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Filing date: **04/09/2008**

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

Proceeding	91182537
Party	Plaintiff Lorillard Licensing Company, LLC
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Date	04/09/2008
Attachments	Response to Motion.pdf (11 pages)(260554 bytes)

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

In the Matter of Application Serial No.: 77/199,749
Published in the Official Gazette at TM Page 940 on October 30, 2007

For the Mark: **L&M FILTER MENTHOL 20 CLASS A CIGARETTES**

LORILLARD LICENSING CO., LLC.,)	
)	
Opposer,)	OPPOSER'S RESPONSE TO
)	APPLICANT'S MOTION TO
v.)	PARTIALLY DISMISS FOR FAILURE
)	TO STATE A CLAIM
TRADEMARKS, LLC,)	
)	Opposition No. <u>91182537</u>
Applicant.)	

Opposer, Lorillard Licensing Company, LLC, through its undersigned attorneys, responds to Applicant's Partial Motion to Dismiss as follows:

I. BACKGROUND

On February 20, 2008, Lorillard Licensing Company, LLC, (hereinafter "Lorillard") owner of the famous NEWPORT mark, filed an Opposition against Applicant's Application Serial No. 77/199,749. Lorillard alleged multiple theories for its harm from registration, including likelihood of confusion between Applicant's and Lorillard's marks (Notice of Opposition ¶ 8), and dilution (*Id.* ¶ 10).

In its motion to dismiss, Applicant argues that because Lorillard did not allege when its NEWPORT mark became famous and that dilution is likely, its Opposition based upon dilution

must be dismissed under Rule 12(b)(6) for failure to state a claim on which relief may be granted. (Motion at first paragraph).

If Lorillard's Notice of Opposition insufficiently pled dilution for failure to state that the NEWPORT mark was famous prior to Applicant's filing date, that defect has been cured by Lorillard's concurrent filing of its First Amended Notice of Opposition.

For these reasons, Applicant's motion must be denied.

II. ARGUMENT

A. Applicant's Motion to Dismiss Should be Denied as Moot

Lorillard concurrently files a First Amended Notice of Opposition (*See* attached Exhibit A.) to address the alleged deficiencies that form the basis for Applicant's Motion to Dismiss. This is enough on its own to justify denial of Applicant's motion. "If the amended compliant corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot." *See* Trademark Trial and Appeal Board Manual of Procedure § 503.03. Directly on point is the case cited by applicant itself, namely *Intel Corp. v. Garaga, Inc.*, 74 USPQ2d 1955 (TTAB 2005).

Lorillard's first amended notice of Opposition includes a separate statement that "The Registered Mark became famous prior to Applicant's filing date of June 6, 2007. Applicant's mark is likely to cause dilution by blurring or dilution by tarnishment of the Registered Mark in violation of 15 USC § 1125(c)." (*See* Exhibit A, paragraph 9.) In view of the amendment, Applicant's argument is moot and its motion should be denied.

III. CONCLUSION

Lorillard respectfully requests that the Board deny Applicant's Motion to Dismiss and accept as filed Opposer's First Amended Notice of Opposition.

Respectfully submitted,

/James L. Lester/
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MACCORD MASON PLLC
P.O. Box 2974
Greensboro NC 27402
(336) 273-4422

ATTORNEY FOR OPPOSER

Date: April 9, 2008

File No.: 4800-174B

CERTIFICATE OF SERVICE

I hereby certify that on April 9, 2008, a true and correct copy of the foregoing
OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO PARTIALLY DISMISS FOR
FAILURE TO STATE A CLAIM was served by United States first class mail, postage prepaid,
on counsel for Applicant:

Christopher P. Foley
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EXHIBIT A

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

In the Matter of Application Serial No.: 77/199,749
Published in the Official Gazette at TM Page 940 on October 30, 2007

For the Mark: **L&M FILTER MENTHOL 20 CLASS A CIGARETTES**

LORILLARD LICENSING CO., LLC,)	
)	
Opposer,)	FIRST AMENDED
)	NOTICE OF OPPOSITION
v.)	Opposition No. <u>91182537</u>
)	
TRADEMARKS, LLC,)	
)	
Applicant.)	

Opposer, Lorillard Licensing Company, LLC, a North Carolina limited liability company, having its principal place of business at 300 North Greene Street, Greensboro, North Carolina [hereinafter “Lorillard Licensing”], believes it will be damaged by registration of the mark **L&M FILTER MENTHOL 20 CLASS A CIGARETTES** identified by Serial No. 77/199,749, published in the *Official Gazette* on October 30, 2007 (TM 940) for “cigarettes” (International Class 34), and hereby opposes same. Opposer was granted an extension of time up until 27 February 2008, as per ESTTA tracking number ESTTA 174235. Opposer filed a Notice of Opposition on February 20, 2008. This paper amends that Notice of Opposition.

