

ESTTA Tracking number: **ESTTA452279**

Filing date: **01/20/2012**

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	The Honorable Order of Kentucky Colonels, Inc.
Granted to Date of previous extension	01/21/2012
Address	1717 Alliant Avenue, Suite 14 Louisville, KY 40299 UNITED STATES

Correspondence information	Matthew A. Williams Wyatt, Tarrant & Combs, LLP 500 West Jefferson Street, Suite 2800 Louisville, KY 40204 UNITED STATES mwilliams@wyattfirm.com Phone:5025895235
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Applicant Information

Application No	85342010	Publication date	11/22/2011
Opposition Filing Date	01/20/2012	Opposition Period Ends	01/21/2012
Applicant	Heritage Tobacco Group, LLC 1660 Harrodsburg Road Perryville, KY 40468 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: Nasal tobacco, snuff, and tobacco chewing bits

Grounds for Opposition

False suggestion of a connection	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.	1227024	Application Date	03/02/1981
Registration Date	02/08/1983	Foreign Priority Date	NONE
Word Mark	HONORABLE ORDER OF KENTUCKY COLONELS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1957/05/10 First Use In Commerce: 1957/05/10 Eleemosynary Services-Namely, Founding of Scholarship, Equipping Playgrounds and the Like and to Collect Historical and Cultural Material Pertaining to Commonwealth of Kentucky

U.S. Registration No.	2812681	Application Date	03/10/2003
Registration Date	02/10/2004	Foreign Priority Date	NONE
Word Mark	KENTUCKY COLONELS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 2002/10/21 First Use In Commerce: 2002/10/21 Metal key chains; metal money clips; commemorative metal license plates Class 014. First use: First Use: 2002/10/21 First Use In Commerce: 2002/10/21 Necklaces; rings being jewelry; ornamental lapel pins; cuff-links; tie-clips Class 021. First use: First Use: 2002/10/21 First Use In Commerce: 2002/10/21 Coffee cups; drinking glasses; shot glasses; drinking flasks Class 022. First use: First Use: 2002/10/21 First Use In Commerce: 2002/10/21 Multi-purpose cloth bags Class 025. First use: First Use: 2002/10/21 First Use In Commerce: 2002/10/21 Clothing, namely, shirts, T-shirts, sweat shirts, jackets, vests, baseball caps [, sun visors] Class 026. First use: First Use: 2002/10/21 First Use In Commerce: 2002/10/21 Embroidered patches for clothing		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	KENTUCKY COLONELS		
Goods/Services	cigars		

Attachments	WYATTDM-#60117131-v4-KENTUCKY_COLONEL_Notice_of_Opposition.pdf (14 pages)(157815 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	/Matthew A. Williams/
Name	Matthew A. Williams
Date	01/20/2012

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

THE HONORABLE ORDER OF)	
KENTUCKY COLONELS, INC.)	
)	
Opposer)	Opposition No. _____
)	
v.)	Application No.: 85/342,010
)	Filing Date: June 9, 2011
HERITAGE TOBACCO GROUP, LLC)	Mark: KENTUCKY COLONEL
)	Class: 034
Respondent)	

NOTICE OF OPPOSITION

Opposer The Honorable Order of Kentucky Colonels, Inc. (“The Honorable Order”) a Kentucky non-profit corporation with its principal office at 1717 Alliant Avenue, Suite 14, Louisville, Kentucky 40299 believes that it will be harmed if Application Serial No. 85/342,010 for the mark KENTUCKY COLONEL in connection with nasal tobacco, snuff, and chewing tobacco bits is allowed to issue as a registration and hereby opposes this application. The Honorable Order has used the trademark KENTUCKY COLONELS in connection with cigars since December 2002. Additionally, The Honorable Order owns Registration No. 2,812,681 for KENTUCKY COLONELS and Registration No. 1,227,024 for HONORABLE ORDER OF KENTUCKY COLONELS.

