

ESTTA Tracking number: **ESTTA496808**

Filing date: **09/26/2012**

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	Nathan Aweida
Granted to Date of previous extension	09/26/2012
Address	1300 S Dearborn St Seattle, WA 98144-2702 UNITED STATES
Party who filed Extension of time to oppose	NathanAweida
Relationship to party who filed Extension of time to oppose	Name was entered in ESTTA database without a space between first and last name.

Attorney information	Jonathan I. Feil Simburg, Ketter, Sheppard & Purdy, LLP 999 Third Avenue, Suite 2525 Seattle, WA 98104-4089 UNITED STATES jfeil@sksp.com Phone:(206) 382-2600
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Applicant Information

Application No	85374436	Publication date	05/29/2012
Opposition Filing Date	09/26/2012	Opposition Period Ends	09/26/2012
Applicant	Pure Glass Distribution, Inc. 5649 East Washington Boulevard City of Commerce, CA 90040 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: accessories for tobacco water pipes, namely, bowls

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85407750	Application Date	08/25/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SWISSPERC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2010/08/31 First Use In Commerce: 2010/08/31 Works of art made of glass		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	Works of art made of glass, artisan-produced glassware designs		

	which are also functional water pipes
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Attachments	85407750#TMSN.jpeg (1 page)(bytes) SwissPerc photo1-opp.jpg 092612Notice_of_Opposition-SwissPerc.pdf (17 pages)(261004 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	/Jonathan I. Feil/
Name	Jonathan I. Feil
Date	09/26/2012

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

In the matter of trademark application Serial No.: 85374436
For the mark: SWISS PERC (Stylized/Design)
Published in the Official Gazette on: May 29, 2012

NATHAN AWEIDA,

Opposer/Plaintiff,

v.

PURE GLASS DISTRIBUTION, INC.,

Applicant/Defendant.

Opposition No.

NOTICE OF OPPOSITION

Nathan Aweida (“Opposer”) believes that he will be damaged by registration of the mark shown in above-identified application and hereby opposes the registration of the mark.

The grounds for opposition are as follows:

1. Opposer, Nathan Aweida, is a citizen of the United States residing in the State of Washington. Mr. Aweida also uses the artist pseudonym Nate Dizzle. Mr. Aweida is the

1 owner of Aweida Arts, Inc., a corporation organized under the laws of the State of
2 Washington with offices in Seattle, Washington.

3 2. Opposer is the owner of the trademark SwissPerc (“Opposer’s Mark”), which
4 has been used continuously by Opposer or a related company for works of art made of glass,
5 including artisan-produced glassware designs which are also functional water pipes, since a
6 date prior to the earliest date that could be asserted as a priority date for the trademark of the
7 Applicant.

8 3. Opposer applied for federal registration of Opposer’s Mark on August 25,
9 2011, under Application Serial Number 85407750 for the trademark SwissPerc for “works of
10 art made of glass” in Class 21.

11 4. Applicant, Pure Glass Distribution, Inc., has applied under Application Serial
12 Number 85374436 (the “Application”) for federal trademark registration of the mark
13 SWISS PERC (Stylized/Design) (the “Applied-for Mark”), based on its allegation of a bona
14 fide intention to use the Applied-for Mark in commerce for “accessories for tobacco water
15 pipes, namely, bowls” in International Class 34.

16 5. Opposer attaches hereto as Exhibit 1 a copy of the Application and requests
17 that it be received in evidence to prove the matters claimed by Applicant as the basis for
18 registration of the Applied-for Mark.

