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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	JJK Industries, L.P.
Granted to Date of previous extension	06/16/2004
Address	JJK Industries, L.P. 6425 S I H 35, #105-134 Austin, TX 78744 UNITED STATES

Correspondence information	Charles J. Rogers Attorney Winstead Sechrest & Minick P.C. 910 Travis Street, Suite 2400 Houston, TX 77002 UNITED STATES CRogers@winstead.com Phone:713-650-2716

Applicant Information

Application No	78129675	**Publication date**	02/17/2004
Opposition Filing Date	06/16/2004	**Opposition Period Ends**	06/16/2004
Applicant	Silver Moon Concepts, Inc.		

Goods/Services Affected by Opposition

Class 014. First Use: 20020201 First Use In Commerce: 20020201 All goods and sevices in the class are opposed, namely: JEWELRY, NAMELY, VIBRATING BODY JEWELRY, NON-VIBRATING BODY JEWELRY, BRACELETS, NECKLACES, EARRINGS, CHARMS, PENDANTS, RINGS, TOE RINGS, CHAINS, BEAD, WATCHES AND WATCH BANDS

Attachments	Notice of Opposition.pdf (16 pages)

Signature	/CRogers/
Name	JJK Industries, L.P.
Date	06/16/2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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JJK INDUSTRIES, L.P.,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. _____
	§	
SILVER MOON CONCEPTS, INC.,	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

Opposer JJK Industries, L.P. ("JJK") files this Notice of Opposition to oppose registration of the purported mark "THE TIGGLER THE ORIGINAL VIBRATING BARBELL POWERED BY A TINY DYNAMO TIGGLER HITS THE SPOT," which is the subject of Application Serial No. 78/129,675 ("the '675 Application"), published in the Official Gazette of February 17, 2004. For the following reasons, Opposer respectfully requests that the proposed registration to Applicant be refused.

I.
INTRODUCTION

1. This is an opposition proceeding brought by Opposer JJK against Applicant Silver Moon Concepts, Inc., through which JJK opposes the registration of the Applicant's purported mark "THE TIGGLER THE ORIGINAL VIBRATING BARBELL POWERED BY A TINY DYNAMO TIGGLER HITS THE SPOT." As grounds in support of its opposition, JJK asserts that the purported mark is merely descriptive, under Section 2(e)(1) of the Trademark Act, because it describes the characteristics, function, components, and other properties of the "vibrating body jewelry" goods identified in the '675 Application as a "vibrating barbell" that is "powered by a tiny dynamo" and "hits the spot."

2. JJK also asserts that the purported mark is deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, because it misdescribes the "vibrating body jewelry" goods identified in the '675 Application as "the original vibrating barbell," which is false. JJK also asserts that the purported mark is deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, because it misdescribes the "non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches and watch bands" goods identified in the '675 Application as a "vibrating barbell" that is "powered by a tiny dynamo," which cannot be true.

3. JJK further asserts that because the only goods identified in the '675 Application, in connection with which the Applicant (on information and belief) has used the purported mark, is "vibrating body jewelry" that infringes, in violation of 35 U.S.C. Section 271, certain claims of a United States patent owned by JJK, Applicant has no lawful use in commerce to be the basis for federal registration of the purported mark.

4. In addition, JJK asserts that the purported mark, which includes the phrase "the original vibrating barbell," so resembles the unregistered mark "The World's Only Oral Vibrator," previously used in the United States by JJK and not abandoned, as to be likely, when used on or in connection with the "vibrating body jewelry" goods identified in the '675 Application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

5. In addition to the foregoing inter partes grounds for its opposition, JJK asserts the following ex parte grounds for its opposition. JJK asserts that the '675 Application is void ab initio as to all goods identified in the Application other than "vibrating body jewelry" due to nonuse, because the Applicant (on information and belief), as of the May 17, 2002 filing date of

the Application, had not used the purported mark in commerce in connection with any of the goods identified in the '675 Application other than "vibrating body jewelry."

6. JJK also asserts that the Applicant has committed fraud through its assertion of false facts in the '675 Application regarding the Applicant's alleged use of the purported mark in connection with the identified goods, which has been deliberate and with the intent to deceive and mislead the public and the Office. The Applicant (on information and belief) has not used the purported mark in connection with any of the goods identified in the '675 Application other than "vibrating body jewelry."

