

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

Robert A. Casey
52 Woodview Drive
Howell, NJ 07731
Casey, Robert A.
August 24, 2010

Ms. Elizabeth Winter,

My name is Robert A. Casey and I am responding to the Notice of Opposition #91195724. My trademark application # is 77929917.

I would like to start by noting that a major principle of the United States trademark law and that of other countries is that trademark protection is national in nature and does not extend beyond a country where the mark is used and registered. In this case, my opposer's foreign mark is neither in use nor registered here in the United States. It is my belief that my opposer's trademark application is a direct response to mine. As you are aware my application submission date is 5 months prior to my opposers'. From my understanding, for that reason, I have the initial rights to pursue this trademark and my American dream of manufacturing and selling cigarettes in the United States. Moreover, my opposer, an owner of a foreign mark who seeks protection here in the U.S. should have taken the necessary steps to ensure that their trademark rights were recognized where they seek to assert them.

I believe that under the Famous Marks Doctrine, my opposer's brand is not covered. I question, what percent of American consumers in the cigarette market are familiar with my opposer's foreign mark? In order to be covered the brand should have a level of recognition. My opposer's brand is not common, ordinary, nor widespread amongst the American smoking public. Their mark in the U.S. is unknown. Under this doctrine the mark needs to be common and since it is not in the U.S. there would be no cause for confusion from the consumers' stand point therefore should not be protected under this doctrine. In their opposition to me, they openly admit that they do not manufacture or sell their products here in the U.S. nor do they intend to. The Trademark Trial and Appeals Board has dismissed cases such as this where the opposer is not protected under the Famous Marks Doctrine, as an example, Bayer Consumer Care AG V. Belmora LLC. In April 2009 the Trade Mark Trial and Appeal Board held that there was no Famous Marks Doctrine in the U.S.

To further address this notice of opposition, I, Robert Casey have spent the last 33 years of my life selling cigarettes in the U.S. As a salesman in the cigarette industry, wouldn't you think that I would have had knowledge of this brand if it was recognized in U.S.?


08-26-2010

I intend to use my extensive experience and knowledge of the cigarette industry to manufacture and sell my pending trademark. To further solidify my intentions of engaging in the cigarette business I should make you aware that I also currently have a Notice of Allowance on Mr. Menthol, application # 77756877, which I also will manufacture and sell.

Manufacturing my pending trademark in the U.S. will no impact on their foreign business in Italy or surrounding countries. My opposer claims they will suffer great damage and irreparable harm. Since my opposer does not have a market in the U.S. and my intentions are to market my pending trademark here in the U.S., how would my opposer ~~stand~~ suffer damages?

In closing, based upon my response to this notice of opposition, it is clear that my opposer has applied 5 months after mine and shouldn't be entitled to protection under the United States Trademark laws.

Sincerely,

A handwritten signature in cursive script that reads "Robert A. Casey". The signature is written in dark ink and is positioned above the typed name.

Robert A. Casey

Thank you for your request. Here are the latest results from the

This page was generated by the TARR system on

Serial Number:

Registration Number: (NOT AVAILABLE)

Mark

Ms. Menthol

(words only):

Standard Character claim:

Current Status

Date of Status:

Filing Date:

Filed as TEAS Plus Application:

Currently TEAS Plus Application:

Transformed into a National Application:

Registration Date: (DATE NOT AVAILABLE)

Register:

Law Office Assigned:

Attorney Assigned:

Current Location:

Date In Location:

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Casey Robert A.

Address:

Casey Robert A.
 77 Woodbury Hill
 Woodbury Hill
 West Sun.

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: 732.938.1111

Fax Number: 732.938.1111

2. John Anthony S.

Address:

John Anthony S.
 18 Frederick Street
 Carteret NJ 07008
 Carteret, NJ, U.S.

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: 732.963.5211

GOODS AND/OR SERVICES

International Class: 33

Class Status: Native

Cigarettes

Basis: 101

First Use Date: 01/01/2001

First Use in Commerce Date: 01/01/2001

ADDITIONAL INFORMATION

Disclaimer: 1/1/2001

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

View all documents for this trademark.

