

This Opinion is a
Precedent of the TTAB

Mailed: September 3, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cielo e Terra, S.p.A.

v.

Hoteles y Viñedos del Valle de Guadalupe S.A. de C.V.

Opposition No. 91287216

Susan Paik and James J. Bitetto of Tutunjian & Bitetto, P.C. for Cielo e Terra,
S.p.A.

Brandon M. Selinsky of Whitcomb, Selinsky P.C. for Hoteles y Viñedos del Valle de
Guadalupe S.A. de C.V.

Before Wellington, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Hoteles y Viñedos del Valle de Guadalupe S.A. de C.V. (“Applicant”) seeks
registration on the Principal Register of the standard-character mark O EL CIELO
VALLE DE GUADALUPE for “wine” in International Class 33.¹

¹ Application Serial No. 97425137 was filed on May 24, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claimed first use of the mark anywhere and first use of the mark in commerce at least as early as June 16, 2016. Applicant

Cielo e Terra, S.p.A. (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Opposer’s Registration No. 2384406 of the standard-character mark CIELO for wines.²

Opposer and Applicant have filed briefs.³ We sustain the opposition.

I. The Record

The record consists of (1) the pleadings;⁴ (2) the file history of the opposed application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1);⁵ (3) the Testimony Declaration of Pierpaolo Cielo, Opposer’s Vice President and Marketing & Export Manager, and Exhibits 1-10 thereto (“Cielo Declaration” or “Cielo Decl.”), 10 TTABVUE 2-338,⁶ and Opposer’s Notice of Reliance on Applicant’s

disclaimed the exclusive right to use VALLE DE GUADALUPE apart from the mark as shown, and translated the phrase EL CIELO VALLE DE GUADALUPE in the mark as “The sky of the valley of Guadalupe.”

² Registration No. 2384406 issued on September 12, 2000 and has been renewed. Cielo Decl. ¶ 17; Ex. 3 (10 TTABVUE 16, 242-46). Opposer translated its CIELO mark as “sky” or “heaven.” The mark is described as being in typeset words. “Prior to November 2, 2003, ‘standard character’ drawings were known as ‘typed’ drawings. A typed or typeset mark is the legal equivalent of a standard character mark.” *Heil Co. v. Tripleye GmbH*, No. 91277359, 2024 WL 4925901, at *26 n.121 (TTAB 2024) (citing *In re Vittera Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012)).

³ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer’s brief appears at 14 TTABVUE and Applicant’s brief appears at 15 TTABVUE.

⁴ The pleadings are Opposer’s Notice of Opposition, 1 TTABVUE, and Applicant’s Answer, 4 TTABVUE, in which Applicant denied the salient allegations in the Notice of Opposition.

⁵ Citations in this opinion to the file history of the opposed application are to pages in the downloadable .pdf version of the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

⁶ We will cite testimony and exhibits in the parties’ declarations by paragraph and exhibit numbers as well as by TTABVUE page numbers.

Disclosures and Discovery Responses, 11 TTABVUE 2-36; and (4) the Testimony Declaration of Gustavo Ortega Joaquin, Applicant's founder and Chief Executive Officer, and Exhibits A-D thereto ("Ortega Declaration" or "Ortega Decl."), 12 TTABVUE 2-105;⁷ and Applicant's First Notice of Reliance on official records of various third-party registrations. 13 TTABVUE 2-66.

II. The Parties and Their Marks

Opposer is an Italian corporation that operates a family-owned winery founded in 1908 by Giovanni Cielo in the Veneto region of Italy. Cielo Decl. ¶ 4 (10 TTABVUE 3). Opposer's witness Pierpaolo Cielo testified that "Opposer adopted the 'CIELO' mark as a continued reference to the Cielo family heritage and an homage to its origins as a family vineyard and winery." Cielo Decl. ¶ 5 (10 TTABVUE 4).

Opposer began sales of its CIELO wines in the United States in 1978. Cielo Decl. ¶ 6 (10 TTABVUE 4). Opposer registered its CIELO mark in a typed drawing for "wines" in 2000, and most recently renewed the registration in 2020. Cielo Decl. ¶ 17; Ex. 3 (10 TTABVUE 17, 242-46).

Opposer has engaged in multiple proceedings before the Board, and through those proceedings has prevented registration of the marks DOBLE CIELO for "alcoholic beverages except beers and distilled spirits;" SOL CIELO for "wine;"

⁷ The Ortega Declaration appears at the end of 12 TTABVUE, following almost 100 pages of exhibits. 12 TTABVUE 100, et seq. The better practice is to present the declaration first, followed by the exhibits. "Our citations to [Mr. Ortega's] trial testimony and the exhibits will first list the higher-numbered TTABVUE pages on which [his] testimony appears followed by the lower-numbered TTABVUE pages on which any referenced exhibits appear." *El Roblar Inv. Prop. LLC v. Roe*, No. 91272200, 2025 WL 2718983, at *2 n.12 (TTAB 2025).

CAPRICORNIUS EL CIELO for various alcoholic beverages, including “wine;”⁸ CIELO ROJO for “alcoholic beverages, except beer; distilled spirits; and distilled agave liquor;” BAJO EL CIELO for “distilled spirits;” BAJA EL CIELO for “distilled spirits;” CIELO for “distilled blue agave liquor; spirits; blended spirits; and distilled spirits;” and ALMA DEL CIELO (stylized) and design for “alcoholic beverages, except beers.” Cielo Decl. ¶ 19 (10 TTABVUE 16-20). At the time of trial, Opposer was also engaged in pending oppositions to registration of BLUE CIELO FARMS (in standard characters and in a composite mark) for “wine,” MISSION CIELO for “mezcal,” and FUEGO DEL CIELO for “distilled agave liquors.” Cielo Decl. ¶ 20 (10 TTABVUE 20-21). These opposed applications have since been withdrawn (in Class 33 or in their entirety) or abandoned in all three proceedings.⁹

Applicant “is a resort located in Baja California, Mexico, along the historic ‘Ruta del Vino’ or Mexican wine route.” Ortega Decl. ¶ 3 (12 TTABVUE 101). From 2016

⁸ In this proceeding, Opposer sought and obtained cancellation of Applicant’s Registration No. 4934913 following the entry of a default judgment against Applicant. Cielo Decl. ¶¶ 22-23; Exs. 6-7 (10 TTABVUE 20-21, 265-321).

⁹ The Board may take judicial notice of the status and disposition of other TTAB proceedings, at least where, as here, the record contains pertinent information regarding those proceedings. *Urock Network, LLC v. Sulpasso*, No. 92058974, 2015 WL 4658976, at *6 n.10 (TTAB 2015) (citing *Kraft, Inc. v. Balin*, No. 73075089, 1981 WL 48124, at *4 n.8 (TTAB 1981) (noting that “[w]e may take judicial notice of our own proceedings” and taking judicial notice of the abandonment of an application and the dismissal of an opposition)). Because significant time has passed between the time of trial and this decision, we take judicial notice regarding the status and disposition of the then-pending proceedings, namely, that the applications to register BLUE CIELO FARMS have been withdrawn in Class 33 and the oppositions have been dismissed without prejudice, 19-20 TTABVUE (Opp. No. 91290218), 26-27 TTABVUE (Opp. No. 91286876), that the opposition to the application to register MISSION CIELO has been sustained after the applicant withdrew its application without Opposer’s written consent, 16 TTABVUE (Opp. No. 91292273), and that judgment by default has been entered in the opposition to the application to register FUEGO DEL CIELO. 4-5 TTABVUE (Opp. No. 91296297).

until this opposition was commenced in 2023, Applicant sold wine in the United States under its O EL CIELO VALLE DE GUADALUPE mark. Ortega Decl. ¶ 4 (12 TTABVUE 101). As noted above, Applicant owned Registration No. 4934913 of the mark CAPICORNIOUS EL CIELO for various alcoholic beverages, but that registration was cancelled in 2021 in Cancellation No. 92076885 brought by Opposer. Applicant also owned Application Serial No. 88186765 to register the mark EL CIELO, which now appears to be abandoned. 11 TTABVUE 10 (Resp. to Int. No. 7).

III. Entitlement to a Statutory Cause of Action

“Entitlement to a statutory cause of action is an element of the plaintiff’s case in every inter partes proceeding.” *El Roblar*, 2025 WL 2718983, at *18 (quoting *Mystery Ranch, Ltd. v. Terminal Moraine Inc.*, No. 91250565, 2022 WL 17369425, at *6 (TTAB 2022) (cleaned up) (citing *Corcamore, LLC v. SMF, LLC*, 978 F.3d 1298, 1303-07 (Fed. Cir. 2020)). “Section 13 of the Trademark Act, 15 U.S.C. § 1063, ‘provides that ‘[a]ny person who believes that he would be damaged by the registration of a mark . . . may . . . file an opposition’ with the USPTO” *Id.* (quoting *Curtin v. United Trademark Holdings, Inc.*, 137 F.4th 1359, 1362 (Fed. Cir. 2025) (citation omitted), *cert. denied*, 2026 WL 1052056 (Apr. 20, 2026)).

“[A] plaintiff may oppose registration of a mark when (1) [its] interests are within the zone of interests protected by the statute [(i.e., it has a ‘real interest’ in the outcome of the proceeding)] and (2) [it] has a reasonable belief in damage that would be proximately caused by registration of the mark in violation of the opposition

statute.” *Id.* (quoting *Curtin*, 137 F.4th at 1367 (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129-34 (2014))).

Opposer argues that it has “standing”¹⁰ in this proceeding because

[t]he use and registration of the Applicant’s “O EL CIELO VALLE DE GUADALUPE” word mark for “wine” in Class 033 is likely to cause confusion or to cause mistake or deception in the trade and among purchasers/users and potential purchasers/users with Opposer’s previously used and duly registered “CIELO” word trademark for “wine” in Class 033, causing damage to Opposer. As the owner of the “CIELO” word trademark and the corresponding U.S. Reg. No. 2,384,406, Opposer has standing to challenge an application for a mark confusingly similar to its “CIELO” word trademark.

14 TTABVue 18 (citations omitted). Applicant does not respond to this argument or otherwise dispute Opposer’s entitlement to oppose.

Opposer has established its entitlement to oppose registration under Section 13 of the Trademark Act on the basis of likelihood of confusion under Section 2(d) of the Trademark Act by submitting electronic records regarding its pleaded Registration No. 2384406 of the mark CIELO for wine from the USPTO’s TSDR database showing the current status and title of the registration, Cielo Decl. ¶ 17; Ex. 3 (10 TTABVue 16, 241-46), which “demonstrate[s] a plausible Trademark Act Section 2(d) claim against the involved application for the mark” O EL CIELO VALLE DE GUADALUPE for wine. *Heil Co.*, 2024 WL 4925901, at *15.

¹⁰ “We now refer to standing as entitlement to a statutory cause of action.” *El Roblar*, 2025 WL 2718983, at *20 n.46 (quoting *Univ. of Ky. v. 40-0, LLC*, No. 91224310, 2021 WL 839189, at *4 (TTAB 2021)). “Despite the change in nomenclature, our prior decisions and those of the U.S. Court of Appeals for the Federal Circuit [addressing standing] remain equally applicable.” *Id.* (quoting *Univ. of Ky.*, 2021 WL 839189, at *4).

