

ESTTA Tracking number: **ESTTA468649**

Filing date: **04/23/2012**

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	Philip Morris USA Inc.
Granted to Date of previous extension	04/22/2012
Address	6601 West Broad Street Richmond, VA 23230 UNITED STATES
Correspondence information	Roberta L. Horton Arnold & Porter LLP 555 12th Street NW Washington, DC 20004 UNITED STATES trademarkdocketing@aporter.com, roberta.horton@aporter.com, joanna.persio@aporter.com Phone:202-942-5161

Applicant Information

Application No	85333114	Publication date	10/25/2011
Opposition Filing Date	04/23/2012	Opposition Period Ends	04/22/2012
Applicant	Arizona Investment & Trading, LLC Suite B-175 7373 E. Doubletree Ranch Road Scottsdale, AZ 85258 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: Cigarettes, namely, cigarettes that are only manufactured in the United States and that are then only sold internationally

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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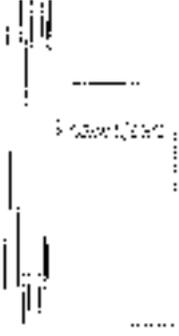
Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	894450	Application Date	08/05/1968
Registration Date	07/14/1970	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U017 (International Class 034). First use: First Use: 1968/07/24 First Use In Commerce: 1968/07/24 CIGARETTES

U.S. Registration No.	912374	Application Date	06/18/1969
Registration Date	06/08/1971	Foreign Priority Date	NONE

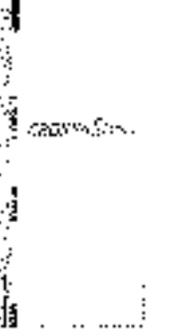
Word Mark	VIRGINIA SLIMS
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class U017 (International Class 034). First use: First Use: 1968/07/24 First Use In Commerce: 1968/07/24 CIGARETTES

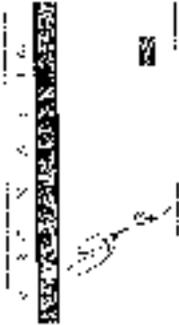
U.S. Registration No.	912375	Application Date	06/18/1969
Registration Date	06/08/1971	Foreign Priority Date	NONE

Word Mark	VIRGINIA SLIMS
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class U017 (International Class 034). First use: First Use: 1968/07/24 First Use In Commerce: 1968/07/24 CIGARETTES

U.S. Registration No.	1897685	Application Date	10/30/1989
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Registration Date	06/06/1995	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS VS SUPERSLIMS		
Design Mark			
Description of Mark	THE DOTTED LINES IN THE DRAWING DO NOT FORM PART OF THE MARK BUT ARE USED TO SHOW THE POSITION OF THE MARK ON THE GOODS.		
Goods/Services	Class 034. First use: First Use: 1989/07/28 First Use In Commerce: 1989/07/28 CIGARETTES		

U.S. Registration No.	3780624	Application Date	09/01/2009
Registration Date	04/27/2010	Foreign Priority Date	NONE
Word Mark	VS VIRGINIA SLIMS SUPERSLIMS 20 CLASS A CIGARETTES		
Design Mark			
Description of Mark	The mark consists of a rectangular design which is divided into two smaller rectangles, one large white rectangle with a gray paisley design throughout and one small rectangle with a red, yellow, pink, and lavender marbled design throughout. There are vertical silver strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS", in red, are located horizontally in the upper right-hand corner of the large white rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS", in red, are located vertically on the left-hand side of the large white rectangle. The words "20 CLASS A CIGARETTES", in silver, are located vertically in the lower right-hand corner of the large white rectangle.		
Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes		

U.S. Registration No.	3789794	Application Date	09/01/2009
Registration Date	05/18/2010	Foreign Priority	NONE

		Date	
Word Mark	VIRGINIA SLIMS SUPERSLIMS VS 20 CLASS A CIGARETTES		
Design Mark			
Description of Mark	<p>The mark consists of a rectangular design which is divided into two smaller rectangles, one large rectangle with a paisley design throughout and one small rectangle with a marbled design throughout. There are vertical strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS" are located horizontally in the upper right-hand corner of the large rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS" are located vertically on the left-hand side of the large rectangle. The words "20 CLASS A CIGARETTES" are located vertically in the lower right-hand corner of the large rectangle.</p>		
Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes		

