

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
March 16, 2004

Paper No. 21
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Republic Tobacco, L.P.

v.

Jesus Javier Ruiz Zuazu

Cancellation No. 92031323

Matthew W. Walch of Latham & Watkins Illinois LLC for
Republic Tobacco, L.P.

William F. Herbert of Staas & Halsey LLP for Jesus Javier
Ruiz Zuazu.

Before Quinn, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

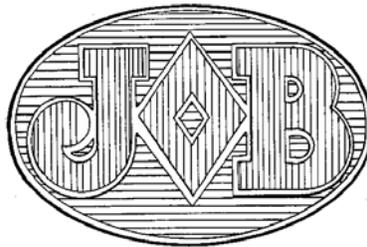
Jesus Javier Ruiz Zuazu ("respondent"), a citizen of
Spain, owns Registration No. 2,297,352, which is of the mark
JOY (in typed form) for goods identified in the registration
as "cigarette papers" in Class 34.¹

¹ Issued on December 7, 1999, from an application filed on
October 28, 1997. The registration issued pursuant to Trademark
Act Section 44(e), 15 U.S.C. §1126(e), based on Spain
Registration No. 2019363, which issued on September 3, 1996 and
which expires on March 21, 2006.

Cancellation No. 92031323

Republic Tobacco, L.P. ("petitioner") has petitioned to cancel respondent's registration, alleging as its ground therefor that respondent's mark, as applied to the goods identified in the registration, so resembles petitioner's previously-used and registered mark JOB as to be likely to cause confusion, to cause mistake, or to deceive.² See Trademark Act Section 2(d), 15 U.S.C. §1052(d). Petitioner has proven status and title of the following registrations:

- Registration No. 73,124, of the mark JOB (in typed form) for "cigarette papers";³
- Registration No. 1,341,384, of the mark depicted below



for "cigarette papers";⁴

² The petition to cancel also includes a dilution claim, but petitioner has waived that claim. See petitioner's brief at footnote 1.

³ Issued on March 16, 1909, from an application filed on October 27, 1908. 4th renewal for twenty years from March 16, 1989; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

⁴ Issued on January 11, 1985, from an application filed on June 6, 1983. Section 8 affidavit accepted; Section 15 affidavit acknowledged. The registration includes the following color lining statement: "The drawing is lined for the colors blue and red." Pursuant to the color lining chart in effect prior to the 1999 amendments to Trademark Rule 2.52, this lining statement means that the oval background is lined for the color blue, and the characters within the oval are lined for the color red.

Cancellation No. 92031323

- Registration No. 1,357,088, of the mark depicted below



for "cigarette papers";⁵

- Registration No. 2,420,646, of the mark JOB (in typed form) for "cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, all such machines being for personal use; filter tips for cigarettes," in Class 34. The registration issued on January 16, 2001, from an application filed on April 5, 1999;

- Registration No. 2,422,747, of the mark depicted below



for the same Class 34 goods as those identified in Registration No. 2,420,646. The registration issued on January 23, 2001, from an application filed on April 5, 1999; and

⁵ Issued on August 27, 1985, from an application filed on October 9, 1984. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

- Registration No. 2,432,868, of the mark depicted below



for the same Class 34 goods as those identified in Registration No. 2,420,646. The registration issued on March 6, 2001, from an application filed on May 11, 1999.⁶

Respondent filed an answer by which he denied the salient allegations of the petition to cancel. At trial,

⁶ The last three of these six registrations were not pleaded by petitioner in the petition for cancellation. (Trademark Rule 2.114(b)(1), 37 C.F.R. §2.114(b)(1), provides that "[a] pleaded registration is a registration identified by number and date of issuance in an original petition for cancellation or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.") Petitioner never filed a motion under Fed. R. Civ. P. 15(a) to amend its pleading to include these three registrations as additional bases of its Section 2(d) claim. However, we note that respondent did not move to strike the unpleaded registrations when petitioner submitted them as exhibits to petitioner's notice of reliance. Also, we note that during the testimony deposition of petitioner's witness Seth Gold, petitioner introduced copies of these unpleaded registrations as exhibits. Respondent's counsel objected on the record to their introduction as exhibits and to the witness' testimony relating to them, arguing that they were not pleaded in the petition to cancel and that they cover goods of petitioner's that were not pleaded in the petition to cancel as a basis for petitioner's Section 2(d) claim. However, objections made during testimony depositions are waived unless they are maintained in a party's brief on the case. See TBMP §707.04 (2d ed. June 2003). Respondent did not file a brief on the case, and therefore has waived those objections. In view thereof, we find that petitioner's ownership of these registrations was tried by the implied consent of the parties, and we therefore deem the pleadings to be amended pursuant to Fed. R. Civ. P. 15(b) to include the registrations. As discussed *infra*, however, petitioner has failed to prove priority as to the marks set forth in Registration Nos. 2,420,646 and 2,422,747, and it therefore has failed to make out its Section 2(d) claim as to those marks.