7. In addition, JJK asserts that the Applicant has committed fraud through its assertion of false facts in the '675 Application regarding the Applicant's alleged dates of first use of the purported mark, which has been deliberate and with the intent to deceive and mislead the public and the Office. The Applicant (on information and belief) did not use the purported mark in commerce, or anywhere, until over several months after the February 1, 2002 date that the Applicant in the '675 Application asserts was its date of first use anywhere, and its date of first use in commerce.

8. Finally, JJK asserts that the Applicant has committed fraud through its improper use of the federal registration symbol, ®, which has been deliberate and with the intent to deceive and mislead the public and the Office.

II.
PARTIES

9. Opposer JJK is a limited partnership organized and existing under the laws of the State of Texas. Its principal place of business is at 6425 South IH 35, #105-134 Austin, Texas 78744-4230.

10. Applicant Silver Moon Concepts, Inc. was a Florida corporation when it filed the '675 Application on May 17, 2002. Since then, on May 7, 2003, Silver Moon Concepts, Inc. merged into Silver Moon Concepts, LLC, a Florida limited liability company, with the LLC being the surviving entity. The Applicant shall be referred to in this Notice of Opposition as Silver Moon Concepts, LLC, successor by merger to Silver Moon Concepts, Inc. (collectively "SMC").

III.
FACTUAL BACKGROUND

11. Opposer JJK is the owner of all right, title, and interest in and to United States Patent No. 6,382,815 ("the '815 patent"), entitled "Energized Body Jewelry," which was issued by the United States Patent and Trademark Office ("Office") to JJK on May 7, 2002.

12. The '815 patent grants to JJK the right to exclude others from making, using, selling, or offering for sale, within the United States, or importing into the United States, the "energized body jewelry" that is the subject matter of the claims of JJK's '815 patent.

13. JJK markets its patented "energized body jewelry" under the standard characters words mark TONGUE JOY®, United States Trademark Registration No. 2,582,316 ("the '316 Registration"), and the stylized compound word mark TongueJoy®, United States Trademark Registration No. 2,663,185 ("the '185 Registration"), for "jewelry" in International Class 14.

14. The date of first use, anywhere, and in commerce, set forth in JJK's '316 and '185 Registrations is November 22, 2000.

15. JJK also has been using in commerce its unregistered mark "The World's Only Oral Vibrator" in connection with its "energized body jewelry" since at least as early as January 7, 2001.

16. Through JJK's exclusive and continuous use in commerce of its unregistered mark "The World's Only Oral Vibrator" in connection with its "energized body jewelry" goods since at least as early as January 7, 2001, JJK's mark had become distinctive of JJK's goods in commerce and acquired secondary meaning prior to Applicant's alleged February 1, 2002 date of adoption of the purported mark set forth in the '675 Application, which includes the phrase "the original vibrating barbell."

17. The purported mark set forth in the '675 Application, which includes the phrase "the original vibrating barbell," so resembles JJK's unregistered mark "The World's Only Oral Vibrator," as to be likely, when used on or in connection with the "vibrating body jewelry" goods identified in the '675 Application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

18. On May 17, 2002, Applicant filed the '675 Application in the Office seeking to register the purported mark "THE TIGGLER THE ORIGINAL VIBRATING BARBELL POWERED BY A TINY DYNAMO TIGGLER HITS THE SPOT" for goods that were ultimately amended to be identified as "jewelry, namely, vibrating body jewelry, non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches and watch bands."

19. The alleged date of first use, anywhere, and in commerce, set forth in Applicant's '675 Application is February 1, 2002.

20. Applicant's purported mark is merely descriptive, under Section 2(e)(1) of the Trademark Act, because it describes the characteristics, function, components, and other properties of the "vibrating body jewelry" goods identified in the '675 Application as a "vibrating barbell" that is "powered by a tiny dynamo" that "hits the spot."

21. Applicant's purported mark is deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, because it misdescribes the "non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches and watch bands" goods identified in the '675 Application as a "vibrating barbell" that is "powered by a tiny dynamo." None of these goods identified in the '675 Application is a "vibrating barbell," and none (on information and belief) is "powered by a tiny dynamo."

22. On June 17, 2002, Opposer JJK filed a patent infringement action against Applicant SMC in the United States District Court for the Southern District of Texas, Houston Division. This patent infringement action has been consolidated into Civil Action No. H-02-2259 ("the 2259 Action"), which was an earlier-filed action in the same District against an affiliate of SMC described below. The 2259 Action is currently pending, with a Scheduling Order setting trial for February 2005.

23. In the 2259 Action, JJK asserts that SMC's "vibrating body jewelry" goods identified in the '675 Application infringe Claims 2, 3, 4, and 5 of JJK's '815 patent.