IV. Likelihood of Confusion Claim

“Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits registration of a mark that ‘[c]onsists of or comprises a mark which so resembles a mark registered in the Patent [and] Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the [goods] of the applicant, to cause confusion, or to cause mistake, or to deceive.’” *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, No. 91270181, 2024 WL 1638376, at *4 (TTAB 2024). “To prevail on its Section 2(d) claim, Opposer must show by a preponderance of the evidence that it has either a registration of or priority in its [CIELO] mark, and that Applicant’s use of its mark is likely to cause confusion, mistake, or deception regarding the source of the [goods] identified in its Application.” *Id.* (citation omitted).

A. Priority

Because Opposer properly made of record its pleaded Registration No. 2384406 of the mark CIELO for wines, and Applicant did not counterclaim to cancel the registration, “priority is not at issue for the mark[] and goods . . . identified therein.” *Heil Co.*, 2024 WL 4925901, at *16 (citing *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1402-03 (CCPA 1974)).

B. Likelihood of Confusion

Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of the “facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.” *DowntownDC Bus. Improvement Dist. v. Clarke*,

No. 91275100, 2024 WL 4449409, at *18 (TTAB 2024) (citing *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). “We discuss the *DuPont* factors for which there is relevant argument and evidence.” *Id.* (citing *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019)).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the [goods or] services.” *Id.* (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”)).

Opposer focuses on these two key factors, 14 TTABVUE 22-27, but also discusses ten of the other 11 *DuPont* factors. *Id.* at 27-40. Applicant also discusses the two key factors, 15 TTABVUE 14-16, but devotes much of its brief to the sixth factor, the “number and nature of similar marks in use on similar goods,” *DuPont*, 476 F.2d at 1361, 15 TTABVUE 9-13, and also discusses the eighth factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361, 15 TTABVUE 16.¹¹

¹¹ Applicant makes two other arguments against a conclusion of likelihood of confusion that it does not associate with any *DuPont* factor. These merit only brief discussion. First, Applicant argues that the “USPTO initially refused registration of Applicant’s mark under Section 2(d) but withdrew the refusal after Applicant submitted evidence of the crowded field and the descriptive or suggestive nature of ‘CIELO.’” 15 TTABVUE 14. Applicant claims that “[t]he Examining Attorney’s withdrawal of the refusal is entitled to weight, as it reflects the Office’s determination that coexistence of the marks does not present a likelihood of confusion.” *Id.* (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001)). This argument is specious. *Nett Designs* did not address the situation here, and “[t]he whole point of having opposition and cancellation challenges is to provide a backstop to purely ex parte

Under the circumstances here, we will address the *DuPont* factors bearing on the similarity of the goods, channels of trade, and classes of consumers, and the possible strength or weakness of Opposer's CIELO mark, before addressing the degree of similarity between the marks under the first *DuPont* factor.

1. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Consumers

“The second *DuPont* factor considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use,’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361), while the “third *DuPont* factor considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.’” *Id.* at 1308 (quoting *DuPont*, 476 F.2d at 1361).

U.S.P.T.O. examination of trademark applications.” *Mountain Gateway Ord., Inc. v. Va. Cmty. Coll. Sys.*, No. 91283412, 2024 WL 2863444, at *5 (TTAB 2024) (citing 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 20:2 (5th ed. March 2024 update) (“MCCARTHY”) (“By definition, if the Trademark Board sustains an opposition on the references cited ex parte, it disagrees with the PTO Examining Attorney, who felt the mark was registerable and passed it to publication. The Trademark Board reviews with a clean slate and is not bound or restricted in any sense by the action of the Examining Attorney. Thus, it is not dispositive or even relevant in an opposition proceeding that applicant was able to convince the Trademark Examining Attorney during ex parte examination that the mark was registerable and to pass the application to publication.”)).

Second, Applicant claims that it “adopted its mark in good faith, inspired by the night skies of its Valle de Guadalupe vineyards” and that “[t]here is no evidence of bad faith or intent to trade on Opposer’s goodwill.” 15 TTABVue 16. Assuming without finding that Applicant “adopted its mark in good faith,” “[w]hile evidence of bad faith adoption typically will weigh against an applicant, good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion.” *Monster Energy Co. v. Lo*, No. 91225050, 2023 WL 417620, at *23 (TTAB 2023) (citing *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991) (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion”) (internal citation omitted); *Eveready Battery Co. v. Green Planet, Inc.*, No. 91180015, 2009 WL 2176668, at *5 (TTAB 2009)).

Applicant concedes that the goods are identical, 15 TTABVUE 16, because Opposer's registration and Applicant's application both cover goods identified as "wine" in the singular or plural.¹² The second *DuPont* factor thus strongly supports a conclusion that confusion is likely. *In re OSF Healthcare Sys.*, No. 88706809, 2023 WL 6140427, at *9 (TTAB 2023).

"Here, where the parties' goods, wine, are identical, we must presume that they would be marketed to the same classes of customers--ordinary adult wine drinkers and purchasers--through the same channels of trade." *Stawski v. Lawson*, No. 94002621, 2018 WL 6921710, at *19 (TTAB 2018) (citing *Viterra*, 671 F.3d at 1362 (internal citation omitted)).¹³ We may "rely on this legal presumption in determining likelihood of confusion." *Viterra*, 671 F.3d at 1362. The third *DuPont* factor thus also strongly supports a conclusion that confusion is likely. *OSF Healthcare*, 2023 WL 6140427, at *9.

2. Strength or Weakness of Opposer's CIELO Mark

"Two of the *DuPont* factors (the fifth and the sixth) consider [the] strength" of a plaintiff's mark. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). "The fifth factor, '[t]he fame of the prior mark (sales, advertising, length of use),' . . . is a measure of the mark's strength in the marketplace." *Id.* (quoting *DuPont*, 476 F.2d

¹² We will refer to the parties' goods as "wine" in the singular.

¹³ Applicant's CEO Mr. Ortega testified that "[o]ur trade channels are not the same as Opposer's" because "[w]e have sold our wine in the United States through La Mision Associates exclusively," Ortega Decl. ¶ 5 (12 TTABVUE 101), but there is no such restriction in Applicant's identification of goods. We must presume that the relevant channels of trade are identical based on the identical goods identified in Opposer's registration and Applicant's application. *Stawski*, 2018 WL 6921710, at *19.

at 1361 and citing *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017)). The sixth factor, “[t]he number and nature of similar marks in use on similar goods’ . . . is a measure of the extent to which other marks weaken the assessed mark.” *Id.* (quoting *DuPont*, 476 F.2d at 1361 and citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005)).

a. Fifth *DuPont* Factor

The fifth *DuPont* factor considers “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 476 F.2d at 1361. “Fame for confusion purposes arises as long as a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards*, 857 F.3d at 1324-25 (quoting *Palm Bay*, 396 F.3d at 1375). “[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public.” *Palm Bay*, 396 F.3d at 1375.

“While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quoting *Palm Bay*, 396 F.3d at 1375). The Board has assessed the “fame” of the prior mark in Section 2(d) cases in terms of the mark’s “commercial strength.” *Monster Energy*, 2023 WL 417620, at *10.

The commercial strength of a mark

may be measured indirectly “by the volume of sales and advertising expenditures in connection with the goods sold under the marks, for example, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the products

identified by the marks; and the general reputation of the products and services.”

Id. at *11 (quoting *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, No. 91199352, 2014 WL 343269, at *6 (TTAB 2014)). “Because of the extreme deference that we accord a famous mark, it is the duty of the party asserting that its mark falls on the higher end of the fame/commercial strength spectrum to clearly prove it.” *Heil Co.*, 2024 WL 4925901, at *19 (quoting *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012) (internal quotation marks and citation omitted)).

Opposer has sold wine in the United States under the CIELO mark continuously since 1978. Cielo Decl. ¶¶ 5-6 (10 TTABVUE 4). CIELO wines are “sold to consumers throughout the United States through distributors, retailers, restaurants and via online distribution,” Cielo Decl. ¶ 7 (10 TTABVUE 4), and at the time of trial in early 2025, they were available through more than 30 online and retail stores, including retail stores in Connecticut, Florida, Texas, New York, Massachusetts, New Jersey, Arizona, Colorado, Illinois, Minnesota, Rhode Island, and Delaware. Cielo Decl. ¶ 8; Exs. 2.1-2.35 (10 TTABVUE 4-10, 72-240). Between 2013 and 2024, Opposer sold more than 4,000,000 bottles of wine bearing the CIELO mark in the United States, accounting for gross sales in excess of \$13,100,000. Cielo Decl. ¶ 11 (10 TTABVUE 11).¹⁴

¹⁴ Under the three-tiered system for sales of alcoholic beverages in the United States, a manufacturer such as Opposer generally sells its goods to a distributor, who sells the goods to a retailer, who in turn sells the goods to the consuming public at or above the legal drinking age. See *Tao Licensing, LLC v. Bender Consulting Ltd.*, No. 92057132, 2017 WL 6336243, at *10 (TTAB 2017).

Opposer has promoted its CIELO wines in the United States through two trade shows in 2015 and 2016, Cielo Decl. ¶ 12(a) (10 TTABVUE 11), and on social media platforms including Instagram, Facebook, and YouTube. Cielo Decl. ¶ 12(b) (10 TTABVUE 11-13).¹⁵ Opposer has also advertised its CIELO wines through various websites, including its own websites at cielo1908.com and cieloterravini.com. Cielo Decl. ¶ 13 (10 TTABVUE 13). Mr. Cielo provided no information regarding the number of visitors to Opposer's social media platforms and websites, or any information regarding advertising in the print or electronic media.

Opposer's CIELO wines have won awards from *The Drinks Business*, a British monthly international B2B magazine having a website published by Union Press. Cielo Decl. ¶ 14 (10 TTABVUE 13). *The Drinks Business* magazine has an international audience of 685,000 monthly readers and regularly provides content for publications such as *The Huffington Post* and *Time* magazine. Cielo Decl. ¶ 14 (10 TTABVUE 13). According to Mr. Cielo, *The Drinks Business* website averages 2,289,052 page views, but he did not specify the period for which that average applies. Cielo Decl. ¶ 14 (10 TTABVUE 13).¹⁶ He also did not provide any information about the number of United States visitors to the website. Between 2018 and 2021,

¹⁵ The Cielo Declaration provided links to Opposer's social media pages with respect to what Mr. Cielo described as videos uploaded by Opposer in 2023 and 2024. Cielo Decl. ¶ 12(b) (10 TTABVUE 11-13). Links contained in briefs or declarations are insufficient to make any referenced information or "linked" materials of record because the "Board does not accept Internet links as a substitute for submission of a copy of the resulting page." *TV Azteca, S.A.B. v. Martin*, No. 92068042, 2018 WL 6504575, at *4 n.15 (TTAB 2018).