Cancellation No. 92031323

petitioner submitted evidence (discussed below); respondent submitted no evidence. Petitioner filed a brief on the case, but respondent did not. No oral hearing was requested.

The evidence of record consists of (a) the file of respondent's involved registration; (b) the pleadings herein; (c) status and title copies of six registrations owned by petitioner, submitted via notice of reliance; (d) certain of respondent's answers to petitioner's interrogatories, submitted via notice of reliance; (e) certain documents produced by respondent during discovery, submitted via notice of reliance; (f) certain documents produced by petitioner during discovery, submitted via notice of reliance and pursuant to the parties' stipulation; and (g) the testimony deposition of Seth Gold, petitioner's executive vice-president, and exhibits thereto.

Because petitioner has made status and title copies of its registrations of record and because its likelihood of confusion claim is not without merit, we find that petitioner has established its standing in this case. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

The earliest date upon which respondent may rely for priority purposes is the October 28, 1997 filing date of the application which matured into his involved registration.

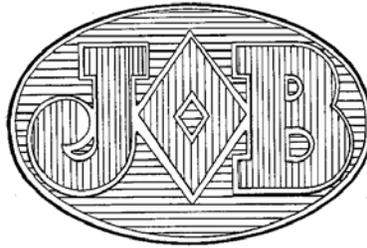
Cancellation No. 92031323

(Respondent has not yet made use of his mark in the United States.) Petitioner's Section 2(d) priority is established as to the marks depicted in its pleaded Registration Nos. 73,124, 1,341,384 and 1,357,088, each of which covers "cigarette papers," because the filing dates of the applications which matured into those registrations predate October 28, 1997. (See *supra* at footnotes 3, 4 and 5.) See *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998). However, petitioner's other three registrations (each of which covers "cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, all such machines being for personal use; filter tips for cigarettes") originated from applications which were filed after October 28, 1997. Therefore, petitioner may rely on those registered marks for its Section 2(d) claim only upon proof of use of the marks prior to October 28, 1997. See *Brewski Beer Co.*, *supra*. The evidence of record shows such prior use only as to one of those registered marks, i.e., the mark depicted in Registration No. 2,432,868. (Gold Depo. at 25-26.)⁷ Because petitioner has not proven its priority as to the marks depicted in Registration Nos. 2,420,646 and

⁷ Mr. Gold testified that petitioner had been using this mark for at least as long as he has been with the company, i.e., since 1982. We note, however, that the date of first use alleged in the registration itself is January 1, 1993.

2,422,747,⁸ petitioner cannot prevail on its Section 2(d) claim as to those marks, and we therefore give them no further consideration.

To summarize, our Section 2(d) likelihood of confusion analysis in this case involves, on one hand, respondent's mark JOY (in typed form) for "cigarette papers," and, on the other hand, petitioner's typed mark JOB and its two design marks depicted below,



all three of which are for "cigarette papers," as well as petitioner's design mark (depicted below)



⁸ Mr. Gold did not specifically testify as to how long petitioner has used the marks depicted in the remaining two registrations, i.e., Nos. 2,420,646 and 2,422,747. See Gold Depo. at 18-21. Nor is there other evidence in the record from which we can determine the dates of use of those marks on those goods.

Cancellation No. 92031323

for "cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, all such machines being for personal use; filter tips for cigarettes."

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). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that the goods identified in respondent's registration, i.e., "cigarette papers," are identical to the goods identified in three of petitioner's registrations. We also find that cigarette papers are complementary and related to the goods identified in petitioner's fourth registration, i.e., "cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, all such machines being for personal use; filter tips for cigarettes." (Gold Depo. at 56-57.) The second *du Pont* evidentiary factor thus weighs in petitioner's favor.

Cancellation No. 92031323

We find that the normal trade channels and classes of purchasers for the parties' identical and otherwise closely related products likewise are identical and overlapping. That is, the goods are sold to general consumers in general retail outlets, including convenience stores, drugstores, music stores, gas station mini marts and tobacco stores. (Gold Depo. at 22-23.) We also find that these goods, especially the cigarette papers, are inexpensive items often purchased on impulse and without a great deal of care. Petitioner's cigarette papers generally retail at \$1.49 to \$1.99 per booklet,⁹ and often are sold at special promotional prices that are even less, e.g., 99 cents. (Gold Depo. at 45-47.) Thus, the third and fourth *du Pont* evidentiary factors weigh in petitioner's favor.

