

No. 23-1100

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**United States Court of Appeals  
for the Federal Circuit**

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BUREAU NATIONAL INTERPROFESSIONNEL DU COGNAC, INSTITUT  
NATIONAL DES APPELLATIONS D'ORIGINE,  
Appellants,

v.

COLOGNE & COGNAC ENTERTAINMENT,  
Appellee.

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Appeal from the Trademark Trial and Appeal Board in Opposition No. 91250532

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**BRIEF OF APPELLANTS**

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

**Case Number** 23-1100

**Short Case Caption** Bureau National Interprofessionnel du Cognac v. Cologne & Cognac Entertainment

**Filing Party/Entity** Bureau National Interprofessionnel du Cognac and Institut National des Appellations d'Origine

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Name: Peter M. Brody

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Form 9 (p. 2)  
March 2023

<p><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p><b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
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<p>Institut National des Appellations d'Origine</p>		

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None/Not Applicable                       Additional pages attached


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**STATEMENT OF RELATED CASES**

Pursuant to Rule 47.5, there are no related cases.

## STATEMENT OF JURISDICTION

Under 28 U.S.C. § 1295(a)(4)(B) and 15 U.S.C. § 1071(a)(1), this Court has jurisdiction over appeals from final decisions of the Trademark Trial and Appeal Board (“Board”) of the United States Patent and Trademark Office in opposition proceedings. Appellants Bureau National Interprofessionnel du Cognac (“BNIC”) and Institut National des Appellations d’Origine<sup>1</sup> (“INAO” and, together with BNIC, “Opposers”) timely filed this appeal on October 27, 2022, Appx1198, after final decision by the Board on August 25, 2022, dismissing Opposition No. 91250532 (“Opposition”) to a trademark application filed by Appellee Cologne & Cognac Entertainment (“Applicant”). Appx1. 15 U.S.C. § 1071(a)(2); 37 C.F.R. § 2.145(d)(1).

Opposers’ entitlement to a statutory cause of action under the Lanham Act was uncontested by Applicant and acknowledged by the Board. Appx8-Appx9. Opposers likewise meet the jurisdictional standing requirements applicable in an Article III court. *E.g., Consumer Watchdog v. Wis. Alumni Rsch. Found.*, 753 F.3d 1258, 1261 (Fed. Cir. 2014) (stating requirements). As the entities responsible for controlling and protecting the COGNAC certification mark, on which the Opposition was based, Opposers and those they authorize to use the mark would

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<sup>1</sup> During the pendency of this litigation, INAO’s name was changed to “Institut National de l’Origine et de la Qualité,” which is still abbreviated as INAO.

suffer concrete and particularized injury fairly traceable to use and registration of Applicant's COLOGNE & COGNAC ENTERTAINMENT and design mark. *See Int'l Union, United Auto., Aerospace and Agric. Implement Workers of Am. v. Brock*, 477 U.S. 274, 282 (1986) (stating elements of representational standing). That injury arises because, as set forth below, Applicant's mark (1) is likely to confuse or deceive the relevant public into believing, falsely, that goods and services offered by Applicant are endorsed or sponsored by, or affiliated with, Opposers or the persons that Opposers authorize to use the COGNAC certification mark and (2) is likely to cause dilution by blurring of the COGNAC mark in the minds of the purchasing public. *See, e.g., Institut Nat'l des Appellations D'Origine v. Vintners Intern. Co.*, 958 F.2d 1574, 1579-80 (Fed. Cir. 1992) (INAO had standing to appeal dismissal of opposition to registration of mark incorporating French appellation of origin); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 493-95 (Fed. Cir. 1987) (trade association had standing to appeal dismissal of opposition to mark incorporating mark used by association's members).



## STATEMENT OF THE ISSUES

In a two-to-one split decision, the Board held registrable a mark prominently incorporating without permission the certification mark COGNAC, holding that the mark (combining the phrase COLOGNE & COGNAC ENTERTAINMENT and a design featuring, *inter alia*, a bottle of COGNAC), if used for hip-hop music and production services, was not likely to cause confusion or dilution. The issues for appeal are as follows:

1. Whether the majority's decision rejecting Opposers' likelihood-of-confusion claim was legally erroneous and must be reversed because:
  - a. The majority applied the wrong legal standard for fame (which this Court considers the "dominant factor" in the likelihood-of-confusion analysis) by requiring COGNAC to be famous for its "certification status" rather than its geographic significance;
  - b. The majority analyzed the similarity of the parties' marks under an incorrect legal standard, finding that the challenged mark was not similar to the COGNAC mark despite *incorporating* it, based on a purported material factual finding about the differing "connotations" of the parties' marks that lacked any citation to, or basis in, the record evidence; and

- c. The majority applied the wrong legal standard in evaluating the factors concerning the relatedness of goods, trade channels, and consumers, by focusing on *Opposers' service of certifying*, rather than on the *goods* bearing the COGNAC certification mark?
2. Whether the Board's decision as to Opposers' dilution claim was legally erroneous and must be reversed because:
    - a. The panel applied erroneous pleading standards in dismissing the claim by requiring Opposers to plead dilution on an element-by-element basis and by failing to construe Opposers' factual pleading in accordance with the Federal Rules of Civil Procedure; and
    - b. The majority applied an erroneous legal standard in evaluating whether the COGNAC mark is famous for dilution purposes?

## INTRODUCTION

In dismissing a trademark opposition filed by the protectors of the long-famous COGNAC certification mark for French brandy to an unauthorized mark comprising the words “COLOGNE & COGNAC ENTERTAINMENT” and a design featuring bottles of cologne and COGNAC spirits, a two-judge majority of the TTAB (over a vigorous dissent) repeatedly used the wrong legal standards in its analysis of Opposers’ likelihood-of-confusion and dilution claims and failed to meet its statutory obligation to cite (and have) evidence to support a finding of fact. In broader terms, the majority’s decision is erroneous because the legal standards it embraced would, if affirmed, provide certification marks with markedly *less* protection than other marks—a critical misapplication of the Lanham Act. While the Board’s decision must at least be vacated and remanded in view of the Board’s repeated and critical legal errors, given the applicable *de novo* standard of review and the *uncontradicted* record, Opposers request that this Court hold that Applicant’s mark poses a likelihood of both confusion and dilution and therefore is unregistrable.

\* \* \*

COGNAC is a world-famous geographical indication for a brandy made exclusively in the Cognac region of France. As this Court’s predecessor observed decades ago, Americans have appreciated COGNAC as “a superior brandy” for “several hundred years.” *Otard, Inc., v. Italian Swiss Colony*, 141 F.2d 706, 708

(C.C.P.A. 1944). The United States, the largest market for COGNAC products, has accorded the COGNAC appellation extremely strong legal protections, including under international treaties, the Federal Alcohol Administration Act, and (as relevant here) as a common law certification mark under the Lanham Act. Opposers are the two bodies charged under French law with the administration and protection of the COGNAC certification mark on a world-wide basis.

As the undisputed evidence establishes, Applicant intentionally appropriated and incorporated Opposers' renowned COGNAC certification mark for French brandy into its own mark, trading on that undisputed renown and hip-hop's close association with the COGNAC mark and certified products in the public's mind. Accordingly, Opposers asserted, *inter alia*, a claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) for refusal of Applicant's mark because it falsely suggests that Applicant's goods and services are endorsed, licensed, or sponsored by Opposers or the COGNAC producers they certify and represent. Appx71. Such a false suggestion is likely to arise because Applicant's mark incorporates the COGNAC mark in its entirety and because of the extensive association between certified COGNAC products and hip-hop record labels and music artists like Applicant and its owner, including well-known advertising campaigns and partnerships for production of certified COGNAC product under celebrity brands. Opposers also asserted a claim under Section 43(c) of the

Trademark Act, 15 U.S.C. § 1125(c) for refusal of Applicant's mark because the mark will dilute the famous COGNAC mark by blurring its distinctiveness. Appx72.

As the dissent observed, and indeed, as Applicant conceded, if Applicant had sought to register a mark incorporating, without authorization, a well-known trademark, as in COLOGNE & HENNESSY ENTERTAINMENT or COLOGNE & COURVOISIER ENTERTAINMENT, that registration should, and would, have been refused forthwith. Appx1180. In light of decades of settled, binding precedent that certification marks are entitled to the *same* level of protection as trademarks under the Lanham Act—and given the applicable legal standards designed to ensure that parity of treatment—that should have been the outcome here.

Instead, the majority rejected both of Opposers' claims and dismissed the opposition. In so doing, the majority made multiple fundamental legal errors. In particular, the majority applied a plainly erroneous legal standard to the likelihood-of-confusion factor considered the "dominant factor" by this Court, namely, the fame of Opposers' mark; applied an equally incorrect legal standard to the "key" factor of the similarity of the parties' marks, compounded by a critical factual finding on the "connotation" of the marks that lacked any citation to, or basis in, the record evidence; and applied yet a third incorrect legal standard to the "key" factors of the relatedness of goods and services and overlap in customers. As for dilution, the majority again legally erred by applying an erroneous pleading standard to dismiss

Opposers' claim and, in its alternative holding on the merits of the claim, using, once again, an incorrect legal standard to assess the fame of the COGNAC mark.

For the reasons set forth in Judge Wolfson's vigorous dissent and below, this Court should reverse.

### **STATUTORY FRAMEWORK**

The Lanham Act broadly addresses rights in, and remedies for, a "mark," which the statute expressly defines as "any trademark, service mark, collective mark, or certification mark." 15 U.S.C. § 1127. In turn, section 45 of the Lanham Act defines "certification mark" as follows:

The term "certification mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

15 U.S.C. § 1127. As the statutory language provides, certification marks differ from trademarks in several key respects.

First, while a trademark's purpose is to indicate a *single* source of a product or service, a certification mark must be "used by a person *other* than its owner."<sup>2</sup> *Id.* By statute, a certification mark necessarily is "applied by other persons, to *their* goods or services, with *authorization* from the owner of the mark."<sup>3</sup> *Midwest Plastic Fabricators, Inc. v. Underwriters Lab'ys Inc.*, 906 F.2d 1568, 1570 (Fed. Cir. 1990) (emphasis in original) (citation omitted); *Luxco, Inc. v. Consejo Regulador Del Tequila, A.C.*, 121 U.S.P.Q.2d (BNA) 1477, 1482 (T.T.A.B. 2017) ("[T]he goods to which a geographic certification mark is applied may emanate from a number of sources comprising various certified producers in the relevant region."). Certification marks thus typically appear alongside third-party trademarks on the labeling, packaging, and advertisements for, certified goods. *See, e.g., Midwest Plastic Fabricators*, 906 F.2d at 1571-72; *Consol. Dairy Prods. Co. v. Gildener & Schimmel Inc.*, 101 U.S.P.Q. 465, 467 (Comm'r Pat.1954). Given this, as the TTAB has long held, the likelihood-of-confusion analysis involving a certification mark must focus on the certified goods and their producers, not on the service of certifying

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<sup>2</sup> Indeed, the owner of a certification mark forfeits protection for the mark if it "engages in the production or marketing of any goods or services to which the certification mark is applied." 15 U.S.C. § 1064(5)(B); *accord* 37 C.F.R. § 2.45.

<sup>3</sup> Going further, the statute forbids a certification mark owner from "discriminately refus[ing] to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies." 15 U.S.C. § 1064(5)(D); *accord, e.g., Idaho Potato Comm'n v. M & M Produce Farm & Sales*, 335 F.3d 130, 138 (2d Cir. 2003).

those goods or the certifying body itself. *See, e.g., Proctor & Gamble Co. v. Cohen*, 375 F.2d 494, 496 (C.C.P.A. 1967); *In re Accelerate s.a.l.*, 101 U.S.P.Q.2d 2047, 2049 (T.T.A.B. 2012) (nonprecedential opinion); TMEP § 1306.04 (July 2022).

Second, Congress has expressly exempted certification marks of regional origin (“CMROs”) from the Lanham Act’s general rule precluding protection of “primarily geographically descriptive” marks. 15 U.S.C. § 1052(e)(2); *see id.* § 1054; *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 497 (2d Cir. 1962). Indeed, the statute ceases to protect a CMRO if it *loses* that primarily geographically descriptive status and becomes a generic term for a category of goods. *Id.*; *see USPTO. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 (2020).

Otherwise, certification marks are to be protected “in the same manner and with the same effect as are trademarks.” 15 U.S.C. § 1054; *accord, e.g.,* 37 C.F.R. § 2.45; *Idaho Potato Comm'n v. M & M Produce Farm & Sales*, 335 F.3d 130, 138 (2d Cir. 2003) (“[T]rademarks and certification marks are ‘generally treated the same.’”) (quoting *Levy v. Kosher Overseers Ass’n of Am., Inc.*, 104 F.3d 38, 39 (2d Cir. 1997)); *Midwest Plastic Fabricators*, 906 F.2d at 1570 (finding no difference in burden or standard of proof for cancelling certification marks or trademarks); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d (BNA) 1881, 1886-87 (T.T.A.B. 2006).



As with trademarks, such protection encompasses both registered and unregistered, or “common law” certification marks.<sup>4</sup> *See, e.g., Black Hills Jewelry Mfg. Co. v. LaBelle’s*, 489 F. Supp. 754, 759 (D.S.D. 1980) (extending Lanham Act protection to “unregistered common law certification mark”), *aff’d on other grounds sub nom. Black Hills Jewelry Mfg. Co. v. Gold Rush, Inc.*, 633 F.2d 746 (8th Cir. 1980); *Stabilisierungsfonds für Wein v. Zimmermann-Graeff KG*, 199 U.S.P.Q. (BNA) 488, 490 (T.T.A.B. 1978) (with certification marks, as with trademarks, “federal registration is merely the recognition of a common law right in a mark that existed prior to registration”).

In particular, Section 2(d) of the Lanham Act bars registration of any trademark that is confusingly similar to another, previously used mark, whether registered or not. 15 U.S.C. § 1052(d). Likewise, Section 43(c) establishes rights and remedies against dilution of any “famous mark.” *Id.* § 1125(c). Although this Court has not itself decided a case specifically involving a certification mark of regional origin, there are well-settled principles regarding the treatment of such marks under Section 2(d) and the dilution provisions established by other Circuits and especially the Trademark Trial and Appeal Board over the nearly 80 years since the Lanham Act’s enactment, as discussed herein.

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<sup>4</sup> When the Lanham Act provides protection specifically for a “registered mark,” the Lanham Act so specifies. 15 U.S.C. § 1114(1) (providing liability for improper uses of “a registered mark”).

## STATEMENT OF THE CASE<sup>5</sup>

### A. The COGNAC Certification Mark

As the record demonstrates, and the Board recognized decades ago, “[t]he Cognac region has become famous as the place where ‘COGNAC’ brandy is produced, and ‘COGNAC’ brandy itself enjoys a world-wide reputation as a superior and prestigious quality brandy” from the Cognac region of France. *Bureau Nat’l Interprofessionnel Du Cognac v. Int’l Better Drinks Corp.*, 6 U.S.P.Q.2d (BNA) 1610, 1612 (T.T.A.B. 1988). The designation “COGNAC” is regulated under French law as an *appellation d’origine controlée* (controlled “appellation of origin,” herein, “AOC”), a category of geographical indications defined by French law for certain products, including wines and spirits. Appx104.

Each AOC specifies the geographic region from which the product originates, as well as the qualities and characteristics that the product must exhibit due to that geographic environment. Appx104. For example, an AOC may require producers to use specified grape varieties and particular methods of planting, harvesting, and vinification. *Id.* The legal standards (known as the *Cahier des Charges*) for the COGNAC AOC detail every aspect of the production of COGNAC spirits, including requirements for growing, harvesting, fermenting, distilling, aging, and labeling among other things. Appx107; Appx151-Appx171 (2018 Specification for the

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<sup>5</sup> Applicant did not dispute the facts set forth in this Statement of the Case.

Registered Designation of Origin). Every AOC, including COGNAC, dually protects the reputation of the designated products and their producers *and* the consumers of AOC products, by ensuring that the designated product (1) originated in a legally delimited area within the named region of France and (2) was produced using the legally required local and customary methods. Appx104-Appx105.

Opposer INAO, an administrative agency within the French government, has developed and protected France's system of appellations of origin for over 80 years. Appx103. INAO oversees external control of geographic indications, including the inspection procedures used to verify compliance with the rules governing that AOC. Appx109-Appx110. INAO has statutory power to enforce compliance with French laws governing all AOCs, including COGNAC, and its decisions have the force of French law. Appx104.

INAO works with regional associations of producers and merchants of products bearing AOCs, such as Opposer BNIC, the interprofessional union of all growers, producers, and merchants who grow, produce, or deal in COGNAC spirits. Appx105. BNIC was created to "represent and defend the collective interests of professional winegrowers and merchants" by, *inter alia*, ensuring that the production standards stated in the COGNAC *Cahiers de Charges* are fully respected. Appx106-Appx109. BNIC also "participat[es] in the defense and protection of the name/mark,

products, and terroir, and enhanc[es] the reputation of the certified COGNAC product.” Appx106.

United States treaties, laws, and regulations expressly protect the COGNAC AOC. Appx586-Appx587. Notably, the United States Alcohol and Tobacco Tax and Trade Bureau (“TTB”)—the federal agency charged with regulating the labeling and advertising of spirits products in the U.S.—prohibits use of the term “COGNAC” on spirits products except for “grape brandy distilled in the Cognac region of France, which is entitled to be so designated by the laws and regulations of the French Government.” 27 C.F.R. § 5.145(c)(2); *see* Appx586-Appx587 (citing to former regulation). French and U.S. law authorize BNIC to identify which products are entitled to be designated as COGNAC. Appx106; 27 C.F.R. § 5.145(c)(2).

Additionally, the United States Patent and Trademark Office has repeatedly recognized the COGNAC AOC as a common law certification mark indicating the regional origin as well as the quality and characteristics of the designated products. *E.g., Bureau Nat’l Interprofessionnel Du Cognac v. Enovation Brands, Inc.*, No. 91242020, 2020 WL 1528535, at \*4 (T.T.A.B. Mar. 13, 2020); *Institut Nat’l des Appellations d’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875, 1884-85 (T.T.A.B. 1998); *Int’l Better Drinks Corp.*, 6 U.S.P.Q.2d at 1614; *see also* Appx110-Appx111. Opposers have successfully opposed and obtained cancellation of several

dozen marks incorporating or alluding to the COGNAC certification mark. Appx110.

**B. The Commercial Success of the COGNAC Mark**

COGNAC spirits have been continuously sold in the United States, in substantial volumes, since they were first imported in 1794. Appx111. COGNAC—known for its “refined smoothness” and considered to be “the peak of the distiller’s art,” Appx757—has long enjoyed a stellar reputation in this country, including an association with luxury and sophistication. *See, e.g.*, Appx303 (COGNAC exudes “old world and luxury”); Appx319; Appx629 (regarding COGNAC “as the most luxurious spirit in the world); Appx647; Appx742; Appx 814 (describing COGNAC as “classy, sophisticated, and really smooth”); Appx970. The United States is the largest market for certified COGNAC products, consuming nearly half of France’s supply. Appx111. In 2019, the year Applicant filed its application, the U.S. imported over 100 million bottles of certified COGNAC spirits, for which importers paid nearly \$2 billion. Appx112. During 2007-2019, over 800 million bottles of COGNAC, for which importers paid over \$11.3 billion, were shipped to the United States. *Id.*

It was undisputed below that certified products bearing the COGNAC mark are heavily marketed in the United States by their suppliers. BNIC reinforces that substantial marketing with its own promotional efforts. Appx112-Appx113. During

the decade preceding the disputed application, BNIC alone spent over \$650,000 to promote COGNAC in the United States, resulting in more than 660,000,000 media impressions.<sup>6</sup> Appx112; *see also* Appx113 (citing Appx488-Appx551 as examples of BNIC marketing materials).

Just in the period 2008-2020, countless unsolicited news stories featured the COGNAC mark and certified COGNAC products. Appx112-Appx113. Those stories appeared in media sources spanning the United States, including major newspapers (*e.g.*, *New York Times*, *Washington Post*, *Wall Street Journal*, *USA Today*, *Los Angeles Times*, *Houston Chronicle*, *Chicago Tribune*, *Philadelphia Inquirer*, *Miami Herald*, *Atlanta Journal Constitution*, *San Francisco Chronicle*, and *Boston Globe*); widely-read magazines (*e.g.*, *Forbes*, *Fortune*, *Maxim*, *LA Weekly*, *Town & Country Magazine*, *Wine Spectator*, *Food and Wine Magazine*, and *Wine Enthusiast*); and other national media (*e.g.*, Fox News, CBS, and Yahoo! Finance). Appx112-Appx113; Appx214-Appx487. Books available in the United States and published between 2005 and 2017 also feature the COGNAC mark and COGNAC products. Appx113-Appx114; Appx587-Appx588; Appx624-Appx649.