On June 9, 2011, Respondent Heritage Tobacco Company, LLC ("Heritage") filed an intent-to-use application, Application Serial No. 85/342,010, for the word mark KENTUCKY COLONEL for use in connection with “nasal tobacco, snuff, and chewing tobacco bits” in International Class 034. This application was published for opposition on November 22, 2011, and on December 21, 2011, The Honorable Order requested an Extension of Time to Oppose until January 21, 2011, which was granted.

As grounds for this Opposition, The Honorable Order states as follows:

1. The rank of Kentucky Colonel is an honorary commission granted by the governor of the Commonwealth of Kentucky to deserving individuals. The first Kentucky Colonel was commissioned in 1813.

2. The Honorable Order is a non-profit organization that distributes grants to needy organizations and educational institutions.

3. Commissioned Kentucky Colonels are members of The Honorable Order. Membership includes Kentucky Colonels from all fifty U.S. States and 35 foreign countries.

4. The Honorable Order owns Registration No. 1,227,024 for HONORABLE ORDER OF KENTUCKY COLONELS for eleemosynary services, namely, founding of scholarships, equipping playgrounds and the like, and to collect historical and cultural material pertaining to the Commonwealth of Kentucky in class 042. The Honorable Order has offered these services in connection with the HONORABLE ORDER OF KENTUCKY COLONELS mark since at least as early as 1957. A printout from the TARR system showing the current status and title of this registration is attached hereto as Exhibit A.

5. The Honorable Order has used the famous and distinctive KENTUCKY COLONELS mark since at least as early as 1931.

6. The Honorable Order sells a variety of merchandise under the KENTUCKY COLONELS mark.

7. Since December 2002, The Honorable Order has used the mark KENTUCKY COLONELS in connection with cigars.

8. The Honorable Order owns Registration No. 2,812,681 for KENTUCKY COLONELS for the following goods: necklaces, rings being jewelry, ornamental lapel pins,

cuff-links, tie-clips in class 014; coffee cups, drinking glasses, shot glasses, drinking flasks in class 021; multi-purpose cloth bags in class 022; clothing, namely, shirts, T-shirts, sweat shirts, jackets, vests, baseball caps in class 025; and embroidered patches for clothing in class 026. The Honorable Order has sold these goods in connection with the KENTUCKY COLONELS mark since October 2002. A printout from the TARR system showing the current status and title of this registration is attached hereto as Exhibit B.

9. KENTUCKY COLONELS is a famous and distinctive mark owned by The Honorable Order.

10. The Honorable Order continues to use and has not abandoned the KENTUCKY COLONELS mark.

11. HONORABLE ORDER OF KENTUCKY COLONELS is a famous and distinctive mark owned by The Honorable Order.

12. The Honorable Order continues to use and has not abandoned the HONORABLE ORDER OF KENTUCKY COLONELS mark.

13. The KENTUCKY COLONELS mark symbolizes the extensive good will and consumer recognition The Honorable Order has created in its KENTUCKY COLONELS brand through a substantial investment of time and effort in advertising and promotion.

14. On June 9, 2011, Heritage filed an intent-to-use application, now Application Serial No. 85/342,010, to register the mark KENTUCKY COLONEL for use in connection with nasal tobacco, snuff, and chewing tobacco bits in International Class 034.

15. Upon information and belief, Heritage has the intent to use the KENTUCKY COLONEL mark in connection with nasal tobacco, snuff, and chewing tobacco bits.

16. The Honorable Order's use of the trademark KENTUCKY COLONELS mark in general and for cigars specifically began long before Heritage filed its intent-to-use application on June 9, 2011.

17. On information and belief, Heritage is a Kentucky limited liability company with its principal place of business in Perryville, Kentucky.

18. On information and belief, Heritage was aware of The Honorable Order's prior use of its KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks at the time Heritage filed its intent to use application Serial No. 85/342,010 for the word mark KENTUCKY COLONEL.

19. On information and belief, Heritage was aware that The Honorable Order continued to use and had not abandoned its KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks at the time Heritage filed its intent to use Application Serial No. 85/342,010 for the word mark KENTUCKY COLONEL.