¹⁶ Mr. Cielo testified that "DB Awards were recognized in the context of the awards program named 'Global Wine Masters': <https://www.globalwinemasters.com/>," Cielo Decl. ¶ 14 (10 TTABVUE 14), but again provided only a link to the cited source.

Opposer's CIELO wines won medals at the Global Wine Masters, a series of blind tasting international competitions that are usually held at the London International Wine Fair. Cielo Decl. ¶ 14 (10 TTABVUE 14-15).

On the basis of this evidence, Opposer argues that it

has enjoyed substantially exclusive use of the CIELO trademark in the United States for over four decades. During this time, Opposer and its predecessors have been continuously promoting and expanding its use both in the U.S. and worldwide. . . . Such use, sales, publicity and promotion of the goods/services under the CIELO trademark have resulted in extremely strong consumer recognition of the "CIELO" mark in the United States. . . .

14 TTABVUE 29. According to Opposer,

[a]s a result of the continuous, prominent, longtime and widespread use in commerce by the Opposer of the aforesaid CIELO trademark in connection with its respective goods, the mark has acquired extensive goodwill, has developed a high degree of distinctiveness, is an asset of the Opposer, and is well known and recognized as identifying at least the listed goods which have their origin with or have been authorized by the Opposer.

Id. at 31.¹⁷

As discussed above, we must place Opposer's CIELO mark "along a spectrum from very strong to very weak," *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quotation and quotation marks omitted), but Opposer's evidence provides little help in that regard. Opposer has sold CIELO wines in the United States for nearly 50 years, but provided

¹⁷ Applicant does not directly address Opposer's evidence or argument under the fifth *DuPont* factor, but as discussed below, Applicant argues under the sixth *DuPont* factor that Opposer's CIELO mark is conceptually and commercially weak due to third-party uses and registrations of CIELO-formative marks and other marks for wine and other alcoholic beverages.

sales revenue and unit sales figures limited to the 11 year-period between 2013 and 2024, in which Opposer had average annual sales of about \$1.2 million and average annual unit sales of about 360,000 bottles. At the time of trial, Opposer's CIELO wines were available in about "thirty (30) online and retail stores" in about a dozen states in the United States. Cielo Decl. ¶ 8 (10 TTABVue 4). We have no information regarding any advertising and promotional expenditures at any time.

Opposer's sales figures are not negligible, but we do not have sufficient context from which to determine their relative significance, if any, in the vast United States wine market, which includes both domestic and foreign wines. "Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading." *Keystone Consol. Indus., Inc. v. Franklin Inv. Corp.*, No. 92066927, 2024 WL 3771168, at *16 (TTAB 2024) (quoting *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1375 (Fed. Cir. 2002)). "It is difficult to accurately gauge the level of [Opposer's] success in the [wine] industry in the absence of additional information, such as [Opposer's] market share or how [Opposer's wine] ranks in terms of sales in the trade." *Id.*¹⁸ "[W]e lack sufficient information as to how these sales numbers compare to other" sellers of wine, and the absence of any such context "makes it difficult to make inferences about this indirect evidence." *Id.*¹⁹

¹⁸ In *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315 (Fed. Cir. 2018), the Federal Circuit held that evidence of market share is not required, but is "one way of contextualizing ad expenditures or sales figures." *Id.* at 1320 (citing *Bose*, 293 F.3d at 1375).

¹⁹ In *Omaha Steaks*, the opposer offered sales and advertising expenditures to prove the fame of its mark, as well as "evidence to contextualize these figures, including testimony about how Omaha Steaks promoted its products to the public through catalogs, direct mailings,

The Federal Circuit held in *Joseph Phelps Vineyards* that industry recognition in the form of awards, accolades, and media coverage can be indirect evidence of the commercial strength of a wine mark. *Joseph Phelps Vineyards*, 857 F.3d at 1325-26. The record in that case showed that the opposer's INSIGNIA wines had been served at the White House three times, *id.*, "were selected as Wine of the Year in 2005 and 1997, with Wine Spectator noting that INSIGNIA wine had by 2005 earned an outstanding score in 26 of its 29 vintages and repeatedly ranked as a 'classic,' scoring between 95 and 100 points," *id.* at 1325, and had been lauded in multiple United States publications, including *The Wall Street Journal* and *The Washington Post*, as one of the most "famous" and "best" Bordeaux-blend wines produced in the Napa Valley, as a wine from "one of the most respected producers in the Napa Valley," as "the finest wine I had ever encountered," and as "a perennial winner at our annual Best of the Best in California." *Id.*²⁰ The Federal Circuit concluded that "[t]he record shows extensive recognition and accolade for INSIGNIA brand wine," *id.*, and "appreciation by consumers and the wine market of Vineyards' INSIGNIA brand." *Id.* at 1326.

Here, it is not clear whether and to what extent United States wine consumers were exposed to Opposer's *The Drinks Business* and Global Wine Masters awards and

email marketing, customer calls, tradeshow, retail stores, national television, radio, magazine and newspaper campaigns, digital marketing, and social media." *Omaha Steaks*, 908 F.3d at 1319. The record here lacks sufficient evidence to contextualize Opposer's sales figures.

²⁰ The Federal Circuit noted that "[t]he record contain[ed] many more examples" of such exposure of the opposer's INSIGNIA mark. *Joseph Phelps Vineyards*, 857 F.3d at 1326.

medals,²¹ and there is no evidence of any exposure of the mark through media coverage of the sort discussed in *Joseph Phelps Vineyards*.

We have carefully considered Opposer's sales, advertising and promotion, and awards evidence, but find that it is insufficient to establish that Opposer's CIELO mark has achieved significant commercial strength in the United States, much less that it is "renowned in the wine market and among consumers of fine wine." *Joseph Phelps Vineyards*, 857 F.3d at 1325.²² We find that Opposer's mark is of average strength, and the fifth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

b. Sixth *DuPont* Factor

"There are two prongs of analysis for a mark's strength under the sixth factor: conceptual strength and commercial strength." *Spireon*, 71 F.4th at 1362 (citation omitted). "Conceptual strength is a measure of a mark's distinctiveness . . . and distinctiveness is often classified in categories of generally increasing distinctiveness[:] . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Id.* (citation, quotation, and quotation marks omitted). "Distinctiveness is relevant to a mark's overall strength in the likelihood of confusion analysis." *Id.*

²¹ None of the websites of the resellers of Opposer's CIELO wines mentioned Opposer's awards or medals.

²² As discussed above, Opposer provided evidence that it has been active in enforcing its CIELO mark before the Board and has prevented the registration of a number of CIELO-formative marks for various alcoholic beverages. But all of the third-party proceedings discussed above ended through default judgments or the withdrawal of the opposed applications, and, in any event, the fame inquiry under the fifth factor is "focused on whether the mark has achieved 'extensive public recognition and renown,'" *Omaha Steaks*, 908 F.3d at 1323 (quoting *Coach Servs.*, 668 F.3d at 1367), "not on enforcement efforts." *Id.*

(citation omitted). “Commercial strength, on the other hand, is ‘the marketplace recognition value of the mark. [It] is a question of ‘whether consumers in fact associate the . . . mark with a unique source[.]’” *Id.* at 1363 (quoting 2 MCCARTHY § 11:80).

i. Conceptual Strength

“Because Opposer’s mark is registered on the Principal Register, with no claim of acquired distinctiveness under Section 2(f), we presume it is inherently distinctive, i.e., that it is at worst suggestive of the goods.” *Heil Co.*, 2024 WL 4925901, at *18 (citing 15 U.S.C. § 1057(b)). Nevertheless, “where there is evidence that a mark, or element of a mark, is commonly used or registered by many different third parties for similar goods or services, that may indicate that the mark or common element has some conceptual weakness.” *August Storck KG v. Florend Indústria E Comércio De Chocolates LTDA*, No. 91277224, 2025 WL 4107480, at *13 (TTAB 2025)²³ (citing *Spireon*, 71 F.4th at 1363, *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015), and *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millenium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015)).

Applicant submitted multiple third-party registrations²⁴ in an effort to show the conceptual weakness of Opposer’s CIELO mark. For ease of reference in following our analysis, we reproduce below a table that appears in Applicant’s brief, 15 TTABVUE

²³ The *August Storck* decision initially issued on November 14, 2025 as non-precedential, but it was redesignated as a precedent of the Board on January 27, 2026.

²⁴ All of the third-party registrations either issued based on allegations of use in commerce, or were maintained based on allegations of use in commerce, but the specimens supporting the allegations of use in commerce are not in the record.

12-13, of the 18 third-party registrations (and one third-party application) in the record:²⁵

<u>Mark</u>	<u>U.S. Serial No.</u>	<u>Goods Include</u>	<u>Status¹</u>
CASA DE CIELO	86284922	wine	Registered
OCCHI DI CIELO	87387033	wine	Cancelled 11/29/2024: failure to file declaration under §8.
VISTA DEL CIELO	85848339	wine	Registered
ESCALERA DEL CIELO	85445853	wine	Cancelled 7/21/2023: failure to file declaration under §8.
VIANDANTE DEL CIELO	78323083	wine	Registered
CIELO SULLA TERRA ESTATE VINEYARDS AND WINERY	88135872	wine	Registered
DCB DEL CIELO BREWING CO	86606316	Beer	Registered
PUERTA DEL CIELO	90295523	Blue agave liquor	Registered
PUNTA DEL CIELO	77665723	alcoholic beverages	Registered
CIELO	97249241	spirits	Abandoned 2/20/2024 after inter partes decision by TTAB.

SKY RIDGE	88625281	wine	Registered
SKY HIGH RANCH	88496168	wine	Registered
INFINITE SKY	88420743	wine	Registered
SKY VALLEY CELLARS	88834268	wine	Registered
SKY BLOSSOM	88347406	wine	Registered
WHEEL IN THE SKY	88505397	wine	Registered
NORTHERN SKY	87199761	wine	Cancelled 11/01/2024: failure to file declaration under §8.
SKY DEVIL	87812153	wine	Registered
SAID THE SKY	87323588	wine	Cancelled 9/09/2024: failure to file declaration under §8.

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²⁵ USPTO records regarding the specific registrations and application listed in the table are in the record at 13 TTABVUE 6-66.

²⁶ The blue highlighting in the table appears elsewhere throughout Applicant's brief. It appears to have no substantive significance. Where we have quoted from Applicant's brief, we have removed any such highlighting from the quoted language.

Applicant argues that “the multitude of third-party registrations show that the term CIELO is a common industry term and, therefore, a weak source indicator by itself for wine.” 15 TTABVue 10. According to Applicant, “trademark registrations that include ‘sky’ or ‘heaven’ for wine further demonstrate the weakness of the registered mark, CIELO,” under the doctrine of foreign equivalents, *id.* at 11, and “[m]any registrations also include CIELO as a primary part of the mark for goods and services that are similar to wine and within the same stream of commerce” and “[t]he goods and services are similar enough to wine to be relevant to an analysis of the likelihood of confusion with a mark for wine.” *Id.* Applicant concludes that “third-party registrations for marks that include ‘cielo,’ ‘heaven,’ or ‘sky’ for wine, beer, and spirits are relevant in showing the ubiquity of Opposer’s Cielo mark and its resultant weakness as a source indicator.” *Id.* at 12.

