

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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**REPLY BRIEF OF APPELLANTS**

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## INTRODUCTION

In its response brief, Applicant concedes multiple critical errors by the Board and simply ignores others. In addressing Opposers' likelihood of confusion claim, Applicant concedes that the proper test to evaluate fame of a certification mark is the public's awareness of the mark as a geographical indication, but as the dissent below pointed out, that is not the test the TTAB majority applied. In light of the majority's reliance on a concededly inapplicable legal test of fame and fame's status as the "dominant factor" in analyzing a likelihood-of-confusion claim, this Court—on this ground alone—can and should reverse the Board's dismissal of Opposers' confusion claim. Further concessions by Applicant underscore the majority's errors in analyzing the other "key" confusion factors, reinforcing the necessity of reversal on that claim.

As for Opposers' dilution claim, Applicant simply ignores this Court's uniform precedents rejecting the type of "element-by-element" pleading standard erroneously applied by the Board in *sua sponte* dismissing the claim; rather, Applicant responds only with *TTAB* decisions that apply the standard of *proof* of dilution, not the appropriate pleading standard. Manifestly, this Court's decisions control and require reversal of the Board's dismissal of the dilution claim under Federal Rule of Civil Procedure 12(b)(6). And because the majority's holding in the alternative, finding no fame for dilution purposes, employed the same flawed test of



fame used in its confusion analysis—which Applicant now concedes is *inapplicable*—that holding also must be reversed.

Applicant’s other arguments against reversal—including its strawman argument that the *amici curiae* and Opposers seek to broaden existing legal protections for geographical indications as to “unrelated goods”—reflect a gross misunderstanding of both Opposers’ position and the protections afforded certification marks under existing U.S. trademark law and international agreements.

## **ARGUMENT**

### **I. APPLICANT’S CONCESSIONS AND UNSUPPORTED ARGUMENTS REINFORCE THE NEED FOR REVERSAL OF THE MAJORITY’S ERROR-PLAGUED HOLDING REGARDING THE LIKELIHOOD OF CONFUSION**

#### **A. Applicant’s Brief Highlights the Majority’s Multiple Errors In Analyzing the Fame Factor**

While Applicant did not contest COGNAC’s famousness for likelihood-of-confusion purposes before the Board, *see* Appx1179-Appx1181, Applicant now purports to endorse the majority’s finding that the COGNAC mark is not famous. Yet Applicant underscores the signal error in that finding by conceding that a certification mark’s fame depends, not on recognition of the mark’s “certification status” (as the majority said), but on the mark’s renown as an indication of regional origin. Resp. 18. Because the majority rendered its finding based on a *concededly* inapplicable test for fame, this Court can and should reverse on this ground alone. As for Applicant’s contention that the majority was correct to consider the vast sales

of COGNAC products “irrelevant” to the certification mark’s fame (Resp. 6), Applicant’s cited authority does not support disregarding such sales. Indeed, to do so contravenes settled law. Finally, Applicant attempts to bolster the majority’s finding that the COGNAC mark is of average strength by arguing that, under the Lanham Act, a common-law certification mark of regional origin can never be inherently distinctive. That argument simply misreads the statute and, again, is at odds with settled law. This Court must vacate the majority’s finding as to fame and—given fame’s undisputed dominant role in the analysis of likelihood-of-confusion claim (*see* Resp. 19)—this Court can and should reverse the Board’s decision on likelihood of confusion on that basis alone.

**1. *Applicant Concedes that the Fame of the COGNAC Mark Does Not Require Public Awareness of the Mark’s “Certification Status”***

The majority applied the wrong legal standard for fame by requiring Opposers to prove that the COGNAC mark is famous “for conveying the message that the goods are certified by Opposers as to regional origin and meeting the prescribed qualities”—*i.e.*, that the mark is famous for its “certification status.” Appx23; Op. Br. 36. Under settled law, a certification mark of regional origin, or “CMRO,” need only be known by consumers “as an indication of a particular regional origin.” *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) (“[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.”); *accord, e.g.*, TMEP § 1306.05(c) (“Consumers need not be expressly aware of the certification purpose of a designation.”).

Applicant *concedes* this point. Resp. 18. And while Applicant airily insists that the majority correctly evaluated “whether the public understands that goods bearing the trademark come only from the region named in the trademark,” and contends that the decision on fame “did not hinge on whether there is ‘consumer awareness of certification status,’” *id.*, Applicant points to nothing in the decision to back up that reading of the decision, and it is contradicted by the majority’s own words. *E.g.*, Appx22-Appx23 (“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. . . . [I]t is difficult to extrapolate from the evidence when it comes to measuring the level of consumer awareness for *the goods’ certification status*”) (emphasis added). Indeed, a focal point of the dissent was *precisely* the majority’s erroneous framing of fame as hinging on whether there is “consumer awareness of certification status.” *See, e.g.*, Appx43. Given the “dominant” role fame plays in the *Dupont* analysis—another

point on which Opposers and Applicant agree, *see* Op Br. 31 (citing cases); Resp. 19—the majority’s reliance on a concededly inapplicable legal test for fame alone merits reversal.

