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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	Motion to Strike
Filer's Name	Yassinn Patrice Diallo
Filer's e-mail	yassinn.diallo@laposte.net
Signature	/yassinn patrice diallo/
Date	10/02/2010
Attachments	Motion_to_strike_plaintiff-s_reply_brief.pdf (44 pages)(12983543 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,)	

MOTION TO STRIKE PLAINTIFF'S REPLY BRIEF

Defendant's Yassinn Patrice DIALLO, respectfully requests to the Trade Mark Trial and Appeal Board to accept the Motion to strike plaintiff's reply brief and 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. Applicant seeks the registration for HYPNOTIZER for specific products as (exhibit F).

Heaven Hill's is the owner of the mark HPNOTIQ for liqueur only (exhibit G) , which is not well known, as opposed to what the Opposer affirms the other products of Heaven Hill are only candles, Liqueur, glassware and clothing with HPNOTIQ mark. The disputed proof in this case demonstrates that the use of HYPNOTIZER is only in connection with specific products as opposed to what the Opposer affirms.

Moreover the evidences provided during the testimony period of the Opposer are not receivable for the following reasons: Depositions may be taken before persons designated by Rule 28 and 29 of the Federal Rules of Civil Procedure. Moreover concerning the cross examination of Heaven Hill witnesses during their trial deposition, Yassinn Patrice DIALLO is not right to question people who work and are paid by the Opposer (c) Disqualification for Interest.

The Board should, therefore denied Heaven Hill's opposition and accept the registration of Mr Diallo's HYPNOTIZER mark.

FACTS

Moreover 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 A).

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

Hypnotizer mark is not made for flavored sparkling water as the opponent lawyer try to affirm. 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 C). Opposed to what the Opposer lawyer intends to demonstrate, HYPNOTIZER application is for specifics beverages including rum, as mentioned on the certificate design (exhibit D).

It is 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 E). It is clear evidence that we apply for a specific mark and a specific design completely different to the opposed mark and design, and not only a mark as a word. As opposed to what the opposing party affirms, Respondent Diallo Yassinn Patrice does not want to register the HYPNOTIZER mark for liqueur (exhibit F), and as it is indicated on his Application form.

The registration for HYPNOTIZER is filed for specifics products such as: Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholics 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 Opposer 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 application to register his 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 G), 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.

Moreover Heaven Hill also claims the name HPNOTIZER supposedly since May 2005 while their lawyer in France knew the registered trademark of Mr Patrice Diallo Yassinn since February 2005 (exhibit H). In May 2005, the lawyer of HEAVEN HILL in France contacted the Applicant requesting that the Applicant abandon his trade mark HYPNOTIZER (exhibit I).

The 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 J), the Opposer requested Applicant not to market his products where HPNOTIQ is present. This request is illegal and has no ground.

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

The case in the United Kingdom is not yet closed as Applicant Diallo Yassinn Patrice has filed for alcoholic beverages and this is pending decision (exhibit K). Hence the Opposer's statement is not accurate.

ARGUMENTS

1. Mr DIALLO Yassinn Patrice Rights regarding the HYPNOTIZER Mark registered in France.

Mr DIALLO YASSINN PATRICE possesses the registration certificate for the trademark HYPNOTIZER in France (exhibit L). 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.

Mr DIALLO YASSINN PATRICE statements in his brief are true as he has the right to use the HYPNOTIZER mark with some alcoholic beverages in France except liqueurs, and these affirmations are not made intentionally and knowingly made to advance the board in his position. The title Drinks that he has chosen and which is registered in his certificate of registration has a general impact and covers alcoholic beverages and others despite their belonging to different administrative classes (32, 33).

Mr DIALLO YASSINN Patrice possesses on his certificate the following elements: **syrops and the other preparations to make drinks, vitamins drinks, energy drinks**. Of this fact nothing prevents Mr DIALLO Yassinn Patrice from marketing in France rum-based alcoholic drinks for example, or other drinks without alcohol. Once again Heaven Hill counsel Mr. Matthew Williams has a misunderstanding and makes a wrong interpretation of the French laws.

