

CORRECTED

No. 2023-1100

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

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

v.

COLOGNE & COGNAC ENTERTAINMENT,
Appellee.

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

BRIEF OF APPELLEE

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

CERTIFICATE OF INTEREST

Case Number 2023-1100

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

Filing Party/Entity Appellee, Cologne & Cognac Entertainment

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Date: 07/12/2023

Signature: /s/ Richard Gearhart

Name: Richard Gearhart, Esq.

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. 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 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>
<p>Cologne & Cognac Entertainment</p>	<p>Travis Davis</p>	

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STATEMENT OF RELATED CASES

Appellee Cologne & Cognac Entertainment (“Appellee” or “Applicant”) acknowledges that there are no related cases under Rule 47.5.

JURISDICTIONAL STATEMENT

Appellee acknowledges that this Court has jurisdiction under 28 U.S.C. §1295(a)(4)(B) and 15 U.S.C. §1071(a)(1). Appellee does not agree with Appellants Bureau National Interprofessionnel du Cognac, and Institut National des Appellations d’Origine (“Appellants” or “Opposers”) statement that “Opposers and those they authorize to use the mark would suffer concrete and particularized injury fairly traceable to use and registration of [Appellee’s mark].” Appellee further does not agree, as will be described herein, with Appellants’ statement that Applicant’s applied for trademark is “likely to confuse or deceive the relevant public into believing, falsely, that goods and services offered by [Appellee],” and that it is “likely to cause dilution by blurring of the COGNAC mark in the minds of the purchasing public.”

ISSUES PRESENTED



- A. Is Appellee’s composite trademark for confusingly similar to Appellants’ common law geographic certification cognac?
- B. Is Appellants’ common law geographic certification cognac a famous mark under the Lanham Act?
- C. With respect to the geographic certification issue(s) raised by the *amicus curie* should geographic certifications receive broader protection for goods and services unrelated to the goods being certified?

STATEMENT OF THE CASE

The Appellants’, in its principal brief, indicated that the “Applicant did not dispute the facts set forth in this Statement of the Case” holds only to the evidence of record in the case.¹ Appellants’ Statement of the Case, however, includes errors by omission to whimsically paint an incomplete, inaccurate representation of the

¹ See n.5 of Appellants’ Principal Brief

facts and shamefully mixes attorney arguments with facts. The following is the Appellee's Statement of the Case.

While the Appellants continually use the word "famous" to describe its common law certification mark cognac, it is anything but. The Trademark Trial and Appeal Board (the "Board") did not (and has not) nor has any evidence been shown that has found that the common law certification mark cognac was a famous or even strong mark in terms of conveying the message to consumers that the goods are certified. Appx23. Rather, the Board found the evidence simply 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." Appx22 at n.37; *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). That was in 1988, and the role of cognac as a geographic certification mark has not changed. *Id.*

While Appellants champion their "success" in "oppos[ing] and obtain[ing] cancellation of several dozen marks" they fail to note that most all result in the applicant/registrant receiving a notice of default for failing to provide an answer to the respective notice or petition. Appx110. While the marks in question were abandoned or canceled, in no way, should this suggest that the Board would have

found in favor of the Appellants should the proceeding have moved to a final decision as with the present case.

Further, third-party use of the common word cognac related to the beverage cognac as well as unrelated uses are rampant throughout the United States and elsewhere. Indeed, the Appellants brag that the term cognac and associated brands have appeared in over a thousand (1,000) songs, yet there is no record of the Appellants enforcing the geographic certification mark cognac against any non-authorized users or any other products using the term cognac for that matter. Appx743; Appx802-Appx806; Appx1063.

In remarking on the alleged commercial success of the common law certification mark cognac, the Appellants lay claim to an alleged “more than 660,000,000 media impressions” and further allege “[a]gain, these figures do not include the heavy advertising spending by the COGNAC houses or their American distributors.”² Appx112; *see also* Appx113. However, none of the evidence in the record relates to the commercial success of the geographic certification mark cognac *alone*. All the evidence of sales and marketing expenditures are co-mingled with the marketing data from separate liquor companies. There is no evidence to show in any way, shape, or form that such dollars are dispensed solely to the geographic

² *See* n.6 of Appellants’ Principal Brief

certification mark cognac as opposed to the respective house mark or brand or product. Appx743.

It is yet another, at best, half-truth masquerading as an “undisputed fact” in the Appellants’ statement of the case. In fact, the Appellants cite, in its own declaration, that the commercial success of cognac was weak, until a rapper mentioned Hennessy, Remy Martin, and Courvoisier in lyrics that went viral.³ Appx562. Thus, the public's knowledge of cognac was elevated not by the activity of the Appellants or even the brands but by an unrelated musical artist (not unlike those goods and services of Appellee) having no apparent connection with the cognac industry.⁴ Appx562. Thus, notoriety for the cognac beverage was not driven by the specific actions of the Appellants.

In Appellants’ statement of the case, and throughout their principal brief, Appellants often use the phrase “[t]he COGNAC mark *and* brand names of certified

³ Ms. Durand testified with regard to Exhibit AA that “The popularity of cognac became more pronounced in 2001, when the industry was in a bad situation. The artist Busta Rhymes sings “Give me the Henny (Hennessy), you can give me the Cree, you can pass me the Remi (Remy Martin), but pass me the Courvoisier”. The video clip of the piece constantly shows the bottle, each plan, close-up, fade...According to the Distilled Spirits Council of the United States, the title would have boosted sales of Courvoisier by 30%.”

⁴ Ms. Durand testified with regard to Exhibit BB that “Mr. Warren said that Busta Rhymes unwittingly turned the “shine,” or spotlight, on Courvoisier. “He picked Courvoisier because it worked in the song.” Mr. Warren said that Busta Rhymes, who declined to comment, did not get paid to write the song. “Busta actually drinks Hennessy,” he said.

