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

Proceeding	91183753
Party	Defendant Yassinn Patrice Diallo
Correspondence Address	Yassinn Patrice Diallo 2 Square Tribord COURCOURONNES 91080, FRANCE yassinn.diallo@laposte.net
Submission	Brief on Merits for Defendant
Filer's Name	Yassinn Patrice Diallo
Filer's e-mail	yassinn.diallo@laposte.net
Signature	/yassinn patrice diallo/
Date	04/19/2010
Attachments	Brief on merit for defendant's 91183753.pdf ( 29 pages )(10600950 bytes )

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

HEAVEN HILL DISTILLERIES, INC	)	
	)	
Opposer,	)	
	)	Opposition No.91183753
V.	)	
	)	Serial No. 77/266,196
	)	Mark HYPNOTIZER
	)	
DIALLO YASSINN PATRICE,	)	Intl Class: 033
	)	
Respondent,	)	

**BRIEF ON MERIT FOR DEFENDANT**

Defendant's Yassinn Patrice DIALLO, respectfully request to the Trade Mark Trial and Appeal Board to reject the observations, arguments and elements sent by the Opposer as they have no ground.

Defendant's, DIALLO YASSINN PATRICE a citizen of France, resident in 2 Square Tribord, 91080 Courcouronnes, France, denies that if his application serial N° 77266196 for the mark HYPNOTIZER is allowed to issue as a registration, it will harm Opposer HEAVEN HILL Distilleries inc, a Kentucky corporation with its principal place of business at 1064 Loretto Road, Bardstown, Kentucky, U.S.A 40004.

No likelihood of confusion, mistake or deception of purchasers or potential purchasers exists between the Opposer's claimed use of its HPNOTIQ Mark and the defendant's use of its trademark HYPNOTIZER because the marks are easily distinguishable in appearance, sound and meaning.

The Respondent DIALLO YASSINN PATRICE never discusses the fact that HEAVEN HILL owns all right on HPNOTIQ mark, but he doesn't agree with the fact that HEAVEN HILL has a right on HYPNOTIZER trade mark. The affirmations and the material facts of HEAVEN HILL in this case are in dispute.

We never discuss that HPNOTIQ belongs to HEAVEN HILL. But HEAVEN HILL admits in the Opposer's response to Respondent first set of request for admissions that HYPNOTIZER doesn't belong to them (exhibit 1).

On September 24 2007, HEAVEN HILL informed the Administrator of the Examiner's failure to identify HEAVEN HILL's mark due to an inadequate search performed during examination. The Administrator denied this protest and allowed publication of the mark HYPNOTIZER on April 8, 2008.

Wherefore, Applicant, DIALLO YASSINN PATRICE, respectfully requests that the opposition be dismissed with prejudice and his application Serial No. 77266196 be registered.

All the decisions mentioned by HEAVEN HILL concerning the case cited on this opposition are not cases similar to that one because HPNOTIQ is not a famous mark, see TTAB decision in opposition 91165621. And all the case cited concern famous mark.

**1. Differences between HPNOTIQ and HYPNOTIZER marks, from a visual, phonetic, intellectual point of view.**

Moreover, The US Trade Mark Office during office Record search for the Application HYPNOTIZER said : The Office Records have been search and no similar registered or pending mark has been found that would bar registration under Trade Mark Act section 2 (d), 15 USC 1052 (d). The opponent can't use this argument and affirm in his ground on the Priority and likelihood of confusion Trademark Act section 2(d).

Diallo Yassinn Patrice seeks registration for HYPNOTIZER mark, which is completely different in terms of products, mark, packaging, size, price (exhibit 2).

As HEAVEN HILL recognizes at the end on page 16 of Memorandum in Support of Opposer's Motion for Summary Judgment and Motion to suspend, « ...the different spellings and differences in phonetic pronunciation of the two marks.... » . For these reasons the consumers will not be confused.

Moreover HEAVEN HILL recognize at the beginning of page 17: « ... there has not yet been evidence of actual confusion between goods bearing HPNOTIQ mark and those bearing HYPNOTIZER mark... », and affirms: « ...the lack of evidence of actual confusion at this point...»

Hypnotizer mark is not made for flavored sparkling water as the opponent lawyer try to affirms. The opposite party can clearly see, that in October 2005 a registration certificate was delivered by French NIPO for HYPNOTIZER with a specific design (exhibit 3). Opposed to what the Opposer lawyer intend to demonstrate, HYPNOTIZER application is for specifics beverages including rum, as mentioned on the certificate design (exhibit 4). It is a clear

evidence that we claim a special style, with a special bottle, and with colors and specific design, completely different from the opponent design (exhibit 5). It is a clear evidence that we apply for a specific mark and a specific design completely different to opponent mark and design, and not only a mark as a word.

Again HEAVEN HILL conceded in his memorandum that there is no likelihood of confusion and that there is no evidence of actual confusion.

More over as the TTAB affirms, we must consider first the similarity or dissimilarity of the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports INC. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Circ.2005).