In United Kingdom the case number 873089 remains pending (exhibit M). The decision of March 30th, 2010 does not relate to the same case (exhibit N) case 2462677. Mr DIALLO YASSINN PATRICE statements and representations in his brief are completely and absolutely true and are not intentionally and knowingly made to the Board to advance his position.

Diallo's submission of his brief to the board with true statements do not violate the rules set forth in 37 C.F.R § 11.18(b). Accordingly, the Board should not strike Diallo's Brief and not terminate this proceeding in Heaven Hill's favor Pursuant to 37 C.F.R 11.18). On the contrary Heaven Hill knowing that the brief is true concerning these statements, Mr DIALLO Yassinn Patrice requests the Board to notice that the false statements of Heaven Hill violates the rule set forth in 37 C.F.R § 11.18 (b). Accordingly, the Board should strike Heaven Hill Briefs in its entirety and terminate this proceeding in DIALLO Yassinn Patrice favor pursuant to 37 C.F.R § 11.18 (c).

2. The testimony of Heaven Hill's witnesses and the exhibits introduced therein must be rejected.

Again Defendant's Yassinn Patrice DIALLO, respectfully requests the Trade Mark Trial and Appeal Board to reject the observations, arguments and elements sent by the Opposer in his Brief as they have no ground. Moreover the evidences provided during the testimony period of the Opposer are not receivable for the following reasons:

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.

For these reasons we request the TTAB to reject the testimony and the evidences and arguments provided during the testimony of Drew Wesley, Justin Ames and the direct examination made by Matthew Williams, as they are the public relation, employees and legal counsel of the Opposer Heaven Hill Distilleries. Moreover Yassinn Patrice DIALLO does not have evidence to invent, besides he is not right to question people who work and are paid by the Opposer (c) Disqualification for Interest.

The rule is that during a trial testimony in inter parte cases § 2.123: “**an officer**” authorized to administer oaths by the laws of the United States or of the place where the examination is held: **means that: 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.** We never designated the Person Notary Public Donna Chupe to take the testimony. She was not designated by the parties (at least two) or by the court.

Moreover the US and Trade Mark Law **U. S. PATENT & TRADEMARK OFFICE June 24, 2010 § 2.123 Trial testimony in inter parte cases**, also specifies (b) *Stipulations*. **If the parties so stipulate in writing**, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions, we never have stipulated anything in writing, so “ to stipulate by the parties” it means at least two . **“By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses”**: we never have made any written agreement for this. **The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing, again we never have stipulated anything in writing.** (2) The deposition shall be taken in answer to questions, with the questions and

answers recorded in their regular order by the officer, **or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties**, again here this is not the case so the testimonies witnesses and direct examination made by Matthew A Willams lawyer of Heaven Hill must be rejected.

Again Yassinn Patrice DIALLO is not right to question people who work and are paid by the Opposer (c) Disqualification for Interest.

3. The Registration of HYPNOTIZER mark will not cause any confusion.

The registration of HYPNOTIZER mark will not create likelihood of confusion in the marketplace because HYPNOTIZER is use in connection with specific products. Each trade mark has a specific design, a different size and content (HPNOTIQ 70cl HYPNOTIZER 33cl) and has a different mark and price.

HYPNOTIZER mark is not made for flavored sparkling water as the opponent lawyer try to affirm. The Opposer can clearly see that in October 2005 a registration certificate was delivered by French NIPO for HYPNOTIZER with a specific design (exhibit C). In contrast to what the Opposer's counsel intends to demonstrate, HYPNOTIZER application is for specific beverages including rum, as mentioned on the certificate design (exhibit D). It is 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 E). 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.

A. The examining Attorney's decision to publish Diallo's Application is wholly justified.

We have never said that the issue was already determined in our favor as the Opposer tries to mislead the Board but only have said that: 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 (exhibit R).

Also in the letter dated May 04 2006 (exhibit O) the TTAB examination report said: 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).