20. On information and belief, Heritage was aware that The Honorable Order's KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks were famous and distinctive at the time Heritage filed its intent to use Application Serial No. 85/342,010 for the word mark KENTUCKY COLONEL.

21. On information and belief, Heritage decided to file its intent to use Application Serial No. 85/342,010 in order to capitalize on the goodwill The Honorable Order has developed in its KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks.

22. Heritage's KENTUCKY COLONEL mark and The Honorable Order's KENTUCKY COLONELS mark are substantially identical.

23. Nasal tobacco, snuff, chewing tobacco bits, and cigars are all tobacco products.

24. Heritage has applied to register the KENTUCKY COLONEL mark for use with certain tobacco products, goods that are closely related the tobacco products The Honorable Order sells under its KENTUCKY COLONELS mark.

25. Because Heritage's KENTUCKY COLONEL mark is substantially identical to The Honorable Order's previously used KENTUCKY COLONELS mark, and both marks are used or planned to be used in connection with tobacco products, Heritage's use of KENTUCKY COLONEL is likely to cause confusion, mistake, or to deceive consumers within the meaning of Section 2(d) of the Trademark Act.

26. Heritage's KENTUCKY COLONEL mark so resembles The Honorable Order's previously used and registered KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks that it is likely to cause confusion, mistake, or to deceive consumers within the meaning of Section 2(d) of the Trademark Act.

27. Heritage's KENTUCKY COLONEL mark so resembles The Honorable Order's previously used and registered KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks that it falsely suggests a connection with The Honorable Order within the meaning of Section 2(a) of the Trademark Act..

28. Heritage's KENTUCKY COLONEL mark so resembles The Honorable Order's previously used and registered KENTUCKY COLONELS and HONORABLE ORDER OF KENTUCKY COLONELS marks that it would dilute the distinctive quality of The Honorable Order's famous marks within the meaning of Section 43(c) of the Trademark Act.

WHEREFORE, The Honorable Order hereby prays that this Opposition be sustained in its favor and that Application Serial No. 85/342,010 be rejected and no registration be issued for the mark KENTUCKY COLONEL.

Respectfully submitted,

/Matthew A. Williams/
William H. Hollander
Matthew A. Williams
WYATT, TARRANT & COMBS, LLP
500 West Jefferson Street, Suite 2800
Louisville, Kentucky 40202-2898
502.589.5235
*Counsel for The Honorable Order of Kentucky
Colonels, Inc.*

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the Notice of Opposition has been served upon the following, by U.S. mail, postage prepaid, on this the 20th day of **January, 2012**:

Andrew J. Heinish
REINHART BOERNER VAN DEUREN P.C.
2215 Perrygreen Way
Rockford, Illinois 61107
*Attorney of Record,
Heritage Tobacco Company, LLC*

/Matthew A. Williams/
*One of Counsel for The Honorable Order of
Kentucky Colonels*

60117131.4

EXHIBIT A

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-01-20 10:22:42 ET

Serial Number: 73299122 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1227024

Mark (words only): HONORABLE ORDER OF KENTUCKY COLONELS

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2002-04-19

Filing Date: 1981-03-02

Transformed into a National Application: No

Registration Date: 1983-02-08

Register: Principal

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 TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2008-04-11

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

1. [Honorable Order of Kentucky Colonels, Inc., The](#)

Address:

[Honorable Order of Kentucky Colonels, Inc., The](#)
[1717 Alliant Avenue, Suite 14](#)
[Louisville, KY 40299](#)
[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Kentucky](#)

GOODS AND/OR SERVICES

International Class: 042

Class Status: Active

Eleemosynary Services-Namely, Founding of Scholarship, Equipping Playgrounds and the Like and to Collect Historical and Cultural Material Pertaining to Commonwealth of Kentucky

Basis: 1(a)

First Use Date: 1957-05-10

First Use in Commerce Date: 1957-05-10

ADDITIONAL INFORMATION

Section 2(f)

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.