**2. *Applicant Identifies No Support for its Categorical Exclusion of Co-Branded Sales of Certified COGNAC Products from Evidence of Fame***

Like the majority, Applicant subscribes to what the dissent aptly termed an unsupported and erroneous “either/or” logic, under which a finding of fame is precluded “if a brandy manufacturer’s famous trademark is applied to a bottle also labeled as certified COGNAC.” *See* Appx59. Indeed, Applicant, while not disputing the vast sales of certified COGNAC products in this country (some 800 million bottles just in the period 2007-2019), goes so far as to declare those sales simply “irrelevant to this proceeding.” Resp. 6; *id.* at 16-21; Op. Br. 15; Appx112.

Like the majority, Applicant identifies no support in the Lanham Act or case law for the categorical disregard of sales of certified products co-branded with a famous mark. In fact, that approach is clearly contrary to decisions of this Court and others, as well as the Board itself, treating evidence of the volume of sales “of the goods traveling under the mark” as highly relevant to a determination of fame.<sup>1</sup> *Bose*

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<sup>1</sup> Applicant’s attempt to leverage *Bose* to support its categorical rule is unsuccessful. Resp. 16, 19. First, the Federal Circuit found that the product marks in *Bose* (to which Applicant attempts to analogize the COGNAC mark) were famous despite co-branding, including given the “vast number of purchases that have been made of the marked products,” specifically 200,000 annual units (which is far outpaced by the

*Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (collecting cases); *see also, e.g., In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (identifying factor as “fame of the prior mark (*sales, advertising, length of use*)”) (emphasis added); *Bureau Nat’l Interprofessionnel Du Cognac v. Enovation Brands, Inc.*, No. 91242020, 2020 WL 1528535, at \*5 (T.T.A.B. Mar. 13, 2020) (measuring commercial fame of a CMRO through “volume of sales and advertising expenditures of the goods sold under the mark”); *Nat’l Pork Bd. & Nat’l Pork Producers Council v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479, 1486-87, 95 (T.T.A.B. June 11, 2010) (finding THE OTHER WHITE MEAT service mark to be famous, including based on “substantial third-party advertising of the mark [that] has taken place through cross-promotional and co-branded activities”); *Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 U.S.P.Q.2d 1555, 1560 (T.T.A.B. 2007) (finding RATED R certification mark to be famous when it is applied on “all movies so rated” over 40 years).

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43-102 million bottles of COGNAC products sold per year). *Bose*, 293 F.3d at 1372, 1375. Second, contrary to Applicant’s analogy, the “product marks” are not akin to the COGNAC mark, but instead the brand marks of particular COGNAC houses, like COURVOSIER and HENNESSY, which are applied to a subset of the larger whole, which are all labeled as COGNAC. Thus, *Bose’s* caution about whether a product mark possesses a separate trademark significance than a famous house mark, does not apply to the COGNAC mark. Even if it did, the undisputed record evidence shows consumer awareness of COGNAC through sales and advertising that is not attributable to a single famous brand mark. *See, e.g.,* Appx112-Appx114; Appx214-487, Appx587-Appx599, Appx624-Appx649; Appx728-Appx1020.

To disregard sales of certified goods on the ground that the goods also bear individual trademarks would make it difficult, if not impossible, for any certification mark to qualify as famous because by statute, certification marks may *only* be applied to the goods of “a person *other* than its owner.” 15 U.S.C. § 1127. Thus, certification marks virtually *always* accompany another’s brand name. *See, e.g., Midwest Plastic Fabricators v. Underwriters Lab’ys Inc.*, 906 F.2d 1568, 1571-72 (Fed. Cir. 1990); *Consol. Dairy Prods. Co. v. Gildener & Schimmel Inc.*, 101 U.S.P.Q. 465, 467 (Comm’r Pat.1954).

Moreover, the presence of a geographic certification mark on a label (think “FLORIDA ORANGES” or “IDAHO POTATOES”) may be more important to the consumer than the individual brand of a product. *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.”).