Moreover in the letter dated August 19 2009 (exhibit P) the TTAB said: "It has come to the attention of the Board that the parties to this proceeding are also parties to Opposition No.91173767. The two opposition proceedings involve virtually identical marks and goods". In fact this is a mark identical to the mark that Heaven Hill describes of Defendant Yassinn Patrice Diallo's previous mark which is now abandoned (exhibit Q). In fact we believe that the Board will make its own independent determination concerning this case.

B. Differences between the marks HYPNOTIZER and HPNOTIQ are absolutely evident.

All the cases cited by the Heaven Hill concern cases that have nothing to do with the present case or concern case for well known brands.

Again the Opposer can clearly see, a registration certificate delivered by French NIPO for HYPNOTIZER with a specific design (exhibit C). In contrast to what the Opposer lawyer intends to demonstrate, HYPNOTIZER application is for specifics beverages, (exhibit F). It is

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 E). It is 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.

The cases cited here :Owens-Illinois Glass Co. v. Clevite Corp., 324 F.2d 1010, 139 U.S.P.Q. 505,507 (C.C.P.A. 1963), Time Warner Entertainment Co. v Jones, 65 U.S.P.Q.2D 1650,1660 (T.T.A.B 2002), by Heaven Hill concern cases that have nothing to do with the present case or concern case for well known brands.

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 well known 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; therefore there is nothing to prove that HPNOTIQ is widely recognized on the market place.

The following cases : *David Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377 (8th Cir. 1965) (finding SARNOFF for vodka to be confusingly similar to SMIRNOFF also for vodka); *Brown-Forman Distillery Co. v. Arthur M. Bloch Liquor Importers, Inc.*, 99 F.2d 708 (7th Cir. 1938) (finding OLD FOSTER for whiskey to be confusingly similar to OLD FORESTER also for whiskey); *Jules Berman*, 202 U.S.P.Q. 67 (T.T.A.B. 1979) (finding CHULA for coffee-flavored liqueur to be confusingly similar to KAHLUA also for coffee-flavored liqueur); *Beck & Co. v. Package Distribs. Of America, Inc.*, 198 U.S.P.Q. 573 (T.T.A.B. 1978) (finding EX BIER for beer to be confusingly similar to BECK’S BEER also for beer). The cases cited by Heaven Hill concern cases that have nothing to do with the present case or concern case for notorious brands. Trademarks HYPNOTIZER and HPNOTIQ are completely different in

terms of marks, meaning, sound, and appearance and as well in terms of products, mark, packaging, size, price. Therefore it cannot be a confusion.

C. Heaven Hill cannot rely on supposed unregistered marks in this proceeding.

Again HPNOTIQ is registered for liqueur only (see certificate exhibit G), the declarations with regards to invented cocktails and supposed unregistered marks are a complete non sense, they have no registration, no certificate, and they have been especially created to claim the mark of Mr Yassinn Patrice Diallo. Moreover they have created a cocktail called “**HPNOTIQ SUB-ZERO MARTINI**” why not also claim the Martini brand?

Moreover, the fact of claiming so-called brand names when it comes to cocktails invented, has no legal value, for example the cocktail named HPNO COLADA, etc..., this does not make Heaven Hill owner of the trademark or cocktail PINA COLADA. Another example: the name of cocktail made with HPNOTIQ and MARTINI cannot make the Opposer the owner of HYPNOTIZE and MARTINI. Their declaration is meaningless, first application for HYPNOTIZER in France is February 2005, and application in the us by extension October 7, 2005 (exhibit Q).

Again all the facts described by Heaven Hill are based on the testimony of a person who are a relative or employee or attorney or counsel of Heaven Hill , or a relative or employee or attorney or counsel, or is financially interested in the action therefore any statement or evidence is not admissible, 37 CFR 2.123 (c) Disqualification for Interest.

Moreover Heaven Hill also claims the name HPNOTIZER: they create a mark like HPNOTIZER to incorporate the name of Mr DIALLO Yassinn Patrice mark. Heaven Hill gives no evidences that they do not adopt the supposed unregistered mark (which is non sense) with the bad faith intent to trade off Diallo’s HYPNOTIZER mark. Mr Diallo has the right to

use HYPNOTIZER mark in connection with alcohol in France, but in our present case we are before the US TTAB and US Federal trademark Laws.