2008-04-11 - Case File In TICRS

2002-04-19 - First renewal 10 year

2002-04-19 - Section 8 (10-year) accepted/ Section 9 granted

2002-02-22 - Combined Section 8 (10-year)/Section 9 filed

1989-04-17 - Section 8 (6-year) accepted & Section 15 acknowledged

1989-01-09 - Section 8 (6-year) and Section 15 Filed

1983-02-08 - Registered - Principal Register

1983-02-08 - Registered - Principal Register

1982-11-16 - Published for opposition

1982-10-05 - Notice of publication

1982-09-14 - Approved for Pub - Principal Register (Initial exam)

1982-02-16 - Non-final action mailed

1982-01-27 - Assigned To Examiner

1982-01-26 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

WILLIAM H. HOLLANDER

Correspondent

WILLIAM H. HOLLANDER

WYATT, TARRANT & COMBS, LLP

500 WEST JEFFERSON STREET, SUITE 2600

LOUISVILLE, KY 40202

EXHIBIT B

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-01-20 10:24:41 ET

Serial Number: 76499062 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2812681

Mark (words only): KENTUCKY COLONELS

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2009-11-24

Filing Date: 2003-03-10

Transformed into a National Application: No

Registration Date: 2004-02-10

Register: Principal

Law Office Assigned: LAW OFFICE 113

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

Current Location: M40 -TMO Law Office 113

Date In Location: 2009-11-24

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

1. [Honorable Order of Kentucky Colonels, Inc., The](#)

Address:

[Honorable Order of Kentucky Colonels, Inc., The](#)
[1717 Alliant Avenue, Suite 14](#)
[Louisville, KY 40299](#)
[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Kentucky](#)

Phone Number: [502-266-6114](#)

Fax Number: [502-266-6643](#)

GOODS AND/OR SERVICES

International Class: 006**Class Status:** Active

Metal key chains; metal money clips; commemorative metal license plates

Basis: 1(a)**First Use Date:** 2002-10-21**First Use in Commerce Date:** 2002-10-21**International Class:** 014**Class Status:** Active

Necklaces; rings being jewelry; ornamental lapel pins; cuff-links; tie-clips

Basis: 1(a)**First Use Date:** 2002-10-21**First Use in Commerce Date:** 2002-10-21**International Class:** 021**Class Status:** Active

Coffee cups; drinking glasses; shot glasses; drinking flasks

Basis: 1(a)**First Use Date:** 2002-10-21**First Use in Commerce Date:** 2002-10-21**International Class:** 022**Class Status:** Active

Multi-purpose cloth bags

Basis: 1(a)**First Use Date:** 2002-10-21**First Use in Commerce Date:** 2002-10-21**International Class:** 025**Class Status:** Active

Clothing, namely, shirts, T-shirts, sweat shirts, jackets, vests, baseball caps

Basis: 1(a)**First Use Date:** 2002-10-21**First Use in Commerce Date:** 2002-10-21**International Class:** 026**Class Status:** Active

Embroidered patches for clothing

Basis: 1(a)**First Use Date:** 2002-10-21**First Use in Commerce Date:** 2002-10-21

ADDITIONAL INFORMATION

Disclaimer: "KENTUCKY"

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.

2009-11-24 - Section 8 (6-year) accepted & Section 15 acknowledged

2009-11-24 - Case Assigned To Post Registration Paralegal

2009-11-13 - TEAS Section 8 & 15 Received

2004-02-10 - Registered - Principal Register

2003-11-18 - Published for opposition

2003-10-29 - Notice of publication

2003-09-09 - Approved for Pub - Principal Register (Initial exam)

2003-09-08 - Examiners amendment e-mailed

2003-09-04 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Sarah Osborn Hill

Correspondent

Sarah Osborn Hill

WYATT, TARRANT & COMBS LLP

500 WEST JEFFERSON STREET, SUITE 2800

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