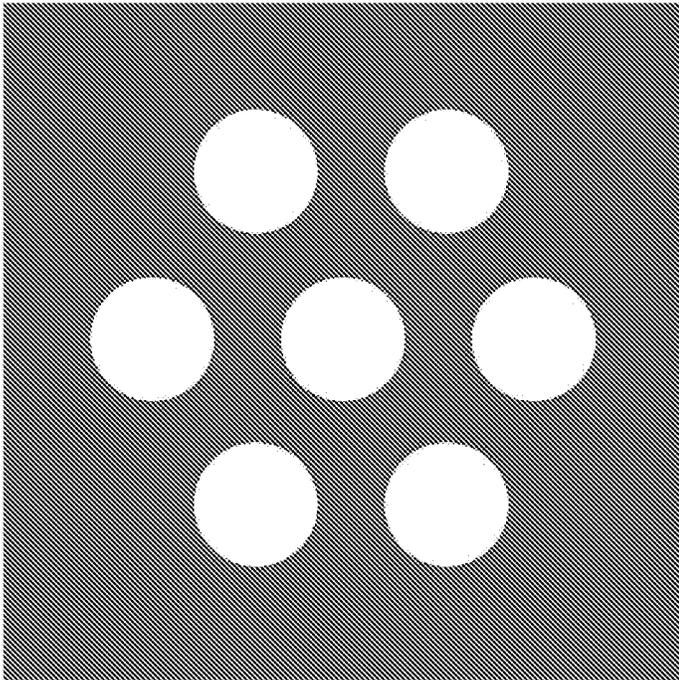
19 6. The Applied-for Mark is confusingly similar to Opposer’s Mark, and the
20 goods identified in the Application are similar or identical to, marketed and sold in similar or
21 the same channels of trade as, marketed and sold to similar or the same purchasers, and
22 marketed and sold for a similar or the same use as the goods for which Opposer’s Mark has
23

1 been used. Accordingly, the use or registration of the Applied-for Mark is likely to cause
2 confusion or mistake or to deceive.

3 7. The Applied-for Mark has been cited against Opposer's Mark by the
4 trademark examining attorney as grounds for suspending action on Opposer's Application Serial
5 Number 85407750.

6 8. By virtue of Opposer's original creation, adoption, and prior and continuous
7 use of Opposer's Mark, Opposer has exclusive right to use in commerce and register
8 Opposer's Mark in connection with works of art made of glass, water pipes, and accessories
9 for water pipes. The registration of the Applied-for Mark would be in derogation of those
10 rights and would be in violation of Section 2 of the Lanham Act, 15 U.S.C. §1052.

11 9. The Applied-for Mark incorporates the following graphic design (the
12 "Design"), which the Application describes as "a red square" inside of which "are 7 white
13 circles arranged in a larger circle" (see Exhibit 1):



1 10. The Design is confusingly similar to a design which Opposer originally
2 created and adopted in 2007 and which has been used by Opposer or a related company at
3 least as early as April 2008 on goods which are similar or identical to, marketed and sold in
4 similar or the same channels of trade as, marketed and sold to similar or the same purchasers,
5 and marketed and sold for a similar or the same use as the goods identified in the
6 Application. Accordingly, the use or registration of the Design as part of the Applied-for
7 Mark is likely to cause confusion or mistake or to deceive.

8 11. Since at least as early as April 2008, Opposer or a related company has
9 marketed and sold products with visual appearance characteristics that are distinctive and are
10 perceived by customers as identifying the source of the product. Although Applicant bases
11 the Application on an alleged intention to use the Applied-for Mark in commerce, Applicant
12 has since approximately September 1, 2011, used the mark to reproduce, distribute, market
13 and sell products whose design (as shown below in Figure 1) is (a) likely to cause confusion,
14 or to cause mistake, or to deceive as to the origin, sponsorship, or approval of Applicant's
15 goods or commercial activities and (b) infringes Opposer's copyright in its products as works
16 of visual art. The Design claimed by Applicant as part of the Applied-for Mark is an integral
17 and inseparable element in Applicant's confusing, deceptive and infringing product design.

Figure 1.