D. The cases cited by Heaven Hill are irrelevant.

Again all the cases cited by the Heaven Hill concern cases for well known brands or cases that have nothing to do with the present case or concern see David Sherman, 144 U.S.P.Q 249; Brown-Forman, 39 U.S.P.Q. 304; Jules Berman, 202 U.S.P.Q 67; Beck & Co., 198 U.S.P.Q.573. 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).

CONCLUSION

Heaven Hill has presented no evidences establishing that its registered mark is widely recognized in the beverages market place or elsewhere. The consumer can't associate different marks: HYPNOTIZER and HPNOTIQ are completely different mark in terms of products, mark, packaging, design, size, and price. Consequently the registration of HYPNOTIZER would not create a likelihood of confusion in the marketplace. Heaven hill presented no evidence to the contrary and HEAVEN HILL currently recognizes the difficulty of securing evidence of actual confusion, simply because there is no risk, finally Heaven Hill presented no evidence and has cited no authority that would lead to that conclusion.

For these reasons Diallo's application for the mark HYPNOTIZER 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 Motion to strike plaintiff's reply brief 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 1st October, 2010.

Matthew A. Williams

Wyatt Tarrant & Combs, LLP

500 West Jefferson Street, Suite 2800

Louisville, KY 40202

UNITED STATES.

502-562-7378 Telephone

Dated: October 1st, 2010

DIALLO YASSINN PATRICE

EXHIBIT A

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.

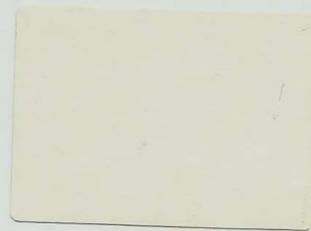
4. Please admit that the trade mark HYPNOTIZER is a trademark who belong to M DIALLO YASSINN PATRICE.

RESPONSE: Denied.

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

RESPONSE: Admitted.

EXHIBIT B





DESSINS ET MODÈLES

Code de la propriété intellectuelle
Livres IV : (Titre premier), V et VIII

EXHIBIT C

NOTIFICATION DE PUBLICATION ET CERTIFICAT D'IDENTITÉ

Le dépôt de dessin(s) ou modèle(s) dont les références et la(les) reproduction(s) figurent au verso a été publié au Bulletin officiel de la propriété industrielle n° **05/21 du 21 octobre 2005**

La présente notification vaut certificat d'identité.

Le Directeur général de l'Institut
national de la propriété industrielle

Benoît BATTISTELLI

**INSTITUT
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91080 COURCOURONNES

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- ⑤① Classement 09-03
- ①① N°(s) de publication 765 152 et 765 153
- ⑤④ Nature du (des) objet(s) : Emballage, Emballage et sa capsule
D.M. n° 1 et 2 : 1 repr.
- ④⑤ Date de publication : 21 octobre 2005
- ⑤⑦ Description : Repr. 1-1 : Vue dépliée. ♦ Repr. 2-1 : Emballage et sa capsule



1-1

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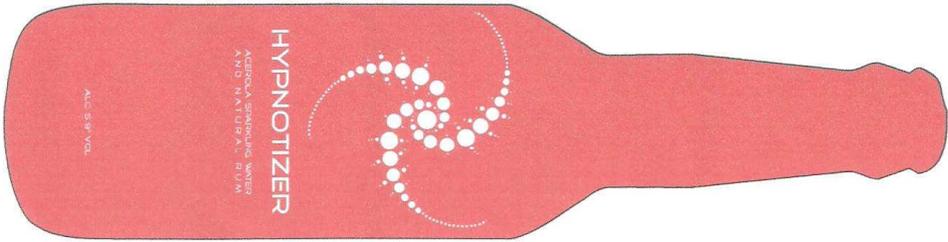