That is precisely the situation here. Contrary to Applicant’s evidence-free assertion that COGNAC is riding “the coattails of a famous (or more visible) cognac house mark and/or certified cognac product mark,” Resp. 19, the reverse is demonstrably the case: *hundreds* of different brand names (a few famous, but many not) bear the COGNAC mark. *See Appx105* (noting there are 300 Cognac houses). The COGNAC certification mark is the unifying factor, present for every cited sale

across these brands, including brands like Hennessy that Applicant admits are well known. Thus, these co-branded sales evidence (rather than preclude) the COGNAC mark's commercial strength.<sup>2</sup>

Finally, while each case must be decided on its facts, Applicant is simply wrong in asserting that Opposers “have not provided *any* decision that shows its common law certification mark is a famous mark.” Resp. 17. In fact, Opposers cited multiple decisions, including one by a unanimous panel of the Board that recognized COGNAC's fame and strength just a year earlier on a similar factual record. *See Enovation Brands*, 2020 WL 1528535 at \*4, \*8 (finding that the “COGNAC certification mark falls on the very strong end of the fame spectrum” 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); *see also, e.g., Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 U.S.P.Q.2d 1610, 1614 (T.T.A.B. 1988) (remarking on “the renown of ‘COGNAC’ brandy” and noting that

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<sup>2</sup> In reliance on *Kuppenheimer & Co. v. Kayser-Roth Corp.*, 326 F.2d 820, 822 (CPA 1964), Applicant asserts that the COGNAC mark and brand name are too integrated to have “distinct commercial impressions.” However, *Kuppenheimer* provides no support for Applicant's arguments. It concerns the similarity of the marks, not fame. Additionally, *Kuppenheimer* concerned a composite mark, which combined the terms “Kuppenheinmer” and “Suppants” so that the “pp” formed part of both words. Applicant identifies no such composite mark here, nor explains how the COGNAC mark is part of an integrated display on co-branded products.

“[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”); *Otard, Inc., v. Italian Swiss Colony*, 141 F.2d 706, 708 (C.C.P.A. 1944) (noting that Americans have appreciated COGNAC as “a superior brandy” for “several hundred years”). Assessed under proper legal standards and given the massive sales of certified COGNAC products the voluminous un rebutted evidence, the COGNAC mark plainly qualifies as a famous mark, as these prior decisions underscore.<sup>3</sup>

**3. *Applicant Misconstrues the Lanham Act and Precedent in Arguing that the COGNAC Mark Is Not Inherently Distinctive or Entitled to a Broad Scope of Protection***

Apparently misreading Section 7 of the Lanham Act and the *Tea Board* decision, Applicant incorrectly asserts that only registered marks can be inherently distinctive and that common law certification marks like COGNAC cannot be. Resp.

14. Applicant confuses the *fact* of inherent distinctiveness (which does not depend

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<sup>3</sup> As for all the other record evidence showing the fame of the COGNAC mark summarized in Opposers’ opening brief—including ubiquitous appearances of the mark in bars, restaurants, liquor stores, books, magazines, newspapers, television, and the Internet (*see* Op. Br. 12-20, 34 (citing *e.g.*, Appx111-Appx115)), Applicant largely is silent, except to suggest, falsely, that the word “cognac” is “nowhere to be seen” in the “headlines.” Resp. 21. In fact, a large number of the headlines of record materials explicitly reference COGNAC, including *Cognac’s Journey from Aristocratic Tipple to Hip-Hop Star* (Appx734); *Cognac and Hip Hop: Brand Names and Big Stars* (Appx750); *Cognac Shares a Long Tradition with Rap Music and Its Artists* (Appx829); *5 Cognac Trends You Should Keep an Eye On* (Appx970); *Cognac’s Streak Continues* (Appx860).



on registration) with the *presumption* of inherent distinctiveness (which registration confers). *See Tea Bd. of India v. Republic of Tea, Inc.*, 80 U.S.P.Q.2d (BNA) 1881, 1899 (T.T.A.B. 2006) (“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.”). Neither Section 7 of the Lanham Act nor *Tea Board* precludes common law marks from inherent distinctiveness. *See also, e.g., Bertini v. Apple Inc.*, 63 F.4th 1373, 1376 (Fed. Cir. 2023) (noting Board’s finding that opposer’s “common law mark APPLE JAZZ is inherently distinctive” was undisputed on appeal); *Edge Sys. LLC v. Aguila*, 635 F. App’x 897, 905 (Fed. Cir. 2015) (explaining ownership of a common law mark requires *inter alia* either inherent distinctiveness or secondary meaning). Indeed, opposer in *Tea Board* had a *common law mark* and an application pending, but no federally registered mark, for DARJEELING, and the Board determined that DARJEELING was “inherently distinctive as a certification mark indicating geographic origin as it inherently identifies the geographic source of the tea” and consequently afforded DARJEELING “greater protection.” 80 U.S.P.Q.2d at 1899. Likewise, as a CMRO, COGNAC is inherently distinctive and entitled to broad protection. *See id.*; Appx55.