Source: http://pureglass420.com/wp-content/uploads/2012/02/SWISS_PERC/SWISS_PERC_FROST_19_1K.jpg (browsed September 26, 2012)

Source: Photograph taken by Opposer in 2007

1 12. Use of the Applied-for Mark by Applicant pursuant to its intent-to-use
2 application would be in non-compliance with other federal law, and accordingly the
3 commerce recited in the Application would not be lawful.

4 13. Applicant filed the Application in the Trademark Office, through its lawyers,
5 declaring: (a) that willful false statements may jeopardize the validity of the Application and
6 any resulting registration, (b) that all statements in the Application made of the declarant's
7 own knowledge were true and all statements made on information and belief were believed to
8 be true, (c) that the declarant believed Applicant to be entitled to use the Applied-for Mark in
9 commerce, and (d) that to the declarant's knowledge and belief no other person, firm,
10 corporation, or association has the right to use the mark in commerce, either in the identical
11 form thereof or in such near resemblance thereto as to be likely, when used on or in
12 connection with the goods or services of such other person, to cause confusion, or to cause
13 mistake, or to deceive.

14 14. On information and belief, Applicant filed the Application, through its
15 lawyers, for a mark that Applicant is not entitled to use in commerce and that Opposer has
16 the right to use in commerce, either in the identical form thereof or in such near resemblance
17 thereto as to be likely, when used on or in connection with Opposer's goods or services, to
18 cause confusion, or to cause mistake, or to deceive, as was, and still is, known by Applicant.

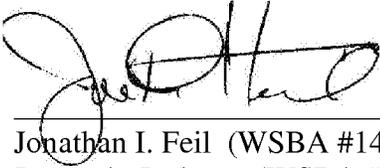
19 15. On information and belief, Applicant committed fraud on the Trademark
20 Office by claiming that Applicant is entitled to use in commerce the mark sought to be
21 registered and by intentionally concealing from the Trademark Office that Applicant is not
22 entitled to use such mark in commerce and that Opposer has the right to use the mark in
23 commerce, either in the identical form thereof or in such near resemblance thereto as to be

1 likely, when used on or in connection with Opposer's goods or services of such other person,
2 to cause confusion, or to cause mistake, or to deceive, as was, and still is, known by
3 Applicant.

4 WHEREFORE, Opposer requests that this opposition be sustained in favor of
5 Opposer and that registration be refused for Application Serial Number 85374436.

6 Respectfully submitted,

7 SIMBURG, KETTER, SHEPPARD & PURDY, LLP

8
9 By: 
10 Jonathan I. Feil (WSBA #14166)
James A. Jackson (WSBA #29836)

11 999 Third Avenue, Suite 2525
12 Seattle, WA 98104-4089
13 Telephone: (206) 382-2600
Fax: (206) 223-3929
E-mail: jfeil@sksp.com

14 DATED: September 26, 2012

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Exhibit 1

Application Serial Number 85374436

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:
Pure Glass Distribution, Inc.
Serial No.: 85/374,436
Filing Date: July 18, 2011
Mark: SWISS PERC plus Design

Examining Attorney:
Doritt L. Carroll
Law Office 116

RESPONSE TO OFFICE ACTION

Mail Stop Responses – No Fee
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

In response to the outstanding Office Action mailed September 27, 2011, please amend the above-identified application as follows:

Please enter the following disclaimer:

No claim is made to the exclusive right to use "Swiss perc" apart from the mark as shown.

Please amend the description of the applied for mark as follows:

The mark consists of the wording SWISS PERC in black in stylized form on a white rectangle. The white rectangle is beneath a red square. Inside the red square are 7 white circles arranged in a larger circle.

Please also amend the color claim to read as follows:

The colors red, white, and black are claimed as features of the mark.

Regarding the identification of goods, please amend the identification of goods changing "accessories for tobacco water pipes" to --accessories for tobacco water pipes, namely, bowls--.