We further find that petitioner's mark is a strong mark and indeed a famous mark as applied to cigarette papers. Petitioner's is the number two brand of premium cigarette papers in the United States, with a market share of thirty to thirty-five percent. (Gold Depo. at 12, 21, 23-24.) Petitioner sells approximately 55 million booklets of its JOB cigarette papers annually, with a dollar volume of well over \$20 million in the year 2000. (Gold Depo. at 12, 72-73.) Over the last decade, petitioner has spent in excess

⁹ Cigarette papers such as petitioner's are sold in "booklets" with the papers interleaved so that when one is pulled out, the

of one million dollars annually to advertise and promote the brand in the United States. (Gold Depo. at 42.)

Based on this evidence, we find that petitioner's JOB mark is a famous mark, for purposes of the fifth *du Pont* evidentiary factor. That fame weighs heavily in petitioner's favor, and indeed must be considered a dominant factor in our likelihood of confusion analysis. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (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). As our primary reviewing court has instructed:

Fame of an opposer's [or petitioner'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.

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

next pops up. (Gold Depo. at 24.) Petitioner's booklets often contain thirty-two papers. (Gold Depo., Exh. 19.)

Cancellation No. 92031323

The strength of petitioner's mark in the marketplace is further corroborated by the absence of any evidence of similar marks in use on similar goods. The sixth *du Pont* factor thus weighs in petitioner's favor.

There is no evidence of actual confusion. However, because respondent has yet to use his mark in the United States, there has been no opportunity for actual confusion to have occurred. In these circumstances, the absence of actual confusion is neither factually surprising nor legally significant. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). The seventh and eighth *du Pont* factors therefore are neutral.

We turn finally to a determination, under the first *du Pont* factor, of whether respondent's mark JOY and petitioner's JOB marks, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. In making that determination in this case, we keep the following principles in mind. 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 purchaser, who normally retains

Cancellation No. 92031323

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).

Petitioner's mark JOB, as registered in typed form, is similar to respondent's mark JOY in terms of appearance insofar as both marks are short, three-letter words which begin with the letters "JO" and differ only as to the last letter. The two marks are similar in terms of sound insofar as they are both one syllable words which start with the sound of the letter "J" followed by variations on the vowel sound "O", but they are dissimilar insofar as petitioner's mark JOB rhymes with "bob" or "rob," while respondent's mark JOY rhymes with "toy" or "boy." (Gold Depo. at 78.) The marks are more dissimilar than similar in terms of connotation, both of them being normal English words with easily-recognized, and different, meanings. Both marks appear to be arbitrary as applied to cigarette papers.

Weighing these similarities and dissimilarities between the marks in terms of appearance, sound and connotation, we

Cancellation No. 92031323

find that respondent's mark and petitioner's mark are on the whole more similar than dissimilar in terms of their overall commercial impressions. The marks differ only by one letter. Given the visual similarity between the marks and the fact that the goods are inexpensive items which often are purchased on impulse, we find that purchasers are likely to misperceive JOY as JOB and mistakenly purchase respondent's goods when they intend to purchase petitioner's.

We also find that respondent's mark is similar rather than dissimilar to petitioner's registered design marks. The dominant feature of those marks is the literal portion thereof, i.e., JOB; the stylized lettering and the carrier devices play merely supporting roles in the commercial impressions of the marks. See *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). Moreover, because respondent's mark is registered in typed form, respondent is free to depict the mark in any reasonable manner, including with stylized lettering and carrier devices similar to petitioner's. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Accordingly, while we have taken the design elements of petitioner's marks into account, we find that they do not suffice to distinguish petitioner's marks from respondent's mark in terms of overall commercial impression.

Cancellation No. 92031323

Where, as in the present case, the marks would appear on virtually identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Moreover, the fame of petitioner's mark entitles it to a wide latitude of protection against competing marks. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises*, 889 F.2d 1070, 1074, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989) ("There is no excuse for even approaching the well-known trademark of a competitor" (internal quotations omitted).) For these reasons, we find that respondent's mark is sufficiently similar to petitioner's marks that confusion is likely to result from the parties' use of the marks on identical goods. The first *du Pont* factor weighs in petitioner's favor.

Having considered the evidence of record pertaining to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. Because petitioner also has established its standing and its priority, petitioner is entitled to prevail in this proceeding.

Decision: The petition to cancel is granted.