



## “Classic” Case of Trademark Infringement? Top Tobacco and North Atlantic Operating Company Argue Whether CLASSIC CANADIAN and CLASSIC AMERICAN BLEND are Confusingly Similar

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*Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.* (TTAB Nov. 21, 2011) (available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91180231&pty=OPP&eno=14>) shows the very fluid application of facts to law in trademark cases, and therefore, that reasonable minds can differ. Top filed oppositions before the Trademark Trial and Appeal Board (the “Board”) to various trademark applications filed by North Atlantic for the mark CLASSIC AMERICAN BLEND in logo form and standard characters, and petitioned to cancel North Atlantic’s registration of ZIG ZAG CLASSIC AMERICAN BLEND. Top based its actions on a claim of likelihood of confusion with Top’s rights in and registration of CLASSIC CANADIAN. Both parties’ marks covered the same goods, namely, tobacco products.

The Board found CLASSIC CANADIAN and CLASSIC AMERICAN BLEND to be confusingly similar and ruled on the oppositions in Top’s favor. Given the extreme weakness of the marks, this ruling is somewhat mystifying. The Board did not consider CLASSIC CANADIAN and ZIG ZAG CLASSIC AMERICAN BLEND to be confusingly similar, however, and denied Top’s petition to cancel.

In the oppositions, the Board evaluated the *Dupont* likelihood of confusion factors. Most interesting is its evaluation of the similarity of the marks. The Board found, not surprisingly, that “[t]he record overwhelmingly establishes that the CLASSIC CANADIAN mark has little intrinsic distinctiveness.” As to “Classic,” Top’s own statements in the prosecution history for its CLASSIC CANADIAN registration were evidence, although not dispositive, that CLASSIC was suggestive of a “well-known” or “typical” type.



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In addition to finding Top's CLASSIC CANADIAN mark to be weak, the Board also agreed with North Atlantic that the parties' ten years of co-existence without actual confusion weighed in favor of a finding of no likelihood of confusion. However, the Board's agreement with North Atlantic in the oppositions ended here.

The Board was apparently swayed most by the exact identity of some of the parties' goods, noting that less similarity of marks is required for a finding of likelihood of confusion when marks are used on identical goods than would be required for a comparison of differing goods. It noted that CLASSIC CANADIAN and CLASSIC AMERICAN were "equally highly suggestive" of a style of tobacco (a finding that could easily have supported a conclusion that the marks were not likely to be confused). Thus, the Board found in Top's favor on the oppositions.

However, the Board found for North American on Top's petition to cancel ZIG ZAG CLASSIC AMERICAN BLEND, finding that inclusion of ZIG ZAG in North Atlantic's mark "may avoid likely confusion where the marks in their entireties convey significantly different commercial impressions or the matter common to the marks is so suggestive or weak that any source-indicating value it has is overwhelmed by the addition of an arbitrary, distinctive element." Top argued that ZIG ZAG CLASSIC AMERICAN BLEND actually created "reverse confusion," where the junior user's use overwhelms that of the senior user. In such circumstances, use of a house mark (like ZIG ZAG) is often held to increase, rather than diminish, confusion. However, the Board held that there was insufficient evidence that North Atlantic was a 'significantly larger or prominent newcomer' who had 'saturated the market' with the ZIG ZAG CLASSIC AMERICAN BLEND mark, to have caused reverse confusion.

In this author's opinion, confusion between these marks in the "real world" seems unlikely. Board proceedings, however, look primarily at the marks and descriptions of goods in the parties' registrations/applications. In this case, neither party relied on a survey, which may or may not have supported a finding of no confusion. Knowledge of the differences between federal court and Board practice, as well as an understanding of some rather arcane evidentiary rules, is required to effectively litigate a case before the Board.

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