03-27-2012

Remarks

In response to the above-noted Office Action, Applicant has disclaimed Swiss Perc, amended the description of the mark, the color claim, and the identification of goods as requested by the Examiner.

Inasmuch as there are no other outstanding issues and there are no conflicting marks which would bar registration under Trademark Act Section 2(d), Applicant submits that the subject application is now in condition for allowance. Accordingly, an early publication in the Official Gazette is requested.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Dated:

3/22/2012

By: _____

Eric S. Hyman

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Responses - NO FEE, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below.

Melinda Mechoso

Trademark/Service Mark Application, Principal Register

Serial Number: 85374436

Filing Date: 07/18/2011

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85374436
MARK INFORMATION	
*MARK	<u>WTICRS\EXPORT1\IMAGEOUT</u> <u>11\853744\85374436\xml1\APP0002.JPG</u>
SPECIAL FORM	YES
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	SWISS PERC
COLOR MARK	YES
COLOR(S) CLAIMED (If applicable)	The color(s) red is/are claimed as a feature of the mark.
*DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the words "SWISS PERC" in stylized form beneath a red square. Inside the red square are 7 white circles arranged in a regular pattern.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	600 x 803
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Pure Glass Distribution, Inc.
*STREET	5649 East Washington Boulevard
*CITY	City of Commerce
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	90040

LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	California
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	034
*IDENTIFICATION	tobacco water pipes and accessories for tobacco water pipes
FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	Eric S. Hyman
ATTORNEY DOCKET NUMBER	008901.T006
FIRM NAME	Blakely, Sokoloff, Taylor & Zafman LLP
STREET	12400 Wilshire Boulevard, Seventh Floor
CITY	Los Angeles
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90025
PHONE	310-207-3800
FAX	310-820-5988
OTHER APPOINTED ATTORNEY	Jacob T. Aikin; Dax F. Alvarez; Farzad E. Amini; Joan O. Arbolante; W. Thomas Babbitt; Michael A. Bernadicou; Roger W. Blakely, Jr.; Lori N. Boatright; Peter B. Bromaghim; Gregory D. Caldwell; Thomas M. Coester; Jonathan P. Crawford; Daniel M. De Vos; Ryan W. Elliott; Justin J. Eurek; Simona Freeman; Angelo J. Gaz; James Y. Go; Kevin O. Grange; James A. Henry; Willmore F. Holbrow III; Sheryl Sue Holloway; George W Hoover II; William L. Jaffe; Benjamin A. Kimes; Dimitri Kirimis; Eric T. King; Lori S. Kozak; Paul M. Krueger; Tong J. Lee; Kim H. Leung; Gordon R. Lindeen III; Michael J. Mallie; Dennis G. Martin; Paul A. Mendonsa; Jonathan S. Miller; Think V. Nguyen; David F. Nicholson; Matthew N. Nicholson; Robert B. O'Rourke; Eric S. Replogle; William W.

Schaal; James C. Scheller, Jr.; Jeremy A. Schweigert; Kevin G. Shao; Stanley W. Sokoloff; Joseph W. Sosinski; Stacie J. Sundquist; Judith A. Szepesi; Edwin H. Taylor; Michael Y. Tse; Lester J. Vincent; Mark L. Watson; Thomas C. Webster; Chui-Kiu T. Wong; and Norman Zafman

CORRESPONDENCE INFORMATION

NAME	Eric S. Hyman
FIRM NAME	Blakely, Sokoloff, Taylor & Zafman LLP
STREET	12400 Wilshire Boulevard, Seventh Floor
CITY	Los Angeles
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90025
PHONE	310-207-3800
FAX	310-820-5988

FEE INFORMATION

NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325

SIGNATURE INFORMATION

SIGNATURE	/eric s. hyman/
SIGNATORY'S NAME	Eric S. Hyman
SIGNATORY'S POSITION	Attorney of Record, California bar member
DATE SIGNED	07/18/2011

Trademark/Service Mark Application, Principal Register

Serial Number: 85374436

Filing Date: 07/18/2011

To the Commissioner for Trademarks:

MARK: SWISS PERC (stylized and/or with design, see mark)

The literal element of the mark consists of SWISS PERC.