COGNAC products” or some variation thereof. (emphasis added). Any such statement is wholly improper and should be disregarded for the evidence it purports to show. Whether a song, advertisement, media impression, soundtrack, printed media article, etc. references a certified cognac product and its standalone associated trademark has no bearing on this present case or the Appellants’ common law certification mark. Courvoisier. Hennessy. D’Ussé. Martell. Landy. Remy Martin. All are certified cognac products and all are irrelevant to this proceeding. Perhaps the Appellee can boast the media impression numbers from the hit television show “The Bachelor.” After all, Appellee did release a debut musical album entitled “Bachelor Life.” Appx1058-1059.

INTRODUCTION

Much like the adage “[i]t’s only champagne if it’s from the Champagne region of France; otherwise, it’s just sparkling wine,” the Appellants’ initial brief muses “[i]t’s only cognac if it’s from the Cognac region of France; otherwise, it’s just grape-based opinion” in chastising the Board’s veracious ruling in favor of the Appellee.

A certification mark is a special creature created for a purpose uniquely different from that of an ordinary trademark or service mark. 3 J. Thomas McCarthy, *McCarthy On Trademarks And Unfair Competition* § 19.91 (4th Ed. 2004). A

certification mark *does not* function as a source identifier, as the owner of a certification mark “cannot refuse to license the mark to anyone on any ground other than the standards it has set.” 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19.96 (5th ed.). Thus, the Appellants, rather than the respective government, grant the rights for the certification mark to be used on the certified product. This is an important distinction between the policies embodied in trademarks and certification marks, and a distinction which must be thrust to the forefront of this proceeding. Appx1208. Further, certification marks are subject to grounds for cancellation that are distinct from the grounds for trademarks and service marks. *See* 15 U.S.C. § 1064(5). A certification mark also does not distinguish the goods or services of one company from those of another producer. A certification mark, in the Appellants’ case, is *only used* to certify the geographic origin of the products (e.g. spirits).

The Appellants mistakenly believe that the majority’s decision is erroneous because the legal standards it embraced allegedly provide certification marks with markedly less protection than other marks. Whether such a statement is true is, ultimately, not for this Court to decide, as the Board’s finding of a no likelihood of confusion was based on the facts, or lack thereof, to support the Appellants’ position and overreach in attempting to put the proverbial handcuffs on a single minority business owner trying to forge his own path in the rat race of life.

The Appellee finds, however, that the Board’s application of law is compliant with that of the Lanham Act and the balancing test that must occur in analyzing a likelihood of confusion. The analysis required is almost exclusively fact-based and thus the facts submitted by each party bear monumental weight on the eventual outcome. Unfortunately for the Appellants and their new counsel (at this appeal stage), Appellants’ previous counsel made generic, overbroad, and irrelevant showings that were not tailored to the case at hand. However, even if such “tailored” showings had been made, the facts show, beyond all reason, that Appellee is entitled to its trademark. Appellants do not own exclusive use to all uses of the common word cognac.

Given the applicable standard of review and the uncontradicted record, the Appellee requests that this Court uphold the Board’s finding that its mark poses no likelihood of both confusion and dilution and is to be immediately moved to registration.

SUMMARY OF THE ARGUMENT

Fame. Appellants do not own a federally registered trademark (whether on the principal or supplemental register), but only an alleged common law certification mark for the word cognac. Thus the burden is on the Appellants to demonstrate all aspects of enforcement of the same (fame, distinctiveness, ownership, etc.). The Appellants common law certification mark, based on a totality of the evidence

submitted before the Board, warrants at best an intermediate scope of protection as opposed to being deemed a “famous” mark as understood in the eyes of trademark law. The Appellants fail to establish the fame of its alleged common law certification mark as the Appellants’ evidence fails to create a nexus between its common law certification mark as opposed to other trademarks of the cognac house and/or the trademark of the cognac-certified product. Simply put, 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 Appellants’ certification mark also being famous.

Dissimilarity of marks. The proper test in comparing marks for likelihood of confusion purposes “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 U.S.P.Q.2d 10914, *18 (TTAB 2020) (citing *Coach Services, Inc. v. Triumph, Learning LLC*, 668 F.3d 1356, 101 U.S.P.Q.2d 1713, 1721 (Fed. Cir. 2012)). The Appellants’ focus solely on the “connotation” of the respective marks and not discussing appearance, sound, and commercial impression speaks volumes. The Board did not improperly analyze the Appellants’ mark differently than prescribed by statute and case law precedent. Further, the Board did properly meet the

substantial evidence standard as the Board cited both the Appellee's and Appellants' evidence in making the ultimate determination as to whether the marks in question are similar.

Relatedness of goods and services and respective customers. The Appellants cite to cases to support its proposition that the goods/services of the marks in question are related. However, the Appellants rely heavily on case law where the mark in question was deemed to be a famous mark which is not the case in the present matter. Thus, the principles relied on by Appellants are not analogous and are in opposite to those here. Proper case law, given the marks in question, shows that the goods/services are not related. The Appellants argue that a nexus between the alcohol industry and various musical artists established the relatedness of the marks in question. However, in such instances, and as the Board correctly pointed out, those musical artists have collaborations with third-party marks (e.g., CONJURE, AFTERMATH, D'USSÉ, and BRANSON) that have no relevance to Appellants' common law certification mark.