Applicant also wrongly asserts that, even if inherently distinctive, the COGNAC mark is thereby entitled only to “an intermediate scope of protection.”

Resp. 15. Applicant (like the majority) cites *Bell’s Brewery*, but that case simply accorded inherently distinctive marks “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340, 1347 (T.T.A.B. 2017) (emphasis added). Under the settled precedents of this Court and others, the “normal” scope of protection to which inherently distinctive marks—including COGNAC—are entitled is a *broad* scope of protection, covering a wider range of goods and services than otherwise would be in play. *See, e.g., Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1339 (Fed. Cir. 2004); *Grubbs v. Sheakley Grp., Inc.*, 807 F.3d 785, 795 (6th Cir. 2015); *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141-42 (9th Cir. 2002). As a mark that is not only famous, but also inherently distinctive, COGNAC is entitled to a broad scope of protection. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011); *Nautilus*, 372 F.3d at 1339; *Entrepreneur Media*, 279 F.3d at 1141.

**B. Because the Majority Cited No Evidence of the Marks’ Different Connotations and Because Applicant Now Concedes that the Marks Have the *Same* Connotation, the Majority’s Finding that the Marks are Dissimilar Must Be Reversed**

Applicant does not deny that 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), and that “[a]s a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls,” *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992). Op. Br. 43; *see* Resp. 22. Applicant also agrees that a comparison of marks for similarity entails consideration of their “appearance, sound, connotation, and commercial impression.” *DuPont*, 476 F.2d at 1361; Op. Br. 43; Resp. 22.

Applicant puzzlingly—and wrongly—asserts that Opposers failed to address the similarity of the parties’ marks in appearance. Resp. 10-11, 23-24. In fact, as discussed in some detail in Opposers’ opening brief, Applicant’s mark *incorporates the entire COGNAC mark as is*, along with an image of a Cognac bottle, and was so designed precisely to trigger an association with the COGNAC mark and certified products in the minds of consumers. *See* Op. Br. 43-54; Appx655, Appx661; Appx665-Appx666. Applicant does not disagree that, under established precedent, such facts normally would establish a *high* degree of similarity.<sup>4</sup> *See, e.g.*, 4 J.

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<sup>4</sup> Applicant mistakenly cites the Board’s decision in *In re Thor Tech, Inc.* for the proposition that “[s]imilarity . . . 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.” Resp. 24. To the contrary, the Board there and elsewhere has stressed that decision “any *one*” of those elements “may be critical in finding the marks to be similar” in a given case. *In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1635 (T.T.A.B. 2009) (emphasis added); *accord, e.g., In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988); TMEP § 1207.01(b)(vi)(C) (“[T]aking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar.”). This Court’s predecessor agreed: “It is sufficient if the similarity in either

Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:50 (5th ed. 2023) (“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.”) (collecting cases).

Instead, Applicant, like the majority, pivots to the marks’ respective connotations. Resp. 23; *see* Appx24. Initially, Applicant purports to agree with the majority’s finding that Applicant’s mark “conjures a different connotation” from Opposers’ mark. Resp. 23; *see* Appx24. Applicant, however, does not solve the fatal defect with that finding—that *the majority cited no evidence of a difference in connotation, and the record contains none. See also* Appx41; *see, e.g., In re St. Helena Hosp.*, 774 F.3d 747, 755 (Fed. Cir. 2013) (requiring that a factual finding made without citation of evidence be set aside). While vaguely assuring that the majority “fully cites the evidence which it relies on” to distinguish the marks’ connotations, Resp. 23, Applicant points to no place in the majority’s opinion that *actually* cites any evidence of a different connotation, and Applicant, for its part, supplies no cites. Nor is there anything in the record *to* cite. *See* Appx41. On that basis alone, the finding should be set aside.

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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).

Applicant then compounds the evidentiary problem with the majority's finding by expressly *contradicting* it, admitting the record evidence actually shows that the COGNAC mark evokes the meanings of "expensive," "civilized," and "upper class," and that "[t]hese are the words at the forefront of connotation of Appellee's applied-for mark." Resp. 23. In short, Applicant expressly concedes that the two marks have the *same* connotation. *Id.* Of course, that same connotation is no coincidence, but reflects Applicant's admitted *intent* in incorporating the COGNAC mark to evoke the distilled spirit. *See* Appx655, Appx661, Appx665-Appx666; *see also* Appx24.

Because (i) Applicant's mark entirely and prominently incorporates the COGNAC mark, (ii) Applicant has now admitted the marks have the same connotation, and (iii) the majority cited no evidence to support its finding of a difference in the marks' connotations, there is no plausible basis to sustain the majority's finding that the marks are dissimilar.

