

ESTTA Tracking number: **ESTTA305356**

Filing date: **09/09/2009**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Apex, LLC
Granted to Date of previous extension	09/09/2009
Address	100 Main Street Pawtucket, RI 02860 UNITED STATES

Attorney information	Gailyc C. Sonia Apex, LLC 100 Main Street Pawtucket, RI 02860 UNITED STATES trademarks@theapexcompanies.com
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Applicant Information

Application No	77539165	Publication date	05/12/2009
Opposition Filing Date	09/09/2009	Opposition Period Ends	09/09/2009
Applicant	Liggett Group LLC 100 Maple Lane Mebane, NC 27302 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: Cigarettes

Grounds for Opposition

Immoral or scandalous matter	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1847961	Application Date	08/27/1993
Registration Date	08/02/1994	Foreign Priority Date	NONE
Word Mark	APEX		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1942/09/00 First Use In Commerce: 1942/09/00 retail department store services

U.S. Registration No.	2155905	Application Date	05/25/1994
Registration Date	05/12/1998	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 automotive repair and maintenance services Class 042. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 retail automobile parts and accessories stores		

U.S. Application No.	77588785	Application Date	10/08/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest in the nature of business marketing and healthy lifestyles		

U.S. Registration No.	2454720	Application Date	10/19/1999
Registration Date	05/29/2001	Foreign Priority Date	NONE
Word Mark	APEX		

Design Mark	APEX		
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1998/11/13 First Use In Commerce: 1998/11/13 anti-theft alarms for vehicles, namely programmable anti-theft alarms, horns, trunk releases, flashing parking lights, shock sensors, plug-in connectors and starter disable relays all for vehicles, and all sold together as a unit		

U.S. Application No.	77745712	Application Date	05/27/2009
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	APEX		
Design Mark	APEX		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 Retail store services featuring a wide variety of consumer goods of others; Retail store services featuring a wide variety of consumer goods		

U.S. Registration No.	2562812	Application Date	08/23/1999
Registration Date	04/23/2002	Foreign Priority Date	NONE
Word Mark	APEX ONLINE		

Design Mark	APEX ONLINE		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/11/01 First Use In Commerce: 1996/11/01 Retail store, mail order purchase and computerized on-line retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, housewares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men# s and ladies# accessories, shoes, athletic footwear, novelties, food and Christmas items		

U.S. Application No.	77588760	Application Date	10/08/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	APEX UNIVERSITY		
Design Mark	Apex University		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1994/00/00 First Use In Commerce: 1995/01/01 Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest in the nature of business marketing and healthy lifestyles		

U.S. Registration No.	2657639	Application Date	11/01/1999
Registration Date	12/10/2002	Foreign Priority Date	NONE
Word Mark	APEX MALL		

Design Mark	APEX MALL		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 SHOPPING MALL SERVICES AND LEASING OF SHOPPING MALL SPACE		

U.S. Registration No.	2443933	Application Date	08/23/1999
Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	APEX STORES		
Design Mark	APEX STORES		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/11/01 First Use In Commerce: 1996/11/01 Retail store, mail order purchase and computerized on-line retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, housewares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic footwear, novelties, food and Christmas items		

U.S. Registration No.	2918976	Application Date	10/27/2003
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	APEX ADVANTAGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 1996/12/01 First Use In Commerce: 2002/09/01 CUSTOM FINISHING AND EMBELLISHMENT OF PROMOTIONAL ITEMS, NAMELY, EMBROIDERY, EMBOSSING, ENGRAVING, CUSTOMIZED		

	PRINTING, IMPRINTING, SCREEN PRINTING AND PAD PRINTING WITH COMPANY NAMES, LOGOS, MONOGRAMS, WORDS, AND/OR PICTURES FOR PROMOTIONAL AND ADVERTISING PURPOSES ON THE GOODS OF OTHERS, NAMELY, SPORTSWEAR, APPAREL AND OTHER PRODUCTS
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U.S. Registration No.	3356317	Application Date	07/12/2006
Registration Date	12/18/2007	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Computer services, namely, creating indexes of information, sites, and other resources available on computer networks; computer services, namely, providing search engines for obtaining data on a global computer network		

U.S. Registration No.	3557603	Application Date	07/12/2006
Registration Date	01/06/2009	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Shopping Mall services, namely, leasing and management of shopping mall space; real estate management; financial services in the nature of investments and financing in the field of real estate, securities, debt, venture capital and loans Class 037. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01		