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<sup>6</sup> Again, these figures do not include the heavy advertising spending by the COGNAC houses or their American distributors.

### **C. The Association Between the COGNAC Mark and Hip-Hop**

COGNAC is well known to a broad cross-section of American consumers. Appx113-Appx114; *see, e.g.*, Appx246; Appx270; Appx301, Appx331-Appx335. In addition, the record establishes a particularly close relationship between COGNAC and the music industry, specifically recording artists, record labels, and consumers of hip-hop music—the genre of the goods and services of the Applicant. *See, e.g.*, Appx1067. Applicant itself admitted that “the association between cognac and the music industry is commonplace and has resulted in increased cognac sales.” Appx1063.

Applicant also admitted that the consuming public is aware of “the prolific use of the term ‘cognac’ and brands of cognac in song lyrics, song titles, etc. Appx1063. In fact, lyrics of hip-hop songs have reflected the popularity of COGNAC since the genre began in the 1990s. *E.g.*, Appx747 (“Over time, rap artists began to mention enjoying cognac in their lyrics, which sparked even more interest within potential consumers.”); Appx751 (“Cognac has been seen in hip hop and rap music since the earliest days of the gangsta rap era, with the beverage appearing the songs of the 90’s...”); Appx738 (“It seems that whenever hip hop artists rap about alcohol, it’s usually Cognac”). As the relationship between hip-hop and COGNAC flourished, it amplified COGNAC’s already strong reputation and fame, particularly

among younger generations of American consumers. *E.g.*, Appx331-Appx332, Appx757, Appx769, Appx771, Appx774, Appx998-Appx999.

The COGNAC mark and brand names of certified COGNAC products have been referenced “in over 1,000 songs, by such famed artists as Notorious BIG, 2Pac, Kanye West, Rick Ross, Nas, Dr Dre, and 50 Cent.”<sup>7</sup> Appx743. As Applicant admitted, such references have measurably affected sales of certified COGNAC products. Appx106. For example, Busta Rhymes and P. Diddy’s 2001 hit song *Pass the Courvoisier*—which named multiple COGNAC brands, including Hennessy and Remy Martin, Appx641—caused sales to jump 30 percent, and other partnerships between COGNAC brands and musicians led to “increased overall sales of cognac in the U.S. by a similar percentage.” Appx757; *see also* Appx761-Appx763; Appx794; Appx814; Appx955-Appx956.

Producers of certified COGNAC products have embraced the hip-hop world, partnering with famous musicians and record labels to market certified COGNAC

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<sup>7</sup> Representative lyrics featuring the COGNAC mark and certified COGNAC products include (1) “chill on the block with Cognac” by NAS; (2) “the Cognac bar, the sweet TV with the VCR” by Timbaland; (3) “Cognac is the drink that’s drank” by Snoop Dogg; (4) “this is culde-sac and plenty Cognac” by Kendrick Lamar; (5) “she like, where the Cognac” by A\$AP Rocky; (6) “so I keep drinkin’ Hennessy” by JA Rule; (7) “old school gangsta style, smokin’ dank Cognac lounge beat” by E-40; (7) “Pass the Courvoisier. Everybody sing it now. Pass the Courvoisier.” Appx590, Appx593-Appx594, Appx599, Appx641, Appx751-Appx753, Appx770-Appx771, Appx802, Appx847, Appx1006-Appx1013.



products in the United States.<sup>8</sup> Appx114-Appx115, Appx590-Appx597. For example:

- Rémy Martin partnered with musicians Pharell Williams and T.I. to assist with promotions, merchandising and digital media campaigns. Appx853-Appx858, Appx903.
- Landy partnered with Snoop Dogg for a digital marketing and social media program featuring Landy certified COGNAC products. Appx774; Appx786; Appx830.
- Hennessy partnered with hip-hop musician Erykah Badu, rap musician Nas, and hip-hop artist A\$AP Ferg to market its certified COGNAC products. Appx582-Appx584; Appx849-Appx850; Appx889-Appx892; Appx898; Appx912-Appx914.
- Martell partnered with rap musician Quavo, making him a brand ambassador for its certified COGNAC product. Appx795; Appx916-Appx918; Appx923.
- Courvoisier partnered with rap musicians Pusha-T to create the Maison Courvoisier pop up series and A\$AP Rocky as a brand ambassador for its certified COGNAC products. Appx830; Appx847; Appx872; Appx877-Appx878; Appx883-Appx886; Appx974
- Courvoisier also partnered with Def Jam Recordings to create a concert tour that showcases artists across the United States with COURVOISIER certified COGNAC as the sponsor. Appx874-Appx875.
- The D’Ussé brand hosted a “Re-mixer” event, allowing guests to create their own D’Ussé cocktail while 9th Wonder—Grammy Award-winning producer of many hip-hop artists—provided a DJ masterclass. Appx780-Appx781; Appx788-Appx789

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<sup>8</sup> The record demonstrates earlier instances of trademarks covering both music and alcoholic beverages as well, including the marks ACDC, IRON MAIDEN, SINATRA, and VIRGIN. *See, e.g.*, Appx588 (citing Appx671-Appx726).

Other hip-hop musicians have partnered with certified COGNAC producers to introduce *new* brands of COGNAC, further demonstrating the commercial value of the COGNAC certification mark. Appx115, Appx597-Appx599. For instance:

- Hip-hop musician Ludacris partnered with Birkedal Hartmann to produce a certified COGNAC product under the brand “Conjure.” Appx930; Appx934; Appx800.
- Hip-hop musician Dr. Dre partnered with Domaines Francis Abecassis to produce a certified COGNAC product under the brand “Aftermath.” Appx903; Appx977-Appx978.
- Hip-hop musician Jay-Z partnered with Chateau de Cognac to produce a certified COGNAC product under the brand “D’Ussé.” Appx832-Appx833; Appx948; Appx951; Appx973.
- Hip-hop musician 50 Cent partnered to produce a certified COGNAC product under the brand “Branson.” Appx939; Appx942-Appx943; Appx973.

Critically, *all* of these products—whether established brands like Courvoisier or new brands like Conjure—bear the COGNAC certification mark, as does every certified COGNAC product.

#### **D. Applicant’s Registration**

Applicant Cologne & Cognac Entertainment is a record label, founded by Travis Davis, a recording artist and songwriter. Appx1059-Appx1060. Mr. Davis describes himself as “an R&B musical recording artist and producer” featured in “HipHopSince1987, The Rapfest, The Source, ThisIsR&B, Respect Magazine, That’s Enuff (DJ Enuff), Hip Hop Weekly, AllHipHop.com, HotSpotAtl.com.”

Appx1165. Applicant has produced songs referencing certified COGNAC products, including his song titled *Red Bull and Hennessy*. See, e.g., Appx654-Appx655.

On March 7, 2019, Applicant filed an application to register the following mark for use with audio and video recordings and various music and video services:



Appx1061; Appx67-Appx69; Appx1078. The application disclaimed exclusive rights in the term “ENTERTAINMENT” but made no such disclaimer regarding “COGNAC.” Appx1079.

In the Board proceeding, Applicant admitted being “aware of the brandy beverage COGNAC” when selecting its mark and admitted the term COGNAC in its mark “identifies a variety of brandy.” Appx655; Appx661. Mr. Davis instructed the contract designer to “incorporate a bottle of cologne and a bottle of cognac” in the mark. Appx666. While Applicant later suggested that the mark’s design merely shows a “generic liquor bottle,” Appx660, Appx1061, the majority rejected that *post hoc* characterization: “The design elements of a spray container and a bottle will likely be interpreted by consumers as stylized representations of cologne and Cognac containers, further reinforcing the phrase—COLOGNE & COGNAC.” Appx25.

### **E. Procedural History**

On August 28, 2019, Opposers filed a timely notice of opposition to registration of Applicant's mark. Appx67. Opposers pleaded various grounds for refusal, including that Applicant's mark, when used for the identified goods and services, was "likely to cause confusion, mistake or to deceive the public" within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Appx71. As Opposers elaborated, "The purchasing public is likely to believe, mistakenly, that goods and services offered by Applicant under the COLOGNE & COGNAC ENTERTAINMENT and Design mark are sponsored by Opposers and/or the persons they represent, or are otherwise affiliated with or connected to Opposers, the persons they represent, or the COGNAC they produce." Appx71. Opposers also claimed dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), averring that Applicant's mark "creates an association with the famous COGNAC mark such that the distinctiveness of the COGNAC mark is impaired" and thus is likely to cause dilution through blurring. Appx71-Appx72.

Following discovery, the parties proceeded to trial on Opposers' confusion and dilution claims. Opposers submitted the Duthilleul Declaration, explaining the role of INAO and BNIC in protecting the COGNAC mark and COGNAC's longstanding fame and connection with the music industry. Appx103-Appx115. This declaration was accompanied by 22 exhibits, relating to media impressions of

COGNAC generally and articles discussing the relationship between COGNAC and the music industry. Appx117-Appx584. Opposers also submitted the first and second Durand Declarations, Appx586-Appx600, Appx1022-Appx1024, collectively containing 71 exhibits concerning the recognition and fame of the COGNAC mark, the relatedness of goods and services at issue, and the public awareness thereof. Appx602-Appx1020; Appx1026-Appx1057. The Durand Declaration also included material from Applicant's website, Applicant's responses to Opposers' interrogatories and requests for admission, and documents produced by Applicant consisting of messages regarding the design of its mark. Appx588; Appx599; Appx650-Appx669; Appx1014-Appx1020.

Applicant did not object to any of Opposers' evidence. Appx34 & n.50. For its part, Applicant submitted a single declaration from Travis Davis, with eight exhibits. Appx1059-Appx1064. These exhibits related to the application for registration and the design and use of Applicant's mark, and also include copies of the declarations of Ms. Durand. *Id.*

Opposers filed an opening trial brief, Applicant filed a response trial brief, and Opposers filed a reply. Appx66.

On August 25, 2022, a three-judge panel of the TTAB consisting of Judges Wellington, Wolfson, and Lykos issued a non-precedential two-to-one split

decision, with Judges Wellington and Lykos in the majority and Judge Wolfson largely dissenting. Appx1; Appx37.

Like prior TTAB panels, the majority found that “Opposers have exclusive rights in COGNAC as a regional certification mark . . . to represent to consumers that a distilled spirit bearing the COGNAC mark comes from a defined region of France and was produced in accordance with local and customary production standards.” Appx8. Turning to the likelihood of confusion, the majority found that all relevant *DuPont* factors weighed against likelihood of confusion or were neutral. Notably, the majority found that COGNAC is not strong or famous, and therefore is only entitled to a normal scope of protection; that Applicant’s mark has a different “connotation” from that of COGNAC and thus is dissimilar; and that the relevant goods and services do not overlap; and nor do the relevant trade channels or purchasers. Appx23, Appx26, Appx29. The majority held that, on balance, confusion was unlikely. Appx29-Appx32.

As for Opposers’ dilution claim, the Board *sua sponte* ruled that Opposers’ pleading was defective because it did not include a specific allegation that the fame of COGNAC predated Applicant’s constructive use date, and further ruled that the issue of whether COGNAC’s fame predated Applicant’s use was not tried by implied consent. Appx35. The majority ruled in the alternative that Opposers had not proved

the fame element of dilution, relying on its analysis of fame for likelihood-of-confusion purposes. Appx35.

Judge Wolfson dissented from the majority’s dismissal of the likelihood-of-confusion claim, asserting that the majority incorrectly analyzed each one of the *DuPont* factors resolved against Opposers. Appx37. As for dilution, while Judge Wolfson concurred that it was not properly pleaded or tried by implied consent, she opined that “given the fame of the mark and the degree of association with it that Applicant’s mark engenders,” it is “highly likely that Opposers would succeed in their dilution by blurring claim” if it *was* pleaded and tried. Appx37.

### **SUMMARY OF THE ARGUMENT**

As Judge Wolfson’s dissent highlighted, the majority’s holding on the likelihood of confusion is replete with fundamental legal and factual errors as to each of the *DuPont* factors resolved against Opposers:<sup>9</sup>

*Fame.* As the dissent stressed, the majority’s evaluation of the strength or fame of the COGNAC mark—the “dominant factor” in the analysis of likelihood of confusion, according to this Court—entailed two legal errors. The majority erred in holding that, to establish the strength or fame of a CMRO, the certifier is required to prove that the mark is renowned for its “certification status.” The majority cited no authority for this holding, and it contravenes both the Lanham Act and the Board’s

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<sup>9</sup> Opposers do not appeal with respect to the factors found to be neutral.

own precedents. The majority also wrongly held that Opposers' evidence of substantial sales and advertising of certified COGNAC products could not establish the fame of the certification mark because those products also prominently bear brand names (such as "Hennessy"). The majority's false dichotomy ignored that, under the Lanham Act, a certification mark *must* be used on third-party products, which virtually always will bear their own brand. And as the dissent observed, fame is not an either/or proposition: both the certification mark and the brands it certifies can be famous, as is the case here.

*Similarity of marks.* Given Applicant's incorporation of the famous COGNAC mark into the dominant portion of its own COLOGNE & COGNAC mark and no countervailing facts, the marks should have been deemed "highly similar" under settled law. Although the Lanham Act mandates the *same* level of protection for certification marks and trademarks, the majority improperly analyzed the similarity of marks differently because of COGNAC's "certification function." That error alone invalidates the majority's finding, but the majority further erred in making a purported finding that Applicant's mark and the COGNAC mark have different "connotations" in the consumer's mind. As a matter of law, the majority's decision on this factor fails the substantial evidence standard because, as the dissent pointed out, the majority cited *no evidence whatsoever* for this purported finding. Indeed, the only evidence on this point in this record establishes quite the opposite.



*Relatedness of goods and services and respective customers.* The majority likewise legally erred by comparing Applicant's goods and services to Opposers' *certification* services. As the dissent explained, the correct comparison is between Applicant's goods and services, on one hand, and certified COGNAC goods and their suppliers, on the other. As the dissent also emphasized, the record establishes a strong relationship between hip-hop music performance and certified COGNAC products and their producers, including specifically advertising deals and partnerships for personal brands of certified COGNAC product. Applicant's mark falsely suggests to consumers precisely this kind of relationship, causing likelihood of confusion.

The majority's decision as to Opposers' dilution claim, too, was legally erroneous. To be sure, the elements of *proof* of a dilution claim include that "defendant's use of its mark began after the plaintiff's mark became famous." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012). But this Court has made clear that "the Federal Rules of Civil Procedure do not require a plaintiff to plead facts establishing that each element of an asserted claim is met." *Nalco Co. v. Chem-Mod, LLC*, 883 F.3d 1337, 1350 (Fed. Cir. 2018) (citation omitted). In any event, Opposers' complaint *did* allege that COGNAC had become famous "over many years," which was necessarily before Applicant's constructive use date only *five months* earlier, thus satisfying even the majority's erroneous

pleading standard. Finally, the majority’s ruling in the alternative on the merits was also erroneous, because it rested on the same incorrect legal standard for fame applied by the majority to the likelihood-of-confusion claim.

This Court must at a minimum vacate the Board’s decision, and either sustain the Opposition due to likelihood of confusion or dilution, or remand for the Board’s analysis under the correct legal standards.

### STANDARD OF REVIEW

This Court reviews *de novo* the Board’s determinations as to questions of law. *In re Pacer Tech.*, 338 F.3d 1348, 1349 (Fed. Cir. 2003). The Board’s application of “an incorrect legal standard” in determining the registrability of a mark is legal error requiring reversal. *In re Sones*, 590 F.3d 1282, 1283 (Fed. Cir. 2009); *e.g.*, 5 U.S.C. § 706(2)(A) (“The reviewing court shall . . . hold unlawful and set aside agency action, findings, and conclusions found to be . . . not in accordance with law.”); *Burlington Indus., Inc. v. Quigg*, 822 F.3d 1581, 1584 (Fed. Cir. 1987) (agency “[d]eterminations that are not in accordance with law must be reversed”).

Factual findings by the Board are accorded a degree of deference, but must be set aside if “arbitrary, capricious, or unsupported by substantial evidence.” *Bridgestone/Firestone Rsch., Inc. v. Auto. Club De L'Quest De La France*, 245 F.3d 1359, 1361 (Fed. Cir. 2001); *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1331 (Fed. Cir. 2014). As a matter of law, this Court cannot find substantial

evidence if the Board does not explain its findings, including by identifying the evidence that supports its conclusions. *In re St. Helena Hosp.*, 774 F.3d 747, 753-55 (Fed. Cir. 2014) (reversing refusal to register mark when the “record contain[ed] no evidence to support a conclusion”); *Custom Comput. Servs., Inc. v. Paychex Props., Inc.*, 337 F.3d 1334, 1337 (Fed. Cir. 2003) (overturning TTAB finding where “Board did not point to any evidence to support its conclusion”). Manifestly, the substantial evidence standard cannot be satisfied by mere speculation. *Nat’l Shooting Sports Found., Inc. v. Jones*, 716 F.3d 200, 214 (D.C. Cir. 2013) (setting aside agency decision based on “conclusory and unsupported suppositions”); *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000) (explaining substantial evidence is not satisfied with “[m]ere uncorroborated hearsay or rumor”).

This Court considers the ultimate issues in this case—likelihood of confusion and likelihood of dilution—to be questions of law (reviewed *de novo*), which depend on underlying factual findings (reviewed for substantial evidence). *StonCor Grp., Inc.*, 759 F.3d at 1331; *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 264-65 (4th Cir. 2007).

On the issue of whether a claim is sufficiently pled under Federal Rule of Civil Procedure 12(b)(6), this Court reviews the Board’s decision *de novo*. *Young v. AGB Corp.*, 152 F.3d 1377, 1379 (Fed. Cir. 1998). Both the Board and this Court must

“accept all factual allegations in the complaint as true and construe the pleadings in the light most favorable” to the plaintiff. *Bot M8 LLC v. Sony Corp. of Am.*, 4 F.4th 1342, 1353 (Fed. Cir. 2021); *see NSM Resources Corp. v. Microsoft Corp.*, 113 U.S.P.Q.2d (BNA) 1029, 1032 (T.T.A.B. 2014); 37 C.F.R. § 2.116 (adopting Fed. Rules of Civil Procedure for *inter partes* proceedings).

## ARGUMENT

### I. THE MAJORITY COMMITTED MULTIPLE REVERSIBLE LEGAL ERRORS IN ITS ANALYSIS OF THE LIKELIHOOD OF CONFUSION

To evaluate likelihood of confusion, this Court relies on the *DuPont* factors. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). As the Board has long held, and the majority here acknowledged at least in principle, “The test for determining likelihood of confusion with respect to regional certification marks is the same as that applied to trademarks, *i.e.*, the *DuPont* analysis.” Appx13; *see, e.g., Institut Nat’l des Appellations d’Origine*, 47 U.S.P.Q.2d at 1890 (“There is nothing in the language of Section 2(d) which mandates or warrants application of one level of likelihood of confusion analysis (*i.e.*, the *du Pont* analysis) in cases where the plaintiff’s mark is a trademark or service mark, but a different and more limited likelihood of confusion analysis in cases where the plaintiff’s mark is a certification mark. Section 2(d) does not distinguish between certification marks, on the one hand, and trademarks and service marks on the other.”).

**A. The Majority Used Erroneous Legal Standards in Evaluating the Fame of the COGNAC Certification Mark**

**1. *The Undisputed Evidence Establishes the Fame of the COGNAC Mark***

The majority began its evaluation of the likelihood of confusion with the fifth *DuPont* factor, the fame or strength of the COGNAC certification mark. This Court has “consistently stated that fame of the mark is a dominant factor in the likelihood of confusion analysis” because of the broad scope of protection afforded famous or strong marks. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000) (“Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.”); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992) (“The driving designs and origins of the Lanham Act demand the standard consistently applied by this court—namely, more protection against confusion for famous marks.”).

Despite the importance of this factor, Applicant’s brief below did not address, much less dispute, the strength or fame of COGNAC in its discussion of the likelihood of confusion, as the majority acknowledged. Appx16 at n.28. Applicant also did not object to, or take issue with, any of Opposers’ evidence of strength and fame.