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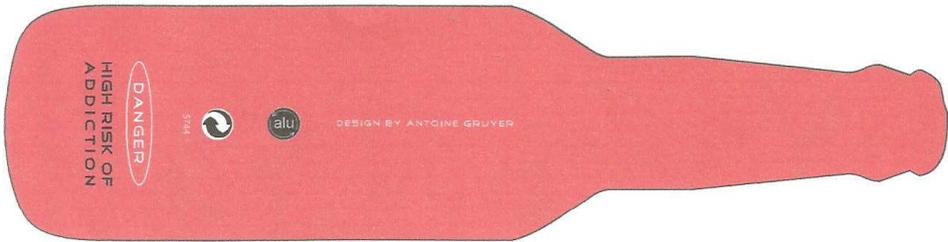
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EXHIBIT D

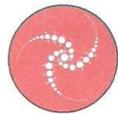
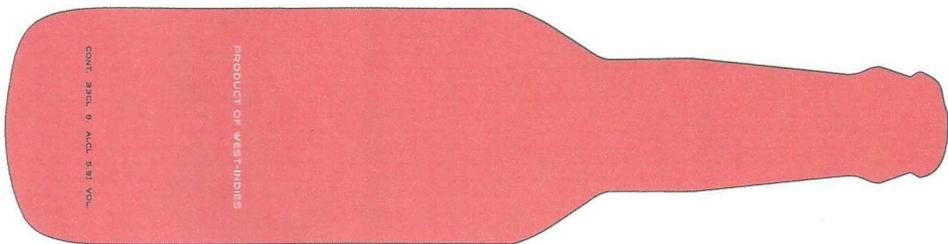
FRONT



SIDE



BACK



CAPSULE

ACROLA SPOILING WATER AND MINDSPACE

EXHIBIT E





United States Patent and Trademark Office

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List At: EXHIBIT F 12 out of 5

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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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18/04/2010

EXHIBIT G

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

Reg. No. 2,642,855

United States Patent and Trademark Office

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

de location d'enregistrements sonores, d'appareils audio, de bande vidéo, de caméras vidéo; montage de bandes vidéo; montage de programmes radiophoniques; montage de programmes de télévision; enregistrement d'images vidéo; publication d'informations; bases de données; services de données, de sons et d'images pour l'enregistrement, la reproduction d'images.

Classes de produits ou services

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; dépliants 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 à un service de radiotéléphonie, service radiomessagerie; abonnements télématiques à une base de données, abonnements à une base de données, abonnement à un centre fournisseur d'accès à un réseau informatique ou de transmission de données, 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, courtage en bourse; estimations financières (assurances, banques, immobilières), 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, radiotéléphoniques, 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 contenues dans des journaux électroniques; service de radiodiffusion; service de divertissements, information, d'éducation; organisation et conduite de colloques, de conférences et de concours (émission et conduite d'épreuve).

EXHIBIT #

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Varsovie



Gide Loyrette Nouel

EXHIBIT 1

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 A LA COUR DE PARIS

26, cours Albert 1^{er} 75008 Paris Tél. +33 (0)1 40 75 60 00 Fax +33 (0)1 43 5

E-mail info@gide.com www.gide.com

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.

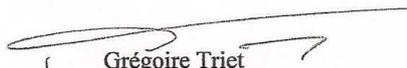
En conséquence, la société Heaven Hill Distilleries, Inc. considère que votre dépôt de marque porte atteinte à ses droits au sens de l'article L. 711-4 du Code de la propriété intellectuelle et est susceptible de constituer un acte de contrefaçon au sens de l'article L. 713-3 du même code.

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

EXHIBIT J

September 10, 2009

CONFIRMATION COPY

**via EMAIL: yassin.diallo@laposte.net
Confirmation via FedEx**

Yassinn Patrice Diallo
2 Square Tribord
COURCOURONNES 91080
FRANCE

**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.

Matthew A. Williams
Matthew A. Williams

LOUISVILLE KY LEXINGTON KY BOWLING GREEN KY NEW ALBANY IN NASHVILLE TN MEMPHIS TN

DN MS

WWW.WYATTFIRM.COM



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

EXHIBIT K

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
Minicom: 08459 222250
DX: 722542 Cleppa Park 3

Website: www.ipo.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

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



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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EXHIBIT L

de commerce ou de service

CERTIFICAT D'ENREGISTREMENT

Le Directeur général de l'Institut national de la propriété industrielle certifie que la marque reproduite au verso a été enregistrée.