The TTAB decided in this opposition N° 99183753 mailed February 24, 2009 when the Opposer's ask for a summary judgment and the Board denied it, that " The marks HYPNOTIZER and HPNOTIQ can be viewed as having different meanings and providing different commercial impressions". See *Lloyd's*, 25 USPQ2d, at 2030; *Old Tyme foods*, 22 USPQ2d at 1545. We can also see that the sound and the appearance of HYPNOTIZER, are completely different from HPNOTIQ. The two Trade Marks would not be pronounced the same.

For these reasons Diallo's application should be registered pursuant to 15 U.S.C § 1052(d).

## **2. Differences of products between HPNOTIQ and HYPNOTIZER marks.**

No likelihood of confusion, mistake or deception of purchasers or potential purchasers exists between the Opposer's claimed use of its HPNOTIQ Mark and the defendant's use of its

trademark HYPNOTIZER because the marks are used in connection with different products and beverages, and marketed to different classes of consumers.

As opposed to what the opposing party affirms, Respondent Diallo Yassinn Patrice doesn't want to register the HYPNOTIZER mark for liqueur (exhibit 6), and as it is indicated on his Application form, the registration for HYPNOTIZER is filed for specific products as : Alcoholic beverage produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines.

Applicant denies the allegation of the opponent concerning the fact that the Applicant Diallo Yassinn Patrice wants to register the HYPNOTIZER mark in connection with liqueur because it is absolutely false. For these reasons Diallo Yassinn Patrice's application to register the HYPNOTIZER mark will not cause confusion, mistake, deception, or affiliation with HEAVEN HILL's HPNOTIQ mark for liqueur.

HPNOTIQ is used for a specific product the liqueur (exhibit 7), HYPNOTIZER is used for different products, there's no likelihood of confusion and moreover of dilution between the two Trade Marks. Diallo Yassinn Patrice's application should be registered pursuant to 15 U.S.C §§ 1052, 1063.

The law is clear in this case and the UPSTO decided to reject the argument of Heaven Hill because they considered that the trade mark HYPNOTIZER was not confusingly similar to the previously registered HPNOTIQ mark. The facts in this case are clear; the HYPNOTIZER mark is not confusingly similar to HEAVEN HILL's HPNOTIQ mark because the good listed in

Diallo Yassinn Patrice application are different from liqueur, which does not appear in the products listed by Yassinn Patrice application for the HYPNOTIZER mark. Therefore, the TTAB should accept Diallo Yassinn Patrice application.

### **3. Lack of recognition of HPNOTIQ Marks.**

HEAVEN HILL argues that HPNOTIQ is a famous mark. Yet, a previous decision by TTAB (TTAB decision in opposition N° 91165621) concluded that the evidence is not sufficient to prove that HPNOTIQ is a famous mark. In fact it is the duty of a plaintiff asserting that its mark is famous to clearly prove it, as the TTAB says. “Blue Man Productions INC. v Tarmann, 75 USPQ2d 1811, 1819 (TTAB 2005). The mark HPNOTIQ has been in use for a short period of time, six years. More over there is no evidence as to Opposer’s advertising expenditure. The Opposer’s didn’t provide any examples of its advertising or promotional materials to assist in determining the impact of the mark consumer.

### **4. Incoherencies of the declarations of the deposition for Opposer of Justin Ames HPNOTIQ brand Manager, and Drew Wesley Account Manager.**

On the ground of Rule 28 of the Federal Rules of Civil Procedure 37 CFR 2.123 (d), Applicant request the TTAB to reject deposition made by Drew Wesley, Justin Ames and direct examination made by Matthew Williams. In fact, they are in conflict of interest in their depositions and direct examination, as they are employees and legal counsel of the opposer Heaven Hill Distilleries.

37 CFR 2.123(d) Persons before whom depositions may be taken.

Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.

(a) Within the United States. Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.

(c) Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

On page 18 of his declaration, Norman Drew Wesley and Matthew Williams, the lawyer representing HEAVEN HILL, also employer of Norman Drew Wesley state that HEAVEN HILL employed the name HPNOTIZER for cocktails in a booklet for the promotion of HPNOTIQ product.

Yet, the Applicant filed the application for HYPNOTIZER trade mark in France on February 18<sup>th</sup> , 2005 and the Applicant's HYPNOTIZER trade mark was published on BOPI (Bulletin Officiel de la Propriété Intellectuelle) (exhibit 8) on March 25<sup>th</sup>, 2005. In May 2005, the lawyer of HEAVEN HILL in France contacted the Applicant requesting that the Applicant abandon its trade mark HYPNOTIZER (exhibit 9).

Hence, this statement proves the lack of objectivity of Norman Drew Wesley's declaration as the Opposer knew about the existence of the Applicant's HYPNOTIZER trade mark at least since March 2005.

On page 7 of his testimony, line 24 to 25, Norman Drew Wesley states that HEAVEN HILL is his biggest client, and at the beginning of page 8 he states that he is in charge of all aspects of marketing and advertising of HPNOTIQ trade mark.

On page 18 of Norman Drew Wesley's testimony, line 16 to 21, he acknowledges that a booklet was edited on May 10<sup>th</sup>, 2005 with a particular recipe named HPNOTIZER. Hence, one can easily assume that Norman Drew Wesley was informed about the existence of the trade mark HYPNOTIZER in March 2005 and decided to create a cocktail that would be called HPNOTIZER.