010-07-20 Opposed by
 010-08-20 Notice of Opposition
 010-09-20 Partial Opposition
 010-10-20 New Opposition
 010-11-20 Opposition
 010-12-20 Opposition
 010-01-21 Opposition
 010-02-21 Opposition
 010-03-21 New Opposition
 010-04-21 New Opposition

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

CASEY BURBANK
 1 WOODBURY
 HOV 1111 070
 Phone No. 603-271-1111
 Fax No. 603-271-1111

Thank you for your request. Here are the latest results from the

This page was generated by the TARR system on 8/23/2010 11:01:11 AM

Serial Number: 77756877

Registration Number: (NOT AVAILABLE)

Mark

Mr. Menthol

(words only): MENTHOL

Standard Character claim:

Current Status: **REGISTERED** (Application No. 77756877, Serial No. 77756877)

Date of Status: 8/23/2010

Filing Date: 8/23/2010

The Notice of Allowance Date is: 8/23/2010

Transformed into a National Application:

Registration Date: (DATE NOT AVAILABLE)

Register:

Law Office Assigned:

Attorney Assigned:

Current Location:

Date In Location:

LAST APPLICANT(S)/OWNER(S) OF RECORD

1.

Address:

Casey, Robert A.
 21 Woodview Drive
 Fairfax, VA 22033
 (703) 261-1122

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: 703-261-1122

GOODS AND/OR SERVICES

International Class: 33

Class Status: Active

Cigarettes

Basis: 1(b)

First Use Date: (00/00/00) (00/00/00)

First Use in Commerce Date: (00/00/00) (00/00/00)

ADDITIONAL INFORMATION

Disclaimer: "MUN" mark

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

Application No. 77756877, filed 08/23/10, for "MUN" on cigarettes, Class 33.

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Application No. 77756877, filed 08/23/10, for "MUN" on cigarettes, Class 33.

2009-08-29 Assign

2009-09-17 Approval of

2009-10-01 Assign

2009-10-15 New Assign

2009-10-15 New Assign

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

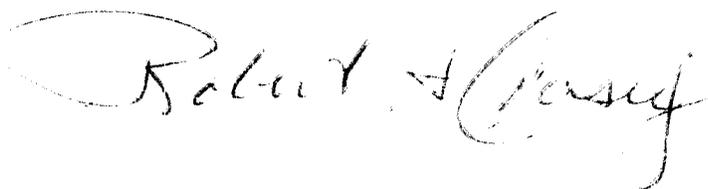
CASEY, ROBERT
LAW OFFICE OF
ROBERT CASEY
Phone Number 00000000

CERTIFICATE OF SERVICE

I hereby certify that a copy of my response to opposition has been sent to my opposer's attorney, Paolo A. Strino of Lucas & Mercanti LLP 475 Park Avenue South, New York, NY 10016. Mailed August 24, 2010 via certified return receipt mail.

Robert A. Casey
52 Woodview Drive
Howell, NJ 07731

CaseyR1@optonline.net

A handwritten signature in cursive script that reads "Robert A. Casey". The signature is written in dark ink and is positioned above the date.

8-24-10

Thank you for your request. Here are the latest results from the

This page was generated by the TARR system on

Serial Number:

Registration Number: (NOT AVAILABLE)

Mark

My Opposer's Application
MS

(words only):

Standard Character claim:

Current Status:

Date of Status:

Filing Date:

Transformed into a National Application:

Registration Date: (DATE NOT AVAILABLE)

Register:

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at

Current Location:

Date In Location:

LAST APPLICANT(S)/OWNER(S) OF RECORD

1.

Address:

BRITISH AMERICAN TOBACCO COMPANY
 Via Amsterdam 147
 Roma 00144
 Italy

Legal Entity Type: Foreign Corporation
State or Country Where Organized: Italy

GOODS AND/OR SERVICES

International Class: 34
Class Status: Active
Basis: First to File
First Use Date: 1997/01/01
First Use in Commerce Date: 1997/01/01

ADDITIONAL INFORMATION

Foreign Application Number: 100000000
Country: Italy
Foreign Filing Date: 2010/08/23

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

10/19/07 - Trademark Application 100000000 - Status: 100000000
 10/19/07 - Trademark Application 100000000 - Status: 100000000

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
 Paolo A. Neri

Correspondent
 PAOLO A. NERI
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 100 WALL STREET, SUITE 1103
 NEW YORK, NY 10038-3307
 Phone: (212) 367-3300