Opposer addresses Applicant’s third-party registration evidence as follows:

In its Notice of Reliance, Applicant identifies nineteen trademark records as purportedly demonstrating “that the word ‘cielo’ is a very common term in the wine industry and in related industries”. Of these nineteen trademark records, nine do not include Opposer’s mark “CIELO” and instead are composite marks which include the term “SKY.” Although the word ‘cielo’ in Spanish or Italian loosely translates to ‘sky’ or ‘heaven’ in the English language, there is no evidence that in the context of Opposer’s CIELO trademark, there is such a connotation. Namely, it has not been demonstrated that ‘cielo’ is a word widely known by the average U.S. consumer and therefore ‘cielo’ is not likely to be perceived as a translation of ‘sky’ (and vice versa). It follows that the existence of the identified composite SKY marks does not diminish the distinctiveness of Opposer’s CIELO trademark.

Of the ten remaining marks, four are for beer or alcoholic beverages other than wine. As an initial matter, Opposer

submits that wine is a distinct market from other alcoholic beverages, and has distinct suppliers which typically do not cross over, e.g., makers of wine do not typically make spirits or beer. Moreover, three of the four mentioned marks are composite marks which contain additional, surrounding terminology that substantially reduces any similarity to the Opposer's mark. The mark 'DCB Del Cielo Brewing Co.' clearly suggests a brewing company selling beer, not wine. Two of the identified marks include additional terms which more particularly invoke the foreign translation of 'cielo' as 'sky' or 'heaven': 'Puerta del Cielo' translates to 'heaven's gate' and Punta del Cielo translates to 'heaven's point'. Finally, the CIELO mark identified by Applicant, U.S. Serial No. 97/249,241, is now dead and has no probative value.

...

The remaining six trademarks identified in Applicant's Notice of Reliance include the term 'cielo' as part of a composite mark in connection with wine. Significantly, none of these marks are identical to Opposer's CIELO mark, which is not a composite mark. Of these six identified trademarks, two of such marks have been cancelled and are not indicative of third-party use. The remaining four composite marks which include the term 'cielo' are sufficiently distinguishable from Opposer's CIELO trademark so as not to significantly weaken Opposer's mark.

14 TTABVUE at 33-34. Opposer concludes that "[t]he existence of four registered trademarks which include the term CIELO as part of a composite mark which conveys specific meaning to the composite mark, does not diminish the strength of Opposer's mark for CIELO standing alone." *Id.* at 35.

We discuss immediately below the probative value of Applicant's third-party registrations.

(a) Cancelled Registrations and Abandoned Application

Applicant made of record four cancelled registrations, and one abandoned application.²⁷ “A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b).” *Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 WL 2188890, at *15 (TTAB 2022) (citing *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 1566 (Fed. Cir. 1989)). As a result, “[a] cancelled registration is of no evidentiary value as to the scope of protection to be afforded to [the] opposer’s claimed mark[].” *Illryian Imp., Inc. v. Adol Sh.p.k.*, No. 91234244, 2022 WL 970321, at *19 (TTAB 2022) (quoting *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, No. 91166701, 2010 WL 2513872, at *4 (TTAB 2010)). Similarly, “[a]bandoned applications have ‘no probative value other than as evidence that the applications [were] filed.’” *Made in Nature*, 2022 WL 2188890, at *14 (quoting *Edwards Lifesciences Corp. v. VigiLanz Corp.*, No. 91154210, 2010 WL 1514315, at *3 n.4 (TTAB 2010) (citation omitted)). Accordingly, we will not consider cancelled Registration Nos. 5467154 of OCCHI DI CIELO for wine, 4273152 of ESCALERA DELCIELO for wine, 5449349 of NORTHERN SKY for wine, and 5414275 of SAID THE SKY for wine, or abandoned Application Serial No. 97249241 to register CIELO for various spirits, because they have no probative value under the sixth factor.

²⁷ Applicant explains that “[a]ll listed marks were active and/or registered during the course of this opposition. However, some were no longer active by the time Applicant’s evidence was filed with the Board. The status date for this table is . . . April 24, 2025, the date Applicant’s Notice of Reliance was filed.” 15 TTABVUE 12 n.1. The relevant issue is whether the third-party registrations were valid and subsisting at the time of our decision.

**(b) Third-Party Registrations of CIELO-
Formative Marks for Goods Other Than Wine**

We turn next to the three third-party registrations of CIELO-formative marks that cover alcoholic beverages that are not identified as “wine”: Registration No. 4877134 of DCB DEL CIELO BREWING CO. and design for “beer,” Registration No. 6695319 of PUERTA DEL CIELO for “distilled blue agave liquor,” and Registration No. 3753859 of PUNTA DEL CIELO for “alcoholic beverages except beers.”²⁸

With respect to the registration of PUNTA DEL CIELO for goods broadly identified as “alcoholic beverages except beer,” “[j]ust as we must consider the full scope of the goods and services as set forth in the application and registration under consideration, we must consider the full scope of the goods and services described in a third-party registration.” *In re Country Oven, Inc.*, No. 87354443, 2019 WL 6170483, at *5 (TTAB 2019). The “full scope” of goods identified as “alcoholic beverages except beer” encompasses “wine,” and we will consider the PUNTA DEL CIELO registration for whatever probative value it may have. *Cf. Apex Bank v. CC Serve Corp.*, 156 F.4th 1230, 1236 (Fed. Cir. 2025) (explaining that when the Board has made a factual finding regarding the similarity of goods or services under the second *DuPont* factor, “the Board should retain the same scope in its consideration of

²⁸ This registration issued under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), and we ordinarily do not consider third-party registrations “that are not based on Section 1(a).” *Heil Co.*, 2024 WL 4925901, at *23 (citing *Made in Nature*, 2022 WL 2188890, at *14). But the USPTO records regarding the registration show that it was subsequently maintained and renewed on the basis of evidence of use, 13 TTABVUE 34, although the nature of that use is a mystery.

similarity under the other factors,” and there is “no reason to impose a different and more stringent legal standard for similarity under the sixth *DuPont* factor.”).

We turn now to the registrations of DCB DEL CIELO BREWING CO. and design for “beer” and PUERTA DEL CIELO for “distilled blue agave liquor.” For purposes of the sixth *DuPont* factor, the similarity of the goods identified in a plaintiff’s registration and the goods identified in third-party registrations must be proven in every case, *see Omaha Steaks*, 908 F.3d at 1325, and “[t]here is no per se rule that holds that all alcoholic beverages are related.” *In re White Rock Distilleries Inc.*, No. 77093221, 2009 WL 3401827, at *2 (TTAB 2009) (citing *G. H. Mum & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1296 (Fed. Cir. 1990); *Nat’l Distillers & Chem. Corp. v. William Grant & Sons, Inc.*, 505 F.2d 719, 721 (CCPA 1974)). Applicant offers no evidence showing that beer or distilled blue agave liquor are similar to wine, but instead cites two non-precedential cases finding that wine and beer, and wine and certain spirits, are related. 15 TTABVUE 11. We are not bound by these non-precedential decisions, *see, e.g., In re Fiat Grp. Mktg. & Corp. Commc’ns S.P.A.*, No. 71099154, 2014 WL 721511, at *3 n.6 (TTAB 2014), and the argument of Applicant’s counsel that these other alcoholic beverages “are similar enough to wine to be relevant to an analysis of the likelihood of confusion with a mark for wine,” 15 TTABVUE 11, is “no substitute for evidence.” *Iron Balls Int’l Ltd. v. Bull Creek Brewing, LLC*, No. 92079099, 2024 WL 2844425, at *26 (TTAB 2024) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371 (Fed. Cir. 2018) (internal quotation omitted)).

But in contrast to the record with respect to the relationship between wine and beer, Opposer challenged, and ultimately prevented the registration of, several CIELO-formative marks for different types of alcoholic beverages other than beer, including goods identified as “distilled blue agave liquor” and “distilled agave liquors,” apparently based on likelihood of confusion claims. Cielo Decl. ¶¶ 19-20 (10 TTABVue 16, 20-21) (“Opposer has undertaken significant efforts to ensure that the ‘CIELO’ mark exclusively identifies Opposer’s wine.”). Having apparently asserted likelihood of confusion claims against those goods, Opposer is hard pressed to deny the similarity of those goods to wine for sixth factor purposes.

Here, we have found under the second *DuPont* factor that the parties’ goods are identical, the ultimate in similarity. But under the sixth *DuPont* factor, we must consider similar marks in use on “similar” goods, and Opposer’s enforcement efforts against these third-party CIELO-formative marks, apparently based on likelihood of confusion claims, Cielo Decl. ¶¶ 19-20 (10 TTABVue 16, 20-21), provide sufficient evidence of similarity for us to find that Registration No. 6695319 of PUERTA DEL CIELO for “distilled blue agave liquor” covers “similar” goods and should be considered as evidence of the conceptual weakness of Opposer’s mark for wine for whatever probative value it may have.

(c) Third-Party Registrations of SKY-Formative Marks for Wine

We turn next to the third-party registrations of marks for wine that do not contain the word CIELO, but instead contain the word SKY, which Applicant argues is one

of the English-language equivalents of the foreign word “cielo.” 15 TTABVue 9.

Applicant argues that

[t]he translations of CIELO are also relevant in evaluating the strength of a mark as a source indicator. . . . “CIELO” is a foreign word. It is the Spanish and Italian word for “sky” or “heaven,” and is commonly used in the context of wine to evoke imagery of place, quality, or aspiration.

Id. at 10 (record citations omitted).

Applicant further argues that “[u]nder the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks,” *id.* (quoting *Palm Bay*, 396 F.3d at 1377), that the “‘ordinary American purchaser’ includes ‘those proficient in a non-English language who would ordinarily be expected to translate words into English,’” *id.* at 11 (quoting *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009)), and that both Spanish and Italian are languages that the Board has found to be ones that an ordinary American purchaser would stop and translate into English. *Id.* (citing *In re Ithaca Indus., Inc.*, No. 73442321, 1986 WL 83611 (TTAB 1986) (Italian) and *In re La Peregrina Ltd.*, No. 78676199, 2008 WL 695794 (TTAB 2009) (Spanish)). Applicant concludes that “trademark registrations that include ‘sky’ or ‘heaven’ for wine further demonstrate the weakness of the registered mark, CIELO.” *Id.*

Opposer argues that “[a]lthough the word ‘cielo’ in Spanish or Italian loosely translates to ‘sky’ or ‘heaven’ in the English language, there is no evidence that in the context of Opposer’s CIELO trademark, there is such a connotation” and that “it has not been demonstrated that ‘cielo’ is a word widely known by the average U.S.

consumer and therefore ‘cielo’ is not likely to be perceived as a translation of ‘sky’ (and vice versa).” 14 TTABVUE 33.