All declarations on risk of confusion made starting from page 36 are pure speculations and prove their lack of independence due to their subordination to their biggest client, HEAVEN HILL Distilleries. The supposed risk of confusion mentioned on page 39 and 40 is a pure speculation with no ground. The declarations on page 41 on the positioning of HYPNOTIZER trade mark are incorrect, HYPNOTIZER is not targeting women.

Hence, all these declarations are driven by the financial interest of their author and cannot be taken into consideration as acceptable and admissible proof.

The declaration of Justin AMES is also subject to caution. Indeed, due to his subordination to his employer HEAVEN HILL, his statement is not independent from the Opposer.

Both Justin AMES and Matthew Williams the lawyer of the Opposer cannot be considered as objective due to their lack of independence. They cannot be judge and party.

On page 15, Justin AMES acknowledges that HPNOTIQ product is liquor. Hence, he cannot contradict the mention on the certificate of registration of HPNOTIQ showing that it is liquor and try to let believe that the product is something else. He also states that HPNOTIQ has 3 syllables while on the certificate it is written "HPNOTIQ", hence two syllables, « HPNO » « TIQ ».

In page 16 of his declaration, he state that HPNOTIQ targets women, yet in page 17 he states that this product used to target the HIP HOP universe. Hence, the target of HPNOTIQ is not precisely defined.

On page 19 of his declaration, Justin Ames state that HEAVEN HILL protects its trade mark as follows: “We monitor other brands registration. We also use trade mark services. We look through magazines to see if other companies are producing or manufacturing any product that might use a similar name or confusingly similar name”.

This proves that when Applicant registered HYPNOTIZER trade mark in France, HEAVEN HILL was aware of Applicant’s HYPNOTIZER trade mark as soon as on March 25<sup>th</sup>, 2005 date of the publication of HYPNOTIZER in BOPI.

Page 21 and 22, Justin Ames acknowledges that HEAVEN HILL product is liquor and is sold on bottles of 750 ml. Again on page 25, Justin Ames mentions cocktails named HPNO-RITA and one other called HPNO-TIZER.

As Applicant has shown above, Justin Ames has discovered Applicant’s HYPNOTIZER in March, and instead of opposing immediately to this mark, he took the time to build a strategy to create a link between HPNOTIQ and HYPNOTIZER by using “HPNO-RITA” “HPNO-TIZER” and “HPNOTIZE” in order to be able to build a case for opposing Applicant’s trade mark, falsely claim ownership of HYPNOTIZER and risk of confusion with HPNOTIQ. The names HPNO-RITA” “HPNO-TIZER” and “HPNOTIZE” were therefore used by Opposer only after the publication of the Applicant’s HYPNOTIZER trade mark, as a strategy and propaganda in order to falsely claim a stake in Applicant’s HYPNOTIZER trade mark.

This appears in page 35 of the declaration saying “so the PR firm would have worked then to develop this name and the formulation for the drink”. On page 66, he acknowledges that he knew about Applicant’s HYPNOTIZER trade mark at the beginning of 2005, to the question: « when did you first become aware of Mr Diallo’s intent to use the Hypnotizer mark in connection wiht alcoholic beverages ? ” he answers :”Early 2005” which means as soon as March 2005.

On page 67, Opposer incorrectly states that he won the case in France against the registration of HYPNOTIZER for alcoholic beverages. This is not accurate as Applicant owns the trade mark HYPNOTIZER in France. As you may see (exhibit 10), Opposer requested Applicant not to market his products where HPNOTIQ is present. This request is illegal and has no ground.

On page 68, Opposer claims having a decision preventing Mr. Diallo from using HYPNOTIZER trade mark for alcoholic beverages in France and United Kingdom.

Yet the case in United Kingdom is not closed as Applicant has filed for alcoholic beverages and is pending decision (exhibit 11). Hence Opposer claim is not accurate.

He recognizes on page 72 that currently there is no risk of confusion between HYPNOTIZER and HPNOTIQ. In addition, HEAVEN HILL lawyer has not brought any proof of risk of confusion as of October 20th, 2009 in spite of its denied request for a Summary Judgment and a period for expert disclosure. No proof was given whereas Opposer was seeking declarations from experts.

On page 72, Justin Ames answers to the question of HEAVEN HILL lawyer : “And has HEAVEN HILL conducted any surveys to establish that consumers are likely to be confused by Mr Diallo’s proposed use of the Hypnotizer mark in connection with alcoholic beverages ?”, “ No conducting a reliable survey is an expensive proposition, and we didn’t think it was necessary because there is a high degree of similarity between Hypnotizer and Hpnotiq.”

Yet, in spite of the additional period of 7 month granted for expert disclosure, Opposer has not been able to provide any proof of risk of confusion.

The counsel of HEAVEN HILL is familiar with this proceeding as specialist law firm. He is supposed to know the laws and the rules as a specialist in the intellectual property.

The TTAB did mention the following before granting additional time to Opposer **“It has been six months since Opposer originally filed its motion for an extension of time. The**

**Board presumes that Opposer has made good use of its time since then to mitigate the issue of not having "sufficient time to complete discovery and prepare for trial."**

Yet, Opposer used additional time just to delay the trial without bringing any proof.