“[L]ikelihood of confusion fame varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017) (citation omitted). Where a mark falls on that spectrum is “primarily a question of assessment of a mark’s distinctiveness or popularity.” *E. I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975). A mark’s strength may be due to either inherent distinctiveness or commercial success or both. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (“A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:80 (5th ed. 2023).

As the majority found, the COGNAC certification mark *is* indisputably distinctive. Appx55-Appx56. Indeed, a geographic certification mark is *inherently* distinctive “as it inherently identifies the geographic source” of the goods in question. *See Tea Bd. of India*, 80 U.S.P.Q.2d at 1899. On that basis alone, COGNAC is a strong mark, entitled to a relatively broad scope of protection. *See Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1339 (Fed. Cir. 2004) (equating inherent distinctiveness and strength); *Estrada v. Telefonos De Mexico, S.A.B. de C.V.*, 447 F. App’x 197, 202 (Fed. Cir. 2011) (same) (unpublished); *see also Grubbs v. Sheakley Grp., Inc.*, 807 F.3d 785, 795 (6th Cir.

2015) (“The more distinct a mark, the more likely is the confusion resulting from its infringement, and therefore the more protection it is due.”).

The COGNAC certification mark has not only “conceptual strength (distinctiveness)” but also “marketplace strength (secondary meaning).” *In re Chippendales USA, Inc.*, 622 F.3d at 1353-54. That strength is a reflection of the mark’s enjoyment of “major commercial success in the United States,” as found by prior panels of the TTAB and this Court’s predecessor. *Enovation Brands, Inc.*, 2020 WL 1528535, at \*5-6; *accord, e.g., Int’l Better Drinks Corp.*, 6 U.S.P.Q.2d 1610, 1612 (T.T.A.B. 1988) (“The Cognac region has become famous as the place where ‘COGNAC’ brandy is produced, and ‘COGNAC’ brandy itself enjoys a world-wide reputation as a superior and prestigious quality brandy.”); *Otard, Inc.*, 141 F.2d at 708 (“[COGNAC] is recognized as a superior brandy; has been so recognized for several hundred years.”).

A mark’s commercial fame is measured by factors such as “volume of sales and advertising expenditures of the goods sold under the mark, for example, and other factors such as length of time the mark has been in use; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services.” *Enovation Brands, Inc.*, 2020 WL 1528535, at \*5; *accord, e.g., Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371-72 (Fed. Cir. 2002); *Blue Man Prods., Inc. v. Tarmann*, 75

U.S.P.Q.2d 1811, 1817 (T.T.A.B. 2005), *rev'd on other grounds*, slip. op. 05-2037, (D.D.C. Apr. 3, 2008).

As detailed in the Statement of the Case, *supra* at 15-20, Opposers submitted extensive, undisputed evidence regarding these and other relevant facts, establishing that, for example:

- COGNAC designated spirits have been continuously sold in the United States since 1794.
- Since 2007, over 800 million bottles of certified COGNAC spirits, valued at over \$11.3 billion, were shipped to the United States for sale.
- Between 2010-2018, marketing pieces sponsored *just* by Opposer BNIC (that is, not even including marketing sponsored by all the various Cognac houses) generated over 660,000,000 media impressions.
- From 2008-2020, print and online publications throughout the United States have featured numerous, and unsolicited, references to the COGNAC mark and certified COGNAC products.
- Books available in the United States describe the history and characteristics of COGNAC spirits.
- The term COGNAC and certified COGNAC products have long been featured in rap and hip hop songs and are well known and recognized in the music industry.
- Certified COGNAC producers have partnered with famous musicians to produce and market certified COGNAC products, including under new brand names.

Notably, earlier decisions by other Board panels unanimously found the mark strong and famous for likelihood-of-confusion purposes based on evidence of the



same type and quantity regarding the general strength and fame of the COGNAC certification mark (although not its particular strength in the hip-hop world). *See, e.g., Enovation Brands, Inc.*, 2020 WL 1528535, at \*5-6, (finding “the COGNAC certification mark would fall on the very strong end of the spectrum of fame for purposes of the likelihood of confusion analysis,” including based on the continuous use of COGNAC mark since 1794, the import of 87.4 million bottles of COGNAC in 2018 alone, and over 700 million in the eleven years prior, and myriad articles and books featuring COGNAC).

As the dissent firmly concluded, a finding of fame was equally warranted here:

The evidence recounted in the majority opinion, and bolstered by the additional examples noted above, is, in my view entirely sufficient to establish the fame of the certification mark. . . . Therefore, on the record presented in this case, I would find Opposers’ mark famous and qualified for enhanced protection against a likelihood of confusion.

Appx59-Appx60.

The majority itself acknowledged that COGNAC is “a popular spirit in the United States, with impressive sales” in terms of volume and dollar value; that “news and industry articles of record further reflect the *renown*” of COGNAC; and that COGNAC is “particularly popular within the hip hop music industry.” Appx22. Yet the majority paradoxically concluded that the COGNAC certification mark is no

more than “distinctive” and thus is only entitled to “a normal scope of protection.” Appx23. It did so because, the dissent suggested, the majority got “sidetracked” by flawed legal arguments advanced by the applicant, in two respects. Appx59.

**2. *The Majority Erred in Ruling that Fame Requires Consumer Awareness of “Certification Status”***

First, the majority erroneously assumed that, to establish the fame of the COGNAC certification mark, Opposers would have to prove the mark’s “renown *for conveying the message that the goods are certified by Opposers as to regional origin and meeting the prescribed qualities,*” Appx22 (emphasis added), or more succinctly, Opposers would have to establish the fame of the “*certification status*” of the mark. Appx18 (emphasis added); *see also, e.g.,* Appx23 n.37 (contending that, not only in the instant case, but in prior litigation, it had not been shown “that COGNAC was a famous or even strong mark *in terms of conveying the message to consumers that the goods are certified*” or that COGNAC was even “used prominently *as a certification mark designation*” even though it appeared on every label of certified COGNAC goods (emphasis added)).

As the dissent rightly pointed out, this is not, and never has been, the law: “Consumers need not be expressly aware of the certification purpose of the designation. It is sufficient that they would perceive COGNAC as an indication of a particular regional origin.” Appx43 (collecting cases). Indeed, in the landmark *Institut National des Appellations d'Origine v. Brown-Forman Corp.* case in 1998

(a precedential decision binding on the instant panel), the Board made clear that public awareness of the “certification function” is not even *relevant* to the recognition and protection of a designation as a certification mark:

[T]he issue is not whether the public is expressly aware of the certification function of the mark or the certification process underlying use of the mark, but rather is whether the public understands that goods bearing the mark come only from the region named in the mark. If use of the designation in fact is controlled by the certifier and limited to products meeting the certifier’s standards of regional origin, and if purchasers understand the designation to refer only to products which are produced in the particular region, and not to products produced elsewhere, then the designation functions as a regional certification mark. Neither the statute nor the caselaw requires that purchasers also be expressly aware of the term’s certification function, per se.

*Id.*, 47 U.S.P.Q.2d at 1885. As the *Institut National* Board recognized, and as discussed *supra* at 8-10, the statute sets forth clearly and explicitly *all* of the requirements and conditions for recognition and protection of a certification mark, and consumer awareness of “certification function” is *not* among them.

Subsequent Board decisions appropriately have followed the *Institut National*’s holding that public awareness of a certification mark’s “certification function” is not relevant to, let alone required for, the recognition and protection of the mark under the Lanham Act. *E.g.*, *Luxco, Inc.*, 121 U.S.P.Q.2d at 1483; *Tea Bd. of India*, 80 U.S.P.Q.2d at 1897-98. Indeed, PTO Examining Attorneys are

*instructed* to apply this principle in examining applications for registration of certification marks:

When reviewing an application for a geographic certification mark, the examining attorney must consider the specimen of record and any other available evidence to determine whether the relevant consumers understand the designation as referring only to goods or services produced in the particular region identified by the term and not those produced elsewhere as well. *Consumers need not be expressly aware of the certification purpose of a designation. It is sufficient that they would perceive the designation as an indication of a particular regional origin; if so, the designation functions as a geographic certification mark and is registrable.*

TMEP § 1306.05(c) (emphasis added). As the Board repeatedly has made plain, a CMRO is protectable as long as consumers are aware of the regional origin indicated by the mark alone, regardless whether they are aware of any other qualities or characteristics that may additionally be certified.<sup>10</sup> *E.g., Tea Bd. of India*, 80 U.S.P.Q.2d at 1886-87.

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<sup>10</sup> While these decisions typically address (and reject) the argument that a given CMRO is *generic*, genericness and famousness are both measurements of the distinctiveness and strength of a mark. *See Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 971-72 (Fed. Cir. 2018) (explaining the spectrum of distinctiveness used to evaluate the strength of a mark extends from generic to fanciful); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012) (fame for likelihood of confusion varies along a spectrum from “very strong to very weak”). And both turn on how consumers perceive a mark. *See USPTO v. Booking.com B. V.*, 140 S. Ct. 2298, 2307 (2020) (genericness depends on consumer perception of the mark); *Coach Servs., Inc.*, 668 F.3d at 1367 (“A famous mark is one that has extensive public recognition and renown.” (quotation

The majority’s erroneous legal ruling that the COGNAC mark must be renowned for its “certification status” was the linchpin of its finding that the mark is not famous, and that finding thus must be vacated. And because fame plays a “dominant role” in the likelihood-of-confusion analysis, the majority’s ultimate ruling of no likelihood of confusion must be vacated as well. *See, e.g., Joseph Phelps Vineyard, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1326 (Fed. Cir. 2017) (vacating and remanding the TTAB’s decision because “the Board used an incorrect standard for fame”).

**3. *The Majority Also Erred in Ruling that Evidence of Substantial Sales and Advertising of Certified Products Does Not Prove Fame of a Certification Mark***

As noted above, the majority itself found that Cognac “is a popular spirit in the United States, with impressive sales in terms of both the number of products sold and the overall dollar value of those sales” and that publications “reflect the renown of the brandy from France.” Appx22. The majority also acknowledged the well-settled rule that “the volume of sales and advertising of the goods or services under [a] mark” indicate the strength of the mark. Appx17; *see, e.g., Bose Corp.*, 293 F.3d 1367 at 1371 (“[T]he fame of a mark may be measured by the volume of sales and

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omitted)). Case law has made clear that consumer awareness of a CMRO’s “certification status” is immaterial to *where* on that spectrum the mark falls; what matters is the strength of the mark’s *geographical significance* to consumers. *E.g., Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d (BNA) 1881, 1887 (T.T.A.B. 2006).

advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”); *Dupont*, 476 F.2d at 1361 (noting “sales, advertising, length of use” are indicative of “[t]he fame of the prior mark”); *Enovation Brands, Inc.*, 2020 WL 1528535 at \*5 (finding COGNAC mark to be “on the very strong end of the spectrum of fame” including on sales of “over 700 million bottles” sold).

But rather than reach the obvious conclusion (COGNAC is famous based on its “impressive” sales and advertising), the majority invented an *exception* to the normal rule if a certification mark appears along with the trademarks of certified products, as in the case of COGNAC. As the dissent saw it, the majority decided that “if a brandy manufacturer’s famous trademark is applied to a bottle also labeled as certified COGNAC, the fact that the trademark identifying the particular certified user may be famous precludes finding fame in the certification mark itself.” Appx59.

Of course, by their nature, virtually *all* certification marks—geographic or otherwise—appear on goods also bearing a trademark. *See Consol. Dairy Prods. Co.*, 101 U.S.P.Q. at 467. The majority’s reasoning thus would make it much more difficult, if not impossible, to establish that certification marks are famous, contrary to settled law that certification marks are to be accorded the same degree of protection as trademarks. *See supra* at 10, 30.

The dissent rightly chided the majority for its unfounded view of the respective strength and fame of geographic certification marks and the trademarks of the goods they certify:

I reject Applicant's contention that any fame that attaches to a brand of COGNAC precludes any possibility of finding fame in the certification mark. While I acknowledge that the record shows examples of use of brand names for COGNAC that are more prominent than the use of the certification mark, I note that the certification mark appears on many more bottles of COGNAC than does any particular brand.

Appx60. This court likewise has recognized that co-branding does not preclude both marks from acquiring fame; by analogy, "product marks" are fully capable of achieving fame in their own right even though they may primarily be used with famous house marks. *E.g. Bose Corp.*, 293 F.3d at 1375.

Indeed, a geographic certification mark often may be a greater driver of consumer purchase interest than the individual trademarks appearing on the certified goods. *See In re Florida Citrus Comm'n*, 160 U.S.P.Q. (BNA) 495, 499 (T.T.A.B. 1968) ("As a consequence of the certification feature of the mark, it is a device which persons generally look for and many times are governed by in making their purchases."). For example, consumers may seek out certified IDAHO potatoes, or certified FLORIDA oranges, or certified GEORGIA peaches without caring much about which *brand* of such goods they are buying. The record in this case offers ample evidence of precisely this effect in the case of COGNAC, including, for

example, the numerous examples of the introduction of entirely *new* brands of certified COGNAC spirits by hip-hop artists. *See supra* at 17-20 (noting partnerships between COGNAC houses and famous artists such as Ludacris, Dr. Dre, Jay-Z, and 50 Cent). While these artists may have name recognition in the hip-hop world, the fact that they chose to launch a certified COGNAC product, rather than any other spirit, in conjunction with their own names, shows that the COGNAC mark, indeed, is “a device which persons generally look for and many times are governed by in making their purchases.” *In re Florida Citrus Comm'n*, 160 U.S.P.Q. at 499. *Cf. In Re CRC Packaging, LLC*, No. 88696519, 2022 WL 486620, at \*4-5 (T.T.A.B. Jan. 28, 2022) (nonprecedential opinion) (rejecting argument that a certification mark is different from a trademark, including due to inconspicuous placement of certification marks).

By again misapplying the relevant legal standard, the majority erred in evaluating the fame of the COGNAC certification mark—the factor that determines the scope of protection a mark is due. The finding—and the holding on likelihood of confusion that relies on that finding—should be vacated due to this legal error. *See Joseph Phelps Vineyard*, 857 F.3d at 1326.



**B. To Find Dissimilarity Between the Marks, the Majority Embraced an Erroneous Double Standard for Certification Marks and Made a Material Factual Finding Without Citing or Having Any Supporting Evidence**

The similarity between the parties' respective marks is also a "key" *DuPont* factor. *Swatch AG (Swatch SA) (Swatch Ltd.) v. M. Z. Berger & Co.*, 108 U.S.P.Q.2d (BNA) 1463, 1469 (T.T.A.B. 2013). Moreover, "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls." *Kenner Parker Toys Inc.*, 963 F.2d at 353.

A comparison of marks for similarity entails consideration of their "appearance, sound, connotation, and commercial impression." *In re E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361. However, "[i]t is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion." *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732 (C.C.P.A. 1968); *accord, e.g., In re Inn at St. John's, LLC*, 126 U.S.P.Q.2d (BNA) 1742, 1746 (T.T.A.B. 2018) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.") (quoting *In re Davia*, 110 U.S.P.Q.2d 1810, 1812 (T.T.A.B. 2014)), *aff'd mem.*, 777 F. App'x. 516 (Fed. Cir. 2019).

As the majority acknowledged, "Applicant's mark incorporates the term COGNAC" in its entirety, as part of the "dominant element" of Applicant's mark. Appx24. Applicant's incorporation of the COGNAC mark was no innocent mistake

or coincidence: as Applicant admitted, it was “aware of the brandy beverage COGNAC” (Appx655) and included it in its mark with the *intention* of referring to COGNAC brandy (Appx661) “because of the popularity of that beverage within the hip-hop music industry.” Appx31. Moreover, the other portion of this “dominant element” of Applicant’s mark (“COLOGNE &”) comprises generic terms.

“If a junior user takes the entire mark of another and adds a generic, descriptive or highly suggestive term, it is generally not sufficient to avoid confusion.” 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:50 (collecting cases); accord TMEP § 1207.01(b)(iii) (“[I]f the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences.”) (collecting cases); *see, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 1378 (Fed. Cir. 2023) (upholding Board’s findings of similarity and likelihood of confusion where the applicant’s mark, “SPARK LIVING,” incorporated another mark, “SPARK”); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 557 (C.C.P.A. 1975) (holding BENGAL and BENGAL LANCER and design confusingly similar); *Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 U.S.P.Q.2d (BNA) 1555, 1561 (T.T.A.B. 2007) (“[W]e find that applicant’s RATED R SPORTSWEAR mark incorporates in its entirety opposer’s mark, RATED R. . . . [B]ecause the dominant

portion of applicant's mark is identical to opposer's mark, the marks convey highly similar connotations.”).

Here, even the “non-dominant” portion of Applicant’s mark reinforces the “incorporation” of the COGNAC mark. As the majority found:

The design elements of a spray container and a bottle will likely be interpreted by consumers as stylized representations of cologne and Cognac containers, further reinforcing the phrase—COLOGNE & COGNAC. In terms of meaning the combination of terms “cologne” with “Cognac” creates an image of a person wearing cologne and drinking brandy, projecting a certain lifestyle, such as one of leisure and high-living.

Appx25. Again, that “reinforcement” is not coincidental: the Applicant *expressly instructed* its graphics designer to “somehow incorporate a bottle of cologne and a *bottle of cognac*” into the mark. Appx665-Appx666 (emphasis added).

As the dissent observed, and as Applicant itself conceded, a mark that incorporates, without permission, a well-known trademark for COGNAC, such as “COLOGNE & HENNESSY,” would be considered unregistrable. Appx1180, Appx43. Likewise, the incorporation of the COGNAC mark in Applicant’s mark, as reinforced by the design, should have dictated finding a *high* degree of similarity here. Appx41. Indeed, the dissent stressed, any other result would be at odds with the principle that certification marks be afforded the same level of protection as trademarks under Section 2(d) of the Lanham Act. Appx40; *see supra* at 10, 30.

Yet the majority reached the opposite conclusion on the similarity of marks on the basis of a finding that, despite incorporating the term COGNAC and the image of a COGNAC bottle, Applicant's mark "engenders a different appearance, sound, commercial impression and connotation from Opposers' certification mark."

Appx24. According to the majority:

Opposers' certification mark, COGNAC, as used by Opposers' certified users, informs consumers that the brandy being sold by the certified users comes from the Cognac region of France. Applicant's mark, on the other hand, when viewed in the context of musical goods and services conjures a different connotation and projects an image of sophistication and elegance.

Appx24. This "finding" entails two related legal errors.

*First*, as the dissent noted, the majority's comment (Appx24) that COGNAC "informs consumers that the brandy being sold by the certified users comes from the Cognac region of France" is factually true, but legally immaterial. Appx39-Appx41. By definition, *every* CMRO functions to inform consumers that certified products come from named region—that is, every CMRO is "primarily geographically descriptive"—but CMROs are still statutorily entitled to the same protections as trademarks, including protection against confusingly similar mark. 15 U.S.C. § 1052(e)(2); *see id.* §§ 1054, 1127. By finding Applicant's mark dissimilar in part *because* COGNAC has primary geographic significance, the majority made a clear legal error. Appx40-Appx41.

*Second*, as the dissent again pointed out, in finding that Applicant’s mark differs from COGNAC because it “conjures a different connotation and projects an image of sophistication and elegance” (Appx24), the majority cited *no evidence* in the record, Appx41, nor did Applicant provide any, and the finding thus is rank speculation. For that reason alone, it must be vacated as a matter of law under the substantial evidence standard of the Administrative Procedure Act. 5 U.S.C. § 706(2)(E); *see, e.g., In re St. Helena Hosp.*, 774 F.3d at 755 (substantial evidence standard cannot be met when “record contain[ed] no evidence to support a conclusion”); *Nat’l Shooting Sports Found., Inc.*, 716 F.3d at 214 (“conclusory and unsupported suppositions” cannot sustain agency action).

Moreover, the majority’s finding that Applicant’s mark connotes “sophistication and elegance” while COGNAC itself does not is squarely *contradicted* by ample record evidence—and *other findings by the majority*—that COGNAC has precisely that connotation. *See supra* at 15. For example, the majority found that COGNAC products “hav[e] a reputation for being a drink for an older or *affluent* clientele” and that the drink’s “refined smoothness was a favorite drink of the upper class.” Appx25 (citing Appx730, Appx704, Appx 757). These are plainly connotations of “sophistication and elegance,” even if expressed in different words. Appx24. As the dissent concluded:

[W]hatever “lifestyle” connotation the majority attributes to the combination of the terms COLOGNE and

COGNAC, *i.e.* that of leisure and high living, is suggested by the term COGNAC alone. The term retains its significance when considering Applicant's mark as a whole; this connotation is no different than that suggested by the combination. . . . [T]o the extent Applicant's mark evokes a lifestyle of leisure or high living, the materials show that it is the term COGNAC alone that projects this image.