The color(s) red is/are claimed as a feature of the mark. The mark consists of the words "SWISS PERC" in stylized form beneath a red square. Inside the red square are 7 white circles arranged in a regular pattern.

The applicant, Pure Glass Distribution, Inc., a corporation of California, having an address of

5649 East Washington Boulevard
City of Commerce, California 90040
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 034: tobacco water pipes and accessories for tobacco water pipes

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Eric S. Hyman and Jacob T. Aikin; Dax F. Alvarez; Farzad E. Amini; Joan O. Arbolante; W. Thomas Babbitt; Michael A. Bernadicou; Roger W. Blakely, Jr.; Lori N. Boatright; Peter B. Bromaghim; Gregory D. Caldwell; Thomas M. Coester; Jonathan P. Crawford; Daniel M. De Vos; Ryan W. Elliott; Justin J. Eurek; Simona Freeman; Angelo J. Gaz; James Y. Go; Kevin O. Grange; James A. Henry; Willmore F. Holbrow III; Sheryl Sue Holloway; George W Hoover II; William L. Jaffe; Benjamin A. Kimes; Dimitri Kirmis; Eric T. King; Lori S. Kozak; Paul M. Krueger; Tong J. Lee; Kim H. Leung; Gordon R. Lindeen III; Michael J. Mallie; Dennis G. Martin; Paul A. Mendonsa; Jonathan S. Miller; Thinh V. Nguyen; David F. Nicholson; Matthew N. Nicholson; Robert B. O'Rourke; Eric S. Replogle; William W. Schaal; James C. Scheller, Jr.; Jeremy A. Schweigert; Kevin G. Shao; Stanley W. Sokoloff; Joseph W. Sosinski; Stacie J. Sundquist; Judith A. Szepesi; Edwin H. Taylor; Michael Y. Tse; Lester J. Vincent; Mark L. Watson; Thomas C. Webster; Chui-Kiu T. Wong; and Norman Zafman of Blakely, Sokoloff, Taylor & Zafman LLP

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025
United States

The attorney docket/reference number is 008901.T006.

The applicant's current Correspondence Information:

Eric S. Hyman
Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025
310-207-3800(phone)
310-820-5988(fax)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