	Real estate development		
U.S. Registration No.	3244685	Application Date	07/12/2006
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving, customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words, and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products		
U.S. Application No.	78981143	Application Date	07/12/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Automobile repair and maintenance		
U.S. Application No.	78928022	Application Date	07/12/2006
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	APEX COMPANIES
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Promoting the goods and services of others by placing advertisements and promotional displays in an electronic site accessed through computer networks; providing an on-line advertising guide featuring the goods and services of others; electronic retailing services and ordering services via computer featuring a wide variety of merchandise; Retail store and advertising services, featuring a wide variety of merchandise; arranging for others the repair, service and replacement of a wide variety of general merchandise and vehicles; retail automobile parts and accessories stores; retail store services featuring customer pick-up and/or payment of newly purchased or repaired merchandise; pick up and delivery services; business, advertising, marketing and management consulting services

Attachments	77588785#TMSN.jpeg (1 page)(bytes) 75826147#TMSN.gif (1 page)(bytes) 77745712#TMSN.jpeg (1 page)(bytes) 75781411#TMSN.gif (1 page)(bytes) 77588760#TMSN.jpeg (1 page)(bytes) 75836787#TMSN.gif (1 page)(bytes) 75781412#TMSN.gif (1 page)(bytes) 78928010#TMSN.jpeg (1 page)(bytes) 78928052#TMSN.jpeg (1 page)(bytes) 78928036#TMSN.jpeg (1 page)(bytes) 78981143#TMSN.jpeg (1 page)(bytes) 78928022#TMSN.jpeg (1 page)(bytes) Apex --- Opposition v Liggett Group Ltd 9.9.09.pdf (9 pages)(99526 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/gailyc c. sonia/
Name	Gailyc C. Sonia
Date	09/09/2009

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

In the matter of Application Serial No. 77/539,165

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APEX, LLC)	
	Opposer)	
)	
v.)	Opposition No.:
)	
LIGGETT GROUP LLC)	
)	
	Applicant)	
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NOTICE OF OPPOSITION

Apex, LLC, a limited liability company organized and existing under the laws of the State of Rhode Island, having a business address of 100 Main Street, Pawtucket, Rhode Island 02860 (“Opposer”), believes that it will be damaged by registration of Application Serial No. 77/539,165 for the mark APEX as it relates to goods in International Class 34, namely, “cigarettes” (the “Liggett Mark”). The grounds for opposition are as follows:

Apex and its Marks

1. Since at least as early as 1924, Opposer and its predecessors and their affiliates (collectively, "Apex") have used the mark “APEX” and other marks incorporating the word “APEX” (collectively the “Apex Marks”). Over the past 85 years, Apex has used the Apex Marks on and in connection with retail services, retail stores, and on-line retail stores and services; manufacturing services; automotive services and sales of automotive parts and accessories; commercial and residential real estate

development and construction services; real estate management services; and advertising and marketing businesses, among others.

2. Opposer is the owner of common law rights in the mark “APEX,” as a result of the continuous use of the APEX mark by Apex since at least as early as 1924.

3. Opposer owns the following U.S. registrations and applications for its APEX family of trademarks and service marks, among others:

<u>Mark</u>	<u>Registration No./ Serial No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
<u>APEX</u>	<u>1,847,961</u>	<u>8/2/1994</u>	<u>Retail department store services (Class 42)</u>
<u>APEX</u>	<u>2,155,905</u>	<u>5/12/1998</u>	<u>Automotive repair and maintenance services (Class 37); retail automobile parts and accessories stores (Class 42)</u>
<u>APEX</u>	<u>77/588,785</u>		<u>Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest (Class 41)</u>
<u>APEX</u>	<u>2,454,720</u>	<u>5/29/2001</u>	<u>Anti-theft alarms for vehicles, namely programmable anti-theft alarms, horns, trunk releases, flashing parking lights, shock sensors, plug-in connectors and starter disable relays all for vehicles, and all sold together as a unit (Class 12)</u>
<u>APEX</u>	<u>77/745,712</u>	<u>5/27/2009</u>	<u>Retail store services featuring a wide variety of consumer goods of others; Retail store services featuring a wide variety of consumer goods (Class 35)</u>
<u>APEX ONLINE</u>	<u>2,562,812</u>	<u>4/23/2002</u>	<u>Retail store, mail order purchase and computerized online retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances,</u>

			<u>house wares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic foot wear, novelties, food and Christmas items (Class 35)</u>
<u>APEX UNIVERSITY</u>	<u>77,588,760</u>	<u>10/8/08</u>	<u>Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest (Class 41)</u>
<u>APEX MALL</u>	<u>2,657,639</u>	<u>12/10/2002</u>	<u>Shopping mall services and leasing of shopping mall space (Class 36)</u>
<u>APEX STORES</u>	<u>2,443,933</u>	<u>4/17/2001</u>	<u>Retail store, mail order purchase and computerized online retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, house wares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic foot wear, novelties, food and Christmas items (Class 35)</u>
<u>APEX ADVANTAGE</u>	<u>2,918,976</u>	<u>1/18/2005</u>	<u>Custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving customized printing, imprinting, screen printing and pad printing with company names, logos,</u>