Appx41 & n. 56.

As a matter of law, the majority's ruling on the marks' respective "connotations" fails the substantial evidence standard and must be set aside. *In re St. Helena Hosp.*, 774 F.3d at 753 (setting aside finding on likelihood-of-confusion factor when the only record evidence was to the contrary). And because that unsupported and speculative finding was central to the majority's finding of a lack of similarity between the marks, that finding also must be set aside. Further, given the undisputed facts about the incorporation of the COGNAC mark in Applicant's mark, as reinforced by the design, this Court, following settled precedent, should find as a matter of law that the marks are highly similar.

**C. The Majority Relied on a Legally Erroneous Comparison in its Evaluation of the Similarity of the Goods and the Overlap in Trade Channels and Classes of Consumers**

Additional "key considerations" in the *DuPont* likelihood-of-confusion analysis are the similarity or relatedness between the goods to which the parties' respective marks are applied and the channels of trade through, and classes of consumers to, which those goods are marketed. *Swatch AG*, 108 U.S.P.Q.2d at 1469.

The Board and courts often consider these factors together, as did both the majority and dissent here.

In evaluating these factors, “it is well established that the goods and services of the parties or their certificant need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion.” *Motion Picture Ass’n of Am., Inc.*, 83 U.S.P.Q.2d at 1562; accord *Coach Servs. Inc.*, 668 F.3d at 1369. Rather, these factors ask whether the goods are related in such a way that “the circumstances surrounding their marketing” would result in relevant consumers mistakenly believing that the goods and services originate from or are associated with the same source.” *Coach Servs. Inc.*, 668 F.3d at 1369. Such confusion is all the more likely where the senior mark is a famous mark; fame thus renders less important any apparent differences between goods or trade channels. *Recot, Inc.*, 214 F.3d at 1328 (compiling cases recognizing confusion between products not closely related); see *Kenner Parker Toys Inc.*, 963 F.2d at 355 (emphasizing TTAB’s error in discounting fame of senior mark in similarity analyses, noting “fame . . . should have magnified the significance of these similarities”).

Moreover, the confusion that is relevant is not limited to confusion over the source or origin of the junior user’s goods, but encompasses any other kind of confusion, including confusion as to “sponsorship, affiliation, or connection.” See,

*e.g., In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1355 (Fed. Cir. 2001) (“The related goods test measures whether a reasonably prudent consumer would believe that non-competitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.”); *accord, e.g., Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 706-15 (4th Cir. 2016) (examining confusion as to the “affiliation, connection, or association” of the goods); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979) (“In order to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market. . . . The public's belief that the mark’s owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement.”).

For example, in the *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.* case (on which TTAB frequently relies), this Court’s predecessor upheld a finding of likelihood of confusion on the basis that “the public, being familiar with appellee’s use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item.” *Id.*, 648 F.2d 1335, 1336 (C.C.P.A. 1981). Similarly, this Court has chided the Board for disregarding evidence of just such confusion:

Indeed, the evidence seems extremely pertinent to the question of whether, absent any evidence of current use of



the FRITO–LAY marks for pet food, *a consumer would likely think that FRITO–LAY produced, sponsored, or licensed its mark* for use for pet snack products. Thus, even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood-of-confusion analysis.

*Recot, Inc.*, 214 F.3d at 1328-29 (citations omitted; emphasis added).

Here, the undisputed evidence shows a strong, well-established, and recognized relationship between COGNAC certified products and hip-hop music.

For example:

- By the 1990s, COGNAC spirits became immortalized in lyrics of hip-hop and rap music. Over 1,000 songs have mentioned the term COGNAC and certified COGNAC products. Appx736-Appx743; Appx749-Appx754; *supra* at 17-18 & n.7.
- From 2001-2006, mentions of COGNAC and certified COGNAC spirits in hip-hop music led to about a 30% increase in Cognac sales across the industry. Appx745-Appx748, Appx755-Appx759; Appx794.
- COGNAC producers have partnered with famous hip-hop musicians and record labels to market certified COGNAC products in the United States, including in advertisements, marketing campaigns, pop-up series, and as brand ambassadors. Appx114-Appx115; *e.g.*, Appx582-Appx584.
- Certified COGNAC producers have also collaborated and partnered with famous hip-hop musicians to create new brands of certified COGNAC products. Appx115, Appx597-Appx599, Appx929-Appx978.

Applicant did not dispute these or any other such facts, and, indeed, expressly acknowledged that “the association between cognac and the music industry is commonplace and has resulted in increased cognac sales.” Appx1063. Applicant also admitted that the reasonable consuming public is aware of “the prolific use of the term ‘cognac’ and brands of cognac in song lyrics, song titles, etc. Appx1063 (asserting this does not create an impression of sponsorship by the Opposers). This abundant evidence shows that certified COGNAC products and their producers are closely related to music recordings and music productions (Applicant’s goods and services) and in precisely such a way that their marketing would mislead consumers into mistakenly believing that there is an association, such as a relationship of endorsement or licensing, between the Applicant and certified COGNAC products and their producers.

In the face of this evidence, the majority legally erred by incorrectly framing the question as whether “consumers will mistakenly believe that *Opposers* are affiliated with any of [Applicant’s] goods or services,” and pointing to the fact that Opposers do not “provide[] musical sound recordings or any services related to the music industry” as evidence of no relationship between the goods. Appx29 (emphasis in original). The majority thus lost sight of the nature of, and statutory rules for, certification marks: they are not (and indeed *may not be*) used by the owner on certified goods, but only by third-party producers of such goods. For that very

reason, the Board consistently has held that the likelihood-of-confusion analysis is to be performed in reference to the goods to which the mark has been applied, not certification services themselves. *See, e.g., In re Accelerate s.a.l.*, 101 U.S.P.Q.2d at 2049; *Motion Picture Ass'n of Am., Inc.*, 83 U.S.P.Q.2d at 1559-60; *Tea Bd. of India*, 80 U.S.P.Q.2d at 1897).

As the dissent correctly observed, the appropriate question is not whether “*Opposers* are affiliated with any of [Applicant’s] goods or services” (Appx29), but whether consumers will perceive *the producers of certified COGNAC goods* as so affiliated. Appx42 (“the focus is necessarily on the use of the certified mark COGNAC by Opposers’ authorized users, and on musical recording products and services, as identified in the involved application.”). And the answer to that question is resoundingly clear from the record: virtually every major COGNAC house and many others have an affiliation of licensing or endorsement involving artists in the Applicant’s very musical genre. *See supra* at 18-20. The consumers of both musical products and services and certified COGNAC spirits thus are acutely aware of the close nexus between these two industries, and the likelihood is high that an appreciable percentage of them would mistakenly believe that the Applicant’s goods

and services are similarly affiliated with certified COGNAC spirits and its producers.<sup>11</sup>

Properly comparing Applicant's goods and services and customers with certified COGNAC products, as settled law requires, the evidence of their relatedness is overwhelming. The majority's legal error in drawing the wrong comparison warrants setting aside its contrary finding.

#### **D. Balancing the *DuPont* Factors**

When the correct legal standards are applied, and the evidence of record is properly assessed in light of those standards, it is plain that the majority's conclusion on each of the "key" *DuPont* factors was wrong, and each of those factors weighs strongly in favor of likelihood of confusion. Indeed, given the importance of each of these factors in the likelihood-of-confusion analysis, error as to any one of them would warrant vacating the majority's dismissal of Opposers' Section 2(d) claim, bearing in mind this Court's appropriate caution that, if there is any doubt as to the likelihood of confusion, "this court should resolve those doubts against the newcomer." *Kenner Parker Toys Inc.*, 963 F.2d at 355 (citations omitted).

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<sup>11</sup> The majority again wrongly discounted the evidence of certified COGNAC products offered by hip-hop musicians on the basis that the certification mark appears alongside of the musician's name or the product's brand. Appx28. That was legal error, for the reasons discussed *supra* at 40-42 and incorporated here by reference.

Because likelihood of confusion is a question of law, this Court can, and should, further hold that Opposers established the likelihood of confusion, including that Applicant's COLOGNE & COGNAC ENTERTAINMENT and design mark is likely to mislead consumers as to the affiliation between Applicant and producers of certified COGNAC product. *See, e.g., Bose Corp.*, 293 F.3d at 1378 (“We consequently reverse the Board's decision, holding that a likelihood of confusion exists, sustaining Bose's opposition, and denying QSC's registration of its POWERWAVE mark.”). Alternatively, this Court should remand for the TTAB to re-evaluate the likelihood-of-confusion factors under the correct legal standards for certification marks, including that (i) consumers need not be aware of a mark's certification status; (ii) the unavoidable “co-branding” of a certification mark with product trademarks should prejudice neither the determination of the fame of the certification mark, nor the comparison of the goods and services at issue; and (iii) the likelihood-of-confusion analysis must focus on the certified products and their producers, rather than the service of certifying or the certification mark owner. *See, e.g., Recot, Inc.*, 214 F.3d at 1327 (“Because the Board improperly discounted the fame of the FRITO–LAY marks, did not consider all of the relevant evidence when determining if the products were related, and improperly dissected the marks, we vacate and remand the case to the Board for further proceedings consistent with this decision.”).

## **II. THE MAJORITY ERRED IN RULING AGAINST OPPOSERS' DILUTION CLAIM**

### **A. The Board Erred in Dismissing the Dilution Claim for a Nonexistent Pleading Deficiency**

Although Applicant's Answer included the "affirmative defense" that "Opposer [sic] has failed to allege grounds sufficient to sustain the Opposition, or upon which relief can be granted," Appx90, Applicant never raised that "defense" again. As the majority acknowledged, "The assertion that Opposers failed to state a claim is considered waived because Applicant did not file a formal motion to dismiss or raise the issue at trial." Appx3-Appx 4, n.4 (citing Fed. R. Civ. P. 12(h)(2)).

Despite that clear waiver, the Board, after trial, *sua sponte* granted the unasked-for relief of dismissal of Opposers' dilution claim for an alleged pleading defect—specifically, the omission of an explicit averment that the fame of COGNAC predated Applicant's constructive use date. *Id.* A pleading's alleged insufficiency (at whatever stage it is determined by the trial court) is an issue of law, reviewed *de novo*, and both the trial court and the reviewing court are obliged to "accept all factual allegations in the complaint as true and construe the pleadings in the light most favorable" to the plaintiff. *Bot M8 LLC*, 4 F.4<sup>th</sup> at 1353; *see Jewelers Vigilance Comm., Inc.*, 823 F.2d at 492 (deeming motion for summary judgment to be "in the nature of a motion to dismiss," because it was granted only upon the pleadings).

This Court has stressed that “the Federal Rules of Civil Procedure do not require a plaintiff to plead facts establishing that each element of an asserted claim is met.” *Nalco Co.*, 883 F.3d at 1350; *accord Bot M8 LLC*, 4 F.4th at 1352 (“A plaintiff is not required to plead infringement on an element-by-element basis.”). Instead, a notice of opposition only must plead facts to show standing and a valid ground for denying the registration. *Young*, 152 F.3d at 1379; TBMP 309.03(a)(2); 37 C.F.R. § 2.104. “Specific facts are not necessary.” *Erickson v. Pardus*, 551 U.S. 89, 93 (2007) (per curiam). The pleading need only allege sufficient facts, that if accepted as true, “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

In *Coach Services, Inc. v. Triumph Learning LLC*, this Court set forth the elements of *proof* of dilution: the plaintiff must show “(1) it owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark; (3) the defendant's use of its mark began after the plaintiff's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.” *Id.*, 668 F.3d at 1372. But the majority below cited *Coach Services* for a different proposition entirely: that these elements must specifically be *alleged* in the pleading (and, apparently, *in haec*

*verba*). *Coach Services* said no such thing,<sup>12</sup> and indeed, such an interpretation conflicts with this Court’s disapproval of element-by-element pleading requirements. *See Bot M8*, 4 F.4th at 1352; *Nalco Co.*, 883 F.3d at 1350. Puzzlingly, the majority also cited *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1537 (T.T.A.B. 2007) in support of its conjured pleading requirement, Appx33, even though the Board there *rejected* an attempt to transmute an element of proof into a pleading requirement, which it termed a “misunderstanding of the rules regarding notice pleading.” *Fair Indigo LLC*, 85 U.S.P.Q.2d at 1534.

But even if this Court required a dilution pleading to allege that the fame of opposer’s mark preceded the priority date of the challenged mark, Opposers’ Notice of Opposition would satisfy such a requirement. Specifically, in paragraph 7 of the pleading, Opposers averred as follows:

COGNAC is a famous designation for brandy and enjoys a world-wide reputation as a superior and prestigious quality brand. COGNAC is symbolic of the extensive goodwill and consumer recognition built up through the substantial efforts and investments of the INAO and the BNIC in the AOC system and the COGNAC AOC and certification mark, and through the promotion and sales of these quality products over *many years*.

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<sup>12</sup> *Coach Services* did not even involve a question of the sufficiency of the pleadings. The majority took similar liberties with at least one other case cited for this proposition, Appx32-Appx33 (citing *Toro Co. v. Torohead, Inc.*, 61 U.S.P.Q.2d (BNA) 1164, 1168-69 (T.T.A.B. 2001)), which also addressed the elements of proof, and not pleading requirements.



Appx71-Appx72 (emphasis added). That averment was made on August 28, 2019, only *five months* after the constructive use date (the application filing date) of March 7, 2019.<sup>13</sup>

Fame alleged to have lasted “many years” necessarily began more than five months earlier. Again, a pleading need not allege “specific facts,” and the majority was wrong to dismiss the dilution claim on precisely such a picayune basis. *Erickson*, 551 U.S. at 93 (per curiam). Rather, viewing the complaint “in the light most favorable” to the complaining party pursuant to Rule 12(b)(6), *Bot M8 LLC*, 4 F.4<sup>th</sup> at 1353, the reference to “many years” satisfied any reasonable pleading requirement. *See, e.g., Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 U.S.P.Q.2d (BNA) 1645, 1656 (T.T.A.B. 2010) (deeming dilution properly pled when opposer only alleged fame prior to the application filing date—and not the first use date, found to be decades earlier), *aff’d*, 637 F.3d 1344 (Fed. Cir. 2011). Based on this pleading, Opposers should have been given the opportunity to prove their case. *Young*, 152 F.3d at 1379 (noting “dismissal is appropriate only if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations.”) (citations and internal quotations omitted).

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<sup>13</sup> The majority found that Applicant could rely on filing date of March 7, 2019 as the constructive use date, because Applicant did not argue or prove an earlier date of first use. Appx9.

While the Board also ruled that the issue of whether COGNAC's fame predated Applicant's constructive use was not tried by implied consent, that ruling depends on the erroneous ruling that the notice of opposition was deficient. *See* Fed. R. Civ. P. 15(b). The Board did not, and could not, find that the issue of the duration of COGNAC's fame relative to that date was waived for trial. To the contrary, as the Board noted, "Opposers submitted evidence in support of the allegation that their COGNAC certification mark is famous," Appx34, and consistent with Opposers' pleading, almost all of which evidence concerned COGNAC's years of fame prior to Applicant's constructive use date.<sup>14</sup> *See, e.g.,* Appx113-Appx114; Appx214-Appx487 (articles on COGNAC from 2008-2020, majority of which predate Applicant's constructive use date); Appx587-Appx588; Appx624-Appx649 (pre-2018 books available in U.S. featuring COGNAC). Indeed, the Board then proceeded to review that evidence to consider, in the alternative, Opposers' dilution claim on the merits (but, as discussed next, once again employed an erroneous legal standard of fame).

### **B. The Majority Committed Legal Error in Evaluating Fame**

Finally, the majority erred in finding that "Opposers did not demonstrate by a preponderance of the evidence that its COGNAC certification mark is famous."

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<sup>14</sup> The *only* problem, in the majority's view, was that Applicant was not "fairly apprised that Opposers were attempting to prove acquisition of fame of their mark prior to any certain date." Appx35.

Here, the two-judge majority relied entirely on its finding regarding fame for likelihood-of-confusion purposes. Appx35. For all the reasons discussed above, that finding was wrong as a matter of law in the context of likelihood of confusion, and it is wrong in the dilution context as well.<sup>15</sup> *Supra* Part I.A. As the dissent concluded, “it [is] highly likely that Opposers would succeed in their dilution by blurring claim, given the fame of the mark and the degree of association with it that Applicant’s mark engenders.” Appx37, n.55. This Court should remand Opposers’ dilution claim for reconsideration in accordance with the correct legal standards and after a proper assessment of the facts in light of those standards.

### CONCLUSION

For the foregoing reasons, Opposers respectfully request that this Court vacate the Board’s decision, and either sustain the Opposition due to likelihood of confusion or dilution, or remand for the Board’s analysis under the correct legal standards.

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<sup>15</sup> Although the standard of fame for dilution purposes differs in some respects from that used in likelihood-of-confusion analyses, *Coach Servs., Inc.*, 668 F.3d at 1373, the majority did not address any of those particulars, instead holding, again, that a CMRO must be proved famous for its “certifying function.” There is no support for that interpretation of the Lanham Act in either the text of the dilution provisions or the caselaw, and it is just as wrong in the dilution context as in the confusion context.

Respectfully submitted,

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Dated: May 12, 2023

ADDENDUM

Filing Date	Paper No.	Description	Appx No.
8/25/2022	23	Final Decision	Appx1

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: August 25, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*Bureau National Interprofessionnel du Cognac and  
Institut National Des Appellations d'Origine*

*v.*

*Cologne & Cognac Entertainment*

—  
Opposition No. 91250532  
—

J. Scott Gerien and Joy L. Durand of Dickenson Peatman & Fogarty,  
for Institut National Des Appellations d'Origine and Bureau National  
Interprofessionnel du Cognac.

Richard Gearhart and James Klobucar of Gearhart Law, LLC,  
for Cologne & Cognac Entertainment.

—  
Before Wellington, Wolfson, and Lykos, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant, Cologne & Cognac Entertainment, seeks registration on the Principal  
Register of the composite mark depicted below (“Entertainment” disclaimed):

Opposition No. 91250532



for

“Audio and video recordings featuring music and artistic performances; compact discs featuring music; digital materials, namely, CDs and downloadable digital audio recordings featuring music; digital music downloadable from the internet; downloadable video recordings featuring music; musical sound recordings; musical video recordings” in International Class 9; and

“Music composition services; production of musical videos; entertainment in the nature of live performances by musical artists; entertainment information services, namely, providing information and news releases about a musical artist; entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings; entertainment services, namely, non-downloadable pre-recorded music and graphics presented to mobile communications devices via a global computer network and wireless networks; entertainment services, namely, providing non-downloadable prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; film and video film production; providing a website featuring non-downloadable videos in the field of music; record master production” in International Class 41.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88329690 was filed on March 7, 2019, based upon Applicant’s allegations of use under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). For the International Class 9 goods, Applicant alleges first use and first use in commerce of at least as early as January 21, 2019; and for the International Class 41 services, Applicant alleges first use of its mark in association with those services at least as early as November 7, 2018, and first use in commerce at least as early as January 21, 2019. The description of the mark reads: “The mark consists of a cologne bottle to the left of a bottle with music notes on it. Both previously mentioned bottles are within a sun-style burst with rays extending outward. The wording ‘Cologne & Cognac’ is written below the previously mentioned bottles in a stacked

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Bureau National Interprofessionnel du Cognac (“BNIC”) and Institut National Des Appellations d’Origine (“INAO”) (jointly “Opposers”),<sup>2</sup> oppose the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), claiming priority and likelihood of confusion with their common-law regional certification mark COGNAC for brandy that comes from the Cognac region of France and is produced in accordance with prescribed standards. Opposers also allege that COGNAC is famous, and that Applicant’s mark, by creating an association with Opposers’ mark, is likely to cause dilution through blurring under Section 43(c) of the Trademark Act (“the Act”), 15 U.S.C. § 1125(c).<sup>3</sup>

Applicant, in its Answer, denied the salient allegations of the Notice of Opposition and asserted various affirmative and putative defenses, including that Opposers failed to state a claim upon which relief can be granted.<sup>4</sup>

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format. The wording ‘Entertainment’ is written below the previously mentioned wording ‘& Cognac.’ Color is not claimed as a feature of the mark.