For these reasons Diallo's application should be registered pursuant to 15 U.S.C § 1052(d) and HEAVEN HILL opposition denied.

Respectfully submitted

DIALLO YASSINN PATRICE

**PROOF OF SERVICE**

I hereby certify that a true and correct copy of Brief on Merits for Defendant's was served on the following attorney for Opposer by deposit in the French Mail, in Paris France, in a sealed envelope, with first class postage fully prepaid this 18 April, 2010.

Matthew A. Williams

Wyatt Tarrant & Combs, LLP

500 West Jefferson Street, Suite 2800

Louisville, KY 40202

UNITED STATES.

502-562-7378 Telephone

Dated : April 18, 2010

DIALLO YASSINN PATRICE

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

HEAVEN HILL DISTILLERIES, INC.,	)		
	)		
Opposer,	)	Opposition No.	91183753
	)		
v.	)		
	)	Serial No.	77/266,196
DIALLO YASSINN PATRICE,	)	Mark:	HYPNOTIZER
	)	Intl Class:	033
Respondent.	)		

**OPPOSER'S RESPONSE TO RESPONDENT'S FIRST SET OF  
REQUEST FOR ADMISSIONS**

1. Please identify the Person(s) answering these interrogatories.

**RESPONSE:** Opposer objects to Request for Admission No. 1 because it fails to propound a statement to be admitted or denied. Without waiving the prior objection, undersigned counsel for Opposer Heaven Hill, Inc. have prepared these Responses to Respondent's Requests for Admissions.

2. Please admit that you want to steal the trademark HYPNOTIZER who belong to YASSINN PATRICE DIALLO, in order to use it for your profit.

**RESPONSE:** Denied.

3. Please admit that your product HPNOTIQ is used only in connection with one specific product the liqueur.

**RESPONSE:** Denied.

4. Please admit that the trade mark HYPNOTIZER is a trademark who belong to M DIALLO YASSINN PATRICE.

**RESPONSE:** Denied.

5. Please admit that the trademark HYPNOTIZER is not a trademark who belong to Heaven Hill Distilleries.

**RESPONSE:** Admitted.

EXHIBIT  
31183753  
1-DEFENDANT'S  
HEAVEN HILL V DIALLO

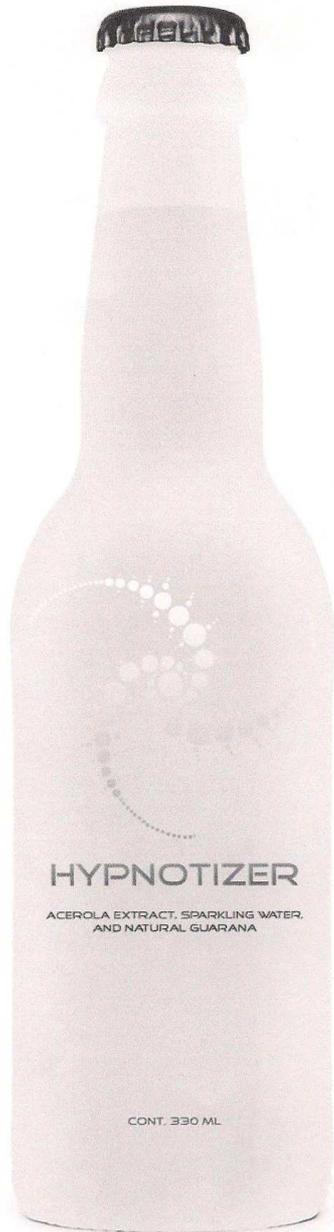


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Heaven Hill V DiAllo



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national de la propriété industrielle

Benoît BATTISTELLI

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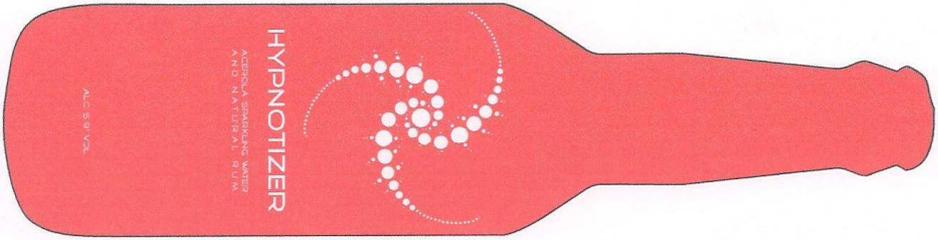