Dilution. The Board's decision as to the Appellants' dilution claim is equally just in the eyes of the law. For starters, the Board determined that the Appellants' common law certification mark is not a famous mark. If a trademark is not a famous mark, then there can be no dilution. Further, the Appellants did not properly plead dilution as the Appellants did not plead its mark became famous prior to Appellee's

use of its mark. Appellants only plead that it has used its mark “over many years” and never once stated when the alleged “fame” of its mark was established. Case law shows and the Board properly recognized that Appellants’ common law certification mark has *never* been deemed to be a famous mark.

Amicus Brief. The Amicus Brief submitted on behalf of twelve organizations broached the subject of geographic certifications or geographic indications (GI). The United States and other countries (including Europe) have negotiated over the scope of protection accorded to geographic certification marks for decades. During these negotiations, some countries have consistently argued for “dilution plus” protection for geographic certifications. Dilution plus would expand the scope of a geographic certification to cover unrelated goods. However, the United States has never been party to any agreement, treaty, etc. that would extend such “dilution plus” protection as so sought by the *amici*. The issue concerning the scope of protection granted to unrelated goods for a geographic certification has already been settled by the executive and legislative branches. It has been decided that it is not in the United States’ interest to provide expanded coverage for unrelated goods to geographic certifications like cognac.

This Court must, accordingly, sustain the Board’s decision in favor of the Appellee and find that Appellants’ common law certification mark *is not* a famous

mark and further that there is no likelihood of confusion between Appellee's mark and Appellants' common law certification mark.

STANDARD OF REVIEW

As a matter of law, this Court is to review the Board's factual findings for substantial evidence, which "requires that this court ask whether a reasonable person might accept that the evidentiary record adequately supports the Board's conclusion." *In re St. Helena Hosp.*, 774 F.3d 747, 750 (Fed. Cir. 2014). In rendering a decision, the Board must "examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made" to allow this Court to properly evaluate the Board's decision-making process. *Nat'l Shooting Sports Found., Inc. v. Jones*, 716 F.3d 200 (D.C. Cir. 2013). This Court will, however, uphold a decision of less than ideal clarity if the Board's path may reasonably be discerned. *Id.*

Separately, dismissal of a claim before the Board (and on appeal) is appropriate "if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations." *Young v. AGB Corp.*, 152 F.3d 1377, 1379 (Fed. Cir. 1998). Pleadings made by pro se litigants are "held to less stringent standards than formal pleadings drafted by lawyers." *Arunachalam v. Apple, Inc.*, No. 2019-1251, at *5 (Fed. Cir. Feb. 13, 2020). 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." This Court can review the Board's decision regarding whether an issue was tried by implied consent for abuse of discretion. *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 145 (Fed. Cir. 2021) "However, implied consent can only be found where the nonoffering 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. TBMP § 501.03(b).

ARGUMENTS

A. THE MAJORITY OPINION OF THE BOARD SHOULD BE SUSTAINED IN ITS LIKELIHOOD OF CONFUSION ANALYSIS

a. The common law certification mark cognac is not famous within the meaning of established trademark law

The majority began its evaluation of the likelihood of confusion with the fifth *du Pont* factor⁵, concerning the alleged fame or strength of the common law certification mark cognac. We do the same here.

Fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts. *Palm Bay Imp. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369 (Fed. Cir. 2005)(quoting *The Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d (BNA) 1164, 1170 (T.T.A.B. 2001). While dilution fame is an either/or proposition

⁵ There are thirteen *du Pont* factors, however, only those factors on appeal will be discussed herein. See *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

— fame either does or does not exist — likelihood of confusion fame "varies along a spectrum from very strong to very weak." *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003).

In the Board's majority decision, the Board properly concluded "that Opposers' COGNAC certification mark is...entitled to a normal scope of protection" as "it is difficult to extrapolate from the evidence when it comes to measuring the level of consumer awareness for the goods' certification status." Appx23.

The Appellants argue that according to *Tea Bd. Of India v. Republic of Tea Inc.*, 80 U.S.P.Q.2d (BNA) 1881 (T.T.A.B. 2006), that geographic certification marks are inherently distinctive. However, the inherent distinctiveness of geographic certification marks is intrinsically tied to said trademark being a federally registered trademark. As noted by the Board in *Tea Bd. Of India*, "[a] mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods." *Id.* Appellants do not own a federally registered trademark (whether on the principal or supplemental register), but only an alleged common law certification mark, and thus the burden is on the Appellants to show the distinctiveness of its mark. 15 U.S.C. § 1094; *E.T. Browne Drug v. Cococare*, 538 F.3d 185, 191 (3d Cir. 2008).

Further, even if Appellants' common law certification mark is deemed to be inherently distinctive, it does not automatically afford the Appellants a "strong mark" bearing a "relatively broad scope of protection." As the Board noted in rendering their decision against the Appellants, in the present case, a mark in the middle of the spectrum receives an intermediate scope of protection. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340, 1347 (T.T.A.B. 2017) (finding that opposer's marks were entitled to "the normal scope of protection to which inherently distinctive marks are entitled"); Appx14. In fact, for a trademark to be "inherently distinctive" only requires that a trademark be at least suggestive of the prescribed goods and/or services. *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1339 (Fed. Cir. 2004) ("A mark that is fanciful, arbitrary, or suggestive is considered to be inherently distinctive). Thus, Appellants are not correct to assume that their common law certification mark, by virtue of existing, is a strong mark entitled to a broad scope of protection.

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." *Bureau Nat'l Interprofessionnel Du Cognac v. Enovation Brands, Inc.*, No. 91242020, 2020 WL

1528535, at *5 (T.T.A.B. Mar. 13, 2020); *accord, e.g., Bose Corp. v. QSC Audio Products, 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).