As grounds for opposition, it is alleged that:

1. Opposer is the assignee of a number of trademarks used by Lorillard Tobacco Company under license, including Newport®, Kent® and True®.
2. Opposer is also the owner of U.S. Trademark Registration No. 1,191,816 for the mark **NEWPORT** for cigarettes (International Class 34)[hereinafter “the Registered Mark”].

The Registered Mark was registered on the Principal Register on March 9, 1982 and was based on an application filed in the U.S. Patent and Trademark Office on May 22, 1980. The Registered Mark is incontestable under 15 U.S.C. § 1065 and was renewed as of January 17, 2002. A copy of the registration is attached hereto as Exhibit A.

3. Lorillard Tobacco Company first used the Registered Mark in commerce in 1956. The Registered Mark is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use said design mark in commerce on the goods specified in the registration.

4. For many years, and long prior to Applicant's filing date, Opposer has used the Registered Mark in interstate commerce throughout the United States in connection with the sale of cigarettes.

5. Ever since the adoption and use of the Registered Mark, Opposer has widely and extensively advertised and sold goods bearing the Registered Mark. Such use has inured to the benefit of Opposer and as a consequence of same, the consuming public and trade have come to recognize and do recognize the Registered Mark as being used by Opposer and by a single source, and to associate and identify the mark with Opposer. Opposer derives substantial good will and value from the identification and association of the Registered Mark with Opposer by the consuming public and trade. The Registered Mark is inherently distinctive for use with cigarettes, and has further developed distinctiveness in the minds of the public.

6. By the application herein opposed, Applicant seeks to register its design mark for "cigarettes" (International Class 34). The goods listed in Applicant's application are identical to and/or closely related to the goods identified for use with the Registered Mark.

7. Applicant's mark is confusingly similar to Opposer's Registered Mark.

8. When applied to Applicant's goods, Applicant's mark is likely to cause confusion and mistake and to deceive, with consequent injury to Opposer, the consuming public, and trade.

9. The Registered Mark became famous before Applicant's filing date of June 6, 2007. Applicant's mark is likely to cause dilution by blurring or dilution by tarnishment of the Registered Mark in violating 15 U.S.C. § 1125(c).

10. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark sought to be registered, will dilute Opposer's Registered Mark, and will give color and exclusive statutory right to Applicant in violation and derogation of prior and superior rights of Opposer.

WHEREFORE, Opposer believes it will be damaged by registration of Applicant's mark and prays that registration not be allowed.

The Commissioner is hereby authorized to charge fees which may be required, or credit any overpayment to Deposit Account No. 501923.

/James L. Lester/
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(336) 273-4422

ATTORNEY FOR OPPOSER

Date: April 9, 2008

File No.: 4800-174B

CERTIFICATE OF SERVICE

I hereby certify that on April 9, 2008, a true and correct copy of the foregoing FIRST AMENDED NOTICE OF OPPOSITION was served by United States first class mail, postage prepaid, on counsel for Applicant:

Christopher P. Foley
Linda K. McLeod
FINNEGAN, HENDERSON, FARABOW,
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EXHIBIT A

Int. Cl.: 34

Prior U.S. Cl.: 17

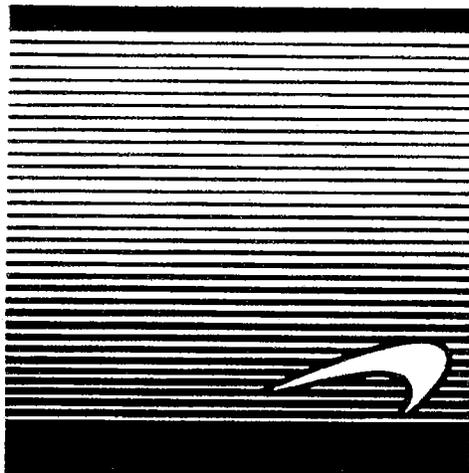
United States Patent and Trademark Office

Reg. No. 1,191,816

Registered Mar. 9, 1982

TRADEMARK
Principal Register

Newport



Loew's Theatres, Inc. (New York corporation), a.k.a.
Lorillard Division
666 5th Ave.
New York, N.Y. 10019

For: CIGARETTES, in CLASS 34 (U.S. Cl. 17).
First use Jun. 14, 1956; in commerce Jun. 14, 1956.
Owner of U.S. Reg. Nos. 871,160, 894,895 and
1,108,876.

The lining and/or stippling shown on the drawing
does not indicate color.

Ser. No. 263,210, filed May 22, 1980.

R. S. BREN, Primary Examiner