**C. Applicant Cannot Plausibly Excuse as a Mere "Typo" the Majority's Clear Error in Analyzing the Relatedness of Goods and Services**

In yet another critical concession, Applicant agrees that, in a case predicated on a certification mark, the "key" factor of the relatedness of goods or services focuses on the "*goods of Opposers' certified users*," and not Opposers' service of certifying those goods. Resp. 27-28 (emphasis added); *see, e.g., In re Accelerate*

*s.a.l.*, 101 U.S.P.Q.2d 2047, 2049 (T.T.A.B. 2012); *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. Applicant also effectively concedes that the majority erred in framing the issue instead as whether “consumers will mistakenly believe that *Opposers* are affiliated with any of [Applicant’s] goods or services” and in reasoning that consumers were unlikely to form such a belief because *Opposers* do not “provide[] musical sound recordings or any services related to the music industry.” Appx29. Applicant implausibly suggests that this error was a mere “typo,” Resp. 28, but the majority maintained its flawed approach in the face of specific criticism by the dissent. Appx42-Appx53.

When the comparison is drawn correctly between the goods and services of Applicant and the “goods of *Opposers*’ certified users,” as Applicant concedes it should be, Resp. 27-28, the undisputed facts of record dictate the outcome: there is a high degree of relatedness. For example, Applicant recognizes the myriad advertising deals and partnerships for certified COGNAC products launched by artists and record labels. Resp. 26; Appx44-Appx52; Op. Br. 51-52. Applicant concedes that the prominent references to certified COGNAC products in music, “not unlike” that produced by Applicant, have contributed to the sales of those products. Resp. 5. Applicant admits that articles on COGNAC submitted by *Opposers* in evidence “are directed at least in part” to music, which is the context for Applicant’s goods and referenced by inclusion of the COGNAC mark. Resp. 23.

Applicant also does not dispute that, where (as here) non-competitive goods are at issue (alcohol versus music), the relevant question is “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,*” or in this case, the producer of certified COGNAC goods. *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1355 (Fed. Cir. 2001) (emphasis added); *see, e.g., Recot, Inc. v. Becton*, 214 F.3d 1322, 1328-29 (Fed. Cir. 2000) (criticizing board’s disregard of evidence pertinent to whether “a consumer would likely think that FRITO–LAY *produced, sponsored, or licensed its mark* for use for pet snack products” (emphasis added)); *Tuxedo Monopoly, Inc. v. General Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336 (C.C.P.A. 1981) (finding of likelihood of confusion because “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”).<sup>5</sup>

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<sup>5</sup> Applicant attempts to distinguish *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1336 (C.C.P.A. 1981) on the ground that the court found the MONOPOLY mark to be famous. However, fame was not dispositive in the case. The key inquiry was whether the public seeing the MONOPOLY mark on other goods (like novelty T-shirts) would be likely to believe that the MONOPOLY-mark owner had “expanded its use of the mark” for such items. *See also In re Thor Tech, Inc.*, 90 U.S.P.Q.2d at 1634 (explaining that goods need not “be identical or even competitive to support a finding of likelihood of confusion” but that they only

As for Applicant’s assertion 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,” Applicant is partially correct: Opposers have not sought to enforce rights in the COGNAC mark against musical artists merely because they refer to the mark in their songs.<sup>6</sup> Of course, such a use is beside the point. *See, e.g., Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 153-159 (2023) (contrasting a third-party’s artistic and expressive use of another’s mark with use “as a trademark”). The issue here is that Applicant wishes to register a mark incorporating the COGNAC mark “to designate the source of its own goods,” and “[t]hat kind of use falls within the heartland of trademark law, and does not receive special First Amendment protection.” *Jack Daniel’s*, 599 U.S. at 145.

By comparing goods and services under a legal standard that Applicant concedes is *inapplicable*, and by disregarding the relevant undisputed facts, the

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need to be “related in some manner” or marketed in a way that give rise to confusion as to source or association).

<sup>6</sup> Applicant is simply wrong in suggesting that Opposers have failed to enforce the COGNAC certification mark against third-party uses “related to the beverage cognac as well as unrelated uses.” Resp. 4. As the record shows, Opposers have exercised considerable diligence in such enforcement efforts. *See, e.g., Appx110; Institut Nat’l des Appellations d’Origine*, 47 U.S.P.Q.2d at 1876 (opposing CANADIAN MIST AND COGNAC).



majority plainly erred. Its finding that the goods and services at issue are unrelated must be set aside.

**D. Especially In Light of Applicant’s Multiple Concessions, the Relevant DuPont Factors, Individually and Together, Strongly Weighs in Favor of a Finding of Likelihood of Confusion, Necessitating Reversal.**

Applying the legal standards that Applicant concedes should be applied to each “key” *DuPont* factor, the majority’s determination of each of them was clearly wrong. Each such error on these key factors for likelihood of confusion separately justifies reversal. And taken together, they overwhelmingly necessitate that outcome—even before application of the undisputed rule that any doubt as to the likelihood of confusion must be resolved “against the newcomer.” *Kenner Parker Toys Inc.*, 963 F.2d at 355.