However, as the Board correctly concluded in its opinion, the Appellants' evidence (while perhaps voluminous) does not create a nexus between its common law certification mark as the products bearing Appellants' common law certification mark bears the trademark of the cognac house and/or the trademark of the cognac certified product in putting forth the end product to the consumer.⁶ *Cf. Bose* 63 U.S.P.Q.2d 1309 (a product mark may be assessed independently for possible fame where the evidence shows the product mark stands apart from the house mark). Rather, the evidence of record shows various sales, numbers of media impressions, and partnerships that fail to delineate between the common law certification mark cognac and, for example, the cognac house mark or the certified cognac product mark. Advertising by the Appellants only amounted to \$650,000 over eight (8)

⁶ Board stating "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."

years, from 2010 to 2018, a paltry \$81,250 per year on average. Appx112. The expenditure is, unsurprisingly, in line with the Appellants' verifiable role in certifying cognac products rather than promoting and selling such products.

Predictably, the Board has previously ruled on the alleged "fame" of the Appellants' cognac common law certification mark finding that the mark *was not* a famous mark or even a strong mark in terms of conveying the message to consumers that the goods are certified. *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 U.S.P.Q.2d (BNA) 1610 (T.T.A.B. 1988). At that time, 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." That is, the Cognac region of France is a famous place, the common law certification mark, however, is not famous. *Id.* Inevitably, this proposition is further upheld as the Appellants have not provided *any* decision that shows its common law certification mark is a famous mark.

Accordingly, it is requested of this Court to find in favor of the Appellee and uphold the Board's finding regarding the lack of fame of Appellants' common law certification mark.

b. The Board’s opinion that the word cognac is not a famous common law certification mark did not hinge on whether there is “consumer awareness of certification status”

The Appellants contend that the Board’s majority erroneously assumed that, to establish the fame of the common law certification mark cognac, the Appellants 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. However, the Appellants’ cherry-picked statement does not support their proposition. The Board, rather, spoke to a straightforward issue when dealing with a likelihood of confusion analysis: whether the public understands that goods bearing the trademark come only from the region named in the trademark, and the subsequent weight afforded to the trademark in the analysis when the consumer is presented with multiple marks within a singular good or service.

The Board stated that “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. *Id.*

To support such a position, the Board relies on this Court’s decision in *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367 (Fed. Cir. 2002). Here, Bose sought to find its trademark WAVE and ACOUSTIC WAVE as famous due to its pairing with the already famous BOSE house mark. This Court recognized the significance of such a ploy stating “[b]ecause fame plays such a dominant role in the confusion analysis, we think those who claim fame for product marks that are used in tandem with a famous house mark can properly be put to tests to assure their entitlement to the benefits of fame for the product marks... We thus do not fault the Board for its insistence that Bose produce evidence that the product marks can properly be seen as independent of the famous house mark.” *Id.* at 1374.

As this Court did not find fault with Bose, this Court shall equally not find fault with the Board’s *identical* analysis regarding the “co-mingling” of the common law certification mark cognac and the more prominently presented cognac house mark and/or certified cognac product mark. As stated in *Bose*, this is not a question of “consumer awareness” as described by the Appellants, but simply a process of untangling the evidence to demonstrate whether the common law certification mark cognac is famous or whether the Appellants are simply looking to ride the coattails of a famous (or more visible) cognac house mark and/or certified cognac product mark. The evidentiary record is, at best, murky with no delineation between the marks in question. *See* Appx102-1058.

On this point, Ms. Duthilleul⁷ testified to the nature of the common law certification mark cognac and in doing so referenced multiple cognac houses such as Raymond Ragnaud, Chateau de Cognac, and Birkedal Hartmann. Appx114-115. Further, Ms. Duthilleul testified to the cognac brands Aftermath, Branson, Conjure, and D’Ussé. *Id.* Ms. Duthilleul’s testimony, again speaks not solely to the common law certification mark cognac, but a bevy of third-party, independently owned trademarks for products (*i.e.*, third-party trademarks for goods). Ms. Duthilleul’s testimony begs the question yet again: who’s trademark(s) is famous and who’s trademark(s) is not?

Unfortunately for the Appellants, the evidentiary evidence becomes even more questionable with the introduction of the Declarations of Joy. L Durand on September 30, 2020 (First Durand Declaration) and October 1, 2020 (Second Durand Declaration). For example, in the First Durand Declaration, Ms. Durand submits articles into evidence entitled “Pusha-T Taps Creative Friends to Curate An Exquisite Maison Courvoisier Experience” and “Grammy-Winning Producer 9th Wonder Hosts Official D’USSE RE-MIXER Launch” and “MEDIA; Hip-Hop Sales Pop: Pass the Courvoisier And Count the Cash”. Appx585; Exhibits Y, BB, and PP.

⁷ Ms. Duthilleul is an attorney employed by Appellant Bureau National Interprofessional du Cognac.

In those article headlines and throughout, we see the third-party trademarks MAISON COURVOISIER, D'USSE, and COURVOISIER. None of the foregoing third-party trademarks are owned by the Appellants. What word, however, is nowhere to be seen in those headlines – cognac. Appellants, in their desire for all things French, want to have their cake and eat it too. The more integrated the display of the house mark and the product mark, the more difficult it is to treat them as separate elements with distinct commercial impressions. *B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (CCPA 1964) (finding that the house mark "KUPPENHEIMER" and the product mark "SUP-PANTS" were integrated, with the double "P" in "KUPPENHEIMER" serving also as the double "P" in "SUP-PANTS," making "an indivisible symbol rather than two divisible words.").

As the Board rightly pointed out, based on the evidence submitted by the Appellants, the evidence *fails* to ascertain whether “the success of a type of product sold under various trademarks []mean[s] that the placement of certification mark(s) on those products is equally successful.” Appx23. As such, the Appellants’ evidence does not provide sufficient support for an unequivocal conclusion that their common law certification mark cognac is famous independent of any third-party trademarks for cognac houses and cognac products.

c. The marks in question are plainly dissimilar under established trademark law

The likelihood of confusion between two trademarks is determined under the multi-factor test set out by *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). However, not all of the *du Pont* factors are necessarily relevant or worthy of being assigned equal weight. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011). Here, the Appellee will address those factors on appeal by the Appellants.