24. Because the only goods identified in the '675 Application, in connection with which the Applicant (on information and belief) has used the purported mark, is "vibrating body jewelry" that infringes, in violation of 35 U.S.C. Section 271, Claims 2, 3, 4, and 5 of JJK's '815 patent, Applicant has no lawful use in commerce to be the basis for federal registration of the purported mark.

25. In addition to being a patent infringement action, the 2259 Action is an interfering patents suit under 35 U.S.C. Section 291. JJK asserts in the 2259 Action that a patent issued to an affiliate of Applicant SMC, described below, interferes with JJK's '815 patent.

26. On July 16, 2002, ten (10) weeks after the Office issued JJK's '815 patent, the Office issued to Eric A. Klein ("Klein") United States Patent No. 6,419,649 ("the '649 patent") entitled "Erotic Stimulation Device."

27. Applicant SMC has asserted in the 2259 Action that it is an exclusive licensee of Klein's '649 patent, and is marketing its "vibrating body jewelry" goods identified in the '675 Application pursuant to this exclusive license agreement with Klein.

28. Klein's '649 patent interferes with JJK's '815 patent because the two patents claim the same patentable subject matter.

29. On the day that the Office issued Klein's '649 patent, July 16, 2002, Opposer JJK amended its Complaint in the 2259 Action to assert an interfering patents claim under 35 U.S.C. Section 291. JJK is asking the federal District Court in the 2259 Action to adjudge the question of the validity of the claims of Klein's '649 patent that interfere with certain claims of JJK's '815 patent, and thereby confirm the validity of JJK's '815 patent claims at issue, and render invalid each of the claims of Klein's '649 patent.

30. Through the interfering patents suit, the 2259 Action, the federal District Court will determine the priority of invention for the interfering subject matter, which includes the "vibrating body jewelry" goods identified in the '675 Application, and the "energized body jewelry" being marketed by JJK under its TongueJoy® trademarks that is a commercial embodiment of the invention disclosed and claimed in JJK's '815 patent.

31. In resolving the interfering patents suit, the 2259 Action, the federal District Court will determine whether the "vibrating body jewelry" goods identified in the '675 Application is the original vibrating barbell.

32. When the Opposer JJK prevails in the interfering patents suit, the 2259 Action, the federal District Court will have confirmed that JJK's patented "energized body jewelry" is the original, and the "vibrating body jewelry" goods identified in the '675 Application is not "the original vibrating barbell."

33. JJK asserts in the 2259 Action that it has priority of invention because its inventors were the first to conceive, and the first to reduce to practice, the interfering subject matter disclosed in JJK's '815 patent and Klein's '649 patent, which means that the "energized body jewelry" being marketed by JJK under its TongueJoy® trademarks is the original, and the "vibrating body jewelry" goods identified in the '675 Application is not "the original vibrating barbell."

34. Applicant's purported mark is deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, because it misdescribes the goods identified in the '675 Application as "<u>the original</u> vibrating barbell."

35. Applicant (on information and belief), as of the May 17, 2002 filing date of the '675 Application, had not used the purported mark in commerce in connection with any of the goods identified in the '675 Application other than "vibrating body jewelry." Applicant filed the '675 Application in the Office seeking to register the purported mark for goods that were ultimately amended to be identified as "jewelry, namely, vibrating body jewelry, non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches and watch bands." Applicant (on information and belief), as of the May 17, 2002 filing date of the '675 Application, had not used the purported mark in commerce in connection with non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings,

chains, bead, watches, or watch bands. The '675 Application is void ab initio as to each of these goods identified in the Application other than "vibrating body jewelry" due to nonuse.

36. The Applicant has committed fraud through its assertion of false facts in the '675 Application regarding the Applicant's alleged use of the purported mark in connection with the identified goods, which has been deliberate and with the intent to deceive and mislead the public and the Office. The Applicant (on information and belief) has not used the purported mark in connection with any of the goods identified in the '675 Application other than "vibrating body jewelry."

37. The Applicant has committed fraud through its assertion of false facts in the '675 Application regarding the Applicant's alleged dates of first use of the purported mark, which has been deliberate and with the intent to deceive and mislead the public and the Office. The Applicant (on information and belief) did not use the purported mark in commerce, or anywhere, until over several months <u>after</u> the February 1, 2002 date that the Applicant in the '675 Application asserts was its date of first use anywhere, and its date of first use in commerce.