“Under the doctrine of foreign equivalents, foreign words used as a mark are translated into English and then tested for likelihood of confusion” under the first *DuPont* factor. *August Storck*, 2025 WL 4107480, at *7 (citing *In re Vetements Grp. AG*, 137 F.4th 1317, 1325 (Fed. Cir. 2025), *cert. denied*, 2026 WL 79820 (Jan. 12, 2026)). “Generally, the Board applies the doctrine of foreign equivalents when one mark is in the English language and the other is in a foreign language.” *Id.* (citing *Ricardo Media Inc. v. Inventive Software, LLC*, No. 91235063, 2019 WL 3956987, at *8 (TTAB 2019)). “In certain circumstances, however, the Board has applied the doctrine of foreign equivalents when considering two marks from different foreign languages or from the same foreign language.” *Id.* (citing *Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, No. 91099024, 1998 WL 1021751 (TTAB 1998) and *In re Lar Mor Int’l, Inc.*, No. 73256334, 1983 WL 51840 (TTAB 1983)).

Here, Applicant asks us to apply the doctrine of foreign equivalents under the sixth *DuPont* factor to consider third-party registrations of marks incorporating the English equivalent of the foreign-language mark CIELO. As noted above, under the sixth factor we consider “similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361. In discussing this factor, the Federal Circuit has explained that “third-party registrations containing an element **that is common to both the opposer’s and the applicant’s marks** can show that that element has ‘a normally understood and well-recognized descriptive or suggestive meaning.” *Spireon*, 71 F.4th at 1363

(emphasis added) (quoting *Jack Wolfskin*, 797 F.3d at 1374); *see also* 2 MCCARTHY § 11:90 (“Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.”); *cf. August Storck*, 2025 WL 4107480, at *13-14 (“Unlike the marks in *Spireon*, *Jack Wolfskin* and *Juice Generation*, Opposer’s and Applicant’s [DANKE and MERCI] marks do not share a ‘common’ element; the only commonality is the similarity in meaning. . . . Applicant submitted only one third-party use-based registration for a mark that includes” the opposer’s mark MERCI). The registered third-party SKY-formative marks that Applicant introduced do not incorporate the word CIELO that is common to both parties’ marks. Accordingly, we find that the subsisting Registration Nos. 7068817 of the mark SKY RIDGE, 6392282 of the mark SKY HIGH RANCH, 6839790 of the mark INFINITE SKY, 6494273 of the mark SKY VALLEY CELLARS, 6180918 of the mark SKY BLOSSOM, 5966171 of the mark WHEEL IN THE SKY, and 5966171 of the mark SKY DEVIL, none of which contains the CIELO element that is common to both marks here, are not probative of the conceptual weakness of Opposer’s mark under the sixth factor.²⁹

²⁹ We note in that regard that there may be circumstances, based on a different factual record, where it would be appropriate to apply the doctrine of foreign equivalents to third-party marks under the sixth *DuPont* factor.

**(d) Differences Between Opposer's CIELO Mark
and the Third-Party CIELO-Formative
Composite Marks for Wine or Similar Goods**

The subsisting third-party registrations covering wine, or a legal equivalent, show the marks CASA DE CIELO; VISTA DEL CIELO (stylized) and design; VIANDANTE DEL CIELO; CIELO SULLA TERRA ESTATE VINEYARDS AND WINERY; and PUNTA DEL CIELO; while the third-party registration covering “distilled blue agave liquor” shows the mark PUERTA DEL CIELO. Opposer argues that these marks “are sufficiently distinguishable from Opposer’s CIELO trademark so as not to significantly weaken Opposer’s mark, 14 TTABVue 34, and that “[t]he existence of . . . registered trademarks which include the term CIELO as part of a composite mark which conveys specific meaning to the composite mark, does not diminish the strength of Opposer’s mark for CIELO standing alone.” *Id.* at 35.

In *Spireon*, the Federal Circuit explained that “[w]here marks share a common segment, [t]hird party registrations are relevant to prove that [the common] segment of the composite marks . . . has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.* at 1364 (quotation and quotation marks omitted). The court also held that evidence of composite third-party registrations is relevant “because [s]uch registrations could . . . show that the PTO, by registering several marks with such a common segment, recognizes that portions of such composite marks other than the common segment are sufficient to distinguish the marks as a whole and to make confusion unlikely.” *Id.* (quotation and quotation marks omitted). The court concluded that “[a]t least where the registrations and application are for non-

identical marks, as they are here, it is error for the Board to effectively disregard third-party composite marks” and that “[t]he composite marks have probative value and should have been included in the Board’s analysis.” *Id.*

Here, as in *Spireon*, the involved marks are not identical, and we will consider the third-party registrations of composite CIELO-formative marks for wine or a legal equivalent, and for distilled blue agave liquor, for whatever probative value they may have.

(e) Summary Regarding Probative Value of Third-Party Registrations

In our analysis of Applicant’s third-party mark evidence as a whole, we will consider, as probative evidence of the conceptual weakness of Opposer’s CIELO mark, the third-party registrations of the wine marks CASA DE CIELO; VISTA DEL CIELO (stylized) and design; VIANDANTE DEL CIELO; and CIELO SULLA TERRA ESTATE VINEYARDS AND WINERY,³⁰ the third-party registration of the mark PUNTA DEL CIELO for “alcoholic beverages, except beer,” and the third-party registration of PUERTA DEL CIELO for “distilled blue agave liquor.”³¹ The other

³⁰ Opposer has entered into what it describes as “agreements . . . for appropriate concurrent use,” 14 TTABVUE 36, with the owners of two of these registered marks, CASA DE CIELO and VISTA DEL CIELO (stylized) and design, Cielo Decl. ¶ 19 (10 TTABVUE 18-19), but neither Opposer nor Mr. Cielo provided, or described the contents of, these agreements. Applicant did not discuss them, and the Board has rejected the notion that “a consent agreement with one third party is an admission that another’s use of the mark is not likely to cause confusion,” and has held that “[n]o such presumption can be made from that type of agreement.” *DC Comics v. Pan Am. Grain Mfg. Co.*, No. 91125404, 2005 WL 2093233, at *7 (TTAB 2005).

³¹ Applicant’s use evidence may also be probative of the conceptual weakness of Opposer’s CIELO mark even though it is offered primarily to show the commercial weakness of the mark, *Juice Generation*, 794 F.3d at 1339, and we will also consider it in our analysis below of the possible conceptual weakness of Opposer’s mark. *See August Storck*, 2025 WL 4107480,

third-party subsisting or cancelled registrations, and the third-party application, have little or no probative value regarding the conceptual weakness of Opposer's CIELO mark for the several reasons discussed above.

**(f) Analysis of Third-Party Registrations and
Uses on Conceptual Strength**

All of the relevant third-party registrations are for composite marks that contain significant and distinguishing matter in addition to CIELO, and in five of the marks, the word CIELO appears at the end. There is no doubt that the word CIELO in these composite marks refers to the sky or to heaven because it was translated as such in all of them. 13 TTABVue 6-10 (translating CASA DE CIELO as “House of Heaven”); 14-18 (translating the words “VISTA DEL CIELO” in the composite word-and-design mark as “sky view”); 22-24 (translating VIANDANTE DEL CIELO as “skywalker”); 25-27 (translating the words “CIELO SULLA TERRA” in the mark CIELO SULLA TERRA ESTATE VINEYARDS AND WINERY as “Heaven on Earth”); 31-32 (translating PUERTA DEL CIELO as “Heaven’s Gate”); 33-35 (translating PUNTA DEL CIELO as “Tip of the Sky”).³²

at *13 (“if under the sixth *DuPont* factor, there is evidence that a mark, or an element of a mark, is commonly used or registered by many different third parties for similar goods or services, that may indicate that the mark or common element has some conceptual weakness.”). At the same time, we note that evidence of third-party registrations unaccompanied by evidence of use of the registered marks is not probative of the commercial weakness of a mark. “Use evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing*, 2017 WL 6336243, at *14.

³² The word “cielo” was not disclaimed in any of the third-party registrations.

As noted above, third-party uses are also potentially probative of conceptual weakness, and Applicant made of record five third-party uses in the United States of CIELO-formative marks for wine, in the form of screenshots from winery websites captured on April 24, 2025. Ortega Decl. ¶ 10; Ex. D (12 TTABVUE 103-04, 16-21). They show the marks Sheehan Winery Cielo Dulce (sheehanwinery.com) (New Mexico), 12 TTABVUE 17; Cielo Farms (woodstockmalibu.com) (Malibu, California), *id.* at 18; Dono del Cielo (stylized) (donodelcielo.com) (Newcastle, California), *id.* at 19; 2022 Estate Cielo Red Blend (abundanciavineyardsllc.com) (Gaston, Oregon), *id.* at 20; and Ruby Hill 2021 Cielo Viola (rubyhillwinery.net) (Pleasanton, California), *id.* at 21. Two of the third-party uses translate the word “cielo” as “sky” or “heaven,”³³ and like the relevant third-party registrations, each of the third-party uses involves composite marks that contain matter in addition to CIELO.

Taken together, the third-party registrations and uses do not show that CIELO has “a normally understood and well-recognized descriptive or suggestive meaning” with respect to wine. *Spireon*, 71 F.4th at 1363 (quoting *Jack Wolfskin*, 797 F.3d at 1374). They show, at most, that “cielo” is mildly suggestive of some celestial quality of the goods. The record as a whole does not show that Opposer’s CIELO mark is conceptually weak.

³³ The Sheehan Winery website states that “Cielo Dulce” means “Sweet Heaven in Spanish,” 12 TTABVUE 16, while the Ruby Hill Winery website states that “Cielo Viola is an Italian phrase which can be translated as either ‘Violet sky’ or ‘Violet Heaven.’” *Id.* at 21.

ii. Commercial Weakness

Another “purpose of introducing evidence of third-party marketplace use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Heil Co.*, 2024 WL 4925901, at *21 (quoting *Omaha Steaks*, 908 F.3d at 1324 (quoting *Palm Bay*, 396 F.3d at 1374) (internal quotation omitted)). “The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* (quoting *Juice Generation*, 794 F.3d at 1338 (internal citations omitted)).

As discussed above, Applicant made of record five third-party uses in the United States of CIELO-formative marks for wine.³⁴ Applicant claims that “[t]hese examples are offered not for the truth of any underlying claims, but to demonstrate the frequency with which ‘cielo’ appears on beverage labels in ordinary trade channels.” 15 TTABVUE 8. Opposer argues that “there is no probative evidence of the extent of use of the term ‘cielo’ in commerce or any potential consumer recognition of the term ‘cielo’ from these five websites,” and that “[t]he existence of five unverified websites does not amount to the term ‘cielo’ being a common industry term for wine, nor does it significantly diminish the strength of Opposer’s CIELO trademark.” 14 TTABVUE 36. Opposer further argues that “both the limited quantity and quality of Applicant’s

³⁴ Applicant admitted in discovery that it “has no knowledge of third parties using or having used the term ‘Cielo’ by itself as an indicator of origin for wine.” 11 TTABVUE 19 (Resp. to Int. No. 46).

purported evidence of third party use is woefully inadequate to undermine the strength of Opposer’s CIELO trademark.” 14 TTABVue 32. Opposer concludes that “[w]hile Applicant may have identified some *de minimus* [sic] third party use of the term ‘cielo’, Opposer has been diligent in keeping such use to a minimum and ensuring that its CIELO trademark exclusively identifies Opposer’s wine,” and that Opposer “has initiated cancellation/opposition proceedings against thirteen trademarks, resulting in eight registrations being denied or cancelled, two agreements being reached for appropriate concurrent use, and three proceedings still pending.” *Id.* at 36.