Under the first *du Pont* factor, one is to determine the similarity or dissimilarity of the marks in question in their entirety, considering their appearance, sound, connotation, and commercial impression. However 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 U.S.P.Q.2d 10914, *18 (TTAB 2020) (citing *Coach Services, Inc. v. Triumph, Learning LLC*, 668 F.3d 1356, 101 U.S.P.Q.2d 1713, 1721 (Fed. Cir. 2012)).

The Appellants allege that the Board found the marks in question to be dissimilar because the common law certification mark cognac has allegedly primary geographic significance, and therefore the Board allegedly made a clear legal error. However, the Board quite plainly states that “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. The Board, despite the Appellants arguing otherwise, fully cites the evidence which it relies on to arrive at its conclusion. This includes evidence submitted by *both* the Appellee and Appellants before the board. Appx25 n.38.

This evidence includes articles submitted by the Appellants which state, for example, "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" and "The world's most civilized spirit" and "deliveries of cognac to the U.S. during the 19th century, where its refined smoothness was a favorite drink of the upper class." Appx729; Appx739; Appx757. Expensive. Civilized. Upper class. These are the words at the forefront of connotation of Appellee's applied-for mark. The Court need to look no further than Appellants' own evidence for support of the Board's position that when viewed in the context of music (to which the articles are directed at least in part) this is the connotation associated with the mark in light of the applied for musical goods and services.

The Appellants focus solely on the "connotation" of the respective marks and

not discussing appearance, sound, and commercial impression speaks volumes. Even similarity, to which the Appellee does not concede, of the marks in one respect – sight, sound, or meaning – does not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. *See In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1635 (T.T.A.B. 2009); *In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988); TMEP §1207.01(b)(i). The Board, focused on the mark as a whole – the big picture – and cited to this Court as the Appellee’s mark as 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 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 1991).

Accordingly, the record does not establish a demonstrable failure by the Board as a matter of law in the analysis of the first *du Pont* factor and the Board’s decision should be upheld.

d. The evaluation of the established similarity of the goods and overlap in trade channels and classes of consumers by the Board was proper under established trademark law

The Board then focused on the second *du Pont* factor regarding the comparison of the goods and services identified in the Applicant’s application vis-à-vis the goods certified under Opposer’s common law certification mark cognac. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110

U.S.P.Q.2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990).

The Appellants cite to *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335 (C.C.P.A. 1981) to make the argument that goods/services at issue in the present matter are likely to be found to be confusingly similar. However, the mark in *Tuxedo Monopoly* was deemed to be a famous mark which is not the case in the present matter. Thus, the principles being relied on for confusion purposes are not analogous and are in opposite to those here.

Analogous to the present case in *Consejo Regulador del Tequila, A.C. v. George Michalopoulos and Tasos Georgas*, Opposition No. 91244395 (T.T.A.B. July 6, 2020), the Board dealt with a similar issue involving the certification mark of an alcoholic or distilled spirit beverage. The Applicant, in that case, attempted to trademark the word TEQUILUSA for “alcoholic beverages, except beer” whereas the Opposer plead “plead[] ownership of Registration No. 5225126 for the certification mark TEQUILA, issued in typed form on the Principal Register, identifying “distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant.” *Id.*

Here, in the likelihood of confusion analysis, the Board noted that the goods (tequila) are manufactured in Mexico from a specific variety of the blue agave plant grown in certain regions of Mexico as defined by Mexican law and standards, and

ultimately that the Board must “determine whether Applicants’ goods are related to the goods provided by users of Opposer’s certification mark.” *Id.* at 6.

However, in contrast to the present case, the Applicant and Opposer were both selling distilled spirits. This correctly led to the Board finding that “[a]s a result, the goods in Applicants’ application are legally identical to the goods listed in Opposer’s registration.” *Id.* at 8.

At present, the Appellee is providing certain goods and services related to musical productions, song recording, live performances, and digital music. The Appellants tried to tie its common law certification mark cognac to that of the goods and services of Appellee, but the Board saw right past stating “[t]he 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...* The record is devoid of any evidence that either Opposer provides musical sound recordings or any services related to the music industry.” (emphasis added). Appx28. Thus, the Board correctly found that the goods/services are not related and thus that this factor favors the Appellee.

Turning to the channels of trade and classes of consumers, the Board equally found the Appellants deficient in their position stating “Opposers have not shown that COGNAC brandy and recorded music and music entertainment services travel in the same trade channels.” Appx29. Most all of the Appellants’ evidence of the channels of trade always includes the phrase “term COGNAC and certified COGNAC products” or some variation thereof.⁸ See e.g., Appx736-Appx743; Appx749-Appx754. Appellants are lumping together its alleged geographic certification mark with the trademarks of others. Whether Courvoisier is mentioned in a song lyric, title, etc. has no bearing on the association of Appellants’ common law certification mark cognac with the music industry. This sleight of hand is undoubtedly done to “pump up the numbers” to support their misguided position.

The Appellants allude to an error in the Board stating that the “Opposers are affiliated with any of Applicant’s goods or services” as the Opposers by nature do not use their own certification mark. However, this is not the intention of the Board, as in the next sentence of its opinion, the Board correctly states that “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

⁸ Appellant’s Principal Brief states in part “By the 1990s, COGNAC spirits became immortalized in lyrics of hiphop and rap music. Over 1,000 songs have mentioned the *term COGNAC and certified COGNAC products*.” (emphasis added).

business of sponsoring or authorizing production of recordings or recording services or the other goods or services of Applicant.” (emphasis added). Appx29. Other references to the “certified users” of the Appellants’ alleged common law certification mark are made throughout the Board’s decision. *See e.g.*, Appx 21; Appx24.

