

ESTTA Tracking number: **ESTTA11152**

Filing date: **07/06/2004**

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

Proceeding	91160937
Party	Plaintiff JJK Industries, L.P. JJK Industries, L.P. 6425 S I H 35, #105-134 Austin, TX 78744 UNITED STATES
Correspondence Address	Charles J. Rogers Winstead Sechrest & Minick P.C. 910 Travis Street, Suite 2400 Houston, TX 77002 UNITED STATES CRogers@winstead.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Charles J. Rogers
Filer's e-mail	CRogers@winstead.com
Signature	/CRogers/
Date	07/06/2004
Attachments	JJK's First Amended Notice of Opposition.Opposition No. 91160937.pdf (12 pages)

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

JJK INDUSTRIES, L.P.,

Opposer,

v.

SILVER MOON CONCEPTS, INC.,

Applicant.

§
§
§
§
§
§
§
§

Opposition No. 91160937

**OPPOSER JJK INDUSTRIES, L.P.'S
FIRST AMENDED NOTICE OF OPPOSITION**

Opposer JJK Industries, L.P. (“JJK”) files this First Amended 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. Pursuant to 37 C.F.R. Section 2.107(a), and Rule 15(a) of the Federal Rules of Civil Procedure, Opposer JJK files this First Amended Notice of Opposition as a matter of course before Applicant has filed a responsive pleading in this action. Opposer JJK believes that it would be damaged by the registration of the purported mark as shown in the ‘675 Application. For the following reasons, Opposer JJK 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 “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” and “hits the spot,” which (on information and belief) is not true.

3. 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.”

4. 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.”

5. 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.

6. 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

7. Opposer JJK is a Texas limited partnership with its principal place of business at 6425 South IH 35, #105-134 Austin, Texas 78744-4230. JJK's general partner is BNC Management, LLC, which is a Texas limited liability company.

8. 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

9. Opposer JJK markets "energized body jewelry" under the standard characters words mark TONGUE JOY®, United States Trademark Registration No. 2,582,316 ("the '316 Registration") issued on June 18, 2002, and the stylized compound word mark TongueJoy®,

United States Trademark Registration No. 2,663,185 (“the ‘185 Registration”) issued on December 17, 2002, for “jewelry” in International Class 14.

10. 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.”

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

12. 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.”

13. 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” and “hits the spot.” None of these particular goods identified in the ‘675 Application is a “vibrating barbell,” and none (on information and belief) is “powered by a tiny dynamo” or “hits the spot.”

14. 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.

15. 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."

16. 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.

17. 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.

18. In addition, 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 alleged 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 [the] 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."

19. Since the June 16, 2004 filing of Opposer JJK's original Notice of Opposition in this proceeding, up through the July 6, 2004 filing of this First Amended Notice of Opposition, Applicant SMC has continued to use this quoted language on its Internet web site, including the federal registration symbol, in connection with its marketing of the "vibrating body jewelry" goods identified in the '675 Application.

20. 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

21. 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."

22. 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 "energized body jewelry" as a "vibrating barbell" that is "powered by a tiny dynamo" and "hits the spot."

COUNT TWO DECEPTIVE MISDESCRIPTIVENESS

23. 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" and "hits the spot," which (on information and belief) is not true. None of these particular goods

identified in the '675 Application is a "vibrating barbell" and none (on information and belief) is "powered by a tiny dynamo" or "hits the spot."

V.
EX PARTE ISSUES

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

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

25. 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 FIVE
FRAUD
APPLICANT'S ASSERTION OF FALSE FACTS
IN ITS APPLICATION REGARDING ITS
ALLEGED DATES OF FIRST USE

26. 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 asserted was its date of first use anywhere, and its date of first use in commerce.

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

27. 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 misrepresented the status of its purported mark by improperly using the federal registration symbol in connection with the purported mark. In addition, 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 alleged 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 [the] 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.”

28. Since the June 16, 2004 filing of Opposer JJK’s original Notice of Opposition in this proceeding, up through the July 6, 2004 filing of this First Amended Notice of Opposition, Applicant SMC has continued to use this quoted language on its Internet web site, including the federal registration symbol, in connection with its marketing of the “vibrating body jewelry” goods identified in the ‘675 Application.

29. 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 6th day of July, 2004.

/CRogers/

Charles J. Rogers
Winstead Sechrest & Minick P.C.
USPTO Registration No. 38,286
910 Travis Street, Suite 2400
Houston, Texas 77002-5895
Telephone: (713) 650-2716
Facsimile: (713) 650-2400
ATTORNEY FOR OPPOSER
JJK INDUSTRIES, L.P.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposer JJK Industries, L.P.'s First Amended Notice of Opposition is being served on Applicant by mailing the copy on the 6th day of July, 2004, via United States First Class Mail, postage prepaid to:

Silver Moon Concepts, Inc.
422 W. Fairbanks Avenue, Suite 300
Winter Park, FL 32789-5079

CM/RRR # 7001 0360 0003 6024 0532

/CRogers/

Charles J. Rogers
Winstead Sechrest & Minick P.C.
USPTO Registration No. 38,286
910 Travis Street, Suite 2400
Houston, Texas 77002-5895
Telephone: (713) 650-2716
Facsimile: (713) 650-2400
ATTORNEY FOR OPPOSER
JJK INDUSTRIES, L.P.