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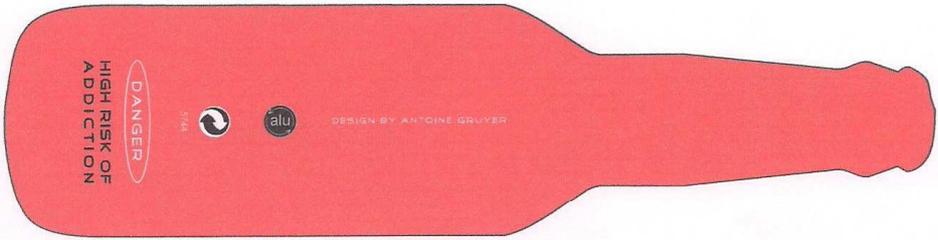
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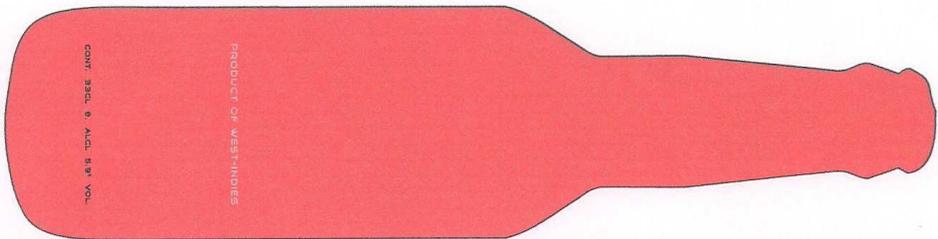
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SIDE



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4 - DEFENDANT'S  
Heaven Hill Vodka



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Heaven Hill VISUALS



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# HYPNOTIZER

**Word Mark** HYPNOTIZER

**Goods and Services** IC 033. US 047 049. G & S: Alcoholic beverage produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard cider, Natural sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, wines

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 77266196

**Filing Date** August 28, 2007

**Current Filing Basis** 1B

**Original Filing Basis** 1B

**Published for Opposition** April 8, 2008

**Owner** (APPLICANT) DIALLO YASSINN PATRICE INDIVIDUAL FRANCE 2 SQUARE TRIBORD COURCOURONNES FRANCE 91080

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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EXHIBIT  
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 G- DEFENDANT'S  
 Heaven Hill v Diallo

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

**United States Patent and Trademark Office**

Reg. No. 2,642,855

Registered Oct. 29, 2002

**TRADEMARK  
PRINCIPAL REGISTER**

**HPNOTIQ**

GLOBAL PERSPECTIVES, INC. (NEW YORK  
CORPORATION)  
108-50 62ND DRIVE  
FOREST HILLS, QUEENS, NY 11375

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

SER. NO. 76-372,289, FILED 2-20-2002.

FOR: LIQUEUR, IN CLASS 33 (U.S. CLS. 47 AND  
49).

YSA DEJESUS, EXAMINING ATTORNEY

EXHIBIT  
S1183753  
7 - DEFENDANT'S  
Heaven Hill V DiAllo

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**Classes de produits ou services :** 9, 16, 35, 36, 38, 41.

**N° National : 05 3 342 166**

**Dépôt du :** 18 FEVRIER 2005

à : I.N.P.I. PARIS

M DIALLO YASSINN PATRICE, 2 SQUARE TRIBORD, 91080 COURCOURONNES.

**Mandataire ou destinataire de la correspondance :**  
M DIALLO YASSINN, 2 SQUARE TRIBORD, 91080 COURCOURONNES.

### HYPNOTIZER

**Produits ou services désignés :** Bières; eaux minérales. Boissons alcooliques; vins; spiritueux.

**Classes de produits ou services :** 32, 33.

**N° National : 05 3 342 167**

**Dépôt du :** 18 FEVRIER 2005

à : I.N.P.I. PARIS

CONFEDERATION NATIONALE DU CREDIT MUTUEL, association régie par la loi du 1er juillet 1901, 88-90, rue Cardinet, 75017 PARIS.

**Mandataire ou destinataire de la correspondance :**  
ERNEST GUTMANN, YVES PLASSERAUD, S.A., 3 rue Chauveau-Lagarde, 75008 PARIS.

### DOMI +

**Produits ou services désignés :** Matériels, équipements et dispositifs électroniques pour la télématique, l'informatique, la bureautique, la monétique; appareils automatiques déclenchés par l'introduction d'une pièce de monnaie, d'un jeton ou d'une carte bancaire, distributeurs automatiques de billets; cartes bancaires; cartes à puce notamment cartes à mémoire, ou à micro-processeur ou magnétique ou à puce comportant un crédit d'unités, notamment d'unités téléphoniques; cartes téléphoniques; supports d'enregistrement magnétiques, numériques et optiques, cédérom, vidéodisques; appareils pour l'enregistrement, la transmission, la reproduction du son ou des images; équipement pour le traitement de l'information et les ordinateurs; téléphones, téléphones mobiles; assistant personnel (ordinateur), ordinateurs, ordinateurs portables, lecteur MP3; puces électroniques; cartes SIM; logiciels, notamment logiciels pour le traitement de l'information, logiciels de jeux, appareils pour jeux conçus pour être utilisés seulement avec récepteur de télévision; jeux automatiques (machines) à préparation. Cartes en papier; cartes en carton; produits de l'imprimerie; bulletins et imprimés d'abonnements téléphoniques, d'abonnements à un service de radiotéléphonie, d'abonnements à un service radiomessagerie, d'abonnements télématiques, d'abonnements à une base de données, d'abonnements à un serveur de bases de données, d'abonnement à un centre fournisseur d'accès à un réseau informatique ou de transmission de données, notamment de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet), d'abonnements à des journaux électroniques, d'abonnements à un service de télécommunication; livres; revues; magazines; journaux; dépliant en papier, prospectus en papier, affiches, calendriers, autocollants, imprimés publicitaires,