L'enregistrement produit ses effets à compter de la date de dépôt de la demande pour une période de dix ans indéfiniment renouvelable.

Cet enregistrement sera publié au Bulletin officiel de la propriété industrielle

n° 09/25 Vol. II du 19 juin 2009

Le Directeur général de l'Institut
national de la propriété industrielle

Benoît BATTISTELLI



M DIALLO YASSINN
2 SQUARE TRIBORD
91080 COURCOURONNES

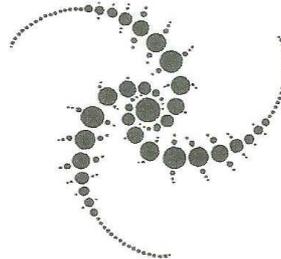
N° National : 09 3 623 129

Dépôt du : 16 JANVIER 2009

à : I.N.P.I. PARIS

DIALLO YASSINN PATRICE, 2 SQUARE TRIBORD, 91080
COURCOURONNES.

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



HYPNOTIZER

Classe N° 14 : Joaillerie ; bijouterie ; horlogerie et montres ; porte-clefs de fantaisie ; étuis à cigares ou à cigarettes ; étuis ou écrins pour l'horlogerie ; médailles.

Classe N° 32 : Jus de fruits ; sirops et autres préparations pour faire des boissons ; limonades ; nectars de fruits ; sodas ; apéritifs sans alcool ; boissons vitaminées ; boissons énergisantes.

Classe N° 34 : Tabac ; articles pour fumeurs non en métaux précieux ; allumettes. Cigares ; cigarettes ; papier à cigarettes ; pipes ; briquets pour fumeurs ; boîtes ou étuis à cigares non en métaux précieux ; boîtes ou étuis à cigarettes non en métaux précieux ; cendriers pour fumeurs non en métaux précieux.

Classes de produits ou services : 14, 32, 34.



EXHIBIT M

Trade Mark Enquiry

[New Search](#) [Amend Search](#)

Search Results

Your search found 3 results. Page 1 of 1 is shown.

Trade Mark No.	Mark Text	File Date	Status	Nice Classes	Vienna Classes	Image	P.
M734514	hypnotizer	23/03/2000	Expired	09 35 42	02.09.00 26.01.00 27.05.00		
M873089	HYPNOTIZER	07/10/2005	Opposition outstanding	32 33		HYPNOTIZER	
2462677	HYPNOTIZER	30/07/2007	Refused	33			

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EXHIBIT N



Case details for Trade Mark 2462677

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

[Case history](#) including, where available, licensee details

Mark

Mark text: HYPNOTIZER

Status

Status: Refused
Class: 33
Status before death: Opposition outstanding

Relevant dates

Filing date: 30 July 2007
Progress stopped: 16 April 2010

Publication in Trade Marks Journal

First advert:

Journal:	6711
Publication date:	23 November 2007

List of goods or services

Class 33: Alcoholic beverages, wines, spirits.

Names and addresses	
Proprietor:	Diallo Yassinn Patrice 2 Square Tribord Courcouronnes, 91080, France
Residence country:	France
Customer's ref:	TM "HYPNOTIZER"
ADP number:	0915387001
Agent:	Diallo Yassinn Patrice c/o Bozor Willy, 69 Wyatt Park Road, London, SW2 3TW
ADP number:	0946427001
Service:	Diallo Yassinn Patrice c/o Bozor Willy, 69 Wyatt Park Road, London, SW2 3TW
ADP number:	0946427001

Earlier rights notification

Opted in for notifications

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EXHIBIT 0

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/019547

MAY 4 2006

APPLICANT: DIALLO YASSINN PATRICE



CORRESPONDENT ADDRESS:

DIALLO YASSINN PATRICE
2, square Tribord
F-91080 COURCOURONNES FRANCE

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: HYPNOTIZER

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and email address.