In assessing Applicant’s third-party use evidence, we bear in mind that the Federal Circuit has held that the “probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay*, 396 F.3d at 1373 (citation omitted). Where “the ‘record includes no evidence of the **extent of [third-party uses]** . . . [t]he probative value of this evidence is thus minimal.” *Id.* (emphasis in bold here in italics in *Palm Bay*) (quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001)).³⁵

In *Palm Bay*, the Federal Circuit found unpersuasive the applicant’s evidence of “five different alcoholic beverages that use the term VEUVE” that “at various points of time appeared in an industry trade publication, the Beverage Media Guide, which

³⁵ Applicant surprisingly did not provide evidence of use of any of the marks shown in the most relevant third-party registrations discussed above. In *Spireon*, the Federal Circuit held that an opposer bears “the burden of showing non-use of identical [registered third-party] marks for identical goods,” *Spireon*, 71 F.4th at 1365, but none of the marks shown in the third-party registrations is identical to Opposer’s mark.

lists all beverage products in the wine and spirits categories sold by wholesalers to restaurants and retail stores in New York State,” *id.*, and the applicant’s evidence, obtained by its private investigator, that “six New York stores displayed for sale a VEUVE DE VERNAY sparkling wine as well as internet web sites and restaurant lists.” *Id.* at 1374.

On its face, the third-party use evidence here is even less potent than the evidence found wanting in *Palm Bay* because here we have only “snapshots” of five websites displaying wine under a CIELO-formative mark in April 2025, and no information regarding the extent of consumer exposure to these third-party marks through the websites or sales of the goods.³⁶ In the absence of **any** evidence regarding the exposure of these five third-party marks, they have little probative value in diminishing the commercial strength of Opposer’s mark unless they are sufficient in number to fall within an important exception to the general rule that the “probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay*, 396 F.3d at 1373 (citation omitted).

After *Palm Bay*, the Federal Circuit decided several cases in which the court held that evidence of the extent and impact of third-party marks may not be required if the third-party mark evidence is “powerful on its face.” *Juice Generation*, 794 F.3d at

³⁶ The website of Sheehan Winery states that there were “2383 bottles produced” of Cielo Dulce wine, and that the wine was the “Gold Medal Winner 2018 NM State Wine Competition,” Ortega Decl. Ex. D (12 TTABVUE 17), but as Applicant correctly acknowledges, 15 TTABVUE 8, we cannot consider the winery webpages for the truth of their contents, “whether there is an objection or not.” *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, No. 91221553, 2018 WL 1326374, at *6 n.18 (TTAB 2018).

1339. In *Juice Generation*, where the opposer's marks were "PEACE & LOVE" formatives for restaurant services, and the applicant's mark was PEACE LOVE AND JUICE and design for juice bar services, the applicant "introduced evidence of a fair number of third-party uses of marks containing 'peace' and 'love' followed by a third, product-identifying term," involving at least 26 different marks. *Id.* at 1339 & n.1. The Federal Circuit held that the Board erred when it "discounted the evidence because there were no specifics regarding the extent of sales or promotional efforts surrounding the third-party marks and, thus, what impact, if any, these uses have made in the minds of the purchasing public." *Id.* (quotation and quotation marks omitted). The court held that the applicant's evidence was "nonetheless powerful on its face" because the "fact that a considerable number of third parties use similar marks was shown in uncontradicted testimony." *Id.*

On the heels of *Juice Generation*, the Federal Circuit decided *Jack Wolfskin*, in which the opposer's mark was KELME (stylized) and a paw design for clothing and the applicant's mark was an angled paw print for clothing. The court stated that the applicant "presented voluminous evidence of paw print design elements that have been registered and used in connection with clothing, but the Board largely discounted these examples." *Jack Wolfskin*, 797 F.3d at 1373. The "voluminous evidence" involved at least 14 different third-party paw print marks. *Id.* at 1373 & n.2. The court held that the Board erred in not considering the "extensive evidence of third-party registrations depicting paw prints and evidence of these marks being used in internet commerce for clothing." *Id.* at 1373. Citing *Juice Generation*, the court

held that “such extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Id.* (quoting *Juice Generation*, 794 F.3d at 1339). The court concluded that the applicant’s

evidence demonstrates the ubiquitous use of paw prints on clothing as source identifiers. Given the volume of evidence in the record, consumers are conditioned to look for differences between paw designs and additional indicia of origin to determine the source of a given product. Jack Wolfskin’s extensive evidence of third-party uses and registrations of paw prints indicates that consumers are not as likely confused by different, albeit similar looking, paw prints. The Board’s conclusion that this factor was neutral is not supported by substantial evidence.

Id. at 1374.

Juice Generation and *Jack Wolfskin* bring to mind the adage that “quantity has a quality all its own.” These cases and their progeny stand for the proposition that where there is “voluminous” or “extensive” evidence of use of third-party marks, the specifics of the uses need not be proven to make the evidence probative of commercial weakness. They do not establish exactly how many third-party marks are required to show “voluminous” or “extensive” evidence of third-party marks, but we note in that regard that in *Juice Generation*, the Federal Circuit “refer[red] to 26 third-party marks as ‘a considerable number,’” *Apex Bank*, 156 F.4th at 1235 (quoting *Juice Generation*, 794 F.3d at 1337 n.1), and that in *Jack Wolfskin*, the Federal Circuit “highlight[ed] fourteen ‘notable examples of third-party registration and use.’” *Id.* (quoting *Jack Wolfskin*, 797 F.3d at 1373 n.2).

Obviously there can be no bright-line number of required third-party uses because the number necessary to show that the relevant “customers have become so conditioned by a plethora of such similar marks that [they] have been educated to distinguish between different such marks on the bases of minute distinctions,” *Palm Bay*, 396 F.3d at 1374, will depend on the facts of each case, including the number of sellers in the United States market for the involved goods or services, and other factors. As noted above, however, the United States wine market is a vast one consisting of both domestic and foreign sellers, and in the context of that market, we find that the uses of CIELO-formative marks discussed above do not constitute voluminous or extensive evidence of use of such marks that is “powerful on its face,” and thus they are insufficient to permit us to infer that “customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Omaha Steaks*, 908 F.3d at 1324 (quoting *Palm Bay*, 396 F.3d at 1374).

iii. Summary of Findings Under the Sixth *DuPont* Factor

We find that the third-party mark evidence falls short of establishing that Opposer’s CIELO mark for wine is either conceptually or commercially weak under the sixth *DuPont* factor. The sixth *DuPont* factor is neutral in our analysis of the likelihood of confusion, and we will accord Opposer’s CIELO mark the “normal scope of protection to which inherently distinctive marks are entitled.” *Iron Balls*, 2024 WL 2844425, at *15 (citation omitted).

3. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, “[w]e consider the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Sage Therapeutics*, 2024 WL 1638376, at *5 (citing *Palm Bay*, 396 F.3d at 1371). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, No. 87075988, 2018 WL 2734893, at *5 (TTAB 2018), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019)); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Sage Therapeutics*, 2024 WL 1638376, at *5 (quoting *Coach Servs.*, 668 F.3d at 1368). “The focus is on the recollection of the average purchaser, who normally ‘retains a general rather than a specific impression of marks.’” *Id.* (quoting *In re i.am.symbolic, llc*, No. 85916778, 2018 WL 3993582, at *4 (TTAB 2018) (citations omitted)). Because the identifications of the parties’ wine do not include “any price points or other restrictions as to channels of trade, the ‘average customer’ is an ordinary wine drinker.” *In re Aquitaine Wine USA, LLC*, No. 86928469, 2018 WL 1620989, at *2 (TTAB 2018).

“Because the parties’ goods, wine, are identical, less similarity between their marks is needed to find a likelihood of confusion.” *Stawski*, 2018 WL 6921710, at *17

(citing *Viterra*, 671 F.3d at 1363; *In re Mighty Leaf Tea*, 601 F.3d 1341, 1348 (Fed. Cir. 2010)).

The parties' marks are CIELO and O EL CIELO VALLE DE GUADALUPE, both in standard characters. Opposer argues that "[t]he addition of surplusage verbiage framing the dominant term 'CIELO' in Applicant's mark does not render Applicant's mark distinctive nor mitigate against a likelihood of confusion." 14 TTABVue 23. Opposer further argues that Applicant "disclaimed the geographic identifier 'VALLE DE GUADALUPE' in its mark," and that "the prefix O EL in Applicant's mark is merely a foreign language term translating to 'O the,' which is hardly distinctive," and "is likewise devoid of distinctiveness, given the above-indicated generic nature of 'EL' and the minimal visual and phonetic impact of the letter 'O'." *Id.* at 24. Opposer concludes that "when evaluating the Applicant's mark in context, it is clear that the dominant/distinctive part of Applicant's mark, and the overall commercial impression thereof, is the term 'CIELO', which is identical to Opposer's mark," *id.*, and that "when properly viewed through the lens of its dominant/distinctive term, Applicant's 'O EL CIELO VALLE DE GUADALUPE' mark creates the same overall commercial impression as Opposer's 'CIELO' Word mark and is likely to cause confusion therewith." *Id.* at 26.

Applicant responds that "Opposer's argument that 'CIELO' is the 'dominant' element of Applicant's mark ignores the weakness of 'CIELO' as a source indicator for wine." 15 TTABVue 14. Applicant further argues that its "mark, **O EL CIELO VALLE DE GUADALUPE**, is a unitary phrase that includes a distinctive initial 'O,'

the phrase ‘EL CIELO,’ and the geographically descriptive ‘VALLE DE GUADALUPE.’” *Id.* at 15 (emphasis supplied by Applicant). Applicant concludes that “[c]onsumers encountering Applicant’s mark in the marketplace are unlikely to perceive it as the same as, or even confusingly similar to, Opposer’s single-word ‘CIELO’ mark, especially given the crowded field.” *Id.*

Marks must be considered in their entirety, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *Detroit Athletic Co.*, 903 F.3d at 1305 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)).

As noted above, the parties disagree about the dominant portion of Applicant’s mark O EL CIELO VALLE DE GUADALUPE. The caption of the masthead of Applicant’s website at vinoselcielo.com identifies Applicant’s goods as “El Cielo Wines,” Cielo Decl. ¶ 21; Ex. 5 (10 TTABVue 21, 254-64),³⁷ and at the time of trial, Applicant promoted an “El Cielo Wine Club” through that website. Cielo Decl. ¶ 31; Ex. 95 (10 TTABVue 24, 327). We find that the words EL CIELO are the dominant portion of Applicant’s mark because they are the first significant literal elements in the mark,³⁸ and the words VALLE DE GUADALUPE that follow the words EL

³⁷ Applicant also owned a website at usa.vinoselcielo.com, 11 TTABVue 12 (Resp. to Int. No. 13), which was closed after the institution of this proceeding. *Id.* at 13 (Resp. to Int. No. 17).