formulaires; papeterie; matières plastiques pour l'emballage à savoir, sacs, sachets, films et feuilles. Publicité, services de location d'espaces publicitaires. Services d'abonnements téléphoniques, abonnements à un service de radiotéléphonie, abonnements à un service radiomessagerie; abonnements télématiques, abonnements à une base de données, abonnements à un serveur de bases de données, abonnement à un centre fournisseur d'accès à un réseau informatique ou de transmission de données, notamment de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet); abonnements à des journaux électroniques; abonnements à des services de télécommunication. Consultations professionnelles d'affaires. Conseils, informations ou renseignements d'affaires dans les secteurs bancaire, financier, monétaire et boursier; consultations et informations dans le domaine de l'épargne; analyses, estimations, informations et prévisions économiques; renseignements économiques, statistiques et commerciaux sur les marchés financiers, monétaires et boursiers accessibles notamment par voies télématiques, par réseaux informatiques, par réseaux Internet, Intranet et Extranet; gestion de fichiers, de bases et de banques de données informatiques, d'annuaires professionnels électroniques dans les secteurs bancaire, financier, monétaire et boursier; gestion administrative de produits financiers, de portefeuilles de titres en bourse, gestion administrative de portefeuilles sous mandat; établissement de relevés de comptes, vérification de comptes. Assurances; affaires financières; affaires monétaires; affaires bancaires; affaires immobilières; gestion de comptes bancaires; gérance de portefeuille; services de cartes de crédit; courtage en assurance et courtage en bourse; estimations financières (assurances, banques, immobilier), estimations et expertises fiscales; recouvrement de créances; émissions de chèques de voyage et de lettres de crédit; services financiers, bancaires, monétaires et boursiers accessibles par réseaux téléphoniques, par réseaux de communications informatiques; réception, exécution et transmission d'ordres pour le compte de tiers (émetteurs et investisseurs) sur un ou plusieurs instruments financiers; gestion financière de portefeuilles sous mandat, gestion financière d'actifs pour le compte de tiers; analyse financière des marchés de taux, de change et d'actions; services d'informations et de conseils sur les produits financiers; services d'informations et de conseils en investissements et en placements financiers; services d'investissements et de placements financiers; agences de change, dépôts de valeurs, dépôts en coffres-forts; gérance de fortunes; crédit, prêts sur gage, prêt sur nantissement, crédit-bail; épargne; gestion de patrimoines mobiliers ou immobiliers; gestion de portefeuilles de titres en bourse; services de cartes de débit et de cartes de crédit; opérations et transactions sur les marchés financiers; émission d'emprunts indexés sur actions, émission d'obligations indexées sur actions et indices financiers et boursiers; informations bancaires, financières et monétaires accessibles notamment par voies télématiques, par réseaux informatiques, par réseaux Internet, Intranet et Extranet. Télécommunication, services téléphoniques, services de diffusion, de transmission d'informations par voie télématique; services de fourniture d'accès à des centres serveurs nationaux et internationaux; services de fournitures d'accès à un réseau téléphonique, radiotéléphonique, de communication mondiale; services de diffusion, de transmission d'informations par voie télématique; transmission de télégramme; transmission par satellite; transmission de messages; transmission et diffusion de données, de sons et d'images; transmission d'informations accessibles via des bases de données et via des centres serveurs de bases de données informatiques ou télématiques; services de fournitures de temps d'accès à des bases de données et à des centres serveurs de bases de données informatiques ou télématiques notamment pour les réseaux de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet); transmissions d'informations par code d'accès à des bases de données et à des centres serveurs de bases de données informatiques ou télématiques; service de courrier électronique, de messagerie électronique, et de diffusion d'informations par voie électronique, notamment pour les réseaux de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet); service de fournitures de temps d'accès à des réseaux téléphoniques, radiotéléphonique, télématiques; services de transmission sécurisée de données, de sons ou d'images; services de location d'appareils pour la transmission de données, de sons et d'images, location d'appareils pour la transmission de messages; location d'appareils et de postes téléphoniques et radiotéléphoniques, location de récepteurs, d'émetteurs téléphoniques et radiotéléphoniques; location, services d'informations en matière de télécommunications; transmission par télécommunication d'informations contenu de radiodiffusion; service de fc matique. Divertissements, info ment, d'éducation; organisati remise de prix; réservation de et conduite de colloques, de ct ion et conduite de concours lé nisation et conduite d'épreu

EXHIBIT  
SM83753  
8 - DEFENDANTS  
Heaven Hill DIALLO

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Varsovie

**Grégoire Triet**  
Associé  
Tél. +33 (0)1 40 75 61 51  
Fax +33 (0)1 40 75 37 01  
triet@gide.com

Monsieur M Diallo Yassinn Patrice  
2, square Tribord  
91 080 Courcouronnes

Paris, le 11 mai 2005

*Lettre recommandée avec accusé de réception*

**Réf. : Dépôt de la marque verbale Hypnotizer n° 05 3 342 166**

Monsieur,

Je suis le conseil de la société américaine Heaven Hill Distilleries, Inc., dont le siège social est situé 1064 Loretto Road – 40 004 Bardstown – Etats-Unis.