Consequently, there is no legal error, but perhaps a typo by the Board and the following sentence and otherwise throughout the Board’s decision makes plain that there is no legal error or fundamental misunderstanding by the Board as to the nature of the use and the consumers of Appellants common law certification mark cognac.

Thus, as the Board demonstrably showed, these factors weigh in favor of the Appellee and a finding of no likelihood of confusion.

e. Balancing the DuPont Factors

As the Board indicated in its ruling, the evidence of record demonstrates that it is apparent that the Board’s conclusion on each of the “key” *du Pont* factors was correct, and each of those factors weighs strongly in favor of *no* likelihood of confusion.⁹

⁹ Because cognac is a common law certification mark, it is used without a registration symbol. The public has no notice of Appellants common law rights. The mark is continuously used in different sized fonts, different letter case, and different placements. (*See e.g.*, Declaration of Travis Davis).

B. THE BOARD SHOULD BE UPHELD IN ITS RULING AGAINST APPELLANTS' DILUTION CLAIM

a. The Board properly dismissed the Appellants' claim for dilution

Both the majority and the dissent at the Board properly found that the Appellants failed to plead its claim for dilution by blurring and correctly dismissed such claim. Appx35; *Id.* at n.55.

It is without dispute that in order to show dilution by blurring a complainant *must* sufficiently plead that “the defendant's use of its mark began after the plaintiff's mark became famous.” *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012); *See* 15 U.S.C. §§ 1063 and 1125(c). Appellants attempt to argue that such an element, along with the other required elements of a dilution by blurring claim, is required to *prove* dilution as opposed to simply *plead* dilution. However, such a proposition is misguided and flies in the face of the Board's unanimous opinion on the matter and long-standing precedent.

In *Luster Products, Inc. v. John M. Van Zandt d/b/a Vanza USA*, No. 91202788 (T.T.A.B. Nov. 28, 2012), it was plainly noted that “opposer's dilution claim is insufficiently pleaded because opposer did not allege that any of its pleaded marks became famous prior to any date upon which applicant can rely in support of his application.” *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540, 1542 (T.T.A.B. 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 U.S.P.Q.2d 1713, 1723-24 (Fed. Cir. 2012); *Toro Co.*, 61 USPQ2d 1174. *See also Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 (T.T.A.B. 2007) (elements of each claim should include enough detail to give the defendant fair notice).

Appellants ultimately concede to this point but argue that their Notice of Opposition is properly pleaded on this issue. Appx71-72. Appellants allege that its common law certification mark has lasted “many years.” Appellants rely on *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 U.S.P.Q.2d (BNA) 1645, 1656 (T.T.A.B. 2010) to support its position of a properly pleaded claim for dilution. In *Citigroup Inc.*, however, the pleading was met with the same deficiency as with Appellants as it did not properly state a dilution claim against applicant’s use-based application because opposer did not allege that the “CITIBANK Marks” became famous prior to applicant’s use of the mark CAPITAL CITY BANK. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1174 n.9 (T.T.A.B. 2001) (“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”).

Indeed, Appellants simply plead that “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.*”¹⁰ (emphasis added). Appx71-72. Appellee does not dispute the plain language of Appellants’ Notice of Opposition nor does Appellee take issue with the alleged use of the common law certification mark that has existed for some number of years. However, the “many years” language *does not* plead or otherwise indicate fame over those “many years” or at any point before the Appellee’s use of its own trademark. Appellants’ principal brief is simply deficient in the manner it was pleaded and both the majority and dissent at the Board reached the same correct conclusion.

Compounding matters for Appellants is that there is no decision, from *any* court or administrative body, showing that the common law certification mark for cognac is famous or when, if ever, it became famous. The majority correctly points out this glaring omission going back over three decades in stating that “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

¹⁰ This is the identical language from Appellants’ Notice of Opposition which they believe supports a showing of fame before the use of Appellee’s trademark.

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.’ Appx23; *Id.* at n.37; *Bureau Nat’l Interprofessionnel Du Cognac*, 6 U.S.P.Q.2d 1610 (T.T.A.B. 1988). Further, outside of blanket statements of assertion (to which the Appellee does not agree) the Appellants offer no evidence or court decision that its common law certification mark cognac has been held to be a famous mark.

Accordingly, we now ask that the Board’s decision be rightfully sustained and that Appellants’ claim(s) for dilution be dismissed.

b. Dilution Requires A Much More Stringent Showing Of Fame Than Likelihood Of Confusion

Likelihood of confusion fame is not “an all-or-nothing measure” as it varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 U.S.P.Q.2d 1733, 1734 (Fed. Cir. 2017); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003)). In contrast, dilution fame requires a more stringent showing. 4 J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition* § 24:104 at 24–290 (4th ed. 2011) (“The standard for the kind of ‘fame’ needed to trigger anti-dilution protection is more rigorous and demanding than the ‘fame’ which is sufficient for the classic

likelihood of confusion test.”). Thus, fame for dilution “is an either/or proposition”—it either exists or it does not. *Palm Bay*, 396 F.3d at 1374–75.

As described, *supra*, Appellee asserts that the Appellants’ common law certification mark was not alleged to be famous before the Appellee’s use of his mark and such removes the need to continue with any further analysis. Further, as asserted herein, the Appellants’ common law certification mark is not a famous mark, and as such there can be no dilution. The Board’s decision regarding dilution, in any capacity, should be upheld and resolved in favor of the Appellee.