<sup>2</sup> After the opposition was filed, Opposer INAO changed its name to “Institut National Des Appellations d’Origine et de la Qualité,” but is still abbreviated as INAO.

<sup>3</sup> In their Notice of Opposition, Opposers claim that Applicant’s mark “falsely suggests a connection with BNIC” under Trademark Act Section 2(a), 15 U.S.C. §1052(a). As Opposers did not pursue the claim in their brief, it is considered waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived; respondent’s affirmative defense of failure to state a claim not argued in brief deemed waived), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (claim not argued in brief is considered waived). On the ESTTA Notice of Opposition cover sheet, Opposers list “deceptiveness” and “dilution by tarnishment” as additional grounds for sustaining the opposition. These claims were neither pleaded in the body of the Notice of Opposition nor argued in Opposers’ brief and are thus not given consideration.

<sup>4</sup> 8 TTABVUE 4. The assertion that Opposers failed to state a claim is considered waived because Applicant did not file a formal motion to dismiss or raise the issue at trial. Fed. R. Civ. P. 12(h)(2); *see, e.g., Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) (“As applicant did not pursue the affirmative defenses of failure to state a claim and unclean hands, either in its brief or by motion, those defenses are waived.”).



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## I. The Record

The record comprises the pleadings, the file of Applicant's opposed Application under Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), and the following:<sup>5</sup>

### Opposers' Evidence

- Declaration of Amandine Duthilleul, an attorney employed by BNIC, with accompanying Exhibits A1-E7.<sup>6</sup>
- First Declaration of Joy L. Durand, an associate with the law firm of Dickenson, Peatman & Fogarty, Opposers' counsel, with accompanying Exhibits E8-KKK.<sup>7</sup>
- Second Durand Declaration, with accompanying Exhibits LLL-RRR.<sup>8</sup>

### Applicant's Evidence

- Declaration of Travis Davis, Applicant's founder and musical recording artist and songwriter, with accompanying Exhibits A-H. 18 TTABVUE.

## II. Geographic Certification Marks

Because this proceeding involves a geographic certification mark, also known as a certification mark indicating regional origin, it is useful to provide a short discussion of such marks.

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Applicant's further allegations in its Answer "are not true affirmative defenses, but rather mere amplifications of Applicant's denials of Opposer's claims." *Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, \*2 (TTAB 2020).

<sup>5</sup> Citations to the proceeding record refer to TTABVUE, the Board's online docketing system. See *Turbin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding "TTABVUE" corresponds to the docket entry number, and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

<sup>6</sup> 12-13 TTABVUE.

<sup>7</sup> 14-16 TTABVUE.

<sup>8</sup> 17 TTABVUE.

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Section 45 of the Trademark Act defines a certification mark to include “any word, name, symbol, or device, or any combination thereof ... used by a person other than its owner ... to certify regional ... origin ... of such person’s goods or services... .” 15 U.S.C. § 1127. *See In re St. Julian Wine Co., Inc.*, 2020 USPQ2d 10595, \*2 (TTAB 2020) (involving registered marks MICHIGAN APPLES (stylized with design, “apples” disclaimed) and MICHIGAN HONEYCRISP (stylized with design, “honeycrisp” disclaimed) to certify apples grown in Michigan); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477 (TTAB 2017) (involving application to register TEQUILA to certify spirits distilled from blue tequilana weber variety of agave plant of Mexican origin); *Swiss Watch Int’l, Inc. v. Fed. of the Swiss Watch Ind.*, 101 USPQ2d 1731 (TTAB 2012) (involving registered marks SWISS and SWISS MADE to certify watches, clocks and their components made in Switzerland). *See also Cmty. of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 133 USPQ 633 (2d Cir. 1962) (involving registered mark ROQUEFORT to certify cheese from a municipality in France).

Section 4 of the Trademark Act provides for the registration of “certification marks, including indications of regional origin.” 15 U.S.C. § 1054. However, as in the case here, an opposer may rely upon prior common law rights in an unregistered certification mark. *Bureau Nat’l Interprofessionnel Du Cognac v. Int’l Better Drinks Corp.*, 6 USPQ2d 1610, 1614 (TTAB 1988) (involving unregistered mark COGNAC for distilled brandy from a region in France) (citing *Stabilisierungsfonds fur Wein v. Zimmermann-Graeff KG*, 199 USPQ 488, 489 (TTAB 1978) (“A federal registration is merely the recognition of a common law right in a mark that existed prior to

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registration. Section 45 of the Act includes the term ‘certification mark’ in its definition of ‘mark.’”). *See also State of Fla., Dep’t of Citrus v. Real Juices, Inc.*, 330 F. Supp. 428, 171 USPQ 66 (M.D. Fla. 1971) (court found the scope of Section 43(a) of the Trademark Act “sufficiently broad to encompass protection of unregistered common law certification marks,” in case involving plaintiff’s pleaded mark SUNSHINE TREE for citrus from Florida).

A certification mark, as distinguished from a trademark, does not indicate commercial source or distinguish the goods or services of one person from those of another person, but “indicates that the goods or services of authorized users are certified as to a particular aspect of the goods or services.” *St. Julian Wine Co.*, 2020 USPQ2d 10595 at \*2. As explained in the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP), “[t]he message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, using methods determined by the certifier/owner ... [and] that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.” TMEP § 1306.01(b) (July 2021).

### **III. COGNAC as a Certification Mark Indicating Regional Origin**

Opposers submitted the testimony declaration of Amandine Duthilleul, an attorney employed by BNIC, who testified that:<sup>9</sup>

2. [INAO] is an administrative agency within the French Ministry of Agriculture, Food and Forestry. For over eighty years, INAO has been responsible for establishing,

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<sup>9</sup> 12 TTABVUE 2-5.

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maintaining and protecting, both in France and internationally, France's "appellations of origin" system.

3. COGNAC is a well-known AOC ["appellation of controlled origin"] that has been recognized and protected by INAO and the French government for decades.

5. The COGNAC AOC is used to represent to consumers that a product bearing the COGNAC AOC comes from a defined region of France and was produced in accordance with the local and customary production method now codified in the various Decrees of the Republic of France relating to the production of products bearing the COGNAC AOC.

9. The AOC system is characterized by cooperation between the INAO, producers and merchants, and their interprofessional associations or unions which are known as "interprofessions."

10. BNIC is the interprofessional union of all growers and producers and négociants or merchants who grow, produce or deal in COGNAC *eaux-de-vie* (which is French for "wine spirit") as defined by Article L631-1 et seq. of the French Rural Code. All parties who are engaged in the production, processing and trade of COGNAC are required by law to be a member of BNIC.

15. BNIC also fulfills a number of public functions, such as monitoring stocks of COGNAC, verifying the age of COGNAC and issuing certificates of age and origin. Certificates of origin certify that the COGNAC product has met the exacting standards governing the COGNAC AOC and must accompany every shipment of COGNAC outside of the European Union. In this way, BNIC controls the COGNAC certification mark in the U.S. for wine spirits.

Applicant concedes that "Opposers control a common law certification mark for 'cognac' to be used in conjunction with distilled spirit products that meet prescribed standards of quality and content, and that are produced in the Cognac region of France at locations, and under conditions, specified and regulated by French law."<sup>10</sup>

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<sup>10</sup> 20 TTABVUE 7.

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Based on the foregoing record evidence and Applicant's concession, there is no dispute that Opposers have exclusive rights in COGNAC as a regional certification mark used by growers, producers, and merchants and has controlled its use by authorized users to represent to consumers that a distilled spirit bearing the COGNAC mark comes from a defined region of France, and was produced in accordance with local and customary production standards now codified in the various Decrees of the Republic of France, treaty provisions between the United States and the European Union, and implementing regulations of the United States, relating to the production of goods bearing the COGNAC mark.<sup>11</sup>

#### **IV. Entitlement to a Statutory Cause of Action**

Opposers must prove their entitlement to a statutory cause of action.<sup>12</sup> *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014) (2014)); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, \*3 (Fed. Cir. 2020) (also citing *Lexmark Int'l, Inc.*).

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<sup>11</sup> We further note that Opposers have been determined to have rights in the COGNAC regional certification in previous, unrelated proceedings. *See Institut Nat'l des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1891 (TTAB 1998) ("undisputed facts of record establish as a matter of law that COGNAC is a common law regional certification mark"); *Bureau Nat'l Interprofessionnel Du Cognac*, 6 USPQ2d at 1614 ("it is clear that the designation 'COGNAC' serves as a certification of regional origin, as well as of the quality of the brandy products entitled to bear the designation under French law and regulations. . .").

<sup>12</sup> Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Major League Soccer, LLC v. F.C. Int'l Milano S.p.A.*, 2020 USPQ2d 11488, at \*5 n. 18 (TTAB 2020).

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Based on Opposers' conceded and established rights in the "Cognac" regional certification mark in the United States, we find that their opposition to registration of Applicant's mark, which contains the term COGNAC, is within the zone of their interests protected by the Act and that they have a reasonable belief of damage that is proximately caused by registration of Applicant's mark. *Corcamore v. SFM*, 2020 USPQ2d 11277, at \*7-8 (TTAB 2020). *See also Australian Therapeutic*, 2020 USPQ2d 10837 at \*3. Accordingly, Opposers have established their entitlement to a statutory cause of action.

## V. Priority

For purposes of priority, Applicant may rely on its application filing date of March 7, 2019 as its constructive date of first use. *In re Inspection Tech.*, 223 USPQ 46, 48 (TTAB 1984) ("Where a first use date has not been supported by proof, an applicant may rely only on the filing date of its application as a first use date."). *See also WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1041 (TTAB 2018). Applicant does not argue in its brief, nor has it proven, an earlier date of first use.<sup>13</sup>

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<sup>13</sup> We note that Applicant's application contains allegations with earlier dates of use of its mark on or in connection with its goods and services (See Note 1). However, without more, such allegations are not evidence on Applicant's behalf, nor are the specimens of use filed in support of the application admissible to prove use. Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2) ("The allegation in an application for registration ... of a date of use is not evidence on behalf of the applicant [and] must be established by competent evidence."); *see also*, authorities discussed in TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 704.04 (2022). We further note that Applicant's witness and principal, Travis Davis, testified that he "set out to create my own record label which I named 'Cologne & Cognac Entertainment,'" and attached as an exhibit a document entitled "Certificate of Formation" dated December 19, 2016. 18 TTABVUE 3 and 12 (Exhibit B). However, the document does not show the mark with design, as shown in the application at issue. In any event, even if we were to consider

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Accordingly, and because Opposers are relying solely on common law rights in their certification mark, they must prove that their proprietary interest in that mark existed in the United States prior to March 7, 2019. *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022-1023 (TTAB 2009) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)). “[B]ecause unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is Opposer[’s] burden to demonstrate that it owns a trademark that was used prior to Applicant’s first use or constructive use [filing of an application] of its mark and not abandoned.” *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017).

Although it is not possible on the record before us to pinpoint a particular date of first use of Opposers’ regional certification mark, COGNAC, this is not necessary because the evidence establishes that Opposers have been certifying COGNAC brandy for sale in the U.S. before March 17, 2019, and therefore have prior common law rights in the mark. In making this determination, we heed the Federal Circuit’s admonition to properly consider evidence for priority purposes:

The TTAB concluded that each piece of evidence individually failed to establish prior use. However, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.

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the date for the certificate as Applicant’s date of first use, it would still be subsequent to Opposers’ first use date.

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*West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994), *cited in Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1105-1106 (TTAB 2007) (finding petitioner proved its priority by credible testimony “buttressed by the documentary evidence”).

Ms. Duthilleul testified that “[t]he COGNAC product was first exported to the US in 1794 and has been continuously sold in the US since such time.”<sup>14</sup> “In 2019, 102.4 million bottles of COGNAC were shipped to the US, making it the largest COGNAC market in the world with over 47.3% of the world market share.”<sup>15</sup> Ms. Duthilleul further testified that “certified COGNAC products” have been featured and advertised in “countless publications” in the U.S.<sup>16</sup> Several of these publications help corroborate that bottles of brandy, labeled Cognac, have been advertised or sold in the U.S. before 2019. For example, as Ms. Duthilleul explained in her testimony, a 2016 Forbes article “Rich Pours: 11 Best Cognacs to Drink Now,” discusses a Hennessy Cognac and a Martell Cognac, amongst others, with their “average price[s]” in \$US.<sup>17</sup> Hennessy and Martell, along with Courvoisier and Remy Martin, are

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<sup>14</sup> 12 TTABVUE 10 (Duthilleul Decl. ¶ 32). It should be noted, however, that Ms. Duthilleul does not state that the COGNAC “product” first exported to the US in 1794, and continuously since, was certified as a brandy from the Cognac region of France under prescribed production standards. Indeed, Ms. Duthilleul does not state when Opposers, or any predecessors in interest, first began using COGNAC as a certification mark. Nevertheless, as explained in this decision, we conclude that Opposers’ COGNAC certification mark has been in use at least since 2017.

<sup>15</sup> *Id.*

<sup>16</sup> *Id.* at 11-12 (Duthilleul Decl. ¶ 34); copies of “representative examples” are attached as Duthilleul Exhibit E.

<sup>17</sup> 12 TTABVUE 238-247.



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regarded as the “Big Four” houses (or producers) of Cognac.<sup>18</sup> In a 2010 article in the online Wine Spectator publication, Cognac is described as “account[ing] for over 30 percent of all brandy consumed by Americans, and continues to be led by the ‘Big Four’ brands of Hennessy, Remy Martin, Courvoisier and Martell, which combine for well over 90 percent share of the U.S. Cognac market.”<sup>19</sup>

Ms. Duthilleul’s testimony, coupled with the corroborating evidence, satisfies Opposers’ burden of proof in showing their priority by a preponderance of the evidence of their pleaded COGNAC mark for brandy from the Cognac region of France. Nothing in the record contradicts Ms. Duthilleul’s testimony declaration and Applicant chose not to take oral cross-examination of this witness pursuant to Trademark Rule 2.123(c). As such, we find the aforementioned averments credible. *Cf. Exec. Coach Builders*, 123 USPQ2d at 1184 (oral testimony of a single witness may suffice to establish priority of use). We have no doubt that Opposers have been certifying Cognac, including that of the ‘Big Four,’ that has been sold in the U.S. prior to 2017. Moreover, Applicant does not dispute any of Ms. Duthilleul’s testimony regarding the history of the Cognac certification mark or contest that Opposers have been certifying Cognac destined for the U.S. Accordingly, Opposers have established prior common law rights in the mark COGNAC in the United States.

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<sup>18</sup> See, e.g., 12 TTABVUE 255 (describing visitor centers for Cognac producers and “especially the Big Four (Hennessy, Courvoisier, Remy Martin, and Martell) ...”).

<sup>19</sup> 12 TTABVUE 139.

## VI. Likelihood of Confusion

The test for determining likelihood of confusion with respect to regional certification marks is the same as that applied to trademarks, i.e., the *DuPont* analysis.<sup>20</sup> *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012) (quoting *Motion Picture Ass'n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559-60 (TTAB 2007)). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

### A. Strength and Alleged Fame of the COGNAC Certification Mark

We begin our likelihood of confusion analysis with the fifth *DuPont* factor, “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567. The fame or strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis, *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043,

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<sup>20</sup> *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

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1056 (TTAB 2017), while a very weak mark receives a narrower scope of protection. A mark in the middle of the spectrum receives an intermediate scope of protection. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017) (finding that opposer's marks were entitled to "the normal scope of protection to which inherently distinctive marks are entitled").

Fame, if present, plays a dominant role in a likelihood of confusion analysis because of the broad scope of protection afforded famous or strong marks. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). However, fame for likelihood of confusion purposes arises only so long as a "significant portion of the relevant consuming public ... recognizes the mark as a source indicator," *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005), or, more precisely stated for the context of the mark at issue here, as an indicator that the brandy that comes from the Cognac region of France and is produced in accordance with prescribed standards.

Opposers' pleaded COGNAC mark enjoys success in the United States to the extent that 102.4 million bottles of the brandy were shipped in 2019, valued at approximately \$1,803,900,000.<sup>21</sup> Figures for prior years (from 2007 to 2019) show U.S. sales values ranging from \$474,900,000 to \$1,367,400,000 per year.<sup>22</sup> Between 2010 and 2018, Opposer BNIC "spent more than \$650,000 promoting COGNAC in the

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<sup>21</sup> 12 TTABVUE 11 (Duthilleul Decl. ¶ 32).

<sup>22</sup> *Id.*

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United States, resulting in more than 660,000,000 media impressions.”<sup>23</sup> Ms. Duthilleul also avers that “[i]ndependently, and through partnerships with public relations agencies, [Opposer] BNIC’s marketing efforts in the United States include media and trade relations, events, and robust social media campaigns. BNIC’s marketing efforts showcase the COGNAC AOC and educate on the region’s history, terroir, diversity of products and expertise of its growers and merchants.”<sup>24</sup> The record also includes a number of articles from U.S. publications describing a strong sales market for Cognac products.<sup>25</sup> Opposer argues that, “[a]s a result of all of the above, the COGNAC certification mark has become famous around the world and in the United States.”<sup>26</sup>

Applicant responds to Opposers’ claim that COGNAC is a famous certification mark by asserting that “a certification mark does not function as a source identifier” because it “does not distinguish the goods or services of one company from those of another producer, . . . [but] in the Opposers’ case, is **only used** to certify the geographic origin of the products (e.g. spirits).”<sup>27</sup> (Emphasis in original). In support, Applicant points to the statutory definition of what constitutes a famous mark, for dilution purposes, namely, “if [the mark] is widely recognized by the general

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<sup>23</sup> *Id.*; ¶ 33.

<sup>24</sup> *Id.*; ¶ 34.

<sup>25</sup> We do not rely upon this material for the truth of any statements contained therein, but consider them for their likely impact on the U.S. consumer, which appears to make consumers aware of Cognac as a growth market product from 2010 to the present. *WeaponX Performance Prods.*, 126 USPQ2d at 1038.

<sup>26</sup> 19 TTABVUE 31.

<sup>27</sup> 20 TTABVUE 24.

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consuming public of the United States as a designation of source of the goods or services of the mark's owner."<sup>28</sup> Applicant focuses on the definition's 'designation of source of the goods' language and asserts that "Opposer[s]' common law certification mark is, by its very nature, not a source identifier."<sup>29</sup> To further make its point, Applicant raises a hypothetical scenario involving a particular brand of Cognac – "If Opposer's argument were that Applicant is utilizing the mark COLOGNE & HENNESSEY [sic] (or another well-known trademarked brand of cognac) that would be a separate issue to which the Applicant would not condone."<sup>30</sup>

To the extent Applicant is arguing that there is an absolute bar to any certification mark acquiring fame because it does not indicate the source of goods or services, we reject this contention.

However, Applicant's argument can also be construed, in essence, as asserting that products bearing both certification marks and trademarks are more likely to be recognized and called for by consumers using their trademarks, and the certification mark is less significant. Thus, any popularity or commercial success of the products is more likely to result in the source-identifying mark becoming famous, and less so

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<sup>28</sup> Section 43(c) of the Act, 15 U.S.C. § 1125(c)(2)(A). Applicant frames its arguments that Opposers' mark is not famous in the context of the dilution ground. Proving fame for likelihood of confusion purposes is not the same as that for dilution, which requires a more stringent showing. *Palm Bay Imports*, 73 USPQ2d at 1694; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Nevertheless, the idea is the same – with all other factors and circumstances being the same, a famous or strong mark is entitled to more protection than a non-famous mark. As mentioned, fame or strength of a mark plays a very important role in a likelihood of confusion analysis because it gives the owner a broader scope of protection. *Bose*, 63 USPQ2d at 1305.

<sup>29</sup> 20 TTABVUE 24.

<sup>30</sup> *Id.*

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for the certification mark. However, we also consider the possibility that consumers familiar with COGNAC certification mark will ask for “a Cognac,” without specifying a brand, or they may ask what “Cognac” brands are available, thereby indicating an understanding of the function of the certification mark.

We agree with Applicant to the extent that it is arguing that a determination of whether a certification mark is famous may be different from an analysis involving marks identifying the source of goods or services, at least when, as here, that factual determination needs to be made on the basis of proffered evidence reflecting sales and advertising of *branded* items under the certification mark. That is, when we assess the strength or fame of a source-identifying mark for likelihood of confusion purposes, we generally will be considering the amount and type of consumer exposure to the mark based on various types of evidence, including the volume of sales and advertising expenditures of the goods sold under that source-identifying mark, as well as any unsolicited media attention attributing a reputation to the goods or services based on the source-identifying mark. *See, e.g., Bose Corp.*, 63 USPQ2d at 1308; *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005), *rev'd on other grounds, slip. op.* 052037, (D.D.C. Apr. 3, 2008). Unless there is evidence to the contrary, there is the assumption that the mark has made an impression on the consumer based on the volume of sales and advertising of the goods or services under that mark.