1. La société Heaven Hill Distilleries, Inc. est titulaire des marques suivantes :
  - marque française verbale "HPNOTIQ" enregistrée le 24 janvier 2002 sous le numéro 3 143 392 pour désigner les produits suivants en classe 33 : "liqueurs" ;
  - marque communautaire verbale "HPNOTIQ" déposée le 18 mars 2002 et enregistrée le 30 juin 2003 sous le numéro 2 620 466 pour désigner les produits suivants en classe 33 : "liqueurs" ;
  - marque communautaire figurative déposée le 23 décembre 2002 et enregistrée le 8 mars 2004 sous le numéro 2 989 085 pour désigner les produits suivants en classe 33 : "liqueurs".

Les droits dont dispose la société Heaven Hill Distilleries, Inc. sur les signes précités lui confère un monopole absolu sur l'usage de ces signes et la faculté de s'opposer à tout dépôt et

ASSOCIATION D'AVOCATS À LA COUR DE PARIS

26, cours Albert 1<sup>er</sup> 75008 Paris Tél. +33 (0)1 40 75 60 00 Fax +33 (0)1 43 5

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EXHIBIT  
51183753  
3 - DEFENDANT'S  
Heaven Hill v Diallo

usage de ceux-ci ou d'un signe similaire pour des produits ou services identiques ou similaires à ceux désignés par ces enregistrements.

2. Or, la société Heaven Hill Distilleries, Inc. a eu la surprise de constater que vous aviez procédé au dépôt, auprès de l'INPI, le 15 février 2005, de la demande d'enregistrement du signe "Hypnotizer" pour désigner les produits et services suivants des classes 32 et 33 : "*Bières, eaux minérales, boissons alcooliques, vins, spiritueux*".

3. Le signe que vous avez déposé est similaire à ceux qui ont été enregistrés par la société Heaven Hill Distilleries, Inc. et désigne des produits identiques ou à tout le moins similaires aux produits désignés par les marques de la société Heaven Hill Distilleries, Inc.

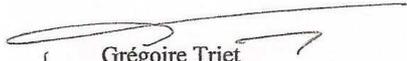
En conséquence, la société Heaven Hill Distilleries, Inc. considère que votre dépôt de marque porte atteinte à ses droits au sens de l'article L. 711-4 du Code de la propriété intellectuelle et est susceptible de constituer un acte de contrefaçon au sens de l'article L. 713-3 du même code.

4. **C'est pourquoi, la société Heaven Hill Distilleries, Inc. vous demande de bien vouloir procéder au retrait total de votre demande de marque n° 05 3 342 166.**

A défaut d'avoir reçu, **au plus tard le 18 mai prochain**, une réponse satisfaisante de votre part et la justification du retrait total de votre demande, la société Heaven Hill Distilleries, Inc. m'a d'ores et déjà chargé de former opposition à l'encontre de son enregistrement.

Je suis bien entendu à la disposition de celui de mes confrères auquel vous souhaiteriez confier la défense de vos intérêts pour m'entretenir de ce dossier avec lui.

Je vous prie de croire, Monsieur, à l'assurance de ma considération distinguée.

  
Grégoire Triet  
Avocat à la Cour



500 West Jefferson Street, Suite 2800  
Louisville, Kentucky 40202-2898  
502.589.5235  
502.589.0309

Matthew A. Williams  
502.562.7378  
mwilliams@wyattfirm.com

CONFIRMATION COPY

September 10, 2009

via EMAIL: [yassin.diallo@laposte.net](mailto:yassin.diallo@laposte.net)  
Confirmation via FedEx

Yassinn Patrice Diallo  
2 Square Tribord  
COURCOURONNES 91080  
FRANCE

COPY

Re: **US Opposition No. 91183753**  
**UK Opposition No. 95763**

Dear Mr. Diallo:

Enclosed with this letter is a copy of the decision the UK Trademark Registry recently issued in the favor of Heaven Hill Distilleries, Inc. ("Heaven Hill") that was forwarded to me by Heaven Hill's counsel in the UK, David Potter.

As I am sure you are aware from your own review of the decision, the Registry found in no uncertain terms that your proposed use of the HYPNOTIZER mark in connection with alcoholic beverages, spirits, and wines would create a likelihood of confusion in the marketplace. The Registry quite justifiably based this decision on the high degree of distinctiveness of Heaven Hill's HPNOTIQ mark when used with liqueurs, the high degree of similarity between the HPNOTIQ and HYPNOTIZER marks, and the identical or related nature of the parties' respective goods.

This now makes two countries that have properly concluded that your proposed use of the mark HYPNOTIZER in connection with alcoholic beverages would create a likelihood of confusion with Heaven Hill's use of its senior HPNOTIQ mark in connection with liqueur. Hopefully, you will now concede that Heaven Hill's rights in its HPNOTIQ mark simply preclude you from using or registering the HYPNOTIZER mark in connection with alcoholic beverages.