C. IN RESPONSE TO THE *AMICI CURIAE*

As noted by the *amici curiae* (“Amici”),¹¹ cognac is a special type of certification mark namely, a geographic certification or alternatively a geographic indication (GI). The distinction is important because GI’s implicate important international treaties. In fact, the United States government has already spoken on the issue raised here, namely, should GI’s receive broader protection for unrelated goods? In short, the answer is “no”.

¹¹ While Counsel for Appellee gave consent to counsel for the SCOTCH WISKEY ASSOCIATION to file the Brief of Amici Curiae (“Amici Brief”) Amicus Brief, counsel for Appellee did not know of or give consent for the other 11 *amici* named as parties in the Amici Brief frequently referenced in the Amici Brief. The numerous Amici parties and multiple references to “geographic certifications” were not discussed by Appellant at the Board and have necessitated this response. Appellees arguments in relation to the international treaties are germane to the international issues in the case.

The Geneva Act of the Lisbon Agreement, and Trade-Related Aspects of Intellectual Property Rights (TRIPS) both bear directly on this case. As discussed further below, both agreements treat the scope of protection to be awarded a GI. This case should not be used as a proxy to end run United States trade policy.

The United States and other countries (including Europe) have negotiated over the scope of protection accorded to geographic certification marks for decades.¹² During these negotiations, some countries have consistently argued for “dilution plus” protection for geographic certifications.¹³ Dilution plus would expand the scope of a geographic certification to cover unrelated goods. For example:

[The] Champagne district wine producers [in France] could theoretically shut down the CHAMPAGNE café chain in California, TEXAS CHAMPAGNE hot sauce, the CHAMPAGNE POWDER ski resort in Steamboat Springs...¹⁴
[footnotes omitted]

Potentially they [geographic certifications] could prevent the use of the word “Champagne” to name a rich yellow wall paint color, or a Vegas show[person], without consumer confusion in any of these cases. In the

¹² See generally for background on the extensive and complex negotiation history of geographic certification marks, Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate About Geographical Indications*, 58 *Hastings L.J.* 299 (2006); cited in Amicus Brief at p, 17 and 25 and; Daniel Gervais, *Irreconcilable Differences? The Geneva Act of the Lisbon Agreement and the Common Law*, 53 *HOUS. L. REV.* (2015).

¹³ Hughes, p. 319.

¹⁴ *Id* at 349.

strong, French, version of GI law, the geographical indication is protected from all similar commercial uses.¹⁵

Or if the logic were to follow, Appellants could shut down Appellee's record label COLOGNE AND COGNAC ENTERTAINMENT or at minimum prevent their trademark application from being registered. These results are absurd.

The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications¹⁶ ("Geneva Act") sets out the legal basis which would lead to the anomalies listed above, but the Geneva Act has never been ratified by the United States or any other common law country.¹⁷ The Geneva Act is relevant here because it sets out the position already taken by the United States government regarding the scope of protection geographic certifications should receive for unrelated goods. By declining to ratify the Geneva Act, United States policy has

¹⁵ *Id* at 348.

¹⁶ Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, October 31, 1958, as revised, July 14, 1967, 923 U.N.T.S. 205 [hereinafter Lisbon Agreement], www.wipo.int/treaties/en/text.jsp?file_id=285856/; World Intellectual Prop. Org. [WIPO], Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications and Regulations under the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, WIPO Document LI/DC/19 (May 20, 2015), [hereinafter Geneva Act], <https://www.wipo.int/publications/en/details.jsp?id=3983>.

¹⁷ See list of signatories WIPO-Administered Treaties, Contracting Parties, Lisbon Agreement, Geneva Act (2015), https://www.wipo.int/wipolex/en/treaties/ShowResults?search_what=A&act_id=5. Last accessed July 10, 2023.

been decided and effectively negates the arguments raised here that geographic certifications could be used to prevent the Applicant's trademark application from achieving registration. From Article 11 of the Geneva Act:

Protection in Respect of Registered Appellations of Origin and Geographical Indications

(1) [Content of Protection] Subject to the provisions of this Act, in respect of a registered appellation of origin or a registered geographical indication, each Contracting Party shall provide the legal means to prevent:

(a) use of the appellation of origin or the geographical indication

(i) ... (ii) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the geographical indication, and would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or geographical indication in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation.

Article 11(1)(a)(ii) quoted above would give geographic certification holders the right to enforce marks for goods “not of the same kind”; in other words, unrelated goods. Unmistakably, a record label and entertainment services are “not of the same kind” when compared to Appellants’ geographic certification of brandies. Appellee’s goods and services are unrelated to the cognac geographic certifications for the distilled spirit cognac.

Had the Geneva Act been adopted in the United States, there would exist a better legal basis to expand protection from spirits to categories of unrelated goods.

But the United States government decided not to ratify the Geneva Act. Even the USPTO has publicly renounced the treaty:

Another international treaty on the protection of GIs [geographic certifications] entered into force on February 26, 2020: the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications. The United States has no intention to join this treaty unless further amendments are introduced to accommodate a trademark system for protecting GIs.¹⁸

Not only has the United States not ratified the Geneva Act, the USPTO has said the United States has “no intention” to ratify the Geneva Act. With such strong, unequivocal language, the Amici and Appellants are asking the Court to overturn policy decisions made by the United States trade representatives and USPTO, despite years of negotiations on the scope of protection geographic certifications should receive.

Moreover, the “scope” of goods and services granted to geographic certifications was a major focus of negotiations during discussions leading to the Geneva Act. The Geneva Act is a de facto expansion by (and for) Lisbon members of GI protection to products other than wines and spirits – a measure sought by a number of WTO members, especially in the developing world.¹⁹

¹⁸ USPTO, IP Policy, Trademark Policy, *Geographical Indications*, <https://www.uspto.gov/ip-policy/trademark-policy/geographical-indications>, last accessed on July 9, 2023.