³⁸ The letter “O” at the front of the mark appears to be an interjection without any source-identifying significance. Mr. Ortega, “a native Spanish speaker and fluent English speaker,” Ortega Decl. ¶ 7 (12 TTABVue 102), did not explain its meaning, and, as shown below, the labels on which Applicant has used its standard-character mark, including its specimens,

CIELO are geographically descriptive and have been disclaimed.³⁹ *See, e.g., Palm Bay*, 396 F.3d at 1372 (finding that the word VEUVE was the dominant element of the involved marks VEUVE CLIQUOT and VEUVE ROYAL); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (affirming the Board’s conclusion that the word DELTA was the dominant portion of the applicant’s mark THE DELTA CAFE and design where CAFE was disclaimed). The “non-source identifying nature of the words [VALLE DE GUADALUPE] and the disclaimer[] thereof constitute rational reasons for giving those [words] less weight in the analysis.” *Detroit Athletic Co.*, 903 F.3d at 1305.

We turn now to the required comparison of the marks in their entirety, in which we will give greater weight to the words EL CIELO in Applicant’s mark than to the letter O that precedes those words and the phrase VALLE DE GUADALUPE that follows them.

With respect to appearance, the parties’ marks CIELO and O EL CIELO VALLE DE GUADALUPE are both standard-character marks, and “each could be used in any typeface, color, or size, including the same stylization actually used or intended to be used by the other party, or one that minimizes the differences or emphasizes

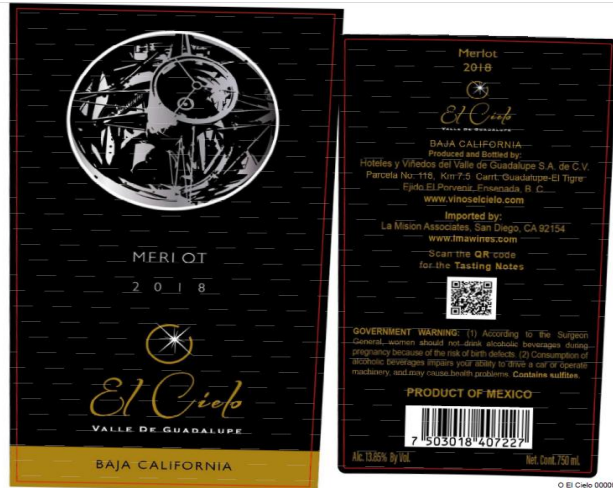
display the “O” as what Applicant calls “a stylized sun-and-vine device. . . .” 15 TTABVue 15.

³⁹ Applicant acknowledges that “[a] term that is a weak source indicator is unlikely to be the dominant portion of a mark.” 15 TTABVue 14 (citation omitted). During prosecution of the opposed application, the examining attorney required a disclaimer of VALLE DE GUADALUPE on the ground that it was primarily geographically descriptive of wine based on evidence that the Valle de Guadalupe is an area of Baja California, Mexico, known for wineries. March 16, 2023 Office Action at 6-7, 10-40. Applicant, who is located there, entered such a disclaimer. June 16, 2023 Response to Office Action at 5.

the similarities between the marks.” *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, No. 91194148, 2015 WL 5316485, at *8 (TTAB 2015) (citing *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1353 (Fed. Cir. 2011) (the “registrant is entitled to depictions of the standard character mark regardless of font style, size, or color, not merely ‘reasonable manners’ of depicting its standard character mark.”)). Accordingly, we must consider how the parties’ standard-character marks might appear, and “illustrations of the mark[s] as actually used may assist the T.T.A.B. in visualizing other forms in which the mark[s] might appear.” *Citigroup*, 637 F.3d at 1353.⁴⁰

The record contains significant evidence of how both parties’ standard-character marks might appear. Applicant submitted several depictions of its use of its standard-character mark O EL CIELO VALLE DE GUADALUPE on labels. Ortega Decl. ¶¶ 6-7; Ex. A (12 TTABVUE 101-02, 3-7). We reproduce a representative example below:

⁴⁰ We consider the actual use of the involved marks for the limited purpose of “visualizing other forms in which the [standard-character] mark[s] might appear,” *Citigroup*, 637 F.3d at 1353, in assessing the possible visual similarity of the marks. The owner of a standard-character mark cannot rely on any current actual use of the mark to argue dissimilarity in appearance because “[t]he rights associated with a standard character mark reside in its wording, and not in any particular display,” which could change at any time. *Look Cycle Int’l v. Kunshan Qiyue Outdoor Sports Goods Co.*, No. 92079409, 2024 WL 3739358, at *9 (TTAB 2024) (citing *Citigroup*, 637 F.3d at 1353).



Ortega Decl. Ex. A (12 TTABVUE 4).

One of Applicant's specimens of use of its standard-character mark shows Applicant's bottles of wine with the mark, as depicted above, on the label:



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⁴¹ June 16, 2023 Specimen at 1.

This rendering of Applicant's standard-character mark has also appeared on third-party materials announcing Applicant's receipt of awards for its wines:



Ortega Decl. ¶ 8; Ex. B (12 TTABVUE 102-03, 15).

Mr. Ortega opined that on Applicant's labels, "EL CIELO' is no more prominent than the 'O' or the 'VALLE DE GUADALUPE'," and he claimed that "we typically employ a design in which the 'O' with the star is the dominant feature:"



and that "[t]he 'O' is sometimes relatively smaller than it is in this example but it still carries the shining star in some form and draws the eye more than the 'EL CIELO.'" Ortega Decl. ¶ 6 (12 TTABVUE 101).

We disagree with Mr. Ortega's opinion that EL CIELO is no more prominent visually on Applicant's labels than the other elements of Applicant's mark. As shown above, Applicant's labels display its standard-character mark O EL CIELO VALLE DE GUADALUPE in a stacked presentation in which the words "El Cielo" generally appear in script lettering that is larger and more eye-catching than the letter O and

its accompanying design that appears above “El Cielo,” and the block-letter words VALLE DE GUADALUPE that appear below “El Cielo.” This actual display of Applicant’s standard-character mark shows that the mark could be used in a manner that draws attention to the dominant words EL CIELO in the mark.

Opposer also submitted evidence of its use of its standard-character CIELO mark on wine labels. One example is shown below:



Cielo Decl. ¶ 13; Ex. 1 (10 TTABVue 13, 55). This display of Opposer’s standard-character CIELO mark shows that the mark could be used in a manner that is visually similar to the display of the script words “El Cielo” on Applicant’s labels.

There are visual differences between Opposer’s mark CIELO and Applicant’s mark O EL CIELO VALLE DE GUADALUPE owing to the presence of additional matter in Applicant’s mark. But both standard-character marks contain the word

CIELO, which is the entirety of Opposer's mark and which appears in the beginning of Applicant's mark, and the record shows that the marks could be used, and have been used, in the "same stylization actually used or intended to be used by the other party," and in a manner that "minimizes the differences or emphasizes the similarities between the marks." *Anheuser-Busch*, 2015 WL 5316485, at *8. We find that the marks are similar in appearance.

With respect to sound, Applicant's mark O EL CIELO VALLE DE GUADALUPE is a very long mark to verbalize, and the Board has acknowledged the "penchant of consumers to shorten marks." *Iron Balls*, 2024 WL 2844425, at *25 (quoting *In re Bay State Brewing Co.*, No. 85826258, 2016 WL 1045677, at *3 (TTAB 2016) (citing *In Abcor Dev. Corp.*, 588 F.2d 811, 815 (CCPA 1978) (Rich, J., concurring) ("the users of language have a universal habit of shortening full names from haste or laziness or just economy of words.")). Particularly given that Applicant's own website identifies its goods as "El Cielo Wines," we find that it is very likely, indeed probably inevitable, that wine consumers will shorten Applicant's "O EL CIELO VALLE DE GUADALUPE" mark to "El Cielo" when verbalizing it, such as when ordering the wine in bars and restaurants, or recommending it by word of mouth to others. *Cf. Bay State Brewing*, 2016 WL 1045677, at *3 ("Beer is often ordered by name, in a bar or restaurant, or from a menu, where only the name of the beer will be used. Many consumers ordering these goods from a bartender or waiter/waitress will not have the opportunity to see a label when they order the product. Further, if the beer is served in a glass because it is a draft beer from a keg, the consumer may never see a label.)).

As discussed above, the similarity of marks is not evaluated based on a side-by-side comparison, and that principle applies to similarity in sound as well as similarity in appearance and connotation. Consumers with a general recollection of the sound of Opposer's mark "CIELO" who later hear Applicant's mark verbalized as "El Cielo" are very likely to hear that mark as virtually identical in sound to Opposer's mark.⁴² The very close similarity of the marks in sound is particularly significant because the parties' goods are wine, which, like all alcoholic beverages, are often ordered verbally in a bar or restaurant. *See id.*

Finally, with respect to connotation, as noted above, Opposer and Applicant both translated the foreign-language word CIELO that constitutes or dominates their respective marks as "sky." Those wine consumers who speak Spanish or Italian would understand CIELO to mean "sky" in both marks, and for the many more wine consumers who do not speak those languages, "[t]o the extent [CIELO] has a meaning in connection with wine, it would have the same connotation in Applicant's mark as in [Opposer's] mark." *Aquitaine Wine*, 2018 WL 1620989, at *2. We find that the marks are similar in connotation and commercial impression.

"Similarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (citation omitted). The marks are similar in appearance, sound, and meaning and commercial impression. The first *DuPont* factor

⁴² The marks are also similar in sound even in the very unlikely event that Applicant's mark O EL CIELO VALLE DE GUADALUPE was verbalized in its entirety because "Cielo" is heard in the beginning of the mark.

supports a conclusion that confusion is likely. *Naterra, Inc. v. Bensalem*, 92 F.4th 1113, 1119 (Fed. Cir. 2024).

4. Eighth *DuPont* Factor

The eighth *DuPont* factor considers “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361. “Under the eighth *DuPont* factor, we ‘look at actual market conditions, to the extent there is evidence of such conditions of record.’” *Keystone Consol. Indus.*, 2024 WL 3771168, at *24 (quoting *In re Guild Mortg. Co.*, No. 86709944, 2020 WL 1639916, at *8 (TTAB 2020) (“our analysis as to the second, third, and fourth *du Pont* factors, discussing the similarity or dissimilarity of the services, channels of trade, and relevant consumers, is based, as dictated by precedent from the Federal Circuit, on the identifications **as set forth** in the application and the cited registration . . . [but] the eighth *du Pont* factor, by contrast . . . requires us to look at **actual market conditions**, to the extent there is evidence of such conditions of record.”) (emphasis in original; citations omitted)). The concurrent use of the marks without evidence of actual confusion is probative of no likelihood of confusion only if there “has been a significant opportunity for actual confusion to have occurred.” *Id.*

Opposer concedes that “there is no evidence of actual confusion.” 14 TTABVue 37. Applicant argues that “[t]here is no evidence of actual confusion in the record, despite years of concurrent use” and that “[t]he absence of confusion is particularly telling given the limited, targeted nature of Applicant’s U.S. sales and the crowded field.” 15 TTABVue 16. Opposer argues that “[w]ith *de minimis* sales and nearly no marketing or promotion of Applicant’s wine under the challenged mark, it is

unsurprising that evidence of confusion has not become pronounced.” 14 TTABVUE 38.