RE: Serial Number 79/019547

EXAMINER'S AMENDMENT

OFFICE RECORDS SEARCH: The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

ADVISORY – AMENDMENTS TO GOODS/SERVICES: If the identification of goods and/or services has been amended below, any future amendments must be in accordance with 37 C.F.R. §2.71(a) and TMEP §1402.07(e).

AMENDMENT(S) AUTHORIZED: *If applicant disagrees with or objects to any of the amendments below, please notify the undersigned trademark examining attorney immediately.* Otherwise, no response is necessary. TMEP §707.

The trademark examining attorney is amending the application as follows. No prior approval or authorization from applicant or applicant's attorney is required. TMEP §707.02.

IDENTIFICATION OF GOODS

Due to some grammatical mistake in that the identification needs to separate the goods through the use of commas, the identification of goods is amended to read as follows:

International Class 033: 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 wine, Tequila, Vodka, Whiskey, Wine coolers, Wines

TMEP §1402.01(e).

/Alain Lapter/
Trademark Attorney
Law Office 108 - 5D29
571-272-8607 (phone)
571-273-8607 (official fax)
alain.lapter@uspto.gov

EXHIBIT P

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 19, 2009

Opposition No. 91183753

Heaven Hill Distilleries,
Inc.

v.

Diallo Yassinn Patrice

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on opposer's motion (filed March 24, 2009) to extend time; however, for potential scheduling reasons outlined below, determination of the motion is deferred.

It has come to the attention of the Board that the parties to this proceeding are also parties to Opposition No. 91173767. The two opposition proceedings involve virtually identical marks and goods. There is an outstanding Board order in Opposition No. 91173767 requiring opposer therein to state whether, in view of the abandonment of the request for extension of protection which is the subject of that opposition, it wishes to go forward to obtain a determination of that opposition on its merits or to have that opposition

Opposition No. 91183753

dismissed without prejudice as moot. Should opposer wish to continue Opposition No. 91173767, the Board will consider consolidating the two proceedings. See TBMP § 511 (2d ed. rev. 2004); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Consolidation on Board's own initiative).

In view thereof, proceedings herein are **suspended** pending a response in Opposition No. 91173767 from opposer therein. Accordingly, determination of the outstanding motion to extend time (filed March 24, 2009 in Opposition No. 91183753) is suspended pending a response in Opposition No. 91173767 from opposer therein.



United States Patent and Trademark Office

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Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Sep 21 04:05:47 EDT 2010

TESS HOME NEW USER STRUCTURED SEARCH HELP PREVIOUS LIST CURRENT LIST
 NEXT LIST FIRST DOC PREV **EXHIBIT Q**

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 1 out of 5**

TARR Status ASSIGN Status TDR TTAB Status (Use the "Back" button of the Internet Browser to return to TESS)

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 wine, Tequila, Vodka, Whiskey, Wine coolers, Wines
Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number 79019547
Filing Date October 7, 2005
Current Filing Basis 66A
Original Filing Basis 66A
Published for Opposition July 4, 2006
International Registration Number 0873089
Owner (APPLICANT) DIALLO YASSINN PATRICE INDIVIDUAL FRANCE 2, square Tribord F-91080 COURCOURONNES FRANCE
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator DEAD
Abandonment Date August 17, 2007

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 NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

http://tess2.uspto.gov/bin/showfield?f=doc&state=4002:72fh45.2.1

22/09/2010



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EXHIBIT R

September 24, 2007

Letter of Protest
ATTN: Trademark Administrator
United States Patent & Trademark Office
600 Dulany Street MDE-4B89
Alexandria, VA 22314-5793

Re: Letter of Protest
Application Serial No.: 77/266,196
Filing Date: August 28, 2007
Mark: HYPNOTIZER
Int'l Class: 33

Dear Sir or Madam:

This Letter of Protest is submitted against the application of Yassini Patrice Diallo ("Diallo") to register HYPNOTIZER for use in International Class 33 with various alcoholic beverages, Serial No. 77/266,196, on behalf of Heaven Hill Distilleries, Inc. ("Heaven Hill"). A copy of the TARR printout for Diallo's application is enclosed as Exhibit A.