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Heaven Hill UDiallo

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Yassinn Patrice Diallo  
September 10, 2009  
Page 2

We further note that the UK Registry's decision requires you to pay a contribution of £1,550 toward Heaven Hill's costs in prosecuting the opposition. Heaven Hill would, however, be willing to forego collection of these costs if you would agree to (1) not appeal the Registry's decision in the UK; (2) voluntarily abandon your U.S. application to register the HYPNOTIZER mark, Serial No. 77/266,196; and (3) undertake to not use the HYPNOTIZER mark in any country where Heaven Hill has registered its HPNOTIQ mark or where Heaven Hill sells its HPNOTIQ goods.

Should these terms be acceptable to you, please sign and return the enclosed copy of this letter acknowledging your acceptance of these terms along with documentation demonstrating that you have filed to voluntarily abandon U.S. Application Serial No. 77/266,196.

If, on the other hand, you proceed with appealing the UK decision, you should be aware that Heaven Hill will vigorously defend against such an appeal and seek a further award of costs to cover the costs it incurs in contesting the appeal of a well-reasoned decision by the Registry.

Please feel free to contact me if you would like to discuss any of these matters in further detail.

Very truly yours,

WYATT, TARRANT & COMBS, LLP

Matthew A. Williams

MAW/dkl  
Enclosure

cc: David A. Calhoun, Esq. (via email)  
David Potter, Esq. (via email)

20318862.2

**AGREED TO, ACCEPTED, AND  
RECEIPT ACKNOWLEDGED BY:**

Yassinn Patrice Diallo

Date

**SIGN  
HERE**

Diallo Yassinn Patrice  
2 Square Tribord Courcouronnes  
91080  
France

**Concept House**

Cardiff Road, Newport  
South Wales, NP10 8QQ  
United Kingdom

Switchboard: +44(0)1633 814000  
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Website: [www.ipa.gov.uk](http://www.ipa.gov.uk)

**Tel:** +44(0)1633 811116  
**Fax:** +44(0)1633 817777  
**O/Ref:** 2462677/Team D/SMACR  
**Y/Ref:** 873089  
**Date:** 18 October 2007

Please quote our reference when replying.

Dear Sir or Madam,

**Application No:** 2462677 in Class 33  
**For the Mark:** HYPNOTIZER  
**Applicant:** Diallo Yassinn Patrice

**EXAMINATION OF TRADE MARK APPLICATION**

I have examined your application and carried out a search of earlier national trade marks and Community and International trade marks which cover the UK.

The requirements for registration appear to be met so the application is accepted. We will now publish it in the Trade Marks Journal on our website for opposition purposes. We will tell you the Journal number and date of publication shortly.

After the mark has been published, there is a three month period in which anybody may oppose its registration. If we receive any such opposition, we will write to tell you.

If nobody opposes the mark, we will automatically register it three weeks after the end of the opposition period and send you the registration certificate soon afterwards.

Yours faithfully,



Mrs S J Macrory  
Trade Marks Examiner

EXHIBIT  
311837/3  
M - DEFENDANT'S  
HEWEN HILL V DIALLO

Search criteria:

Target Nice classes: 33  
Cross search list Nice classes: 32, 33, 34, 35

Case statuses:  
New Application  
Examined  
Awaiting advert  
Advertised  
Opposition outstanding  
Removed from Journal  
To be readvertised  
Late objection raised  
Progress Delayed  
Ready for registration  
Registered  
Protected  
Expired  
Surrendered  
Withdrawn  
Refused  
Revoked  
Deemed abandoned  
Abandoned  
Invalid

Word Search Terms:

hypnotizer, hypnotiser, hypnotize, hypnotise, hypnotizers, hypnotizes

Word Mark types:

Word Only  
Word and Device  
Stylised Word Mark  
Form (Shape) and Word  
Miscellaneous Word

Dates:

From 01.01.1876 to 30.07.2007

Marked Hits:

Case number:	Case status:	Case number:	Case status:
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Word Hits:

* M873089	<i>Precedent</i> OPPOSED	M734514	PRTCTD
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\*\*\*END OF REPORT\*\*\*

*See attached print*

*20/2*



## Case details for International Madrid(UK) Trade Mark M873089

[Explanation of terms](#) used on this page

### Mark

**HYPNOTIZER**

Mark text: HYPNOTIZER

### Status

UK case status: Opposition outstanding

Classes: 33, 32

### Relevant dates

Date of international registration: 07 October 2005

Date of designation in UK: 07 October 2005

Next renewal date: 07 October 2015

### Office of origin details

Office of origin: France

Office of origin reference: GM

Basic application or registration number Filing or registration date

053342166 07 October 2005

### Publication in Trade Marks Journal

First advert: Journal: 6628

**Publication date:** 07 April 2006

**List of goods or services**

**Class 33:** Alcoholic beverages, wines, spirits.  
**Class 32:** Beers.

**Names and addresses**

**Holder:** DIALLO YASSINN PATRICE  
2, square Tribord, F-91080  
COURCOURONNES, France

**UK service:** M Diallo Yassinn Patrice C/o Willy Bozor  
14 Abbey Court, 20 MacLeod Street, London,  
United Kingdom, SE17 3HA

**Earlier rights notification**

Opted in for notifications

[Explanation of terms](#) used on this page

The "M" prefix is used purely within the UK and is not part of the Madrid(UK) registration number.

This enquiry shows information from the International Registration held by us. If you want to see details of the definitive International Registration, please visit the [World Intellectual Property Organization](#).



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