In evaluating the relevance of the number of sales of certified goods or services, as well as the extent of advertising and its effect on consumers, we must look to what impression is being made on the consuming public. We cannot assume that success

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based on such evidence is a reflection of renown or fame of the certification mark, versus that of the various source-identifying marks used to sell the goods or services. In other words, the fact that a brand, such as HENNESSY, may be a famous one based on a showing of sales, advertisements, unsolicited media attention, etc., does not necessarily translate to Opposers' certification mark also being famous. Or, put differently, it is difficult to determine what is driving the significant sales from the perspective of the consumers—are so many purchases being made because of the popularity of the brand names on the bottles, e.g., Hennessy, Remy Martin, Martell, etc., or are the sales the result of the popularity of the product because it is certified COGNAC. While this is not an “either ... or” proposition and, indeed, popularity based on sales volume and advertising may inure to benefit of both the certification mark and source-identifying marks, we must look closer at the evidence and how the marks are presented to the consumer on the goods and in the advertising. *Cf. Bose* 63 USPQ2d 1309 (a product mark may be assessed independently for possible fame where the evidence shows the product mark stands apart from the house mark).

Here, the record presented in this case reflects that users of Opposers' certification mark, such as Hennessy, often use the term “Cognac” or “cognac” (with a lowercase “c”) in advertisements or on the bottles in a manner either inconspicuously or in a manner that is not likely to heighten consumer awareness to the certification status of the term COGNAC—to wit:

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### Hennessy V.S

Hennessy Very Special (V.S) is one of the most popular cognacs in the world. Matured in new oak barrels, Hennessy V.S is bold and fragrant. Its beguiling

MORE

[The first sentence of the advertisement states: “Hennessy Very Special (V.S.) is one of the most popular cognacs in the world.”];<sup>31</sup>

And:

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<sup>31</sup> 15 TTABVUE 132 (Durand Ex. UU).



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<sup>32</sup> 13 TTABVUE 95 (Duthilleul Ex. E).

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Use of the term “cognac” or “Cognac,” or even COGNAC by certified users on bottles like that depicted above, is not likely to make a strong impression on consumers for purposes of showing strength or even raising awareness as to Opposers’ certification mark. We further note that the record is replete with use of the term “cognac,” spelled in all lower-case lettering, in articles, including from some well-known publications. To wit:

- USA Today, “Hennessy Cognac unveils new visitor experience”<sup>33</sup>

“Calling all cognac connoisseurs ... Shedding light on the savoir-faire of eight generations of cognac drinkers ... Perhaps we have Snoop Dogg to thank for rappers’ cognac obsession, but America’s lover for the spirit goes back to the 18<sup>th</sup> century ... Just like perfume, a fine cognac is the perfect blend of aged eaux-de-vie ... where a guide introduces both the spirit and the town that gave cognac its name ... .”

- Fortune Magazine, “Why Cognac Makers Want More U.S. Business”<sup>34</sup>

“France’s centuries-old cognac houses are raising their bets on the U.S. market with new products and campaigns to broaden the drink’s appeal beyond its African-American stronghold. ... On its home turf, cognac is seen as the drink of choice for mature gentlemen but in the U.S., it is often enjoyed by status-conscious revelers ... The companies are also trying to push cognac into cocktails. ...”

- WLNY CBS New York, “NYC’S Top 5 New Orleans-Inspired Cocktails”<sup>35</sup>

“Their ‘Pecan Maple Sazerac’ includes BOTH rye whiskey and cognac, absinthe, peach sugar, and Peychaud’s bitters.”

“Vieux Carre ... a mixture of rye whiskey, sweet vermouth, cognac, Benedictine, Peychaud’s and Angostura bitters. This will wake you right up—just in time for more Fat Tuesday celebrations.”

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<sup>33</sup> At <https://www.usatoday.com>, June 13, 2016; *Id.* 13 TTABVUE 14-17; Durand Decl., Exhibit E.

<sup>34</sup> At <https://www.fortune.com>, November 23, 2015; *Id.* at 19-22.

<sup>35</sup> At <https://www.newyork.cbslocal.com>, January 30, 2013; *Id.* at 11-12.

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- The Wall Street Journal, “Napoleon’s Nightcap Gets a Good Rap From Hip-Hop Set; Cognac Producers May Not Speak Jay-Z’s Language, But They Like the Plugs”<sup>36</sup>

“Rappers’ adoption of cognac, the storied French spirit, as their preferred party booze has been a godsend for [French farmers] ... These days, the cognac industry is thriving—thanks to America, not Asia. Exports of cognac to the U.S. have nearly tripled ... That has spawned a cult cognac following among young urban blacks ...”

Ultimately, as conceded by Applicant and as demonstrated on the record presented to us in this case, we find COGNAC is a distinctive certification mark. However, Opposers’ evidence does not provide sufficient support for an unequivocal conclusion that their COGNAC mark is a strong one in terms of renown for conveying the message that the goods are certified by Opposers as to regional origin and meeting the prescribed qualities. Rather, the evidence of record shows that Cognac (again, frequently spelled “cognac”) is a popular spirit in the United States, with impressive sales in terms of both the number of products sold and overall dollar value of those sales. The news and industry articles of record further reflect the renown of the brandy from France, and that it has been featured and is particularly popular within the hip hop music industry. As to Opposer BNIC’s promotional efforts during the years 2010-2018, its expenditures are significant but not all that impressive. Although Ms. Duthilleul testified that such efforts have resulted in “more than 660,000,000 media impressions,” this is a nebulous factual assertion and less probative without more detail as to these “media impressions.”<sup>37</sup> Despite Cognac’s

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<sup>36</sup> At <https://www.sonomapa.conoma.llb.ca.us.com>, July 14, 2003; 15 TTABVUE 38-42; Durand Decl., Exhibit DD.

<sup>37</sup> We are mindful while this number “media impressions” appears to be impressive, it also appears to be less significant than that relied on in the Board’s 1988 decision involving Opposer BNIC’s common law COGNAC certification mark. *Bureau Nat’l Interprofessionnel*

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success as a spirit, it is difficult to extrapolate from the evidence when it comes to measuring the level of consumer awareness for the goods' certification status. In other words, the success of a type of product sold under various trademarks does not necessarily mean that the placement of certification mark(s) on those products is equally successful.

In sum, we find that Opposers' COGNAC certification mark is distinctive and entitled to a normal scope of protection.

### **B. Similarity of the Marks**

Under the first *DuPont* factor, we determine the similarity or dissimilarity of the marks in their entirety, considering their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Palm Bay*, 73 USPQ2d at 1692. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB

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*Du Cognac*, 6 USPQ2d 1610. That is, the Board in the 1988 decision relied on evidence showing significantly more promotional efforts at that time – to wit, "promotional activities in the United States during the recent period covering 1982-1986 amounted to a total of more than \$1,300,000, with additional funds having been expended in years prior thereto. In 1985 alone, [opposer's] promotional activities resulted in nearly 300,000,000 impressions on behalf of 'COGNAC' brandy." *Id.* at 1612. In other words, the media impressions of COGNAC in that single year (1985) were nearly half of what they were over the more recent nine-year period of 2010-2018. In addition, over twice as much was spent to promote the certification mark between 1982-1986 than in the much longer and more recent period of 2010-2018. Also, in the Board's 1988 decision, evidence was submitted by the exclusive U.S. distributor for Hennessy showing that "[t]he goods are sold under the mark 'HENNESSY', and the labels for the goods also include prominent use of the 'COGNAC' designation." *Id.* As discussed *infra*, the record before us in this case does establish that COGNAC is used prominently as a certification mark designation. In any event, the Board did not expressly find in 1988 that COGNAC was a famous or even strong mark in terms of conveying the message to consumers that the goods are certified. Rather, the Board found the evidence showed that "[t]he Cognac region has become famous as the place where 'COGNAC' brandy is produced, and 'COGNAC' brandy itself enjoys a world-wide reputation as a superior and prestigious quality brandy." *Id.*

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2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff'd mem.*, (Fed. Cir. Sept. 13, 2019). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, \*18 (TTAB 2020) (citing *Coach Servs. Inc. v. Triumph, Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)).



In this case, although Applicant’s mark **COLOGNE & COGNAC ENTERTAINMENT** incorporates the term COGNAC, it engenders a different appearance, sound, commercial impression and connotation from Opposers’ certification mark. Opposers’ certification mark, COGNAC, as used by Opposers’ certified users, informs consumers that the brandy being sold by the certified users comes from the Cognac region of France. Applicant’s mark, on the other hand, when viewed in the context of musical goods and services conjures a different connotation and projects an image of sophistication and elegance.

In analyzing Applicant’s mark, we find the phrase COLOGNE & COGNAC is the dominant element. The stacked alliterative phrase, COLOGNE & COGNAC, appears prominently above the smaller and merely descriptive or generic term ENTERTAINMENT. The terms COLOGNE and COGNAC are not only joined with

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an ampersand, but also possess strong alliterative sound and spelling similarities. Consumers are likely to call for Applicant's goods and services by this catchy and melodious combination. It more clearly and readily identifies the source of Applicant's goods and services than the design. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“[T]he verbal portion of a word and design mark likely will be the dominant portion”); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001) (“words are normally accorded greater weight because they would be used by purchasers to request the goods”). *See also In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark's commercial impression.”). The design elements of a spray container and a bottle will likely be interpreted by consumers as stylized representations of cologne and Cognac containers, further reinforcing the phrase—COLOGNE & COGNAC. In terms of meaning the combination of terms “cologne” with “Cognac” creates an image of a person wearing cologne and drinking brandy, projecting a certain lifestyle, such as one of leisure and high-living. The connotation and commercial impression of Applicant's mark differs significantly from the meaning attributed to Opposers' certification mark.<sup>38</sup>

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<sup>38</sup> Several materials introduced by Opposers show how Cognac is perceived as having a reputation for being a drink for an older or affluent clientele, e.g., “For many, the word ‘cognac’ brings up an image of an older person drinking an amber-coloured liquid from an expensive piece of glassware, with classical music playing softly in the background.” 14 TTABVUE 144. Advertisements for the Hennessy brand of Cognac describe it as “The world's most civilized spirit.” *Id.* at 154. A copy of an article from Slate magazine, also introduced by Opposers, discusses a long tradition of Americans drinking “cognac” and references “deliveries of cognac to the U.S. during the 19<sup>th</sup> century, where its refined smoothness was a favorite drink of the upper class ...” *Id.* at 172.

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In sum, viewed in its entirety, Applicant's composite mark has a "distinct meaning of its own independent of the meaning of its constituent elements." *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Accordingly, we find this *DuPont* factor weighs in favor of finding no likelihood of confusion.

### **C. Relatedness of the Goods and Services; Trade Channels; Consumers**

We next address the second *DuPont* likelihood of confusion factor focusing on the comparison of the goods and services identified in Applicant's application vis-à-vis the goods certified under Opposer's common law COGNAC certification mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Because Opposers' mark is a regional certification mark, we bear in mind that it is not used by its owners, 15 U.S.C. § 1127, but is instead used by authorized users. Accordingly, our analysis is based on the authorized users' goods, which in this case consist of brandy that comes from the Cognac region of France and is produced in accordance with prescribed standards. *See St. Julian Wine Co.*, 2020 USPQ2d 10595 at \*3 (citing *E. I. DuPont de Nemours & Co. v. Yoshida*, 393 F. Supp. 502, 185 USPQ 597, 608 (E.D.N.Y. 1975) ("proximity [of products] may be measured against that of the certification mark user...").

Applicant's goods are "audio and video recordings featuring music and artistic performances; compact discs featuring music; digital materials, namely, CDs and downloadable digital audio recordings featuring music; digital music downloadable

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from the internet; downloadable video recordings featuring music; musical sound recordings; musical video recordings” in International Class 9; and its services are described as “Music composition services; production of musical videos; [various related entertainment services]; film and video film production; and providing a website featuring non-downloadable videos in the field of music; record master production.”

Opposers argue that “COGNAC certified product has an intimate and legendary history with music, particularly rap and hip hop music, in the United States,”<sup>39</sup> and that Cognac or the brand names of authorized users (Hennessy, Remy Martin, Courvoisier) are commonly the subject matter of song titles and song lyrics. In support, Opposers submitted copies of several news articles discussing the appearance of the term “Cognac” or brand names of Cognac in hip-hop or rap music lyrics.<sup>40</sup> Opposers have also shown that brand owners such as Hennessy have partnered with various musical artists, in particular hip-hop and rap artists, to market Cognac in the United States.<sup>41</sup>

Ms. Duthilleul testified that four musicians have produced “a certified COGNAC product” under a personal brand: CONJURE (by Ludacris with maker Birkedal Hartmann), AFTERMATH (by Dr. Dre with Domaines Francis Abecassis), D’USSÉ (by Jay-Z with Chateau de Cognac) and BRANSON (by 50 Cent with Raymond

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<sup>39</sup> 12 TTABVUE 13,

<sup>40</sup> We focus on those articles that predate Applicant’s constructive first use date of March 7, 2019 and repeat that we do not accept the articles for the truth of the matter stated therein, but only for what they show on their face, i.e., public exposure to the references as of the dates released.

<sup>41</sup> 12 TTABVUE 13 (Duthilleul Decl.)



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Ragnaud).<sup>42</sup> Opposers also submitted copies of seven third-party registrations (or pairs of third-party registrations) for these goods and services in order to show that companies have registered such under a single mark.<sup>43</sup> The probative value of Ms. Duthilleul's testimony, however, is limited because the examples of musicians involved in the production of Cognac only do so under a source-identifying mark distinct from both the musician's name or mark, e.g., CONJURE, AFTERMATH, D'USSÉ and BRANSON. In other words, as Applicant points out, "[w]hen a recording artist or record label launches a new brand of cognac, they are launching a distinct brand name which serves as its own trademark apart from any common law certification mark."<sup>44</sup>

Similarly, as to the third-party registrations (or pairs of registrations), these only show relatively few entities have sought to adopt the same mark for musical recordings or entertainment services, e.g., SINATRA, MOTORHEAD, AC/DC, etc., and alcoholic beverages. It is unclear how this type of evidence is relevant for purposes of showing that consumers may mistakenly believe Applicant would be involved with Opposers, who are responsible for certifying others to use the term COGNAC for brandy being sold under a different name.

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<sup>42</sup> *Id.* at 14.

<sup>43</sup> 14 TTABVUE 87-142. Two of the seven carry no weight because they issued under Section 44(e) or Section 66(a) of the Trademark Act with no claim of use in commerce.

<sup>44</sup> 19 TTABVUE 20.

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Based on the record evidence, we find it unlikely that, upon encountering



Applicant's mark on recorded music or in connection with music-related entertainment services, consumers will mistakenly believe that Opposers are affiliated with any of those goods or services. Use of the certification mark, COGNAC, on the one hand, and Applicant's use of COLOGNE & COGNAC ENTERTAINMENT and design on the other, will not cause consumers of Applicant's goods or services, or consumers of the goods of Opposers' certified users, to believe that Opposers have now ventured into the business of sponsoring or authorizing production of recordings or recording services or the other goods or services of Applicant. The record is devoid of any evidence that either Opposer provides musical sound recordings or any services related to the music industry.

Turning to trade channels and classes of consumers, Opposers have not shown that COGNAC brandy and recorded music and music entertainment services travel in the same trade channels. That rap and hip-hop musicians endorse various brands of Cognac, have established their own brands, and frequently use the term in song lyrics or titles does not, standing alone, demonstrate an overlap of trade channels. That some consumers of Cognac brandy may also be enthusiasts of rap or hip-hop music, which appears to be the type of music produced by Applicant, does not demonstrate an overlap of relevant purchasers.

For these reasons, the *DuPont* factors of the relatedness of the goods and services, trade channels, and classes of consumers favors a finding of no likelihood of confusion.

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#### **D. Consumer Sophistication**

Applicant argues that because COGNAC is expensive and buyers must be of adult age, purchasers are sophisticated and make purchases with deliberation.<sup>45</sup> The record evidence supports a finding that COGNAC brandy is comparatively expensive, but because individual consumers of no special sophistication may have occasion to purchase the parties' goods and services, this *DuPont* factor is neutral. *See Stone Lion*, 110 USPQ2d at 1163 (decision whether purchasers are sophisticated is based "on the least sophisticated potential purchasers" at issue).

#### **E. Actual Confusion**

Applicant argues that because actual confusion does not exist, "there is no likelihood of confusion between the marks."<sup>46</sup>

It is well-established that where, as here, there has been an insubstantial amount of time during which both Opposers' goods and Applicant's goods and services have been available, the absence of evidence of actual confusion does not mean that confusion is unlikely. *See In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009). The test under Section 2(d) is likelihood of confusion, not actual confusion. This *DuPont* factor is neutral.

#### **F. Bad faith**

Opposers contend that Applicant acted in bad faith because Mr. Davis instructed the designer of Applicant's record label to "incorporate a bottle of cologne and a bottle

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<sup>45</sup> 20 TTABVUE 22.

<sup>46</sup> 20 TTABVUE 23.

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of cognac” into the design of Applicant’s mark.<sup>47</sup> Mr. Davis refutes the suggestion of bad faith in his declaration and supports his statement that Applicant’s design “features a generic fragrance bottle and a generic liquor bottle” by way of an exhibit attached to the declaration, which shows that COGNAC bottles have no uniform shape.<sup>48</sup>

Establishing bad faith requires a showing, by a preponderance of the evidence, that a party intentionally sought to trade on the goodwill or reputation associated with another’s marks. *See Big Blue Prods. Inc. v. Int’l Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991). Here, the evidence suggests that Applicant selected the term COGNAC to include as part of its mark because of the popularity of that beverage within the hip-hop music industry. *See Bd. of Regents v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1196 (TTAB 2014) (no bad faith found where applicant selected mark because of the tradition of coal mining and as a tribute to that culture).

Opposers have not carried their burden to show that Applicant acted in bad faith. This *DuPont* factor is neutral.

### **G. Balancing the *DuPont* Factors**

Applicant’s mark is so dissimilar from Opposers’ certification mark in terms of sound, appearance, connotation and commercial impression, and the parties’ respective goods and services are not related nor do they travel in similar trade channels to the same consumers. The conditions of sale, actual confusion and bad faith *DuPont* factors are neutral. With these factors in mind, on balance, Opposers

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<sup>47</sup> 19 TTABVUE 38-39.

<sup>48</sup> 18 TTABVUE 3, 15-19 (Exhib. D).

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have not shown by a preponderance of the evidence that a likelihood of confusion exists.

#### **H. Conclusion on Section 2(d) Claim**

Although Opposers have shown by a preponderance of the evidence that they own prior common-law rights in the regional certification mark COGNAC, they have not demonstrated a likelihood of confusion, a critical element of their Section 2(d) claim. In view thereof, the Section 2(d) claim is dismissed.

### **VII. Dilution**

We now turn to Opposers' dilution by blurring claim.

The U.S. Court of Appeals for the Federal Circuit, has set forth the following four elements a plaintiff must prove in order to prevail on a claim of dilution by blurring in a Board proceeding:

- (1) that plaintiff owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark became famous; and
- (4) the defendant's use of its mark is likely to cause dilution by blurring.

*Coach Services Inc.*, 101 USPQ2d 1723-24. See Sections 13 and 43(c) of the Act, 15 U.S.C. §§ 1063 and 1125(c).

Under the third requirement, because Applicant's mark is use-based, Opposers must allege, and ultimately prove, that COGNAC became famous prior to either Applicant's actual date of use or constructive date of use of its mark. *Toro Co.*, 61

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USPQ2d 1174 n.9 (“In a use-based application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), the party alleging fame must show that the mark had become famous prior to the applicant’s use of the mark,” *cited in Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010)).

Here, Opposers did not plead, argue or prove that their mark became famous *prior to* any actual or constructive use by Applicant. In terms of pleading, Opposers do not assert when their COGNAC certification mark acquired fame or, simply and more importantly, that it did so prior to Applicant’s constructive use date. Opposers merely allege that “COGNAC is a famous designation for brandy and enjoys a world-wide reputation as a superior and prestigious quality brand” and then, in a conclusory manner, refer to their mark as the “famous COGNAC mark.”<sup>49</sup> By failing to allege that the COGNAC certification mark became famous prior to Applicant’s date of constructive use, Opposers failed to properly plead a claim of dilution by blurring. *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (dilution pleading legally insufficient where opposer failed to allege that its mark became famous before constructive use date of involved intent-to-use application). *See also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012); *Toro Co.*, 61 USPQ2d 1174. *See also Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should include enough detail to give the defendant fair notice).