U.S. Registration No.	3787090	Application Date	09/01/2009
Registration Date	05/11/2010	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20 CLASS A CIGARETTES		
Design Mark			
Description of Mark	<p>The mark consists of a rectangular design which is divided into two smaller rectangles, one large white rectangle with a gray paisley design throughout and one small rectangle with a yellow, green, light green, blue, light blue, and dark blue marbled design throughout. There are vertical silver strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS", in green, are located horizontally in the upper right-hand corner of the large white rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS", in green, are located vertically on the left-hand side of the large white rectangle. The word "MENTHOL", in green, is located vertically in the lower right-hand corner of the large white rectangle. The words "20 CLASS A CIGARETTES", in silver, are located vertically to the right of the word "MENTHOL" in the lower</p>		

	right-hand corner of the large white rectangle.
Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes

U.S. Registration No.	3783883	Application Date	09/01/2009
Registration Date	05/04/2010	Foreign Priority Date	NONE

Word Mark	VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20 CLASS A CIGARETTES
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Design Mark	
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Description of Mark	The mark consists of a rectangular design which is divided into two smaller rectangles, one large rectangle with a paisley design throughout and one small rectangle with a marbled design throughout. There are vertical strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS" are located horizontally in the upper right-hand corner of the large rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS" are located vertically on the left-hand side of the large rectangle. The word "MENTHOL" is located vertically in the lower right-hand corner of the large rectangle. The words "20 CLASS A CIGARETTES" are located vertically to the right of the word "MENTHOL" in the lower right-hand corner of the large rectangle.
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Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes
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Attachments	72330405#TMSN.gif (1 page)(bytes) 72330406#TMSN.gif (1 page)(bytes) 73835069#TMSN.gif (1 page)(bytes) 77817162#TMSN.jpeg (1 page)(bytes) 77817170#TMSN.jpeg (1 page)(bytes) 77817181#TMSN.jpeg (1 page)(bytes) 77817187#TMSN.jpeg (1 page)(bytes) Notice of Opposition (serial no. 85333114).pdf (7 pages)(21722 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 Overnight Courier on this date.

Signature	/Roberta L. Horton/
Name	Roberta L. Horton
Date	04/23/2012

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

In Re Application Serial No. 85/333,114

Mark: VIRGINIA20

Filed: 05/28/2011

Published in the Official Gazette: 10/25/2011

Philip Morris USA Inc.,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
Arizona Investment & Trading, LLC,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Philip Morris U.S.A., Inc. (“Opposer” or “Philip Morris USA”) believes that it will be damaged by the registration of the mark VIRGINIA20, which is the subject of Application Serial No. 85/333,114, and hereby opposes registration of the same in International Class 34 under the provisions of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. § 1063 and Trademark Rule 2.101, 37 C.F.R. § 2.101.

As grounds for opposition, Opposer alleges that:

I. THE PARTIES

1. Opposer Philip Morris U.S.A., Inc. is a corporation that manufactures and sells cigarettes, including the famous VIRGINIA SLIMS® brand of cigarettes. Opposer

is a Virginia corporation with its principal place of business at 6601 West Broad Street, Richmond, Virginia 23230.

2. On information and belief, Applicant Arizona Investment & Trading, LLC (“Applicant”) is a company organized under the laws of Arizona with its principal place of business at 7373 E. Doubletree Ranch Road, Suite B-175, Scottsdale, Arizona 85258.

II. THE PARTIES’ MARKS

A. Opposer’s VIRGINIA SLIMS® Trademark

3. Opposer Philip Morris USA Inc. manufactures, markets, and sells cigarettes under its famous VIRGINIA SLIMS® trademark and variations thereof.

VIRGINIA SLIMS® cigarettes have been marketed and sold in commerce by Opposer (and various predecessor entities) for more than four decades, since at least as early as 1968.

4. Opposer has obtained federal trademark registrations with the U.S. Patent and Trademark Office (the “USPTO”) for the VIRGINIA SLIMS® trademark and variations thereof, including the following trademarks (the “VIRGINIA SLIMS® Marks”), among others, on the Principal Register:

Trademark	Registration No.	Date Registered	Goods
VIRGINIA SLIMS®	894,450	July 14, 1970	Cigarettes
VIRGINIA SLIMS® and Design	912,374	June 8, 1971	Cigarettes
VIRGINIA SLIMS® and Design	912,375	June 8, 1971	Cigarettes
VIRGINIA SLIMS VS SUPERSLIMS® and Design	1,897,685	June 6, 1995	Cigarettes
VS VIRGINIA SLIMS SUPERSLIMS 20 CLASS A	3,780,624	April 27, 2010	Tobacco products, namely, cigarettes

CIGARETTES [®] and Design			
VIRGINIA SLIMS SUPERSLIMS VS 20 CLASS A CIGARETTES [®] and Design	3,789,794	May 18, 2010	Tobacco products, namely, cigarettes
VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20 CLASS A CIGARETTES [®] and Design	3,787,090	May 11, 2010	Tobacco products, namely, cigarettes
VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20 CLASS A CIGARETTES [®] and Design	3,783,883	May 4, 2010	Tobacco products, namely, cigarettes

5. The VIRGINIA SLIMS[®] Marks are valid and subsisting, and several of the registrations for these marks are incontestable.