38. The Applicant has committed fraud through its improper use of the federal registration symbol, ®, which has been deliberate and with the intent to deceive and mislead the public and the Office. The alleged specimens that the Applicant submitted to the Office in the '675 Application do not include the federal registration symbol, but the Applicant's actual use in commerce of the purported mark in connection with the "vibrating body jewelry" goods identified in the '675 Application does improperly include the federal registration symbol. The Applicant's improper use of the federal registration symbol has been deliberate and intentional, with the intent to deceive the purchasing public and others in the trade into believing that the purported mark has been registered. Applicant has aggressively misrepresented the status of its

purported mark by improperly using the federal registration symbol in connection with threats that it will vigorously enforce its intellectual property rights, apparently including federal registration trademark rights in the purported mark that do not exist. Applicant has asserted, in connection with its marketing of the "vibrating body jewelry" goods identified in the '675 Application, the following: "Please note that we have registered copyrights for almost all of styles offered on this site and we enforce our intellectual property rights globally. Reward available for those reporting violators. The Tiggler® is a protected by US patent #6,419,649 and we vigorously prosecute all those offering counterfeit products."

39. Applicant's fraud also includes its failure to disclose to the Office the Applicant's improper use of the federal registration symbol, which has been deliberate and with the intent to deceive and mislead the Office. Applicant's submission of alleged specimens in the '675 Application that do not include the federal registration symbol, while at the same time Applicant is aggressively misusing the federal registration symbol in the Applicant's actual use in commerce of the purported mark in connection with the "vibrating body jewelry" goods identified in the '675 Application, evidences the Applicant's deliberate intent to deceive and mislead the Office.

IV.
INTER PARTES ISSUES

COUNT ONE
DESCRIPTIVENESS

40. The purported mark is merely descriptive, under Section 2(e)(1) of the Trademark Act, because it describes the characteristics, function, components, and other properties of the "vibrating body jewelry" goods identified in the '675 Application as a "vibrating barbell" that is "powered by a tiny dynamo" and "hits the spot."

41. Applicant's proposed registration of the purported mark would interfere with Opposer JJK's right to lawful descriptive use of these terms to describe JJK's patented "energized body jewelry" as a "vibrating barbell" that is "powered by a tiny dynamo" and "hits the spot."

COUNT TWO
DECEPTIVELY MISDESCRIPTIVE

42. The purported mark is deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, because it misdescribes the "vibrating body jewelry" goods identified in the '675 Application as "the original vibrating barbell," which is false.

43. Opposer JJK would be damaged by the economic injury resulting from the Applicant's proposed registration of the purported mark, which is deceptively misdescriptive, because the registration would lead to lost sales to the extent that the purchasing public or others in the trade were to be deceived into believing that the Applicant's "vibrating body jewelry" goods identified in the '675 Application is "the original vibrating barbell," and prefer them to JJK's patented "energized body jewelry," which truly is the original.

44. The purported mark is deceptively misdescriptive, under Section 2(e)(1) of the Trademark Act, because it misdescribes the "non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches and watch bands" goods identified in the '675 Application as a "vibrating barbell" that is "powered by a tiny dynamo," which (on information and belief) is not true. None of these goods identified in the '675 Application is a "vibrating barbell," and none (on information and belief) is "powered by a tiny dynamo."

COUNT THREE
ABSENCE OF LAWFUL USE IN COMMERCE

45. Applicant's "vibrating body jewelry" goods identified in the '675 Application infringe Claims 2, 3, 4, and 5 of JJK's '815 patent.

46. Because the only goods identified in the '675 Application, in connection with which the Applicant (on information and belief) has used the purported mark, is "vibrating body jewelry" that infringes, in violation of 35 U.S.C. Section 271, Claims 2, 3, 4, and 5 of JJK's '815 patent, Applicant has no lawful use in commerce to be the basis for federal registration of the purported mark.

47. Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. Pursuant to 37 C.F.R. Section 2.69, when the sale of any product for which registration of a trademark is sought is regulated under an Act of Congress, and the sale violates the Act, including the patent statutes, the Office should refuse registration based on the absence of lawful use in commerce.

COUNT FOUR
LIKELIHOOD OF CONFUSION

48. JJK has been using in commerce its unregistered mark "The World's Only Oral Vibrator" in connection with its "energized body jewelry" since at least as early as January 7, 2001.

