

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

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Paper No. 15  
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Chivas Brothers Limited  
v.  
Ganador Sports, Inc.

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Opposition No. 91150525  
to application Serial No. 78024069  
filed on September 1, 2000

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Patrick T. Perkins of Fross Zelnick Lehrman & Zissu, P.C.  
for Chivas Brothers Limited.

David A. Einhorn of Anderson Kill & Olick, P.C. for Ganador  
Sports, Inc.

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Before Simms, Bottorff and Holtzman, Administrative  
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark CHIVAS (in typed form) for goods identified in  
the application as "hats, tee shirts, jerseys, shorts,  
socks, polo shirts, sweatshirts, sweatpants, shoes,  
underwear, jackets."<sup>1</sup>

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<sup>1</sup> Serial No. 78024069, filed September 1, 2000. The application  
is based on applicant's asserted bona fide intent to use the mark  
in commerce. The application includes the following translation

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Opposer has opposed registration of applicant's mark, alleging as grounds therefor that opposer is the prior user of the marks CHIVAS and CHIVAS REGAL on Scotch whisky and on collateral products including clothing, that opposer is the owner of registrations of the marks CHIVAS for "whiskey" and CHIVAS REGAL for "whisky,"<sup>2</sup> and that applicant's mark, as applied to the goods identified in the application, so resembles opposer's previously-used and registered marks as to be likely to cause confusion. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Opposer also has alleged that applicant's mark is likely to dilute the distinctive quality of opposer's pleaded marks. Trademark Act Sections 43(c), 13 and 2(f), 15 U.S.C. §§1125(c), 1063 and 1052(f).<sup>3</sup>

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statement, entered pursuant to the Office's requirement during prosecution of the application: "The English translation of 'CHIVAS' is 'goats.'"

<sup>2</sup> Registration Nos. 309,456 and 325,152. The disparate spellings of "whiskey" and "whisky" are as per the registrations. This opinion will refer to opposer's goods as "Scotch whisky." As discussed more fully *infra*, opposer failed to properly make either of these registrations (or the two additional unpleaded registrations opposer relies on in its brief) of record.

<sup>3</sup> On November 1, 2002, opposer filed a motion under Fed. R. Civ. P. 15(a) for leave to amend its notice of opposition to include an additional ground of opposition, i.e., that applicant may not lawfully use in commerce or register the applied-for mark because such use or registration would be in violation of a Settlement Agreement and Order which was entered in prior litigation in the United States District Court for the Eastern District of New York between opposer and a third party (with whom applicant is in privity, opposer alleges) (Chivas Brothers Limited and Joseph E. Seagram & Sons, Inc. v. Club Deportivo Guadalajara, A.C., et al., CV 98-7853 (RR)). Review of the opposition proceeding file shows that opposer's Rule 15(a) motion, which was not contested by applicant, was never ruled on by the Board. However, in view of our decision herein sustaining opposer's Section 2(d) ground of

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Applicant filed an answer by which it denied the salient allegations of the notice of opposition and asserted certain "affirmative defenses" which essentially are further denials of opposer's likelihood of confusion and dilution claims.

At trial, opposer presented evidence, but applicant did not. Opposer filed a brief on the case, but applicant did not. No oral hearing was requested. For the reasons discussed below, we sustain opposer's Section 2(d) ground of opposition. In view thereof, we deem opposer's dilution ground of opposition to be moot, and we make no findings or decision thereon.

The evidence of record in this case consists of the pleadings; the file of the opposed application; certain third-party registrations made of record by opposer via notice of reliance; and the testimony deposition of Christopher John Willis, opposer's vice-president of marketing (and exhibits thereto).<sup>4</sup>

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opposition to registration of applicant's mark (see *infra*), we deem this additional ground of opposition, and the Rule 15(a) motion by which opposer seeks to assert it, to be moot, and we make no findings or decision thereon.