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<sup>49</sup> 1 TTABVUE 5-6 (Not. of Opposition ¶ 7).

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We also do not find the issue of whether Opposers' COGNAC mark became famous prior to Applicant's constructive use date as tried by implied consent. Fed. R. Civ. P. 15(b)(2) provides, in relevant part, that "[w]hen an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings." Implied consent can only be found where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1656 (TTAB 2010) ("*Citigroup I*") (quoting TBMP § 501.03(b)), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) ("*Citigroup II*"). "The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter." *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009).

Here, although Opposers submitted evidence in support of the allegation that their COGNAC certification mark is famous, Opposers did not argue or make clear that the evidence was being submitted to show acquisition of fame prior to Applicant's constructive use date.<sup>50</sup> Opposers, in their brief, repeatedly refer to their certification mark as "famous" and, after discussing the record, argue that "[a]s a result of all of

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<sup>50</sup> Applicant did not object to Opposer's evidence, but argued in its trial brief that Opposers' mark is not famous and "[a]s is well understood in the eyes of the law, if the mark in question is not famous, then there is no dilution, and the Applicant asks the Board find for the Applicant on this point." 20 TTABVUE 25. Applicant, in its Answer, also denied Opposers' allegations of fame and specifically asserted, as an "affirmative defense," that Opposers' mark has "not obtained the level of fame, renown, and distinctiveness sufficient to obtain relief for dilution under the Lanham Act... ." 8 TTABVUE 3-4 (Answer ¶ 7 and "Second Affirmative Defense").

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the above, the COGNAC certification mark has become famous around the world and in the United States,”<sup>51</sup> without clarifying that this occurred before Applicant’s constructive use date. Opposer’s witness, Ms. Duthilleul, only averred that “[a]s a result of its history, the substantial efforts and investments of the French government and Opposers, and the promotion and sales of COGNAC certified products over many years, the COGNAC certification mark has become famous around the world and in the US.”<sup>52</sup> Thus, we do not find that Applicant was fairly apprised that Opposers were attempting to prove acquisition of fame of their mark prior to any certain date.

Because Opposers’ dilution claim was not sufficiently pleaded or tried by the parties, it is not before us.<sup>53</sup> We hasten to add, however, that even if we were to find that the issue was tried by implied consent, it has not been proven. As discussed in the context of our likelihood of confusion analysis, Opposers did not demonstrate by a preponderance of the evidence that its COGNAC certification mark is famous for likelihood of confusion, let alone for dilution purposes, which is a more difficult standard to meet.<sup>54</sup>

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<sup>51</sup> 19 TTABVUE 31.

<sup>52</sup> 12 TTABVUE 12 (Duthilleul Decl. ¶ 36).

<sup>53</sup> As discussed, *supra*, Applicant notes that the dilution statute defines a “famous mark” as one that is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” Because we do not address the merits of Opposers’ dilution claim for the reasons discussed in this decision, we also need not reach Applicant’s argument that, in essence, certification marks cannot be deemed “famous” for dilution purposes.

<sup>54</sup> Dilution requires a more stringent showing of fame than likelihood of confusion. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012). Thus, for the same reasons we have determined that Opposer has not proven that their mark is famous for purposes of likelihood of confusion, Opposers has not met their higher burden to prove fame in the dilution context, and its dilution claim would fail. *See id.* at 1727.



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**Decision:** The opposition against Applicant's mark is dismissed under Section 2(d) of the Act. The mark will proceed to registration in due course.

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**Opinion by Wolfson, Administrative Trademark Judge, concurring in part and dissenting in part:**

I concur in the majority's decision to dismiss Opposer's dilution by blurring claim.<sup>55</sup> I respectfully dissent, however, from the majority's dismissal of Opposer's claim under Section 2(d) of the Trademark Act. For the reasons discussed below, the majority incorrectly analyzes the first, second and third *DuPont* factors and fails to accord proper weight to the fifth and thirteenth factors. This leads the majority to find incorrectly that confusion of consumers is unlikely.

**I. The Marks**

Applicant's mark appropriates Opposers' COGNAC mark completely. "Marks have frequently been found to be similar where one mark incorporates the entirety of another mark, as is the case here." *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1115 (TTAB 2019). *See also Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188



USPQ 105, 106 (CCPA 1975) (BENGAL for gin and for nonalcoholic club

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<sup>55</sup> Although I agree that an allegation that Opposers' mark was famous prior to Applicant's constructive date of first use was not properly pleaded or tried by implied consent, I do not agree with the majority's statement that even were we to find the issue tried by consent, we would find that dilution has not been proven. To the contrary, I find it highly likely that Opposers would succeed in their dilution by blurring claim, given the fame of the mark and the degree of association with it that Applicant's mark engenders.

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soda, quinine water and ginger ale similar); *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, \*6-7 (TTAB 2019) (finding ROAD WARRIOR and WARRIOR similar); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (“likelihood of confusion is often found where the entirety of one mark is incorporated within another”); BARR and BARR GROUP similar).

The majority correctly finds that the phrase COLOGNE & COGNAC is the dominant portion of Applicant’s mark because it will be used to call for the goods and services and more clearly and readily identifies the source of Applicant’s goods and services than either the design or the merely descriptive or generic term ENTERTAINMENT. Therefore, the marks COGNAC and COLOGNE & COGNAC are similar in appearance due to the shared term COGNAC, and similar in sound because Applicant’s brand cannot be spoken without speaking Opposers’ mark.

As for the meaning of COGNAC in Applicant’s mark, Applicant acknowledges that its use of COGNAC in its mark refers to brandy, but argues that the term merely “identifies a variety of brandy,” much as a generic term would name a category. Applicant’s Responses to Opposers’ first set of interrogatories, 14 TTABVUE 77, Exhibit I (“Applicant states that the term ‘cognac’ in the Cologne & Cognac Entertainment mark identifies a variety of brandy.”). The majority, while finding that COGNAC is a “distinctive certification mark,” nonetheless also opines that consumers may perceive the term merely as a “popular spirit,” albeit with “impressive sales in terms of both the number of products sold and overall dollar value of those sales.” Despite evidence of impressive sales, the majority concludes that the evidence “does not provide sufficient support for an unequivocal conclusion that their

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COGNAC mark is a strong one in terms of renown for conveying the message that the goods are certified by Opposers as to regional origin and meeting the prescribed qualities.”

I respectfully disagree. The sporadic presentation of COGNAC as “cognac” in some news articles has not been shown to unduly diminish the mark’s conceptual strength or degree of distinctiveness. Rather, Opposers have shown that their use of COGNAC is “controlled and limited in such a manner that it reliably indicates to purchasers that the goods bearing the designation come exclusively from a particular region” and accordingly, that COGNAC “functions as a regional certification mark, just as a term which reliably indicates to purchasers that the goods come from a particular producer functions as a trademark.” *Institut Nat’l Appellations D’Origine*, 47 USPQ2d 1875, 1885 (TTAB 1998) (finding COGNAC to be a “common-law regional certification mark”).

Opposers’ common law certification mark identifies brandy that comes from the Cognac region of France, a place acknowledged by Applicant in its brief by name and as “an amazing place.” 20 TTABVUE 25. Although it is not used as a brand name, its use as a certification mark does serve to distinguish the goods of the certified users of COGNAC from those of other brandy makers, such as those whose brandies originate in Spain or Germany.

The meaning of Opposers’ mark has been incorporated into Applicant’s COLOGNE & COGNAC mark. For consumers of Applicant’s goods or services, the term COGNAC projects the identical meaning in Applicant’s mark as in Opposers’

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mark: that of a brandy that originates in the Cognac region of France and is produced in strict accordance with prescribed certification standards.

Applicant essentially contends – and the majority largely accepts the contention – that because Opposers’ mark is a certification mark, it is only used to certify the geographic origin of certified goods, and is therefore functionally different from Applicant’s mark. In other words, Applicant argues that the fact that its mark distinguishes its goods and services from those of competitors, while Opposers’ mark distinguishes goods of one geographic group of brandy makers from others, means that the two marks do not create the same commercial impression. I disagree, and find that COGNAC, as used by Opposers’ certified users and as used by Applicant in its mark, conveys precisely the same commercial impression, that of brandy from a particular geographic location. Applicant’s actual or prospective customers have become familiar with the mark because of the association of the brands of COGNAC associated with various musicians or whose virtues have been extolled in various musical compositions. As the Board has made clear:

In short, we reject applicant’s argument that ... opposers’ COGNAC mark is entitled to a more narrow scope of protection merely because it is a certification mark rather than a trademark. Rather, we hold, as a matter of law, that the traditional *du Pont* likelihood of confusion analysis is applicable in this case, and that, as in any other Section 2(d) case, the “likelihood of confusion” which may bar registration of applicant’s mark, if proven, includes likelihood of confusion as to source, sponsorship, affiliation, or connection.

*Institut Nat'l Des Appellations D'Origine*, 47 USPQ2d at 1891. *Cf. Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (holding that PACKARD TECHNOLOGIES and HEWLETT PACKARD differ in appearance

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and sound, but the marks convey a similar commercial impression because consumers would be aware of Hewlett-Packard's heavy involvement in technology-based goods, and therefore the marks are similar in their entirety).

Here, the common consumers of Applicant's and Opposers' goods and services will know of the frequent references to the certified products in musical compositions, and that these references also additionally refer to the certified users' brand names (such as Hennessy or Courvoisier). Thus, the references to COGNAC on the labels of the certified goods and to various brands of such certified goods in musical compositions both convey similar commercial impressions.

The majority acknowledges that the words in Applicant's mark are its dominant element, but concludes that the phrase COLOGNE & COGNAC has a meaning derived from the combination of these two terms that transcends the respective meanings of each of the terms separately. No support is provided for this conclusion.<sup>56</sup> Nor does the majority attribute this alleged separate meaning of the combination to any evidence or argument presented by Applicant. I believe that whatever "lifestyle" connotation the majority attributes to the combination of the terms COLOGNE and COGNAC, i.e. that of leisure and high living, is suggested by the term COGNAC alone. The term retains its significance when considering Applicant's mark as a whole; this connotation is no different than that suggested by the combination.

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<sup>56</sup> Although the majority notes that "[s]everal materials introduced by Opposers show how Cognac is perceived as having a reputation for being a drink for an older or affluent clientele," none of the referenced materials associate the term "cologne" with affluence, refinement, or the upper class. Indeed, to the extent Applicant's mark evokes a lifestyle of leisure or high living, the materials show that it is the term COGNAC alone that projects this image.

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The first *DuPont* factor accordingly favors Opposers, because the dominant portion of Applicant's mark incorporates the entirety of Opposers' mark, and results in the marks being similar in sight and sound. Further, the common term COGNAC has the same meaning and creates the same commercial impression in the respective marks, resulting in the marks being similar in connotation and overall commercial impression.

## **II. Relatedness of the Goods and Services; Trade Channels; Consumers**

As noted by the majority, the question of whether there is a likelihood of confusion between the marks is based on an analysis of the evidence of record regarding how the COGNAC mark is used by the authorized users and the presumptive ways in which Applicant's mark would be used, based on the identification of goods and services. Thus, the focus is necessarily on the use of the certified mark COGNAC by Opposers' authorized users, and on musical recording products and services, as identified in the involved application.

The majority concludes that the record is devoid of any evidence that Opposers provide musical sound recordings or any services related to the music industry, or of any evidence that consumers of the certified products or of Applicant's products and services will believe Opposers have ventured into the fields of Applicant.

I agree that it is unlikely that consumers will conclude that Opposers have ventured into new businesses because Opposers are likely to be largely or even completely unknown to the consumers of either the certified products or the products or services of Applicant. Nonetheless, the anonymity of Opposers does not preclude the likelihood of confusion among consumers in the overlapping classes of persons

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that consume COGNAC brandy and who purchase musical recording products or services. Consumers need not be expressly aware of the certification purpose of the designation. It is sufficient that they would perceive COGNAC as an indication of a particular regional origin. See *Institut Nat'l Des Appellations d'Origine*, 47 USPQ2d at 1884-85 (finding that COGNAC is a common law regional certification mark based on evidence of consumer perception, separate and apart from the fact that federal regulations established a standard of identity for Cognac brandy which specifies that the designation COGNAC applies only to grape brandy distilled in the Cognac region of France); TMEP § 1306.05(c) (“Consumers need not be expressly aware of the certification purpose of a designation.”).

Applicant argues that, “Cognac is not the trademark end-users are directly associating with the beverage, nor is it the identifier, unlike, for example, Jack Daniels® and Southern Comfort® which both identify whisky. Cognac is the quality control term only.” 20 TTABVUE 20. However, Applicant concedes that it would be precluded from using the hypothetical mark “COLOGNE & HENNESSEY” for COGNAC brandy. 20 TTABVUE 24. This is nothing more than an argument that there can be no likelihood of confusion among consumers when faced with a certification mark and a trademark or service mark that are very similar. This Board has held otherwise. As the Board explained in *Institut Nat'l des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1890 (TTAB 1998):

There is nothing in the language of Section 2(d) which mandates or warrants application of one level of likelihood of confusion analysis (i.e., the *duPont* analysis) in cases where the plaintiff's mark is a trademark or service mark, but a different and more limited likelihood of confusion analysis in cases where the plaintiff's mark is a certification mark.



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Section 2(d) does not distinguish between certification marks, on the one hand, and trademarks and service marks on the other.

Further, it has long been recognized that goods and services need not be identical or competitive for a likelihood of confusion to exist. It is sufficient that products and services are related in some manner or that the circumstances of marketing are such that the respective products and services are likely to be encountered by persons who would assume some relation or common source, even if such belief would be mistaken. *Id.* at 1891 (“[A]s in any other Section 2(d) case, the ‘likelihood of confusion’ which may bar registration of applicant’s mark, if proven, includes likelihood of confusion as to source, sponsorship, affiliation, or connection.”).

As an alcoholic beverage, COGNAC brandy travels in different channels of trade than musical recordings and entertainment services, but the class of consumers of each overlap. As shown by Opposers, “COGNAC certified product has an intimate and legendary history with music, particularly rap and hip hop music, in the United States,” Duthilleul Decl., 12 TTABVUE 13, and COGNAC or the brand names of authorized users (Hennessy, Remy Martin, Courvoisier) are commonly the subject matter of song titles and song lyrics. Ms. Duthilleul’s testimony is supported by copies of several news articles that predate Applicant’s constructive first use date of March 7, 2019, discussing the appearance of COGNAC or brand names in hip-hop or rap music:

- Christie, “Cognac – The (Unofficial) Spirit Of Black America,” COCKTAIL COLLECTIVE December 8, 2018<sup>57</sup>

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<sup>57</sup> At <https://cocktailcollective.co/2018/12/08/cognac-spirit-america/>, 14 TTABVUE 153-159, Durand Decl., Exhibit P.

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- “If you believe that lyrics matter, then Cognac’s endorsement of the black community has certainly paid off, as it is believed that the words ‘Hennessy’ or ‘Cognac’ are mentioned in over 1,000 songs by such famed artists as Notorious BIG, 2Pac, Kanye West, Rick Ross, Nas, Dr Dre, and 50 Cent.”
- “Hennessy Cognac, #1 in Music” November 8, 2017.<sup>58</sup>
  - “A 2013 study on alcohol references in music determined Grey Goose, Patron, Jack Daniel’s & Hennessy as the four most frequently mentioned in popular music. Hennessy claimed first place on the list....”
- Hopkins, “Study Identifies Top Four Spirits Mentioned in Music,” THE SPIRITS BUSINESS, August 30, 2013.<sup>59</sup>
  - “Hennessy is a high-end brand of Cognac whose popularity among the younger generation has increased over recent years with numerous references in hip-hop songs.”
- Curtis, “Cognac’s Identity Crisis,” THE ATLANTIC June 2012.<sup>60</sup>
  - “This year marks the 10th anniversary of a seminal moment in the history of cognac: the release of rapper Busta Rhymes’s ‘Pass the Courvoisier Part II.’”
- Beardsley, “French Cognac Makers Get a Boost from Rap Music,” NPR January 2, 2009.<sup>61</sup>
  - “A shift began in 2001, when rap artist Busta Rhymes came out with his hit song, ‘Pass the Courvoisier.’”
- Holloway, “MEDIA; Hip-Hop Sales Pop: Pass the Courvoisier and Count the Cash,” THE NEW YORK TIMES September 2, 2002.<sup>62</sup>
  - “Pass the Courvoisier. Everybody sing it now. Pass the Courvoisier. So goes a refrain of the popular song, ‘Pass the Courvoisier Part Two’

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<sup>58</sup> At <https://home.imurj.com>; 16 TTABVUE 54-61, Durand Decl., Exhibit HHH.

<sup>59</sup> At [thespiritsbusiness.com](http://thespiritsbusiness.com), 16 TTABVUE 72-3, Durand Decl., Exhibit JJJ.

<sup>60</sup> At <https://www.theatlantic.com>, 14 TTABVUE 190-91, Durand Decl., Exhibit V.

<sup>61</sup> At <https://www.npr.org>, 15 TTABVUE 10-11, Durand Decl., Exhibit X.

<sup>62</sup> At <https://www.nytimes.com>; 15 TTABVUE 27-30, Durand Decl., Exhibit BB.

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by Busta Rhymes, featuring Sean Combs, who is known these days as P. Diddy. It became a party anthem du jour.”

Applicant agrees that “the association between cognac and the music industry is commonplace and has resulted in increased cognac sales.” Davis Decl., 18 TTABVUE 6. Applicant contends, however, that Opposers should have no objection to Applicant’s use of COGNAC in its mark any more than to the use of COGNAC or specific brands of COGNAC, in song lyrics and titles. The critical distinction between these instances is that Applicant’s use of COGNAC, unlike song lyrics or titles, performs a trademark function as part of Applicant’s brand, and consumers are likely to presume a connection, sponsorship, or affiliation between Applicant’s goods and services and COGNAC brandy sold by Opposers’ authorized users. As the evidence shows, brand owners such as Hennessy have partnered with various musical artists, in particular hip-hop and rap artists, to market COGNAC in the United States. Duthilleul Decl., 12 TTABVUE 13. An example of this is the following Hennessy advertisement featuring American singer-songwriter Erykah Badu:<sup>63</sup>

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<sup>63</sup> Duthilleul Decl., Exhibit H, 13 TTABVUE 221.

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As the majority acknowledges, Ms. Duthilleul also testified that four musicians have produced “a certified COGNAC product” under a personal brand: CONJURE (Ludacris and maker Birkedal Hartmann), AFTERMATH (Dr. Dre and Domaines Francis Abecassis), D’USSÉ (Jay-Z and Chateau de Cognac) and BRANSON (50 Cent and Raymond Ragnaud). 12 TTABVUE 14. Ms. Duthilleul’s testimony further identifies several more partnerships, including a partnership between Courvoisier and Def Jam Recordings, a producer of musical recordings that is in the same business as Applicant (emphasized below):

40. Many producers of certified COGNAC products have partnered with famous musicians to market certified COGNAC products in the United States. For example, Rémy Martin partnered with rap musician T.I. to assist with promotions, merchandising and digital media campaigns.

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Landy partnered with Snoop Dogg for a digital marketing and social media program featuring Landy certified COGNAC products. Hennessy has partnered with hip-hop musician Erykah Badu, rap musician Nas, and hip-hop artist A\$AP Ferg to market its certified COGNAC products. Martell partnered with rap musician Quavo, making him a brand ambassador. Courvoisier has partnered with rap musicians Pusha-T to create the Maison Courvoisier pop up series and A\$AP Rocky as a brand ambassador, **in addition to partnering with Def Jam Recordings to create a concert tour that showcases artists across the United States**. Finally, Remy Martin has partnered with musician Pharrell Williams.

*Id.* at 13.

To corroborate the testimony, Opposers submitted copies of news articles about the musicians that predate Applicant's first use date:<sup>64</sup>

1. Quavo

- "Cognac's Climb," Market Watch December 27, 2018.<sup>65</sup>
  - "To infuse excitement into the Cognac category, Martell partnered with rapper Quavo of Migos (Martell H.O.M.E. series pictured)."
- "Quavo and Martell Cognac Join Forces for the Culture with 'Make Your Statement' Movement," December 21, 2018.<sup>66</sup>
  - Classic meets contemporary as one of the most historic cognac houses, Martell Cognac teams with one of the most cultivated leaders of the new generational hip-hop and cultural powerhouse, Quavo.

