

ESTTA Tracking number: **ESTTA579866**

Filing date: **01/03/2014**

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	U.S. Smokeless Tobacco Manufacturing Company LLC
Granted to Date of previous extension	01/29/2014
Address	6603 West Broad Street Richmond, VA 23230 UNITED STATES

Attorney information	Joel D. Leviton Fish & Richardson P.C. 60 South Sixth Street, Suite 3200 Minneapolis, MN 55402 UNITED STATES leviton@fr.com, alatriam@fr.com, trademarkgroup@altria.com Phone:612-335-5070
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**Applicant Information**

Application No	85907999	Publication date	10/01/2013
Opposition Filing Date	01/03/2014	Opposition Period Ends	01/29/2014
Applicant	Argo Brands Inc 37 Carol Ct. Staten Island, NY 10309 NY		

**Goods/Services Affected by Opposition**

Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Electronic cigarettes
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**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.	4108549	Application Date	07/21/2011
Registration Date	03/06/2012	Foreign Priority Date	NONE
Word Mark	SKOAL X-TRA		

Design Mark	<b>SKOAL X-TRA</b>
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2011/03/14 First Use In Commerce: 2011/03/14 Tobacco Products, Namely, Smokeless Tobacco

U.S. Registration No.	4418734	Application Date	05/23/2013
Registration Date	10/15/2013	Foreign Priority Date	NONE
Word Mark	X-TRA		
Design Mark	<b>X-TRA</b>		
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2011/03/14 First Use In Commerce: 2011/03/14 Tobacco Products, Namely, Smokeless Tobacco		

Attachments	85377058#TMSN.jpeg( bytes ) 85940443#TMSN.jpeg( bytes ) Notice of Opposition_XTRA (1-3-14).pdf(289842 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	/Joel D. Leviton/
Name	Joel D. Leviton
Date	01/03/2014



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

U.S. SMOKELESS TOBACCO  
MANUFACTURING COMPANY LLC,

Opposer,

v.

ARGO BRANDS INC.

Applicant.

**NOTICE OF OPPOSITION**

In the matter of Serial No. 85/907,999

For the mark XTRA

Published on October 1, 2013

Opposition No.: \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer U.S. Smokeless Tobacco Manufacturing Company LLC believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes the same pursuant to the provisions of 15 U.S.C. § 1063.

The grounds for opposition are as follows:

**THE PARTIES**

1. Opposer U.S. Smokeless Tobacco Manufacturing Company LLC is a Virginia limited liability company with a place of business at 6603 West Broad Street, Richmond, Virginia 23230.

2. Upon information and belief, Applicant Argo Brands Inc. (“Applicant”) is a New York corporation with a place of business at 37 Carol Ct., Staten Island, New York 10309.

**FACTUAL BACKGROUND**

3. U.S. Smokeless Tobacco Manufacturing Company LLC, by and through its predecessors-in-interest and related companies, (collectively, “USSTMC”) has been selling

smokeless tobacco products since the 1800s. Today, USSTMC is the leading manufacturer of smokeless tobacco products sold at retail to adult consumers.

4. USSTMC enjoys common law rights in the trademarks SKOAL X-TRA and X-TRA for smokeless tobacco products dating back to at least as early as March 14, 2011. In addition to its common law rights, USSTMC owns United States trademark registrations for its SKOAL X-TRA and X-TRA trademarks. In particular, USSTMC owns Registration No. 4,108,549 for the mark SKOAL X-TRA for “tobacco products, namely, smokeless tobacco” in class 34, which was filed on July 21, 2011, and issued on March 6, 2012. USSTMC also owns Registration No. 4,418,734 for the mark X-TRA for “tobacco products, namely, smokeless tobacco” in class 34, which was filed on May 23, 2013, identifies a date of first use of March 14, 2011, and issued on October 15, 2013. USSTMC’s SKOAL X-TRA and X-TRA marks set forth in this paragraph are collectively referred to as the “X-TRA Marks.” The certificates of registration for Registration Nos. 4,108,549 and 4,418,734 are attached as Exhibit A.

5. On April 18, 2013, Applicant filed an application to register the proposed mark XTRA in connection with “electronic cigarettes” in class 34 (“Applicant’s Goods”), which was designated Application Serial No. 85/907,999 (the “Application”), based on an intent-to-use under Section 1(b).

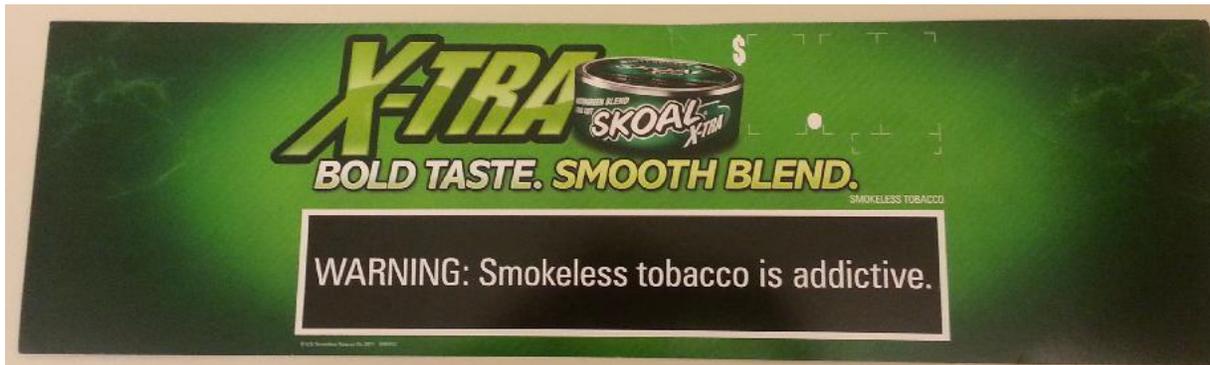
6. The Application was published for opposition in the *Official Gazette* on October 1, 2013. Thereafter, USSTMC sought and obtained an extension of time to oppose the Application until January 29, 2014. Consequently, this Notice of Opposition has been timely filed.