<sup>4</sup> In its brief, opposer refers to a November 27, 2002 testimony deposition, noticed by opposer, of applicant's employee Christopher Olson. The Board's proceeding file does not include any transcript for such deposition, nor any record of its having been filed. However, the only citation in opposer's brief to this purported deposition is to a portion thereof which, according to opposer, shows that neither the witness nor applicant's counsel appeared for the deposition. Because the only argument opposer makes in its brief regarding applicant's

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Initially, we find that opposer failed to properly make its pleaded registrations of record. Opposer did not submit status and title copies of the registrations. See Trademark Rule 2.122(d). Opposer's witness, Mr. Willis, identified the registrations in his testimony deposition, but he did not testify as to their current status and title.<sup>5</sup> Because the registrations are not of record, opposer is not entitled to rely on them (or on the statutory presumptions arising from them) to establish its standing to oppose or its grounds of opposition in this case. Instead, opposer is limited to whatever common law rights in its marks it has proven with competent evidence.

Opposer has proven that it uses the mark CHIVAS REGAL in commerce on Scotch whisky, as well as on clothing items. In view thereof, and because opposer's likelihood of confusion claim is colorable, we find that opposer has established its standing to oppose registration of applicant's mark. See, e.g., *Lipton Industries, Inc. v.*

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alleged failure to appear at this deposition is that such failure to appear is itself evidence which supports the additional ground of opposition which opposer sought to assert by its Rule 15(a) motion, and because we already have deemed that additional ground of opposition to be moot (see *supra* at footnote 3), we shall overlook opposer's apparent failure to file the transcript of the deposition as required by Trademark Rule 2.125.

<sup>5</sup> Exhibit No. 18 to Mr. Willis' deposition is opposer's amended complaint (filed February 19, 1999) in the Eastern District of New York civil litigation (see *supra* at footnote 3). Copies of the registrations were attached as exhibits to the amended complaint, and Mr. Willis identified them as such, but he did not testify as to their current status and title.

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*Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

On the issue of Section 2(d) priority, we find that the earliest date on which applicant may rely is the September 1, 2000 filing date of its intent-to-use application. Opposer has proven use of its mark CHIVAS REGAL on Scotch whisky in the United States since prior to that date. Indeed, in 1999, opposer's retail sales of CHIVAS REGAL Scotch whisky totaled \$166 million. (Willis Depo. at 11-13.) We therefore find that opposer has established its Section 2(d) priority as to the mark CHIVAS REGAL for Scotch whisky.

However, the evidence of record does not establish that opposer made use of the mark on any collateral goods, including clothing, prior to applicant's September 1, 2000 application filing date. In his December 5, 2002 testimony deposition, Mr. Willis testified that opposer currently produces and distributes various clothing items bearing the mark, and that opposer plans to introduce additional clothing items in the future. However, he did not testify as to the date of opposer's first use of the mark on clothing items bearing the mark, and we simply cannot conclude from his testimony (or from any other evidence in the record) that such use began prior to September 1, 2000.

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Additionally, although opposer has proven prior common law rights in the mark CHIVAS REGAL for Scotch whisky, the evidence of record fails to establish that opposer has made prior (or any) trademark use of the term CHIVAS, per se.

The product labels and consumer-directed advertisements for opposer's Scotch whisky which are of record all depict opposer's mark as CHIVAS REGAL, not CHIVAS alone.

(Opposer's collateral products, including clothing items, likewise all bear the mark CHIVAS REGAL.) Moreover, there is no evidence in the record from which we might conclude that consumers know or commonly refer to opposer, or to opposer's Scotch whisky, merely as CHIVAS.<sup>6</sup> Accordingly, because opposer's registration of the mark CHIVAS is not of record, and because opposer has failed to prove common law rights in the mark CHIVAS alone, we find that opposer's mark is CHIVAS REGAL, for purposes of this proceeding.

In summary, we find that opposer has proven its Section 2(d) priority as to the mark CHIVAS REGAL (not CHIVAS alone) for Scotch whisky (not clothing).