			<u>monograms, words and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products (Class 40)</u>
<u>APEX COMPANIES</u>	<u>3,356,317</u>	<u>12/18/2007</u>	<u>Computer services, namely, creating indexes of information, sites and other resources available on computer networks; computer services, namely, providing search engines for obtaining data on a global computer network (Class 42)</u>
<u>APEX COMPANIES</u>	<u>3,557,603</u>	<u>1/6/2009</u>	<u>Shopping Mall services, namely, leasing and management of shopping mall space; real estate management; financial services in the nature of investments and financing in the field of real estate, securities, debt, venture capital and loans (Class 36); Real estate development (Class 37)</u>
<u>APEX COMPANIES</u>	<u>3,244,685</u>	<u>5/22/2007</u>	<u>Custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products (Class 40)</u>
<u>APEX COMPANIES</u>	<u>78/981,143</u>	<u>7/12/2006</u>	<u>Automobile repair and maintenance (Class 37)</u>
<u>APEX COMPANIES</u>	<u>78/928,022</u>	<u>7/12/2006</u>	<u>Promoting the goods and services of others by placing advertisements and promotional displays in an electronic site accessed through computer networks; providing an on-line advertising guide featuring the goods and services of others; electronic retailing services and ordering services via computer featuring a wide variety of merchandise; Retail store and</u>

			<u>advertising services, featuring a wide variety of merchandise; arranging for others the repair, service and replacement of a wide variety of general merchandise and vehicles; retail automobile parts and accessories stores; retail store services featuring customer pick-up and/or payment of newly purchased or repaired merchandise; pick up and delivery services; business, advertising, marketing and management consulting services (Class 35)</u>
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4. Registration No. 1,847,961 for the mark APEX, and Registration No. 2,155,905 for the mark APEX have both been renewed pursuant to the applicable provisions of the Lanham Act, and affidavits of incontestability have been filed and acknowledged.

5. Affidavits of continued use have been filed and accepted, and affidavits of incontestability have been filed and acknowledged, in connection with Registration No. 2,562,812 for the mark APEX ONLINE, Registration No. 2,443,933 for the mark APEX STORES, Registration No. 2,657,639 for APEX MALL, and Registration No. 2,454,720 for the mark APEX.

6. Opposer has spent a considerable amount of money, time and energy in connection with the advertising, marketing and promotion of products and services bearing the APEX trademark. As a result, the APEX trademark has become famous, and the public has come to identify the APEX trademark with Opposer and its goods and services.

Applicant and its Marks

7. Upon information and belief, Liggett Group LLC (“Applicant”) is a Delaware limited liability company with a business address at 100 Maple Lane, Mebane, North Carolina 27302.

8. Applicant is the record owner of the following U.S. Trademark Application for the mark APEX:

<u>Application No.</u>	<u>Filing Date</u>	<u>Goods and Services</u>
77/539,165	August 5, 2008	Cigarettes, in International Class 34

COUNT I: LIKELIHOOD OF CONFUSION

9. Oposer repeats and incorporates herein by reference the averments in the preceding paragraphs.

10. The Liggett Mark is identical in appearance and commercial impression to the Apex Marks.

11. The goods recited in Application No. 77/539,165 are closely related to those of Opposer, in particular, to Opposer’s retail, mail order and online retail services, and the products sold via those services.

12. On information and belief, Opposer is the prior user of the APEX mark. Application for the Liggett Mark was made based on an intention to use the mark. Consequently, Applicant’s date of first use for their mark is subsequent to Opposer’s actual date of first use of the Apex Marks for the identical or closely related goods and services.

13. In light of the foregoing, the Liggett Mark for the goods recited in the opposed application is confusingly similar to Opposer’s Apex Marks and is likely to cause confusion or mistake, and to deceive the public into believing that Applicant’s

goods or services originate or are in some manner sponsored, licensed, associated or otherwise authorized by Apex in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

COUNT II: DILUTION

14. Opposer repeats and incorporates herein by reference the averments in the preceding paragraphs.

15. Opposer is damaged and will continue to be damaged because Applicant's future use and registration of the Liggett Mark would dilute the distinctive quality of Opposer's Apex Marks.

COUNT III: IMMORAL OR SCANDALOUS MATTER

16. Opposer repeats and incorporates herein by reference the averments in the preceding paragraphs.

17. Opposer is damaged and will continue to be damaged by Applicant's future use and registration of the Liggett Mark because a substantial portion of the general public would consider the mark, as applied to Applicant's goods, to be immoral or scandalous in the context of contemporary attitudes toward cigarettes and their negative effects on the health of children and adults. Applicant's use of the mark APEX would give the impression that use of its products would be a highlight in consumers' lives.

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/gailyc c. sonia/
Gailyc C. Sonia