2. Pharrell Williams

- Setiawan, "Louis XIII Cognac And Pharrell Williams Challenge The World To Stop Global Warming," Forbes March 1, 2018.<sup>67</sup>

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<sup>64</sup> Articles regarding the other musicians are dated after March 7, 2019.

<sup>65</sup> At <https://www.marketwatchmag.com>, 13 TTABVUE 29-35, Durand Decl., Exhibit E.

<sup>66</sup> At [bet.com](https://bet.com), 15 TTABVUE 141-46, Durand Decl., Exhibit WW.

<sup>67</sup> At [forbes.com](https://forbes.com), 15 TTABVUE 77-83, Durand Decl., Exhibit LL.

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- French luxury cognac maker Louis XIII teamed up with musician Pharrell Williams to fight climate change. How you ask? Louis XIII commissioned Pharrell to compose an exclusive song, '100 Years,' that will not be released until 2117.

### 3. Jay-Z

- Bossart, "Inside the Extraordinary Cognac Brand Part-Owned by Jay-Z: Exclusive," *Billboard*, October 19, 2017.<sup>68</sup>
  - "It was a combination of all three factors that drew Jay-Z to the lifeblood of its eponymous region in southwestern France six years ago when he, alongside Bacardi, approached the portfolio's Cognac arm, Chateau de Cognac, with a proposition to create a new blend that would not only honor the region's centuries of production but also push the boundaries of traditional consumption. ... A vested interest in and a personal affinity for Cognac drove Jay to pursue this new venture, now known as D'USSEÉ, for which the rapper and mega-mogul heads global strategy in addition to serving as a partial owner, *Billboard* has learned exclusively, though the details of his ownership remain unconfirmed."
- Kelsey, "Jay-Z and Cognac: How booze made him world's richest rapper," *Newsbeat* March 2, 2018.<sup>69</sup>
  - "Jay-Z's taste for a French brandy is one of the main reasons he's now the richest rapper for the first time."

### 4. Ludacris

- "Ludacris loves his cognac," *Miami Herald* February 5, 2010.<sup>70</sup>
  - "The Mediterranean manse tucked behind gates in Miami Beach is now formally known as the House of Conjure - at least while rapper/actor/entrepreneur Chris "Ludacris" Bridges stays there. Ludacris, here for the business and pleasure of Super Bowl, introduced his new Conjure cognac to a set of tastemakers in the rented home this week. He created the spirit with Birkedal Hartmann, a Norwegian-owned Cognac producer, from a blend of some 40 distinct brandies."

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<sup>68</sup> At <https://www.billboard.com>, 16 TTABVUE 24-27, Durand Decl., Exhibit DDD.

<sup>69</sup> At <https://www.bbc.com>, 16 TTABVUE 29-32, Durand Decl., Exhibit EEE.

<sup>70</sup> At <https://www.miamiherald.com>, 16 TTABVUE 3-5; Durand Decl., Exhibit YY.

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- Jones, “Multitasker Ludacris runs his own show: Rapper sweats the details of his music, his acting and even his Cognac brand,” USA Today March 9, 2010.<sup>71</sup>
  - “[Ludacris] was already a connoisseur of fine spirits when he was approached two years ago by the venerable French/Norwegian winery Birkedal Hartmann about bringing a new Cognac brand, Conjure, to the USA in a 50/50 venture.”

#### 5. 50 Cent

- Santi, “50 Cent Announces Liquor Partnership with Branson Cognac,” EBONY April 27, 2018.<sup>72</sup>
  - “After inking a deal for Le Chemin Du Roi, an emerging champagne company, 50 announced a new liquor partnership with Branson, a French Cognac, according to XXL.”

#### 6. Dr Dre

- Lodge, “Hip-Hop Star T.I Signs With Remy Martin,” Fraternity Spirits July 7, 2010.<sup>73</sup>
  - “With Ludacris promoting Conjure, Busta Rhymes backing Courvoisier, Dr Dre planning his own range of high-end Aftermath Cognac and Circe benefiting from its association with P Diddy, it seems the fashion for recruiting controversial hip-hop artists as brand ambassadors is slowing no sign of slowing down.”<sup>74</sup>

In further support of their assertion that music goods and services are related to alcoholic beverages, Opposers submitted copies of third-party registrations for these goods and services, showing that companies have registered such goods and services

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<sup>71</sup> At <https://sonomarpa.sonoma.lib.ca.us:2220/usnews>, 16 TTABVUE 7-10, Durand Decl., Exhibit ZZ.



<sup>72</sup> At <https://www.ebony.com>; 16 TTABVUE 16-20, Durand Decl., Exhibit BBB.

<sup>73</sup> At <https://www.thedrinksbusiness.com>, 15 TTABVUE 128, Durand Decl., Exhibit DD.

<sup>74</sup> Another article, referred to by Durand as “a true and correct copy of a printout from the billboard.com internet website of an August 5, 2008 article entitled “Dr. Dre Cognac About to Hit the Market,” is of less probative value because none of the text of the article was legible, only the title. 14 TTABVUE 14, Exhibit GGG at 16 TTABVUE 51.

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under a single mark. There are seven probative marks covering music goods and services in a single registration or pair of registrations:

1.  has been registered for “downloadable music featuring recorded musical performances” and “wine;”<sup>75</sup>
2.  has been registered for prerecorded compact discs featuring music and live performances by a band;<sup>76</sup>
3. **IRON MAIDEN** has been registered for musical sound records and live musical entertainment performances<sup>77</sup> and beers; alcoholic beverages except beers;<sup>78</sup>
4. **SINATRA** has been registered for musical sound recordings; “provision of entertainment information relating to entertainment and cultural events and activities, via the Internet or other communications networks”;<sup>79</sup> and “alcoholic beverages except beers.”<sup>80</sup>

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<sup>75</sup> Reg. No. 4921246, registered March 22, 2016 under Section 1(a). 14 TTABVUE 87-89.

<sup>76</sup> Reg. No. 2910692, registered December 14, 2004 under Section 1(a); renewed. 14 TTABVUE 90-92.

<sup>77</sup> Reg. No. 3840031, registered August 31, 2010 under Section 1(a); Sections 8 and 15 combined declaration accepted and acknowledged. 14 TTABVUE 93-97.

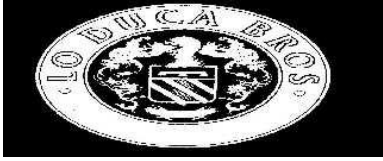
<sup>78</sup> Reg. No. 4848431, registered November 10, 2015 under Section 66(a); Section 71 accepted. 14 TTABVUE 98-100.

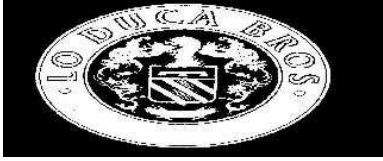
<sup>79</sup> Reg. No. 4203997, registered September 11, 2012 under Section 1(a) and claiming priority under Section 44(d); partial Sect. 8 & 15 combined declaration accepted and acknowledged. 14 TTABVUE 125-28.

<sup>80</sup> Reg. No. 4383616, registered August 13, 2013 under Section 1(a); Sect. 8 & 15 combined declaration accepted and acknowledged. 14 TTABVUE 129-131.




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5.  has been registered for pre-recorded CDs featuring musical instrument instruction and “wines;”<sup>81</sup>




6.  has been registered for “sound records of music; pre-recorded audio and video discs, phonograph records featuring music;”<sup>82</sup>



7.  has been registered for “wine.”<sup>83</sup>

Based on this evidence, I would find that an appreciable number of consumers



encountering Applicant’s mark  in association with recorded music and music-related entertainment services will mistakenly believe that Applicant’s use of the mark has been authorized or endorsed by the same authority, even if anonymous, that authorizes the certified users of COGNAC to use the certification mark on their products. *See., e.g., In re Julian Wine Co.*, 2020 USPQ2d 10595 at \*7-8 (“It is likely that consumers encountering REAL MICHIGAN on hard cider will mistakenly

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<sup>81</sup> Reg. No. 3297850, registered September 25, 2007 under Section 1(a); renewed. 14 TTABVUE 133-135.

<sup>82</sup> Reg. No. 2709578, registered April 22, 2003 under Section 1(b); Section 8 accepted; renewed. 14 TTABVUE 136-139.

<sup>83</sup> Reg. No. 3245593, registered May 22, 2007 under Section 1(b); Section 8 accepted; renewed. 14 TTABVUE 140-142.

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assume that these beverages are made from MICHIGAN APPLES branded apples, i.e. apples certified as grown in the state of Michigan, and that the Michigan Apple Committee has in some fashion authorized or endorsed Applicant's hard cider and use of its mark."); *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2051 (TTAB 2012) ("Purchasers familiar with registrant's certification mark COLOMBIAN for coffee, upon encountering applicant's coffee house services offered under the very similar mark COLOMBIANO COFFEE HOUSE, are likely to believe that registrant is authorizing applicant's use of the mark, and assume that applicant's services are therefore licensed by or in some way associated with registrant.").

In my view, the *DuPont* factors of the relatedness of the goods and services, and classes of consumers favor a finding of likelihood of confusion.

### **III. Fame of Opposers' Mark**

The fifth *DuPont* factor enables Opposers to expand the scope of protection afforded their pleaded mark by adducing evidence of "[t]he fame of the prior mark (sales, advertising, length of use)," while the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of "[t]he number and nature of similar marks in use on similar goods." *DuPont*, 177 USPQ at 567.

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy extensive public recognition and renown, and consequently a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir.

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1992). This principle applies to certification marks as much as to trademarks or service marks; as noted supra: “there is no authority for treating certification marks differently from service marks or trademarks under Section 2(d), or for affording them a lesser scope of protection.” *Institut Nat'l Des Appellations D'Origine*, 47 USPQ2d at 1890.

Likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). It “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). To determine a mark’s place on that spectrum, we consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2021 update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark

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at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”).

#### **A. The inherent or conceptual strength of COGNAC**

The COGNAC mark is conceptually strong. Although it identifies a well-known geographical region, pursuant to Trademark Act Section 1052(e)(2), 15 U.S.C. §1052(e)(2), indications of regional origin are not prohibited by the Act's general prohibition to registration of any mark that is primarily geographically descriptive of goods or services.<sup>84</sup> See *Cmty of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 133 USPQ 633, 635 (2d Cir. 1962) quoted in *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1482 (TTAB 2017) (“A geographical name does not require a secondary meaning in order to qualify for registration as a certification mark. ... [It] may be registered as a certification mark even though it is primarily geographically descriptive”); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“we consider DARJEELING inherently distinctive as a certification mark indicating geographic origin as it inherently identifies the geographic source of the tea.”).

Here, the conceptual strength of the term COGNAC is amply supported, including by dictionary definitions. For example, the Merriam-Webster dictionary defines “Cognac” as the certified product: “a brandy from the departments of

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<sup>84</sup> See also TMEP § 1210.09, providing that when an applied-for certification mark consists of or includes a geographic designation that functions to certify regional origin, the examining attorney should not refuse registration or require a disclaimer on the basis that the designation is primarily geographically descriptive of the goods or services.

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Charente and Charente-Maritime distilled from white wine.”<sup>85</sup> *Luxco, Inc.*, 121 USPQ2d at 1487 (citing *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1085 n.15 (TTAB 2014) (dictionary definitions with a usage characterization may be evidence of the general perception of a term), *aff'd Pro-Football, Inc. v. Blackhorse*, 113 USPQ2d 1749 (E.D. Va. 2014)).

Accordingly, the designation functions as a conceptually strong geographic certification.

### **B. The commercial strength of COGNAC**

Commercial strength may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products or services identified by the marks, as well as their general reputation. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Raw numbers alone may be misleading, however, and some context in which to place raw statistics may be necessary, such as market share or sales or advertising figures for comparable types of goods or services. *Id.* at 1309. Other contextual evidence probative of the renown of a mark may include the following:

- extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;

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<sup>85</sup> 17 TTABVUE 3, Second Durand Decl. ¶3, Exhibit MMM; *accord* Exhibit NNN, page from Britannica.com defining COGNAC as a brandy named for the town of Cognac, the production of which is “strictly regulated”).

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- the number of consumers that Opposer solicits through its advertising throughout the year;
- local, regional, and national radio and television advertising campaigns, free-standing print campaigns, and referrals in national publications;
- unsolicited media attention; and
- product placement in television and in movies.

*Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018).

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, Opposers have the duty to prove the fame of their mark clearly. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), *citing Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposers introduced significant evidence of long use, quality control in the U.S., U.S. sales, and extensive promotional activity, including:

- Long Use - COGNAC brandy “was first exported to the US in 1794 and has been continuously sold in the US since such time.”<sup>86</sup>
- Quality Control - Certificates of origin “must accompany every shipment of cognac outside of the European

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<sup>86</sup> 12 TTABVUE 10 (Duthilleul Decl. ¶ 32). The majority contends that Opposers have not proven the date COGNAC was first used as a certification mark in the United States. I choose to accept the statement made in Ms. Duthilleul’s testimony as sufficiently probative. *See e.g., Bass Pro Trademarks, LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1856 (TTAB 2008) (testimony of a single witness may be sufficient to prove first use). Regardless, the Board recognized COGNAC as being a valid certification mark over thirty years ago, in 1988, in the case of *Bureau Nat’l Interprofessionnel Du Cognac*, 6 USPQ2d at 1614. The cumulative evidence supports a finding of long use of the mark as a certification mark by Opposers.

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Union.”<sup>87</sup> title 27, CFR, section 5.22 and 5.52 set forth labeling and advertising requirements for distilled spirits including cognac.<sup>88</sup>

- Sales - U.S. sales values ranging from \$474,900,000 to \$1,367,400,000 per year for years from 2007 to 2019.<sup>89</sup> 102.4 million bottles were shipped in 2019, valued at approximately \$1,803,900,000, “making [the U.S.] the largest COGNAC market in the world with 47.3% of the world market share.”<sup>90</sup>
- Promotion - Between 2010 and 2018, Opposer BNIC “spent more than \$650,000 promoting COGNAC in the United States, resulting in more than 660,000,000 media impressions.”<sup>91</sup> “BNIC regularly sponsors master classes throughout the U.S. to educate bartenders, wine merchants, distributors and importers about COGNAC.”<sup>92</sup> BNIC also regularly publishes various newsletters and publications promoting the COGNAC AOC.”<sup>93</sup> Numerous articles from U.S. publications describe a strong sales market for COGNAC products.<sup>94</sup> COGNAC “has been the subject of numerous books including: *Cognac: The Story of the World’s Greatest Brandy* by Nicholas Faith and *Cognac: The Seductive Saga of the World’s Most Coveted Spirit* by Kyle Jarrard.”<sup>95</sup>

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<sup>87</sup> 12 TTABVUE 5 (Duthilleul Decl. ¶ 15).

<sup>88</sup> 14 TTABVUE 2-3 (Durand Decl. ¶ 2-5, Exhibits A-D).

<sup>89</sup> *Id.*

<sup>90</sup> 12 TTABVUE 11 (Duthilleul Decl. ¶ 32).

<sup>91</sup> *Id.*; ¶ 33.

<sup>92</sup> 12 TTABVUE 12 (Duthilleul Decl. ¶ 34).

<sup>93</sup> 12 TTABVUE 12 (Duthilleul Decl. ¶ 35, Exhibit F).

<sup>94</sup> I agree with the majority that we do not rely upon this material for the truth of any statements contained therein, but consider them for their likely impact on the U.S. consumer.

<sup>95</sup> 12 TTABVUE 13 (Duthilleul Decl. ¶ 37); *see also* Exhibit F to Durand Decl., 12 TTABVUE 50-57 (pages from 2016 edition of *Cognac: The Story of the World’s Greatest Brandy* by Nicholas Faith, including discussion of COGNAC and its relationship to rap music).

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The evidence recounted in the majority opinion, and bolstered by the additional examples noted above, is, in my view entirely sufficient to establish the fame of the certification mark. The majority, however, concludes that COGNAC, though a protectible common law certification mark, is merely very strong, but not famous. In its assessment of the record, the majority reaches this conclusion because it became sidetracked, in part by inapposite arguments of Applicant.

First, Applicant contends that Opposers' mark cannot meet a statutory definition of a famous mark, because it is not a "source identifier," by which Applicant means the mark does not identify a single manufacturer. Applicant, however, has focused on what qualifies a mark as "famous" under Trademark Act Section 43(c)(2)(A), 15 U.S.C. § 1125(c)(2)(A), which involves dilution, not likelihood of confusion, mistake or deception.<sup>96</sup> Second, the majority appears to accept Applicant's contention that if a brandy manufacturer's famous trademark is applied to a bottle also labeled as certified COGNAC, the fact that the trademark identifying the particular certified user may be famous precludes finding fame in the certification mark itself. Finally, the majority finds the presentation of the term COGNAC on the labels of various certified users of that mark, and in their advertisements, to be less prominent than the brand name, and improperly concludes that the certification mark is thus not being used in a "trademark" manner.

Even if, as Applicant contends, a certification mark cannot qualify for protection against dilution because it identifies the regional source of origin and not the brands

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<sup>96</sup> As noted supra, we do not reach Opposers' dilution claim.



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of the certified users, that does not preclude the certification mark from being considered famous for likelihood of confusion purposes. I likewise reject as inapposite Applicant's hypothetical situation showing what it concedes would be actionable, as a means to suggest that Opposers' claim under Section 2(d) of the Trademark Act is not. I reject Applicant's contention that any fame that attaches to a brand of COGNAC precludes any possibility of finding fame in the certification mark. While I acknowledge that the record shows examples of use of brand names for COGNAC that are more prominent than the use of the certification mark, I note that the certification mark appears on many more bottles of COGNAC than does any particular brand.

Accordingly, I find that COGNAC is a famous mark in connection with brandy from the Cognac region of France produced under, and governed by, a strict set of laws (including Title 27, the 1994 "European Union Distilled Spirits and Spirit Drinks Agreement" between the European Community and the United States, and the 1971 Industry Circular from the US Department of the Treasury<sup>97</sup>), for purposes of our likelihood of confusion analysis. Therefore, on the record presented in this case, I would find Opposers' mark famous and qualified for enhanced protection against a likelihood of confusion.

#### **IV. *DuPont* Factor Thirteen**

The last *DuPont* factor contemplates weighing any other established fact probative of the effect of use. As already discussed in both the majority and this opinion, the association of COGNAC with various musical performers has led not only

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<sup>97</sup> See Exhibits A-D to the Durand Decl. at 14 TTABVUE 18-38.

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to the recognition of the certification mark in songs and performances, but has led to musical performers entering into business arrangements with producers of certified COGNAC products. Applicant's testimony of Travis Davis acknowledges "As evidenced by [testimony of Opposers' witness,] alcoholic beverages, including cognac, are commonly the subject matter of song titles and song lyrics, and the association between cognac and the music industry is commonplace and has resulted in increased cognac sales."<sup>98</sup> The testimony also acknowledges "prolific use of the term 'cognac' or brands of cognac in song lyrics [and] song titles."<sup>99</sup>

The majority appears to discount this unique association that has developed by relying on the fact that each of the musicians who choose to market a brand of COGNAC does so under a different name than the name the musician uses for recordings and performances. However, it appears clear from the record that the musicians behind these brands are known. They are not anonymous to consumers of their music. This association of well-known performers with COGNAC enhances the likelihood that consumers of musical recordings or those who stream or download musical performances through the Applicant's services will draw an association between Applicant and Opposers' certification mark. It is not necessary to support a finding of likelihood of confusion that they draw a direct connection to Opposers. *Cf. Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423, 1429 (TTAB 1993) ("Although confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user's

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<sup>98</sup> 18 TTABVUE 6 (Davis Decl. ¶ 17).

<sup>99</sup> *Id.* at ¶ 21.

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mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection.”).

### **Conclusion**

For these reasons, I would sustain Opposers’ Section 2(d) claim.

## CERTIFICATE OF SERVICE

On May 12, 2023, the undersigned caused the foregoing document to be filed electronically by using the Court's CM/ECF system. All parties are represented by registered CM/ECF users and will be served by the appellate CM/ECF system.

*/s/ Peter M. Brody*

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## CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). The brief contains 13,855 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii). This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Word 365 in Times New Roman 14-point font.

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