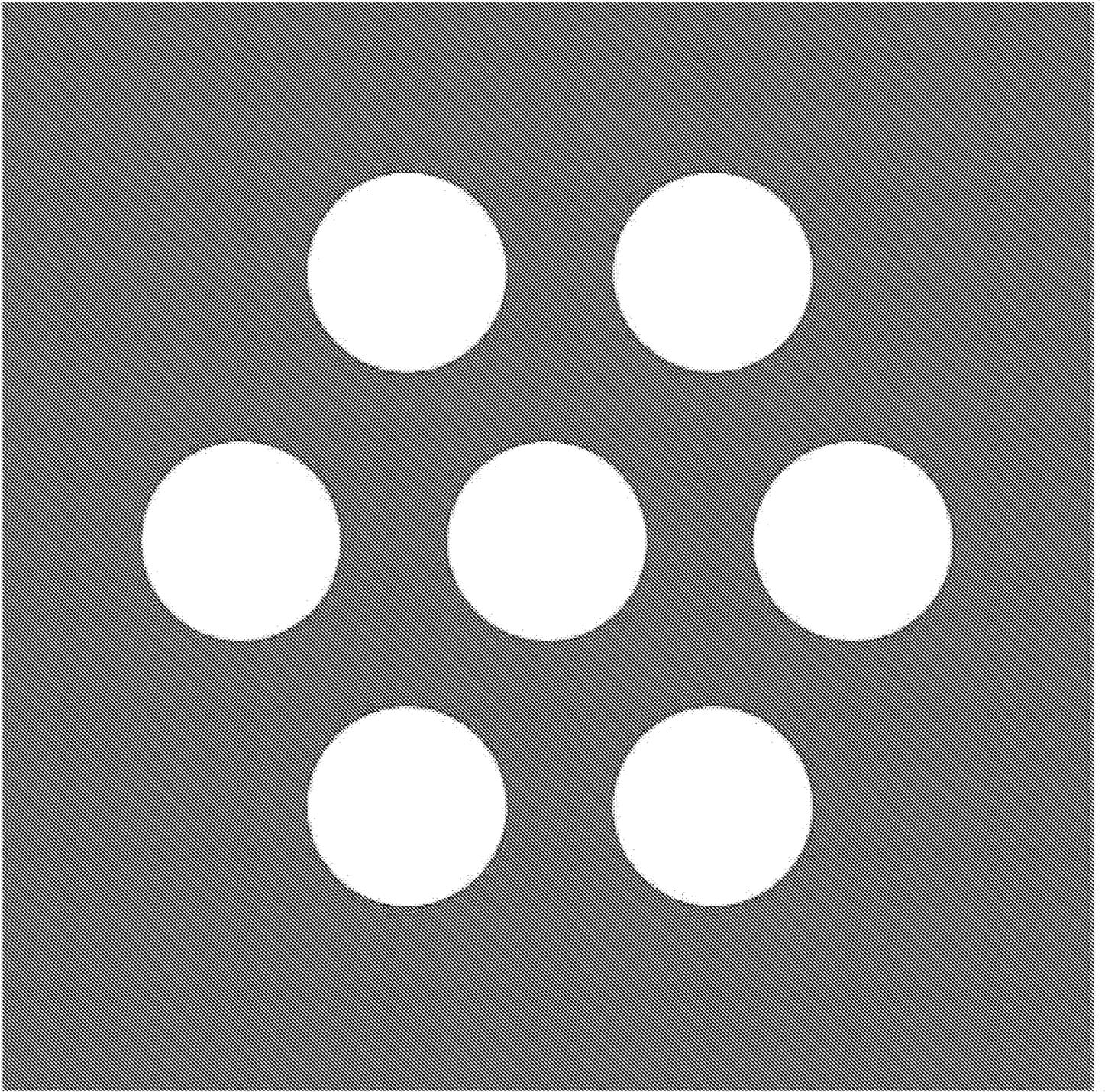
Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /eric s. hyman/ Date Signed: 07/18/2011
Signatory's Name: Eric S. Hyman
Signatory's Position: Attorney of Record, California bar member

RAM Sale Number: 8252
RAM Accounting Date: 07/19/2011

Serial Number: 85374436
Internet Transmission Date: Mon Jul 18 21:16:22 EDT 2011
TEAS Stamp: USPTO/BAS-12.197.95.71-20110718211622670
226-85374436-480ca112ec258b0e0269a7994b6
b75913fa-DA-8252-20110718192852924446



SWISS PERC

1 CERTIFICATE OF SERVICE

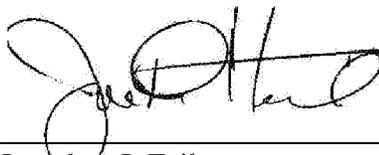
2 I certify that on this date a copy of the foregoing document was served sent by U.S.

3 First Class mail and email, addressed to:

4 Pure Glass Distribution, Inc.
5 5649 East Washington Boulevard
6 City of Commerce, CA 90040

7 Eric S. Hyman
8 Blakely, Sokoloff, Taylor & Zafman LLP
9 12400 Wilshire Blvd Fl 7
10 Los Angeles, CA 90025-1019
11 Additional copy by email: eric_hyman@bstz.com

12 DATED: September 26, 2012

13 

14 Jonathan I. Feil

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