6. Opposer has spent substantial time, effort, and money advertising and promoting the VIRGINIA SLIMS[®] Marks. Through its longstanding, continuous use of the VIRGINIA SLIMS[®] Marks, Opposer has developed significant goodwill in the VIRGINIA SLIMS[®] Marks, which the public associates exclusively with Opposer and the cigarette products that it markets and sells.

7. The VIRGINIA SLIMS[®] Marks have become famous, and VIRGINIA SLIMS[®] is, to this day, one of the best-selling and most recognizable cigarette brands nationwide.

B. Applicant's "VIRGINIA20" Mark

8. On information and belief, on May 28, 2011, Applicant filed an application with the USPTO to register the mark "VIRGINIA20" that is the subject of Application Serial No. 85/333,114 (the "Opposed Application").

9. The Opposed Application, as originally filed, was based on an asserted intent-to-use the mark “VIRGINIA20” in commerce in association with “Cigarettes” in International Class 34.

10. On information and belief, Applicant has not used the mark “VIRGINIA20” in commerce.

11. On information and belief, on April 4, 2012, Applicant filed a post publication amendment seeking to change the identification of goods in the Opposed Application from “Cigarettes” to “Cigarettes, namely, cigarettes that are only manufactured in the United States and that are then only sold internationally” in International Class 34 (the “Amended Goods”). The USPTO has now accepted that amendment.

12. The Opposed Application was published for opposition on October 25, 2011.

III. GROUND FOR OPPOSITION

A. Likelihood of Confusion

13. There is no issue as to priority. Opposer has priority in the VIRGINIA SLIMS® Marks dating back decades -- long before Applicant filed its intent- to-use application on May 28, 2011.

14. Applicant’s VIRGINIA20 mark is confusingly similar to Opposer’s VIRGINIA SLIMS® Marks for the following reasons, among others:

- a) The Marks are Virtually Identical. The parties’ marks are similar in sound, sight, and appearance. “Virginia” is the dominant portion of both Opposer’s VIRGINIA SLIMS® Marks and Applicant’s “VIRGINIA20” mark. In addition, several of Opposer’s VIRGINIA SLIMS® Marks also include “20”,

which is the only element besides “Virginia” of which Applicant’s mark is comprised. Thus, the marks are virtually identical and have the same commercial impression.

b) Strength of Opposer’s VIRGINIA SLIMS® Marks. As described in Paragraphs 6-7 above, the VIRGINIA SLIMS® Marks have become famous. Opposer has developed an enormous amount of goodwill in the VIRGINIA SLIMS® Marks, and the public has come to associate these marks exclusively with Opposer and its products. Additionally, apart from Opposer’s VIRGINIA SLIMS® Marks, there are very few, if any, registrations for cigarettes in International Class 34 that include “VIRGINIA” as the dominant element of the mark. Opposer’s VIRGINIA SLIMS® Marks are thus unique and highly distinctive in the field.

c) Similarity of the Goods. The parties’ goods in International Class 34 are the same; Opposer’s VIRGINIA SLIMS® Marks are registered and used in association with cigarettes. Applicant seeks to register “VIRGINIA20” for cigarettes.

d) Nature of Purchasers. On information and belief, Applicant intends to market its cigarettes under the “VIRGINA20” mark to the same type of consumers that comprise the purchasing public of Opposer’s products offered under the VIRGINIA SLIMS® Marks, namely, adult smokers.

15. Registration of Applicant’s mark is thus barred by 15 U.S.C. § 1052 (d) because Applicant’s mark so resembles Opposer’s VIRGINIA SLIMS® Marks as to be likely, when applied to the goods of Applicant, to cause confusion, mistake, or to deceive consumers.

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For the reasons set forth above, Opposer believes that it would be damaged by the registration of Applicant's proposed VIRGINA20 Mark. Applicant should thus be denied registration of this proposed mark, and this Opposition to Application Serial No. 85/333,114 should be sustained.

This Notice of Opposition is submitted along with the official filing fee.

PHILIP MORRIS USA INC.

By: /Roberta L. Horton/

Roberta L. Horton
Arnold & Porter
555 12th Street, NW
Washington, D.C. 20004-1206
(202) 942-5000

Attorneys for Opposer

Dated: April 23, 2012

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition was served on April 23, 2012, upon the following attorney for Applicant via FedEx overnight courier:

Duane M. Byers, Esq.
Nixon & Vanderhye P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203

/Roberta L. Horton/

Roberta L. Horton

Date: April 23, 2012