We agree with Opposer that the absence of evidence of actual confusion is not significant in this case. According to Mr. Ortega, Applicant sold its wine in the United States from 2016 until it “paused [its] U.S. distribution upon the institution of this opposition” in September 2023, Ortega Decl. ¶ 4 (12 TTABVUE 101), but it did so in what he claims are “trade channels [that] are not the same as Opposer’s,” namely, “La Mision Associates exclusively.” Ortega Decl. ¶ 5 (12 TTABVUE 101).⁴³ Mr. Ortega provided no information about the extent of Applicant’s sales through those claimed different trade channels, but in discovery Applicant stated that it had sales of only \$9,000 in 2018, the single year during that period for which it responded to an interrogatory requesting sales figures. 11 TTABVUE 11 (Resps. to Int. Nos. 9(F) and (G)). Applicant has also “not used its mark in marketing in the United States,” *id.* (Resp. to Int. No. 9(F)), and apparently has sold wine only in California, through e-commerce. *Id.* at 12 (Resp. to Int. No. 15).

We find that the evidence of concurrent use based on actual market conditions does not indicate a significant opportunity for confusion to have occurred. *See Keystone Consol. Indus.*, 2024 WL 3771168, at *26. The eighth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

⁴³ As discussed above, we must determine the channels of trade under the third *DuPont* factor based solely on the identifications of goods in the registration and application, but under the eighth *DuPont* factor, we must consider the parties’ actual channels of trade if there is relevant record evidence.

5. Other *DuPont* Factors

As discussed above, although Opposer acknowledges that “not every *Du Pont* factor is relevant or of similar weight in every case, and an opposer need not prevail on every single factor,” 14 TTABVUE 21, Opposer invokes the fourth, ninth, tenth, eleventh, and twelfth factors in addition to the first, second, third, fifth, sixth, and eighth factors discussed above. *Id.* at 38-40. We discuss the fourth, ninth, tenth, eleventh, and twelfth factors briefly below.

The fourth *DuPont* factor considers the “conditions under which and buyers to whom sales are made, i. e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 476 F.2d at 1361. Opposer argues that “[w]hen products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care,” 14 TTABVUE 28 (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000)), and that “it is clear that the goods are not expensive, luxury goods requiring consumers to exercise great care or expertise in their purchase.” *Id.* According to Opposer, the parties’ “wine is ‘sold at a relatively modest cost, [and] it is expected that consumers often purchase them on impulse without particular deliberation or care.’” *Id.* (quoting Cielo Decl. ¶ 10 (10 TTABVUE 10)).

The parties’ identifications of goods do not contain any limitations as to classes of consumers or price points, so we must presume that the parties’ wines could include both expensive and inexpensive wines. *Aquitaine Wine*, 2018 WL 1620989, at *9. Ordinary wine drinkers could exercise varying degrees of care in purchasing the

goods. We find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

The ninth *DuPont* factor considers “[t]he variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark).” *DuPont*, 476 F.2d at 1361.

Opposer argues that

“[b]oth Opposer and Applicant use their CIELO trademark and Contested Mark, respectively, for wine. In each case, the mark is used as the brand designator for several varieties of wine. The focused use of the CIELO trademark for a single product makes the Applicant’s use of its mark for the identical product more likely to result in confusion.

14 TTABVue 38.

Opposer’s argument misapprehends the ninth factor. “If a party in the position of plaintiff uses its mark on a wide variety of goods or services, then purchasers are more likely to view a defendant’s related goods or services under a similar mark as an extension of the plaintiff’s line,” *Monster Energy*, 2023 WL 417620, at *19 (citation omitted), and “[i]n some cases, where the goods are not obviously related, the ninth *DuPont* factor may favor a finding that confusion is likely.” *Iron Balls*, 2024 WL 2844425, at *26 (citing *Monster Energy*, 2023 WL 417620, at *19). “But in this case, ‘[g]iven the [identity] of the parties’ identified goods, we find it unnecessary to rely on this factor.’” *Id.* (quoting *Made in Nature*, 2022 WL 2188890, at *32). The ninth factor is inapplicable in our analysis of the likelihood of confusion.

The tenth factor considers “[t]he market interface between applicant and the owner of a prior mark,” such as “(a) a mere ‘consent’ to register or use,” “(b) agreement provisions designed to preclude confusion, i.e., limitations on continued use of the

marks by each party,” “(c) assignment of mark, application, registration and good will of the related business,” and “(d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.” *DuPont*, 476 F.2d at 1361.

Opposer does not refer to any of these sorts of “market interface,” but instead argues that “[t]his factor evidences Applicant’s bad faith adoption of the challenged mark and favors Opposer,” 14 TTABVUE 38, because “when the instant application was filed, Applicant was fully aware of Opposer’s prior registration and Opposer’s long standing rights in the CIELO trademark” based on the pendency of Opposer’s cancellation proceeding against Applicant’s Registration No. 4934913 of the mark CAPRICORNIUS EL CIELO for various alcoholic beverages, including wine. *Id.* at 37-38. Opposer also argues that Applicant admitted in discovery that prior to the filing of the opposed application, Applicant was aware of Opposer’s mark. *Id.* at 38-39 (citing 11 TTABVUE 25-26 (Resps. to Reqs. for Adm. Nos. 5-6)).⁴⁴

Opposer invokes the wrong *DuPont* factor in making these arguments. Bad faith adoption of a mark may be relevant under the thirteenth *DuPont* factor, *Major League Baseball Players Ass’n v. Chisena*, No. 91240180, 2023 WL 2986321, at *26 (TTAB 2023), *aff’d*, No. 23-2073 (Fed. Cir. Jan. 8, 2026) (citing *Quiktrip West, Inc. v.*

⁴⁴ Opposer further argues that “even many years beforehand, on July 26, 2013 (as is apparent from the USPTO online trademark records), the Applicant filed an application for the Design Trademark ‘O El Cielo’ (U.S. Serial No. 86/021,361) but such application was rejected by the USPTO Examiner based on a likelihood of confusion with the Opposer’s Registration No. 2,384,406 (i.e., the Opposer’s CIELO trademark), and ultimately such application was abandoned.” 14 TTABVUE 38. Applicant admitted in discovery that it filed the referenced July 2013 application, which it described as a “dead application,” 11 TTABVUE 10 (Resp. to Int. No. 7), but there is no record evidence regarding the circumstances of the abandonment of the application.

Weigel Stores, Inc., 984 F.3d 1031, 1036 (Fed. Cir. 2021)), but under that factor, “[a]n inference of ‘bad faith’ requires something more than mere knowledge of a prior similar mark,” *Quiktrip*, 984 F.3d at 1036 (quotation and quotation marks omitted), specifically, “an intent to confuse.” *Id.* (citation omitted). Opposer offers no evidence of Applicant’s intent to confuse, and the thirteenth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

The eleventh *DuPont* factor considers “the extent to which applicant has a right to exclude others from use of its mark on its goods.” *DuPont*, 476 F.2d at 1361. Opposer argues that “Applicant has not identified any established property right by which it can exclude others from using the challenged mark,” that “[t]o the extent it had developed any common law rights through its limited use of the challenged mark, those rights were not strong and are even more attenuated based on Applicant’s admission that it has discontinued use of the mark in the United States since around 2023,” and that “[t]he lack of Applicant’s enforceable property rights in the challenged mark favor [sic] Opposer with respect to the eleventh *Du Pont* factor.” 14 TTABVue 39 (citations omitted).

“In a likelihood of confusion determination, ‘applicant’s right to exclude’ considers applicant’s place in the market and any resulting consumer perception as defined by the applicant’s trademark use, insofar as that use is reflected in the mark and goods described in the application.” *Monster Energy*, 2023 WL 417620, at *20 (citation omitted). “The Board has previously considered an applicant’s right to exclude as assessing whether the applicant had achieved ‘an appreciable level of consumer

recognition’ **and** whether the applicant could demonstrate having ‘successfully asserted its [trademark] rights.’” *Id.* at *21 (emphasis in original) (quoting *McDonald’s Corp. v. McSweet LLC*, No. 91178758, 2014 WL 5282256, at *17 (TTAB 2014)).

Given its nature, the eleventh *DuPont* factor is customarily invoked “defensively” by the applicant, as in *Monster Energy*, to strengthen the applicant’s position in the overall *DuPont* analysis. We agree with Opposer that Applicant has not shown any appreciable right to exclude others based on its prior use of the O EL CIELO VALLE DE GUADALUPE mark, but we disagree with Opposer that the “lack of Applicant’s enforceable property rights in the challenged mark favor [sic] Opposer with respect to the eleventh *Du Pont* factor.” 14 TTABVUE 39. We instead find the eleventh factor to be neutral in our analysis of the likelihood of confusion.

Finally, the twelfth *DuPont* factor considers “[t]he extent of potential confusion, i. e., whether *de minimis* or substantial.” *DuPont*, 476 F.2d at 1361. Opposer argues that “the facts at bar strongly suggest that if Applicant obtained a registration for the Contested Mark, the potential for confusion with Opposer’s wine would be substantial,” 14 TTABVUE 40, based on consideration of the other *DuPont* factors. *Id.* Opposer concludes that if Applicant obtains a registration, Applicant’s goods will be “on a collision course with Opposer’s wine under the CIELO trademark and would surely result in consumer confusion,” and that the twelfth factor “suggests that potential confusion is all but inevitable if Applicant were to receive a registration for the Contested Mark” and “strongly favors Opposer.” *Id.*

Opposer's arguments concerning the extent of potential confusion under this factor essentially repeat arguments under the other *DuPont* factors, and have been duly considered, and we treat the twelfth *DuPont* factor as neutral. *See Heil Co.*, 2024 WL 4925901, at *37.

6. Summary of *DuPont* Factors

The key first and second *DuPont* factors, and the third factor, support a conclusion that confusion is likely, and the other applicable factors are neutral. The goods, channels of trade, and classes of consumers are identical, and the CIELO and O EL CIELO VALLE DE GUADALUPE marks are similar. We find, based on the record as a whole, that consumers with a general recollection of Opposer's CIELO mark for wine who separately encounter Applicant's mark O EL CIELO VALLE DE GUADALUPE for wine are likely to believe mistakenly that the goods have a common source.

V. Conclusion

Opposer proved that it is entitled to oppose the application under Section 2(d) of the Trademark Act, and also proved the elements of that claim, priority based on its registered CIELO mark and a likelihood of confusion, by a preponderance of the evidence.

Decision: The opposition is sustained.