

ESTTA Tracking number: **ESTTA407749**

Filing date: **05/09/2011**

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	R.J. Reynolds Tobacco Company
Granted to Date of previous extension	05/11/2011
Address	401 North Main Street Winston-Salem, NC 27102 UNITED STATES

Attorney information	William M. Bryner Kilpatrick Townsend & Stockton LLP 1001 West Fourth Street Winston-Salem, NC 27101 UNITED STATES wbryner@kilpatricktownsend.com, lamiller@kilpatricktownsend.com, jburns@kilpatricktownsend.com
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**Applicant Information**

Application No	85111881	Publication date	01/11/2011
Opposition Filing Date	05/09/2011	Opposition Period Ends	05/11/2011
Applicant	Lorillard Licensing Company, LLC 1601 Wachovia Tower, 300 N. Greene St. Greensboro, NC 27401 UNITED STATES		

**Goods/Services Affected by Opposition**

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

Application No	85111876	Publication date	01/11/2011
Opposition Filing Date	05/09/2011	Opposition Period Ends	
Applicant	Lorillard Licensing Company, LLC 1601 Wachovia Tower, 300 N. Greene St. Greensboro, NC 27401 UNITED STATES		

**Goods/Services Affected by Opposition**

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

Application No	85095824	Publication date	01/11/2011
Opposition Filing Date	05/09/2011	Opposition Period Ends	
Applicant	Lorillard Licensing Company, LLC 1601 Wachovia Tower, 300 N. Greene St. Greensboro, NC 27401 UNITED STATES		

## Goods/Services Affected by Opposition

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

The mark is merely descriptive	Trademark Act section 2(e)(1)
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Attachments	PLEASURE CNOO.pdf ( 9 pages )(27603 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	/Laura Miller/
Name	Laura C. Miller
Date	05/09/2011

**In the matter of Application Serial Nos. 85/111,881, 85/111,876, and 85/095,824  
Published in the *Official Gazette* on January 11, 2011**

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

R.J. REYNOLDS TOBACCO	)	
COMPANY,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
vs.	)	Alleged Marks:
	)	
LORILLARD LICENSING	)	• SMOKING PLEASURE
COMPANY, LLC,	)	• SMOKING PLEASURE
	)	WITHOUT MENTHOL
	)	
Applicant.	)	• NON-MENTHOL PLEASURE!

**CONSOLIDATED NOTICE OF OPPOSITION**

Opposer R.J. Reynolds Tobacco Company, a North Carolina corporation having a place of business at 401 N. Main Street, Winston-Salem, North Carolina 27101 (“Opposer”), believing that it will be damaged by registration to Applicant Lorillard Licensing Company LLC (“Applicant”), hereby gives notice that it opposes the registrations sought by Applicant of the following:

- the composite phrase “SMOKING PLEASURE,” in standard character format, for use in connection with “cigarettes” in International Class 34, as shown in U.S. Trademark App. Ser. No. 85/111,881 and published in the *Official Gazette* on January 11, 2011 (the “’881 Application”);
- the composite phrase “SMOKING PLEASURE WITHOUT MENTHOL,” in standard character format, for use in connection with “cigarettes” in International Class 34, as shown in U.S. Trademark App. Ser. No. 85/111,876

and published in the *Official Gazette* on January 11, 2011 (the “876 Application”); and

- the composite phrase “NON-MENTHOL PLEASURE!,” in stylized script, for use in connection with “cigarettes” in International Class 34, as shown in U.S. Trademark App. Ser. No. 85/095,824 and published in the *Official Gazette* on January 11, 2011 (the “824 Application”).

As grounds for opposing registration, Opposer alleges the following:

**FACTS COMMON TO ALL GROUNDS OF OPPOSITION**

1. Opposer, together with its related companies and predecessors-in-interest (hereinafter collectively referred to as “Reynolds”), is engaged, and for many years has been engaged, in the business of manufacturing, selling and distributing cigarettes and related products throughout the United States.
2. Applicant, together with its related companies and predecessors in interest (hereinafter collectively referred to as “Lorillard”), also is engaged, and for many years has been engaged, in the business of manufacturing and distributing cigarettes and related products throughout the United States. Lorillard is a competitor of Reynolds, and has been a competitor of Reynolds for many years.
3. The business of manufacturing, selling and distributing cigarettes in the United States is highly competitive. Both Reynolds and Lorillard, as well as the other cigarette manufacturers, have historically relied heavily, and continue to rely heavily, on advertising and promotion — as permitted by applicable laws, regulations, and agreements — to market their cigarettes and related goods and services.