## GROUNDS FOR OPPOSITION

### Priority and Likelihood of Confusion

7. There is no issue as to priority. USSTMC began using the SKOAL X-TRA and X-TRA marks in commerce at least as early as March 14, 2011, long before Applicant's filing date of April 18, 2013. USSTMC's Registration No. 4,108,549 for SKOAL X-TRA was filed on July 21, 2011, and issued on March 6, 2012, more than a year before Applicant filed the Application. USSTMC's common law and statutory priority dates precede the priority date of the Application and, upon information and belief, any priority date on which Applicant may rely.

8. USSTMC prominently features its X-TRA mark both on tobacco products as well as on point-of-sale material used with its smokeless tobacco products, as shown by the point-of-sale material depicted below:



USSTMC's X-TRA Marks are distinctive of the tobacco products manufactured by USSTMC.

9. Applicant allegedly intends to use the mark XTRA, which is phonetically identical to USSTMC's X-TRA mark and visually identical to USSTMC's X-TRA mark but for Applicant's removal of the hyphen. Applicant's proposed mark is nearly identical to and virtually indistinguishable from USSTMC'S X-TRA mark.

10. Applicant allegedly intends to use the mark XTRA on tobacco products, in particular electronic cigarettes. The goods Applicant allegedly intends to offer under the mark

XTRA are classified in International Class 34, the same class in which the tobacco products USSTMC offers under its X-TRA Marks are classified.

11. USSTMC's smokeless tobacco products offered under the X-TRA Marks are sold to adult tobacco consumers. Upon information and belief, Applicant's electronic cigarettes are intended to be sold to adult tobacco consumers. USSTMC's and Applicant's products will be offered through the same channels of trade and directed to the same types of consumers.

12. The standalone trademark XTRA, when used on or in connection with tobacco products, is likely to be perceived as nearly identical, if not identical to USSTMC's X-TRA Marks, as Applicant's proposed mark XTRA merely removes the hyphen between the letters "X" and "TRA." As such, Applicant's proposed mark XTRA so resembles USSTMC's previously adopted and used X-TRA Marks, and previously registered SKOAL X-TRA mark, as to be likely, when used in connection with Applicant's Goods, to cause confusion, to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the products Applicant allegedly intends to sell under the XTRA designation are produced, sponsored, endorsed, or approved by USSTMC, or are in some way affiliated, connected, or associated with USSTMC, all to the detriment of USSTMC. Registration of Applicant's mark, therefore, should be refused under 15 U.S.C. §§ 1052(d) and 1063.

13. Registration of Applicant's proposed mark XTRA would be a further source of damage to USSTMC because it would confer upon Applicant various statutory presumptions to which it is not entitled in view of USSTMC's long prior adoption, use, and registration of its X-TRA Marks.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, USSTMC respectfully requests that its Notice of Opposition be sustained and that the registration of the mark shown in Application Serial No. 85/907,999 be refused.

Please direct all correspondence with respect to this Opposition to Joel D. Leviton at the address below. Please charge the Notice of Opposition fee to the Deposit Account of Fish & Richardson P.C., Account No. 06-1050.

Respectfully Submitted,

Date: January 3, 2014

/Joel D. Leviton/  
Joel D. Leviton  
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Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696

Attorneys for U.S. Smokeless Tobacco  
Manufacturing Company LLC

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served this 3rd day of January, 2014, by First Class U.S. Mail, postage prepaid, upon Applicant Argo Brands Inc. at the following address:

ARGO BRANDS INC  
37 CAROL CT  
STATEN ISLAND, NEW YORK 10309-3536  
UNITED STATES

*/Joel D. Leviton/*\_\_\_\_\_

Joel D. Leviton

**EXHIBIT A**

**TO NOTICE OF OPPOSITION**

# United States of America

United States Patent and Trademark Office

## SKOAL X-TRA

**Reg. No. 4,108,549**

**Registered Mar. 6, 2012**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

U.S. SMOKELESS TOBACCO MANUFACTURING COMPANY LLC (VIRGINIA LIMITED LIABILITY COMPANY)  
6603 WEST BROAD STREET  
RICHMOND, VA 23230

FOR: TOBACCO PRODUCTS, NAMELY, SMOKELESS TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 3-14-2011; IN COMMERCE 3-14-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 504,609, 1,344,928 AND OTHERS.

SER. NO. 85-377,058, FILED 7-21-2011.

CURTIS FRENCH, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

**United States of America**  
United States Patent and Trademark Office

**X-TRA**

**Reg. No. 4,418,734**

**Registered Oct. 15, 2013**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

U.S. SMOKELESS TOBACCO MANUFACTURING COMPANY LLC (VIRGINIA LIMITED LIABILITY COMPANY)

6603 WEST BROAD STREET  
RICHMOND, VA 23230

FOR: TOBACCO PRODUCTS, NAMELY, SMOKELESS TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 3-14-2011; IN COMMERCE 3-14-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 4,108,549.

SER. NO. 85-940,443, FILED 5-23-2013.

HEATHER SAPP, EXAMINING ATTORNEY



*Lea Street Lee*

Deputy Director of the United States Patent and Trademark Office