We turn next to the issue of likelihood of confusion, i.e., whether applicant's mark CHIVAS, as applied to the clothing items identified in the application, so resembles

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<sup>6</sup> Some of the evidence might suggest that opposer refers to itself and its product as CHIVAS in intra-company communications or in communications directed to distributors. There is no evidence that the end consumer ever sees these communications or this usage.

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opposer's previously-used CHIVAS REGAL mark for Scotch whisky as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d). Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The fifth *du Pont* evidentiary factor requires us to consider evidence of the fame of opposer's mark, and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

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*Bose Corp. v. QSC Audio Products Inc., supra*, 63 USPQ2d at 1305.

The evidence of record establishes that CHIVAS REGAL is the number three Scotch whisky brand in the United States, with a 37% share of the deluxe Scotch whisky market.

(Willis Depo. at 11, 13-14.) Opposer's retail sales of CHIVAS REGAL Scotch whisky in the United States for the years 1999-2001 totaled \$470 million. Opposer spends \$10 million per year in advertising the brand. (*Id.* at 15.)

We find that this evidence establishes the fame of opposer's CHIVAS REGAL mark, under the fifth *du Pont* evidentiary factor. That fame weighs heavily in opposer's favor in this case; indeed, in light of the authorities cited above, the fame of opposer's mark must be deemed to be a dominant factor in our likelihood of confusion analysis.

We next must determine whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. 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 that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average

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purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles here, we find that applicant's mark CHIVAS and opposer's mark CHIVAS REGAL obviously are identical to the extent that they both include (or consist of) the word CHIVAS. CHIVAS is the dominant feature in the commercial impression of opposer's mark because it comes first in the mark, see, e.g., *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988), and because the word REGAL is suggestive and somewhat laudatory. We find that the similarity between the marks which arises from the presence in both marks of the word CHIVAS outweighs any dissimilarity arising from the presence of the word REGAL in opposer's mark. Viewing the marks in their entirety, we find them to be similar rather than dissimilar.

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We turn next to the issue of the relatedness of the parties' respective goods. It is not necessary that the respective goods or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Opposer has submitted third-party registrations which show that the marks ABSOLUT, HEINEKEN, BACARDI and JOHNNIE WALKER are registered for both alcoholic beverages and for clothing. Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they suggest that the goods identified therein are of a type which may emanate

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from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). The evidence of record shows that opposer itself markets clothing bearing the CHIVAS REGAL mark, a fact which further supports a finding that the respective goods are related. Finally, it is settled that it is a common practice for owners of marks, especially famous marks, to use those marks on collateral products, including clothing items. See, e.g., *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942 (TTAB 1996).

We find that applicant's clothing items are sufficiently related to opposer's Scotch whisky that source confusion is likely to result from the parties' use of the similar marks involved herein. That is, purchasers familiar with opposer's famous CHIVAS REGAL brand of Scotch whisky are likely to assume, upon encountering clothing items bearing the mark CHIVAS, that opposer is the source of such clothing items, or that opposer has sponsored or approved use of the mark CHIVAS thereon.

Applicant's identification of goods includes no limitation or restriction as to trade channels or classes of purchasers, and we therefore presume that the goods will be marketed in all normal trade channels for such goods and to

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all normal classes of purchasers for such goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Both applicant's goods and opposer's goods are relatively inexpensive consumer items which would be purchased by general consumers with no more than ordinary care.

Considering all of the evidence of record pertaining to the relevant *du Pont* factors, and for the reasons discussed above, we find that a likelihood of confusion exists. Opposer also having established its standing to oppose and its priority of use, we sustain opposer's Section 2(d) ground of opposition.<sup>7</sup>

Decision: The opposition is sustained.

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<sup>7</sup> We deem opposer's pleaded dilution ground of opposition, and its proposed additional ground based on the civil action settlement agreement (see *supra* at footnote 3), to be moot.