49. Through JJK's exclusive and continuous use in commerce of its unregistered mark "The World's Only Oral Vibrator" in connection with its "energized body jewelry" goods since at least as early as January 7, 2001, JJK's mark had become distinctive of JJK's goods in commerce and acquired secondary meaning prior to Applicant's alleged February 1, 2002 date of

adoption of the purported mark set forth in the '675 Application, which includes the phrase "the original vibrating barbell."

50. The purported mark set forth in the '675 Application, which includes the phrase "the original vibrating barbell," so resembles JJK's unregistered mark "The World's Only Oral Vibrator," as to be likely, when used on or in connection with the "vibrating body jewelry" goods identified in the '675 Application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

V.
EX PARTE ISSUES

COUNT FIVE
NONUSE
AS TO ALL GOODS IDENTIFIED IN THE APPLICATION OTHER THAN "VIBRATING BODY JEWELRY"

51. Applicant (on information and belief), as of the May 17, 2002 filing date of the '675 Application, had not used the purported mark in commerce in connection with any of the goods identified in the '675 Application other than "vibrating body jewelry." Applicant filed the '675 Application in the Office seeking to register the purported mark for goods that were ultimately amended to be identified as "jewelry, namely, vibrating body jewelry, non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches and watch bands." Applicant (on information and belief), as of the May 17, 2002 filing date of the '675 Application, had not used the purported mark in commerce in connection with non-vibrating body jewelry, bracelets, necklaces, earrings, charms, pendants, rings, toe rings, chains, bead, watches, or watch bands. The '675 Application is void ab initio as to each of these goods identified in the Application other than "vibrating body jewelry" due to nonuse.

COUNT SIX
FRAUD
APPLICANT'S ASSERTION OF FALSE FACTS
IN ITS APPLICATION REGARDING ITS
ALLEGED USE OF THE PURPORTED MARK
IN CONNECTION WITH THE IDENTIFIED GOODS

52. Applicant has committed fraud through its assertion of false facts in the '675 Application regarding the Applicant's alleged use of the purported mark in connection with the identified goods, which has been deliberate and with the intent to deceive and mislead the public and the Office. The Applicant (on information and belief) has not used the purported mark in connection with any of the goods identified in the '675 Application other than "vibrating body jewelry."

COUNT SEVEN
FRAUD
APPLICANT'S ASSERTION OF FALSE FACTS
IN ITS APPLICATION REGARDING ITS
ALLEGED DATES OF FIRST USE

53. Applicant has committed fraud through its assertion of false facts in the '675 Application regarding the Applicant's alleged dates of first use of the purported mark, which has been deliberate and with the intent to deceive and mislead the public and the Office. The Applicant (on information and belief) did not use the purported mark in commerce, or anywhere, until over several months <u>after</u> the February 1, 2002 date that the Applicant in the '675 Application asserted was its date of first use anywhere, and its date of first use in commerce.

COUNT EIGHT
FRAUD
APPLICANT'S IMPROPER USE
OF THE FEDERAL REGISTRATION SYMBOL ®

54. Applicant has committed fraud through its improper use of the federal registration symbol, ®, which has been deliberate and with the intent to deceive and mislead the public and

the Office. Applicant's improper use of the federal registration symbol has been deliberate and intentional, with the intent to deceive the purchasing public and others in the trade into believing that the purported mark has been registered by the Office. Applicant has aggressively misrepresented the status of its purported mark by improperly using the federal registration symbol in connection with threats that it will vigorously enforce its intellectual property rights, apparently including federal registration trademark rights in the purported mark that do not exist. Applicant has asserted, in connection with its marketing of the "vibrating body jewelry" goods identified in the '675 Application, the following: "Please note that we have registered copyrights for almost all of styles offered on this site and we enforce our intellectual property rights globally. Reward available for those reporting violators. The Tiggler® is a protected by US patent #6,419,649 and we vigorously prosecute all those offering counterfeit products."

55. Applicant's fraud also includes its failure to disclose to the Office the Applicant's improper use of the federal registration symbol, which has been deliberate and with the intent to deceive and mislead the Office. Applicant's submission of alleged specimens in the '675 Application that do not include the federal registration symbol, while at the same time Applicant is aggressively misusing the federal registration symbol in the Applicant's actual use in commerce of the purported mark in connection with the "vibrating body jewelry" goods identified in the '675 Application, evidences the Applicant's deliberate intent to deceive and mislead the Office.

VI.
PRAYER

Opposer JJK respectfully requests that this Opposition be sustained and that registration to the Applicant SMC be refused.

Respectfully submitted this 16th day of June, 2004.

/CRogers/

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