¹⁹ Gervais, *supra* at page 128.

Despite involved and extensive negotiations over many years, the United States has not agreed to “dilution plus” protection for geographical indications. Expanding the scope of the geographic certification for cognac to cover the Applicant’s record label, music production, entertainment services, and digital music would bypass what the United States government has already decided.

Notwithstanding the foregoing, there is an additional treaty implicated in this case, the WTO Agreement on TRIPS,²⁰ to which the United States is a signatory.²¹ As previously noted, cognac is a geographic certification²² and is therefore subject to Article 23(1) of the TRIPS, which states as follows:

“Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as ‘kind,’ ‘type,’ ‘style,’ ‘imitation’ or the like.”

²⁰ World Trade Organization, Agreement on Trade-Related Aspects of Intellectual Property Rights, https://www.wto.org/english/docs_e/legal_e/trips_e.htm#part1 last accessed on July 10, 2023.

²¹ World Trade Organization, Amendment of the TRIPS Agreement, https://www.wto.org/english/tratop_e/trips_e/amendment_e.htm.

²² Article 22 of TRIPS defines Geographical indications: “Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” *Bureau Nat’l Interprofessionnel Du Cognac v. Int’l Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COGNAC for distilled brandy from a region in France).

Article 23(1), as noted above, pertains to wines and spirits specifically, and explicitly limits the scope of protection for geographical certifications to goods that are wines and spirits and does not grant protection to unrelated goods. So-called “dilution plus” was negotiated and excluded from TRIPS.

The European Union’s original TRIPS proposal similarly provided that all GIs would be protected from “usurpation” *by any product or commercial use*—a standard drawn from French law and most easily understood by American lawyers as a dilution or “dilution plus” standard of protection for all GIs. In contrast, TRIPS Article 23(1) limits its confusion-less protection to uses within the wine or spirit product category (that is, it bars “a geographical indication identifying wines for wines not originating in the place indicated”).²³ (*emphasis added*).

Thus, the scope of a geographic certification mark pertaining to spirits is limited to enforcement against other spirit makers. The plain language of Article 23(1) and its negotiation history make clear geographic certifications were not intended to extend to unrelated products. In this case, the geographic certification cognac should not be extended to cover Appellee’s goods and services, and the Appellee’s application is to be put forth for registration immediately.

The issues discussed above have a long-negotiated history in international trade policy. The issue concerning the scope of protection granted to unrelated goods for a geographic certification has already been settled by the executive and

²³ Hughes, J., at page 319.

legislative branches. They have decided that it is not in the United States' interest to provide expanded coverage for unrelated goods to geographic certifications like cognac. While this Court must decide the present case, the prudent course is to deny the relief the Appellants seek, avoid a new and dangerous precedent, and let the governments continue to negotiate for the respective national interests.

The Appellants are government-regulated agencies.²⁴ Undoubtedly, the Appellants are familiar with the Geneva Act and TRIPS. There are also 12 Amici, all of them organizations representing certification mark holders.²⁵ It would be hard to believe that this level of attention would be lavished on the Appellee and its goods and services unless the Appellants and Amici believed there are substantial issues at stake.

Logically, there must be a reason for so much interest. Do the Amici believe that they can establish a precedent for geographic certifications generally, for all the products the Amici represent? Wouldn't this result in "dilution plus" coverage, contrary to the positions already adopted by the executive and legislative branches

²⁴ See Appellants' Principal Brief at pp. 12-13

²⁵ Scotch Whisky Association; Colombian Coffee Growers Federation; Confederation Générale Des Producteurs De Lait De Brebis Et Des Industriels De Roquefort; Consejo Regulador del Tequila, A.C.; Consorzio del Prosciutto di Parma; Distilled Spirits Council of the United States, Inc.; Federation of the Swiss Watch Industry FH; Irish Whiskey Association; Kentucky Distillers' Association; Napa Valley Vintners; and Organization for an International Geographical Indications Network. Nine of the twelve Amici appear to represent origins outside the United States.

of the United States government, acting pursuant to their constitutional authority?²⁶

The record before this Court is narrow and limited to the facts presented to the Board.

Is this the correct forum to grant expanded goods protection, given the complex international trade and political issues regarding geographic certification marks which further implicate trade relations between the United States and countries such as France, Scotland, and Switzerland? Do the Appellants believe they can prevail over a weaker and underfunded adversary?²⁷

We can only speculate, but much time went into coordinating an *amicus* brief of twelve (12) international trade organizations from multiple geographies and industries. The well-coordinated effort only highlights the significance of the anticipated ruling. This Court should maintain the legal status quo, respect United States trade policies, and deny the Amici and Appellants' attempts to expand a geographic certification mark for "cognac" to unrelated goods like record labels and entertainment services.

²⁶ U.S. Const. art. I § I; art. II § 1; art. III § I.

²⁷ Mr. Travis Davis, sole owner of the Appellee, is full time police officer in Newark, New Jersey, and part time recording artist and music producer.

CONCLUSION

For the foregoing reasons, the Appellee respectfully requests that this Court to sustain the Board's decision in full and allow the Appellee's trademark application to proceed to registration without impediment.

Respectfully submitted,

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Dated: July 12, 2023

CERTIFICATE OF SERVICE

I hereby certify that on this 12 day of July 2023, I caused this Brief of Appellee to be filed electronically with the Clerk of the Court 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/ James Klobucar, Esq.

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitation of Federal Rules of Appellate Procedure 32(a)(7)(B). The brief contains 10916 words. 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.

Dated: July 12, 2023

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