No. 2872359.

standard character or typed drawing format, there is no restriction on how opposer may present its mark. *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).

The Board therefore finds that this *du Pont* factor weighs in favor of finding a likelihood of consumer confusion.

Balancing the Factors

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists because the goods are identical, they are likely to be sold through the same channels of trade, and the marks are similar.⁹

Decision: The opposition is sustained. Serial No. 78470957 is refused registration.

⁹ Since we sustain the opposition on the ground of likelihood of confusion, we need not consider opposer's claim of dilution.