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Mailed: September 25, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Max Rohr, Inc.  
v.  
Boxer Tobacco Company

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Cancellation No. 92047286

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Charles W. Grimes of Grimes & Battersby, LLP for Max Rohr, Inc.

Thomas I. Rozsa of Rozsa Law Group LC for Boxer Tobacco Company.

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Before Hairston, Holtzman and Bergsman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Petitioner, Max Rohr, Inc., filed a petition to cancel a registration owned by Boxer Tobacco Company (respondent) for the mark shown below on the Principal Register for "cigarillos" in Class 34.<sup>1</sup>



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<sup>1</sup> Registration No. 3122507, issued August 1, 2006.

In its petition to cancel, petitioner alleges that respondent is the owner of the subject registration by assignment;<sup>2</sup> that petitioner is the owner of application Serial No. 78914642 for the mark VERONA'S COURT for "cigars" which, petitioner states, has been published for opposition; that petitioner is a wholly owned subsidiary of Altadis U.S.A. Inc. and is using the mark through that company; that petitioner has used the mark VERONA'S COURT since at least as early as September 2003; and that respondent's mark when applied to respondent's goods so resembles petitioner's previously used mark VERONA'S COURT for cigars as to be likely to cause confusion.

Respondent filed an answer to the petition admitting that respondent is the owner of the registration, and denying the remaining allegations. In addition, respondent affirmatively asserts that "the only commonality is the descriptive term of the city Verona." Ans. ¶ 10.

The record includes the pleadings and the file of the involved registration. In addition, petitioner has submitted a notice of reliance on, inter alia, its unanswered requests for admissions; TARR printouts of Registration No. 3233292 for the mark VERONA'S COURT for cigars, which issued from petitioner's pleaded application, and Registration No. 1047827 for the mark

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<sup>2</sup> The registration issued to International Tobacco Partners, Ltd. Office records show that the registration was assigned to Boxer Tobacco Company on February 7, 2006, and that the assignment was recorded in the Office at reel/frame 3275/0672.

ROMEO Y JULIETA for cigars;<sup>3</sup> an entry for "ROMEO Y JULIETA" from The Ultimate Cigar Encyclopedia (1998); and printouts of various newspaper articles from the LexisNexis database referring to ROMEO Y JULIETA cigars. Petitioner has also submitted the testimony, with exhibits, of Eric Workman, senior vice president of marketing for Altadis U.S.A. Inc., petitioner's licensee.

Respondent did not attend the deposition of petitioner's witness; nor did respondent introduce any testimony or other evidence on its own behalf. Only petitioner filed a brief.

As a preliminary matter, we note that because respondent failed to respond to petitioner's requests for admissions, each of the requests is deemed admitted, and moreover each fact in the requests deemed admitted is "conclusively established." Fed. R. Civ. P. 36(a)(3) and (b).<sup>4</sup> Respondent's admissions, in pertinent part, are as follows:

Petitioner has used its VERONA'S COURT mark in commerce since at least as early as September 2003, and prior to respondent's first use of the mark on August 1, 2005 (Adm. Nos. 20, 21 and 23);

Respondent was familiar with the VERONA'S COURT mark for cigars at the time of filing its application (Adm. No. 2);

Petitioner's VERONA'S COURT mark is well known for cigars and respondent knew the mark was well known for cigars at the time of filing its application (Adm. Nos. 3, 4);

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<sup>3</sup> Petitioner did not move to amend the pleading to assert ownership of these registrations. Nevertheless, under the circumstances, we deem the pleading amended to include a claim of ownership of the registrations.

<sup>4</sup> Nevertheless, the Board retains the authority to decide the issue of likelihood of confusion and that finding cannot be delegated despite the facts deemed admitted.

Respondent acknowledges that goodwill is associated with petitioner's VERONA COURT mark in relation to cigars and respondent knew that goodwill was associated with the mark at the time of filing its application (Adm. Nos. 5, 6);

Respondent's identified goods "cigarillos" are a type of cigar (Adm. No. 7);

Cigarillos and cigars are advertised in the same publications (Adm. Nos. 10, 14) and sold in the same channels of trade, including in retail cigar stores and on the same websites (Adm. Nos. 8, 9, 12, 13), to the same purchasers (Adm. Nos. 15, 17);

Respondent "chose to use the term VERONA to cause consumers to associate Registrant's cigarillos with Petitioner's cigars" (Adm. No. 19);

Respondent's "use of VERONA is likely to cause consumers to believe that registrant's cigarillos are associated with petitioner's VERONA'S COURT cigars" (Adm. No. 18).

#### Standing and Priority

As we noted, petitioner submitted TARR printouts of its Registration Nos. 3233292 and 1047827 by a notice of reliance. However, TARR records are not proper evidence to prove that the registrations are valid and subsisting and owned by petitioner. See Trademark Rule 2.122(d);<sup>5</sup> and TBMP §704.03(b)(1)(A) (2d ed. rev. 2004). Furthermore, petitioner did not otherwise properly make the registrations of record. Petitioner did not introduce the registrations during the deposition of Mr. Workman; and there are no admissions by respondent concerning the registrations.