Applicant does not disagree that, because likelihood of confusion is a question of law, this Court may simply hold that a likelihood of confusion exists, sustain the opposition, and deny Applicant registration of its mark. *See, e.g., Bose*, 293 F.3d at 1378. At a minimum, however, this Court should remand for the TTAB to re-evaluate the likelihood-of-confusion factors under the correct, and largely undisputed, legal standards for certification marks. *See, e.g., Recot, Inc.*, 214 F.3d at 1327.

## **II. CONTROLLING PRECEDENT AND APPLICANT’S CONCESSION REGARDING THE FAME STANDARD REQUIRE REVERSAL OF THE BOARD’S RULING ON OPPOSER’S DILUTION CLAIM**

### **A. Applicant Ignores this Court’s Repeated Rejection of Element-by-Element Pleading Requirements**

Seeking to support the Board’s *sua sponte* dismissal of Opposers’ dilution claim on the basis of an alleged pleading deficiency, Applicant unaccountably asserts it is “without dispute” that a dilution claim “*must* sufficiently plead that ‘the defendant’s use of its mark began after the plaintiff’s mark became famous.’” On the contrary, Opposers vigorously contested that very proposition in their opening brief, *see* Op. Br. 56-60, citing multiple decisions by this Court stressing that the Federal Rules of Civil Procedure (and thus, by extension, the Board’s rules, 37 C.F.R. § 2.116) 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) (emphasis added); *see also* Op. Br. 57 (citing *e.g.*, *Erickson v. Pardus*, 551 U.S. 89, 93 (2007) (per curiam); *Bot M8 LLC v. Sony Corp. of Am.*, 4 F.4th 1342, 1352 (Fed. Cir. 2021)).

Applicant’s response to these controlling decisions is to ignore them. Applicant thereby effectively concedes that, under those decisions, the Board’s holding was error.

As for the cases that Applicant does discuss, they are all inapposite, as they either address only the elements of *proof* for dilution or mistakenly incorporate those

elements wholesale as the pleading standard. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012) (identifying elements to prove for dilution claim); *Toro Co. v. Torohead, Inc.*, 61 U.S.P.Q.2d (BNA) 1164, 1173-75 (T.T.A.B. 2001) (same); *see also Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540, 1542 (T.T.A.B. 2001) (incorporating element of proof from *Toro* into the pleading standard); *Luster Prods. Inc. v. Van Zandt*, 104 U.S.P.Q.2d 1877, n.6 (T.T.A.B. 2012) (citing, in *dicta*, *Trek's* pleading standard, incorporating element of proof from *Toro*).<sup>7</sup>

Applicant, like the majority, quotes the Board's statement in *Fair Indigo* that "[t]he elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice." *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 (T.T.A.B. 2007); *see* Resp. 30. But both Applicant and the majority ignore that the Board there *rejected* the defendant's

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<sup>7</sup> Likewise, in *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 U.S.P.Q.2d (BNA) 1645, 1650-51 (T.T.A.B. 2010), the Board (1) determined that opposer had sufficiently pled dilution for the intent-to-use applications, because opposer asserted that its marks "became famous prior to the date [a]pplicant filed the applications" and (2) deemed that opposer had sufficiently pled dilution for the use-based applications because Applicant's first use is subject to proof at trial and Applicant did not move to strike the dilution claim, even though opposer had not pled fame prior to Applicant's first use. *Citigroup*, 94 U.S.P.Q.2d at 1649-50. Thus, Applicant's characterization that the pleading in *Citigroup* "was met with the same deficiency" is inaccurate. Resp. 30. Moreover, *Citigroup* then continued to consider the issue of whether opposer's mark became famous prior to applicant's use on the merits. *Citigroup*, 94 U.S.P.Q.2d at 1665.

argument for an element-by-element pleading requirement, considering it a “misunderstanding of the rules regarding notice pleading” because it confused the “requirements for pleading” an issue with the “requirements for proving priority at trial or summary judgment.” *Id.* Moreover, Applicant’s insinuation that it lacked “fair notice” of the claim is belied by the fact that Applicant did not challenge the sufficiency of Opposers’ pleading below, but addressed the merits of the claim in its brief to the Board.