4. For decades, tobacco and cigarette companies, including Reynolds and Lorillard, have used the words “smoking,” “pleasure,” “menthol,” “non-menthol,” and composite phrases incorporating those words, in connection with the marketing, advertising and promotion of tobacco products.

5. The words “smoking,” “pleasure,” “menthol,” and “non-menthol,” and composite phrases incorporating those words, have been widely used to describe smoking, cigarette attributes, and/or the feelings smokers experience by smoking cigarettes. Doctors, experts and smokers have testified, under oath, to the pleasurable aspects of smoking and the pleasure-seeking that leads people to smoke.

#### **GROUND 1**

#### **“SMOKING PLEASURE” IS DESCRIPTIVE WHEN USED IN CONNECTION WITH CIGARETTES**

6. In the '881 Application, Lorillard has applied, on an intent-to-use basis pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), to register on the Principal Register the composite phrase “smoking pleasure” in connection with “cigarettes.”

7. Many adult smokers smoke for pleasure, because smoking is a pleasurable activity for many adult smokers. Many adult smokers derive pleasure from cigarettes, and smoking gives many adult smokers a feeling of pleasure. Cigarettes are, among other things, a source of enjoyment or gratification for many adult smokers.

8. The composite phrase “smoking pleasure” is therefore descriptive and self-laudatory when applied to cigarettes. The composite phrase “smoking pleasure” describes a desirable characteristic, attribute or quality of “cigarettes.”

9. The composite phrase “smoking pleasure,” as shown in the ’881 Application, is merely descriptive of the goods identified in the ’881 Application, namely, cigarettes. Registration of the composite phrase “smoking pleasure,” as shown in the ’881 Application, and for use in connection with Lorillard’s goods as identified in the ’881 Application, would therefore violate Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

10. Reynolds possesses a right equal with Lorillard to use the composite phrase “smoking pleasure” in connection with Reynolds’ offering and sale of its cigarette products and related goods and services. Registration to Lorillard of the composite phrase “smoking pleasure,” as shown in the ’881 Application and for the goods identified in the ’881 Application, will give color of exclusive statutory rights to Lorillard in derogation of Reynolds’ equal right to use that composite phrase in commerce. Registration to Lorillard of the composite phrase “smoking pleasure,” as shown in the ’881 Application and for the goods identified in the ’881 Application, is inconsistent with Reynolds’ equal right to use that composite phrase to describe and tout Reynolds’ goods and the experience to be derived therefrom. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Reynolds believes it will be damaged by registration to Lorillard of the composite phrase “smoking pleasure,” as shown in the ’881 Application and for the goods identified in the ’881 Application.

## **GROUND 2**

### **“SMOKING PLEASURE WITHOUT MENTHOL” IS DESCRIPTIVE WHEN USED IN CONNECTION WITH CIGARETTES**

11. In the ’876 Application, Lorillard has applied, on an intent-to-use basis pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), to register on the Principal

Register the composite phrase “smoking pleasure without menthol” in connection with “cigarettes.”

12. Many adult smokers smoke non-menthol cigarettes for pleasure, because smoking non-menthol cigarettes is a pleasurable activity for many adult smokers. Many adult smokers derive pleasure from non-menthol cigarettes, and smoking non-menthol cigarettes gives many adult smokers a feeling of pleasure. Non-menthol cigarettes are, among other things, a source of enjoyment or gratification for many adult smokers.

13. The composite phrase “smoking pleasure without menthol” is therefore descriptive and self-laudatory when applied to cigarettes. The composite phrase “smoking pleasure without menthol” describes a desirable characteristic, attribute or quality of non-menthol “cigarettes.”

14. The composite phrase “smoking pleasure without menthol,” as shown in the ’876 Application, is merely descriptive of the goods identified in the ’876 Application, namely, cigarettes. Registration of the composite phrase “smoking pleasure without menthol,” as shown in the ’876 Application, and for use in connection with Lorillard’s goods as identified in the ’876 Application, would therefore violate Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

15. Reynolds possesses a right equal with Lorillard to use the composite phrase “smoking pleasure without menthol” in connection with Reynolds’ offering and sale of its cigarette products and related goods and services. Registration to Lorillard of the composite phrase “smoking pleasure without menthol,” as shown in the ’876 Application and for the goods identified in the ’876 Application, will give color of exclusive statutory rights to Lorillard in derogation of Reynolds’ equal right to use that composite phrase in commerce.