Heaven Hill is the owner of the U.S. Trademark Registrations listed below for the mark HPNOTIQ (copies of the registration certificates are enclosed as Exhibit B).

Mark	Registration No.	Goods	First use of mark in commerce
HPNOTIQ	2642855	Liqueur, in IC 033	September, 2001
HPNOTIQ	2822475	Liqueur, in IC 033	September, 2001
HQOPN (& bottle design)			
HPNOTIQ	2834133	Candles, in IC 004	May 2, 2003
		Beverage glassware, in IC 021	March 23, 2003
HPNOTIQ	2834130	Clothing, namely shirts, in IC 025	February 7, 2003

LOUISVILLE, KY LEXINGTON, KY BOWLING GREEN, KY NEW ALBANY, IN NASHVILLE, TN MEMPHIS, TN FORT COLLINS, CO JACKSON, MS

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Letter of Protest
September 24, 2007
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Heaven Hill believes that its registrations provide prima facie evidence supporting a refusal of registration on the basis of a likelihood of confusion because two of its registrations are for alcoholic beverages in International Class 33 and because of the similarity of the marks. See TMEP § 1715. Therefore, Heaven Hill's Letter of Protest should be granted.

As further background, Heaven Hill notes that this is Diallo's second attempt to register HYPNOTIZER in international class 33 for the same goods. His first attempt, Application Serial No. 79/019,547, was a 66A application that was cancelled after his underlying French registration was cancelled for all alcoholic beverages. The TARR and TESS printouts for this application are attached hereto as Exhibit C.

This cancellation occurred as a result of an opposition prosecuted by Heaven Hill in France. The decision of the Court of Appeals of Paris, and an English translation thereof, upholding the finding of the French Industrial Property Office that HYPNOTIZER, when used in connection with alcoholic beverages and beer, created a likelihood of confusion with Heaven Hill's HPNOTIQ mark is attached as Exhibit D. Before this cancellation occurred, Heaven Hill had actively opposed Application Serial No. 79/019,547 in Opposition No. 91173767.

While the conclusions of the French Industrial Property Office and the French Court's are not dispositive, they certainly support Heaven Hill's position that its registrations for HPNOTIQ in connection with liqueur present prima facie evidence supporting a refusal to register Diallo's HYPNOTIZER mark on the basis of a likelihood of confusion.

Moreover, the prosecution history in Serial No. 79/019,547 demonstrates that the Examining Attorney may not independently identify Heaven Hill's registrations despite the similarity of the marks and the goods. This is illustrated by the summary of the XSearch performed during the examination of Serial No. 79/019,547, which is attached as Exhibit E. A review of this summary reveals that the search did not identify any marks having a "h" followed directly by a "p" as it occurs in Heaven Hill's HPNOTIQ mark. Rather, as illustrated by the inquiries in lines 01 and 02, the search methodology only identified marks having an "i," "y," or "e" between an "h" and a "p." Similarly, the inquiry in line 03 did not identify Heaven Hill's HPNOTIQ registrations because it identifies only marks having a "t" followed by an "i," "e," or "y" followed by a "c," "s," or "z." The remaining inquiries, lines 04-07, are simply combinations of 01-03 or inquiries 01, 02, or 03



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with an additional limitation. Thus, the search failed to identify Heaven Hill's HPNOTIQ registrations.

Rather than forcing it to wait until Diallo's new application is published for opposition and forcing it to again endure the burden of prosecuting an opposition, Heaven Hill respectfully requests that its Letter of Protest be granted. This will ensure that the Examining Attorney has the opportunity to consider the likelihood of confusion that Diallo's applied for mark creates with Heaven Hill's pre-existing registrations.

If we can provide you with any additional information to assist you in deciding to grant this Letter of Protest, please do not hesitate in calling me at 502-562-7378.

Very truly yours,

WYATT, TARRANT & COMBS, LLP

Matthew A. Williams

MAW/dkl
Enclosures

cc: Mr. Max L. Shapira
William H. Hollander, Esq.
(both w/out encls.)

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