

ESTTA Tracking number: **ESTTA253622**

Filing date: **12/08/2008**

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

Proceeding	91183753
Party	Plaintiff Heaven Hill Distilleries, Inc.
Correspondence Address	Matthew A. Williams Wyatt, Tarrant & Combs, LLP 500 W. Jefferson Street, Suite 2800 Louisville, KY 40202 UNITED STATES mwilliams@wyattfirm.com, mcapiro@wyattfirm.com
Submission	Reply in Support of Motion
Filer's Name	Matthew A. Williams
Filer's e-mail	mwilliams@wyattfirm.com
Signature	/Matthew A. Williams/
Date	12/08/2008
Attachments	Reply in Support of SJ - 91183753.pdf ( 3 pages )(13373 bytes )

Certificate of Electronic Filing

I hereby certify that this document is being electronically filed as of **December 8th, 2008**, with the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

/Matthew A. Williams/  
Matthew A. Williams

**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.	)		

**REPLY IN SUPPORT OF OPPOSER'S MOTION FOR  
SUMMARY JUDGMENT AND MOTION TO SUSPEND**

Opposer Heaven Hill Distilleries, Inc. ("Heaven Hill") files this Reply in support of its Motion for Summary Judgment to address two issues raised in Applicant's Response.

First, Heaven Hill believes that it should be noted on the record that the exhibit Applicant provided with his Response, allegedly to demonstrate that his use of the HYPNOTIZER mark is "completely different," is, in fact, an image of a bottle of flavored, sparkling water. This exhibit does not represent use of the HYPNOTIZER mark with the beverage alcohol products that are claimed in his application, and it does not alter the fact that the application specifically seeks registration of the HYPNOTIZER mark for use in connection with beverage alcohol products. This undeniable fact is an important factor in the likelihood of confusion analysis since Heaven Hill has registered and uses its HPNOTIQ mark in connection with beverage alcohol products.

Moreover, Applicant has applied to register his HYPNOTIZER mark as a word mark without any claim as to a particular style or font. Thus, Applicant's submission of evidence of use of his mark in a particular form does not demonstrate or prove that Applicant's mark or the manner in which he intends to use the mark are "completely different" from the manner in which Heaven Hill uses its mark. *See, e.g., Smith v. Tobacco By-Products and Chemical Corp.*, 44 C.C.P.A. 880, 883, 243 F.2d 188, 190 (C.C.P.A. 1957) ("[W]hat we are primarily concerned with is the registrability of the mark as shown and described in the application itself."); *Wells Fargo & Co. v. Stagecoach Properties, Inc.*, 685 F.2d 302, 306 (9<sup>th</sup> Cir. 1982) ("[T]he Board considers only the use shown in the application, not actual use . . .").

Finally, Heaven Hill notes that Diallo quotes Heaven Hill's Memorandum—completely out of context—in an attempt to argue that Heaven Hill has somehow conceded that there is no likelihood of confusion because Heaven Hill has no evidence of actual confusion. In fact, Heaven Hill stated in its Memorandum that, while it has no evidence of actual confusion, this particular factor is not relevant to this proceeding because the lack of such evidence is to be expected since the application being opposed is an intent-to-use application. *See Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 284, 42 U.S.P.Q.2d 1173 (6<sup>th</sup> Cir. 1997).

For the reasons stated herein and in Heaven Hill's Memorandum, Diallo's application should be rejected pursuant to 15 U.S.C. § 1052(d) and Heaven Hill's motion for summary judgment should be granted.

Respectfully submitted,

/Matthew A. Williams /

David A. Calhoun

Matthew A. Williams

Michael A. Capiro

WYATT, TARRANT & COMBS, LLP

500 West Jefferson Street, Suite 2800

Louisville, Kentucky 40202-2898

(502) 589-5235

Counsel for Opposer, Heaven Hill

Distilleries, Inc.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing Opposer's Reply has been served upon

Diallo Yassinn Patrice

2 Square Tribord

Courcouronnes 91080

France

via United States Postal Service's First Class Mail International Service (postage prepaid), this **8th** day of **December, 2008**.

/Matthew A. Williams/

One of Counsel for Opposer, Heaven Hill

Distilleries, Inc.

20307852.4