Finally, Applicant misses the point of Opposers’ alternative argument that, even under the Board’s unduly stringent pleading standard, Opposers’ allegation that “COGNAC is a famous designation for brandy” with “extensive goodwill and consumer recognition” that had been built up through Opposers’ efforts “over many years” sufficed. Appx71-Appx72. As Opposers explained in their opening brief, the Notice of Opposition was filed on August 28, 2019, only *five months* after the constructive use date (the application filing date) of March 7, 2019. Fame alleged to have lasted “many years” as of the filing of the pleading *necessarily arose more than five months earlier*. See, e.g., *Bot M8 LLC*, 4 F.4th at 1352 (finding claims properly pled if they “allow[] the court to draw the reasonable inference that the defendant is liable”); *Citigroup*, 94 U.S.P.Q.2d at 1649-50. It was not essential that Opposers use any “magic words” to convey that fact, contrary to Applicant’s suggestion (Resp. 31). *Fair Indigo*, 85 U.S.P.Q.2d at 1538. Viewing the allegation

“in the light most favorable” to the complaining party pursuant to Rule 12(b)(6), the reference to “many years” satisfies any reasonable pleading requirement. *Bot M8 LLC*, 4 F.4th at 1353.

**B. In Its Alternative Ruling on the Merits of the Dilution Claim, the Majority Relied on the Same Test of Famousness that Applicant Concedes Is Inapplicable**

As discussed above, Applicant concedes that the fame of a certification mark should be measured by its renown as an indication of regional origin, and not for its “certification function.” *Supra* Section I.A. The majority relied on that concededly inapplicable test of fame, not only in its likelihood-of-confusion analysis, but also in deciding the merits of Opposers’ dilution claim. The majority’s dismissal of that claim can and should be vacated on this basis as well.

**III. APPLICANT’S PROPOSED *PER SE* RULE FOR GEOGRAPHICAL INDICATIONS AND “UNRELATED GOODS” CONFLICTS WITH THE LANHAM ACT AND THE TRIPS AGREEMENT**

In the final portion of its brief, Applicant mistakenly contends that Opposers and the eleven *amici curiae* seek “broader protection for unrelated goods” for CMROs than ordinary trademarks receive. Resp. 33. Neither Opposers nor *amici* advocate for such a regime, but they do criticize the majority’s decision below because *it* departs from settled law and the Lanham Act, creating new legal standards that accord *less* protection against confusion and dilution for certification marks than is afforded ordinary trademarks.

Ironically, *Applicant* now argues for an unprecedented (and even more extreme) new rule that would protect a CMRO against confusion or dilution only if the other party's mark is used for goods identical to the certified goods. Resp. 39. In all other scenarios—which Applicant lumps together under the misnomer “unrelated goods”—such a claim would be *per se* barred. Thus, under Applicant's proposed rule, “a geographic certification mark pertaining to spirits is limited to enforcement against other spirit makers.” *Id.*

Applicant did not argue for such a rule below, and the majority, for all its errors, did not go that far either. In any event, Applicant's proposed *per se* rule starkly conflicts with the Lanham Act and the TRIPS Agreement,<sup>8</sup> which Applicant mistakenly believes demands such a rule.

Applicant does not dispute that, under current U.S. law, the test for likelihood of confusion (specifically, the *DuPont* analysis) is the same for trademarks and certification marks, including CMROs. Op. Br. 30; Appx13; *see* Resp. 13-28; *see also, e.g., Institut Nat'l des Appellations d'Origine*, 47 U.S.P.Q.2d at 1890 (rejecting a “different and more limited likelihood of confusion analysis” for certification marks and explaining that “Section 2(d) does not distinguish between certification marks, on the one hand, and trademarks and service marks on the other”). The

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<sup>8</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS].

*DuPont* analysis considers relatedness of goods to be just one of many factors to consider in finding likelihood of confusion. *DuPont*, 476 F.2d at 1361. Necessarily, the “unrelatedness” of goods cannot, by itself, dictate the outcome on likelihood of confusion or there would be no occasion to consider any other *DuPont* factors. Likewise, Lanham Act protections against dilution *paradigmatically* apply in cases involving “unrelated goods.” 15 U.S.C. §§ 1063, 1125(c); *see, e.g., Jack Daniel’s*, 599 U.S. at 147 (requirements for dilution include similarity between the marks, but not relatedness of goods). Finally, Section 2(a) of the Lanham Act has, since 1996, also prohibited registration of a mark that consists of or comprises “a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods.” 15 U.S.C. § 1052(a). But that *extra* layer of protection available for certain CMROs only added to—and did not supersede—the preexisting confusion and dilution protections for all certification marks in cases involving identical, related, and unrelated goods.