Registration to Lorillard of the composite phrase “smoking pleasure without menthol,” as shown in the ’876 Application and for the goods identified in the ’876 Application, is inconsistent with Reynolds’ equal right to use that composite phrase to describe and tout Reynolds’ goods and the experience to be derived therefrom. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Reynolds believes it will be damaged by registration to Lorillard of the composite phrase “smoking pleasure without menthol,” as shown in the ’876 Application and for the goods identified in the ’876 Application.

### **GROUND 3**

#### **“NON-MENTHOL PLEASURE!” IS DESCRIPTIVE WHEN USED IN CONNECTION WITH CIGARETTES**

16. In the ’824 Application, Lorillard has applied, on an intent-to-use basis pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), to register on the Principal Register the composite phrase “non-menthol pleasure” in connection with “cigarettes.”

17. Many adult smokers smoke non-menthol cigarettes for pleasure, because smoking non-menthol cigarettes is a pleasurable activity for many adult smokers. Many adult smokers derive pleasure from non-menthol cigarettes, and smoking non-menthol cigarettes gives many adult smokers a feeling of pleasure. Non-menthol cigarettes are, among other things, a source of enjoyment or gratification for many adult smokers.

18. The composite phrase “non-menthol pleasure” is therefore descriptive and self-laudatory when applied to cigarettes. The composite phrase “non-menthol pleasure” describes a desirable characteristic, attribute or quality of non-menthol “cigarettes.”

19. The composite phrase “non-menthol pleasure,” as shown in the ’824 Application, is merely descriptive of the goods identified in the ’824 Application, namely,

cigarettes. Registration of the composite phrase “non-menthol pleasure,” as shown in the ’824 Application, and for use in connection with Lorillard’s goods as identified in the ’824 Application, would therefore violate Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

20. Reynolds possesses a right equal with Lorillard to use the composite phrase “non-menthol pleasure” in connection with Reynolds’ offering and sale of its cigarette products and related goods and services. Registration to Lorillard of the composite phrase “non-menthol pleasure,” as shown in the ’824 Application and for the goods identified in the ’824 Application, will give color of exclusive statutory rights to Lorillard in derogation of Reynolds’ equal right to use that composite phrase in commerce. Registration to Lorillard of the composite phrase “non-menthol pleasure,” as shown in the ’824 Application and for the goods identified in the ’824 Application, is inconsistent with Reynolds’ equal right to use that composite phrase to describe and tout Reynolds’ goods and the experience to be derived therefrom. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Reynolds believes it will be damaged by registration to Lorillard of the composite phrase “non-menthol pleasure,” as shown in the ’824 Application and for the goods identified in the ’824 Application.

**WHEREFORE**, Opposer requests that registration on the Principal Register of Application Serial Nos. 85/111,881; 85/111,876; and 85/095,824 be refused.

The required fee for instituting this opposition proceeding is being submitted herewith. If for any reason this amount is insufficient, it is requested that Opposer’s Deposit Account No. 11-0855 be charged with any deficiency.

Please recognize William M. Bryner, Laura C. Miller, and the law firm of Kilpatrick Townsend & Stockton LLP as attorneys for Opposer in connection with this opposition proceeding. Please address all correspondence regarding this proceeding to William M. Bryner at Kilpatrick Townsend & Stockton LLP, 1001 West Fourth Street, Winston-Salem, NC 27101.

This the 9<sup>th</sup> day of May, 2011.

**/s/ William M. Bryner**

William M. Bryner

Laura C. Miller

KILPATRICK TOWNSEND & STOCKTON LLP

1001 West Fourth Street

Winston-Salem, NC 27101

Telephone: (336) 607-7300

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

R.J. REYNOLDS TOBACCO	)	
COMPANY,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
vs.	)	Alleged Marks:
	)	
LORILLARD LICENSING	)	• SMOKING PLEASURE
COMPANY, LLC,	)	• SMOKING PLEASURE
	)	WITHOUT MENTHOL
	)	
Applicant.	)	• NON-MENTHOL PLEASURE!

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **CONSOLIDATED NOTICE OF OPPOSITION** has been served on the attorney-of-record for Applicant Lorillard Licensing Company LLC by mailing said copy on May 9, 2011, via First Class Mail, postage prepaid, and addressed as follows:

Howard A. MacCord, Jr.  
MACCORD MASON PLLC  
P.O. Box 2974  
Greensboro, NC 27402-2974

**/s/ Laura C. Miller**  
Laura C. Miller  
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1001 West Fourth Street  
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