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<sup>5</sup> Trademark Rule 2.122(d)(1) was recently amended to allow the submission of copies of records from Office electronic databases, such as TARR, to prove the status and title of the registration. However the amendment is only applicable to Board proceedings commenced on or after August 31, 2007.

Nevertheless, respondent's admissions that petitioner has prior use of the mark VERONA'S COURT and that respondent intended to associate its cigarillos with petitioner's cigars, are sufficient to establish petitioner's standing to bring the proceeding, as well as its priority of use.

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 the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, 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 (CCPA 1976).

*Goods/Channels of trade/Purchasers*

Respondent has admitted, and the evidence shows, that cigarillos and cigars are legally identical products. As Mr. Workman testified, a cigarillo refers to a size of cigar. Respondent's admissions, as well as the other evidence of record, further establish that that the goods are sold in the same channels of trade to the same classes of purchasers.

*Fame or relative strength of VERONA'S COURT*

Petitioner argues that its mark VERONA'S COURT is famous for cigars. However, the evidence falls short of establishing

the "extensive public recognition and renown" required for fame.<sup>6</sup> See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Nevertheless, respondent has admitted that the mark is well known and, moreover, the evidence is sufficient to establish that the mark has achieved at least some degree of recognition and strength in the market. See *Kenner Parker Toys*, supra at 1456 ("A strong mark...casts a long shadow which competitors must avoid.")

Furthermore, there is no evidence of any third-party use or registration of similar terms in the field. In fact, on this record, the term VERONA appears to be unique and arbitrary for cigars.<sup>7</sup> In view of the foregoing, we find that the mark VERONA'S COURT is entitled to broad protection.

*The marks*

We turn then to a comparison of the marks, keeping in mind that when marks would appear on identical goods, the degree of

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<sup>6</sup> Petitioner has not established fame of the mark VERONA COURT'S apart from any asserted fame of petitioner's mark ROMEO Y JULIETA. Cf. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (noting defendant's "strong point" in stating that "product marks do not acquire fame simply as a matter of the long shadow cast by the accompanying famous house mark"). In this case, petitioner's evidence is directed in substantial part to the recognition of the mark ROMEO Y JULIETA. We note, for example, that none of the advertisements for ROMEO Y JULIETA cigars or Nexis articles referring to ROMEO Y JULIETA cigars mention the VERONA'S COURT mark.

<sup>7</sup> We note respondent's defense in its answer that the only shared term is descriptive of the city of Verona. However, the mere fact that a term is geographic does not automatically mean the term is weak. It is well established, as stated in *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 895 (CCPA 1982), that "A geographic term may be used in a manner which is...inherently distinctive, which includes arbitrary and suggestive usage....".

similarity between the marks necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

It is also important to consider that, while marks must be compared in their entireties, "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." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When compared in their entireties, we find that respondent's mark VERONA (and design) is similar in sound, appearance and commercial impression to petitioner's mark VERONA'S COURT. The word VERONA is the entire literal portion of respondent's mark, and it is aurally and visually a significant part of VERONA'S COURT. While respondent's mark includes a design element, it is the word VERONA itself, rather than the design, that is likely to have a greater impact on purchasers and be remembered by them. See *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"). This is particularly true in this case where the design element in respondent's mark consist of an ordinary geometric shape that

serves essentially as background for the display of the word and it does little to affect or change the commercial impression created by VERONA alone. Moreover, when referring to respondent's products, consumers will call for VERONA cigarillos.

Furthermore, the marks VERONA and VERONA'S COURT connote the same, or variations of the same, geographic place, and they convey a substantially similar image and overall commercial impression.<sup>8</sup> Purchasers who are familiar with petitioner's cigars and its strong and arbitrary mark VERONA'S COURT would be likely to believe, upon encountering respondent's highly similar mark VERONA on identical goods, that such goods originated with or are in some way associated with or sponsored by petitioner.

*Petitioner's claim of bad faith*

By virtue of respondent's failure to deny petitioner's requests for admission, respondent admitted that it intended to associate its goods with petitioner. It has often been said that a party who knowingly adopts a mark similar to the well-known mark of another for closely related goods does so at his own peril, and all doubt on the issue of likelihood of confusion is resolved against him. In re Shell Oil Co., 992 F.2d 1204, 26

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<sup>8</sup> On the other hand, we are not persuaded by petitioner's argument that purchasers would make a connection between VERONA as used on respondent's cigarillos and the imagery associated with the Shakespeare play "Romeo and Juliet." We are not convinced that purchasers would actually go through the elaborate mental process of first associating VERONA'S COURT with petitioner's allegedly famous ROMEO Y JULIETA cigars, then making the connection between VERONA'S COURT and related Shakespeare imagery, and then going on to associate VERONA itself with that same imagery.

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USPQ2d 1687 (Fed. Cir. 1993); and *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989). Thus, if we had any doubt in this case, which we do not, we would resolve it in favor of petitioner.

In view of the similarities between the marks, and the identity of the goods, we find that confusion is likely.

**Decision:** The petition to cancel is granted, and Registration No. 3122507 will be cancelled in due course.