Applicant not only ignores the Lanham Act, but also grossly misreads TRIPS as somehow supporting Applicant’s *per se* rule. To the contrary, TRIPS contemplates precisely the same protections currently embodied in the Lanham Act. In particular:

- TRIPS Article 16 mandates protection for all registered marks against unauthorized third-party use and attempted registration, under a likelihood-

of-confusion framework, and permits equal protection for all unregistered marks based on use.<sup>9</sup>

- TRIPS Article 22 requires member states to protect against the use or registration of a mark including or comprising a geographical indication that would mislead the public as to the “true place” or “geographic” origin of the good.
- TRIPS Article 23 concerns (and is entitled) “*Additional Protection for Geographical Indications for Wines and Spirits.*” TRIPS art. 23 (emphasis added). This provision mandates a limited *per se* bar to registration of marks for wines or spirits that incorporate a geographical indication for goods that are not from that indicated region. But it does not displace the baseline confusion-based protections for such marks already provided under Articles 16 and 22.<sup>10</sup>

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<sup>9</sup> Specifically, protection is required under Article 16 where:

- i. an “identical” mark is used for “identical” goods or services (indeed, a likelihood of confusion is presumed) (art. 16.1);
- ii. an “identical” or “similar” mark is used for “similar” goods or services, *and* a likelihood of confusion is shown (art. 16.1);
- iii. an “identical” or “similar” mark is used for goods or services that are not similar, *and* the owner of the senior mark shows that use of the junior mark would “indicate a connection between those goods or services” and the owner’s interests “are likely to be damaged by such use,” (art. 16.3).

<sup>10</sup> Applicants cited law review articles recognize the same. *See* Resp. 34, 37, 39; J. Hughes, *Champagne, Feta and Bourbon: The Spirited Debate About Geographical*



The last of these, Article 23, was in fact the impetus for the above-described Lanham Act amendment in 1996 adding an extra layer of trademark protection for wine and spirits geographical indications. *See* 15 U.S.C. § 1052(a); Hughes, *supra*, at 318 n.107. But while adopting that new provision, Congress made no other material changes to the Lanham Act pursuant to TRIPS, concluding that U.S. law—including the then-existing U.S. protections for registered and common law CMROs under the other provisions of the Lanham Act—otherwise already fully complied with the requirements of the agreement. *See, e.g.*, Pub. L. No. 103-465, Title V, §§ 521-523, 108 Stat. 4982 (1994); Geographical Indications, U.S. Pat. & Trademark Off., <https://www.uspto.gov/ip-policy/trademark-policy/geographical-indications> (last visited Sept. 11, 2023) [hereinafter USPTO Geographical Indications].

Applicant unaccountably converts TRIPS Article 23’s “*Additional Protection*” for geographical indications for wine and spirits (emphasis added) into the *exclusive* protection available for them, reading out the broader, confusion-based protections offered under Articles 16 and 22. This reading of TRIPS is manifestly

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*Indications*, 58 Hastings L.J. 299, 314, 317-18 (2006) (recognizing “Article 22 provides the ‘floor’ protection for all GIs [geographical indications]” and “patrols use of GIs that would mislead or deceive the consumer” while Article 23 “adds another layer of obligations in relation to wines and spirits”); D. Gervais, *Irreconcilable Differences? The Geneva Act of the Lisbon Agreement and the Common Law*, 53 Hous. L. Rev. 339, 343, 349 (2015) (recognizing the “dual layer of protection for GIs” under Article 22 and as to wines or spirits under Article 23).

incorrect—and is squarely refuted by Congress’s own implementation of the agreement in the Lanham Act. *See* Pub. L. No. 103-465, Title V, § 522, 108 Stat. 4982 (1994).

Applicant is equally confused about the Geneva Act’s content and the U.S. position on it. As one of Applicant’s cited sources summarizes, the Geneva Act aims to provide a higher level of protection for *all* GIs (not just those for wines and spirits) as to both related *and unrelated* goods in certain situations “without the need to show deception or confusion.” Gervais, *supra*, at 349. Contrary to Applicant’s confused account, the United States’ refusal to ratify the Geneva Act does not reflect a policy against protecting CMROs in cases involving “unrelated goods,” but instead reflects the U.S.’s commitment to the trademark system and a confusion-based standard for all marks except to the extent required by TRIPS Article 23 and Lanham Act § 2(a). *See* USPTO Geographical Indications, *supra* (explaining GIs are protected as “certification and collective marks indicating regional origin” and that the U.S. will not join the Geneva Act “unless further amendments are introduced to accommodate a trademark system for protecting GIs”); *see also* 15 U.S.C. § 1054.

### **CONCLUSION AND STATEMENT OF RELIEF SOUGHT**

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 remand for the Board's analysis of Opposers' likelihood of confusion and dilution claims under the correct legal standards.

Respectfully submitted,

*/s/ Peter M. Brody*

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Dated: September 12, 2023

## 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) and Federal Circuit Rule 32(b)(1). The brief contains 6,800 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2). 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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## CERTIFICATE OF SERVICE

On September 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.

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