

ESTTA Tracking number: **ESTTA581602**

Filing date: **01/13/2014**

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	Mr.RichardStarkey a/k/a Ringo Starr
Granted to Date of previous extension	01/11/2014
Address	c/o Bruce Grakal, Esq. 10866 Wilshire Boulevard, Suite 1550 Los Angeles, CA 90024 UNITED STATES

Correspondence information	Sunny S. Nassim Attorney of Record Jacobson, Russell, Saltz, Nassim & de la Torre LLP 10866 Wilshire Boulevard Suite 1550 Los Angeles, CA 90024 UNITED STATES sunny@jrsnd.com, claudia@jrsnd.com Phone:310-446-9900
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Applicant Information

Application No	85956085	Publication date	11/12/2013
Opposition Filing Date	01/13/2014	Opposition Period Ends	01/11/2014
Applicants	Assouline, Felix 2182 NE 186 Terrace Miami, FL 33179 USX Malek, Michel 2182 NE 186 Terrace Miami, FL 33179 USX		

Goods/Services Affected by Opposition

<p>Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cigar and cigarette boxes; Cigar and cigarette boxes not of precious metal; Cigar and cigarette boxes of precious metal; Cigar boxes; Cigar boxes not of precious metal; Cigar boxes of precious metal;Cigar cases; Cigar cases of precious metal; Cigar cutters; Cigar holders; Cigarholders of precious metal; Cigar humidifiers; Cigar lighters; Cigar tubes; Cigar wraps; Cigars; Electric cigars; Electronic cigars; Filtered cigars and cigarettes; Holders for cigar and cigarette of precious metal; Holders for cigars and cigarettes; Holders of cigars and cigarettes of precious metal; Non-electric cigar lighters not of precious metal; Smokeless cigar vaporizer pipes; Smokers' articles, namely, cigar glue; Smokers' articles, namely, cigar relighting liquid solution; Smokers' articles, namely, cigar storage tubes; Smokers' articles, namely, containment clips used to keep a cigarfrom falling apart; Smokers' articles, namely, outdoor cigar and cigarette disposal units; Smokers' articles, namely, outdoor receptacles for cigar and</p>

cigarette ash and waste; Tobacco, cigars and cigarettes

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.	3334665	Application Date	02/21/2006
Registration Date	11/13/2007	Foreign Priority Date	NONE
Word Mark	RINGO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1962/07/01 First Use In Commerce: 1962/07/01 ENTERTAINMENT SERVICES IN THE NATURE OF LIVE MUSICAL PERFORMANCES; ENTERTAINMENT, NAMELY, LIVE MUSIC CONCERTS; ENTERTAINMENT SERVICES, NAMELY, PROVIDING A WEB SITE FEATURING MUSICAL PERFORMANCES, MUSICAL VIDEOS, RELATED FILM CLIPS, PHOTOGRAPHS, AND OTHER MULTIMEDIA MATERIALS; AND FAN CLUBS		

U.S. Registration No.	3213560	Application Date	02/21/2006
Registration Date	02/27/2007	Foreign Priority Date	NONE
Word Mark	RINGO		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 009. First use: First Use: 1962/07/01 First Use In Commerce: 1962/07/01 PRE-RECORDED COMPACT DISCS AND AUDIO CASSETTE TAPES FEATURING MUSIC; PRE-RECORDED VIDEODISCS AND VIDEOTAPES FEATURING MUSIC

U.S. Registration No.	3552187	Application Date	02/22/2006
Registration Date	12/23/2008	Foreign Priority Date	NONE

Word Mark	RINGO
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 018. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 BEACH BAGS, BOOK BAGS, TOTE BAGS
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U.S. Registration No.	2508897	Application Date	02/02/2000
Registration Date	11/20/2001	Foreign Priority Date	NONE

Word Mark	RINGO STARR
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 009. First use: First Use: 1962/07/01 First Use In Commerce: 1962/07/01 Pre-recorded phonograph records, compact discs, analog and digital audio tape cassettes and mini discs featuring musical performances; pre-recorded videodiscs and video tapes, and CD-ROMS featuring Musical performances computer software for transmitting, modifying, utilizing data, graphics, video and sound via global computer networks and others computer networks, namely, screensaver software and video streaming software; and sunglasses
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U.S. Registration No.	2508898	Application Date	02/02/2000
Registration Date	11/20/2001	Foreign Priority Date	NONE
Word Mark	RINGO STARR		
Design Mark	RINGO STARR		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1962/07/01 First Use In Commerce: 1962/07/01 [Magazines, newsletters,] posters, [calendars and trading cards regarding musical performances; pre-printed stickers and labels,] catalogs featuring clothing, sound and video recordings, printed matter and giftware; [playing cards;] writing instruments; [bookmarks; paperweights; and] souvenir programs, brochures and flyers regarding and musical performances		

U.S. Registration No.	2647855	Application Date	02/02/2000
Registration Date	11/12/2002	Foreign Priority Date	NONE
Word Mark	RINGO STARR		
Design Mark	RINGO STARR		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1962/07/01 First Use In Commerce: 1962/07/01 MEN'S, WOMEN'S AND CHILDREN'S CLOTHING, NAMELY [SWEATSHIRTS AND SWEATPANTS, SHORTS, TOPS, BRA TOPS,] T-SHIRTS, SHIRTS, [WIND RESISTANT JACKETS, JACKETS, VESTS, JEANS, SKIRTS, SWIMWEAR, UNDERWEAR, FOOTWEAR, BANDANAS, GLOVES, SCARVES, BERETS, HEADBANDS,] HATS, CAPS [, BELTS AND TIES]		

U.S. Registration No.	2494026	Application Date	02/02/2000
Registration Date	10/02/2001	Foreign Priority Date	NONE
Word Mark	RINGO STARR		

Design Mark	RINGO STARR
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1962/07/01 First Use In Commerce: 1962/07/01 ENTERTAINMENT IN THE NATURE OF A LIVE MUSICAL GROUP AND PERFORMANCE; ENTERTAINMENT SERVICES, NAMELY, PROVIDING TELEVISION AND RADIO PROGRAMS IN THE FIELD OF MUSIC AND ENTERTAINMENT VIA A GLOBAL COMPUTER NETWORK; SOUND AND VIDEOTAPE RECORDING PRODUCTION, MOTION PICTURE FILM PRODUCTION, PRODUCTION AND DISTRIBUTION OF ENTERTAINMENT AND MUSIC PROGRAMS FOR RADIO, TELEVISION, CABLE, SATELLITE, PAY-PER-VIEW, INTERACTIVE MEDIA, HOME VIDEO MARKETS; AND MULTIMEDIA PRODUCTION SERVICES IN THE FIELD OF MUSIC AND ENTERTAINMENT

U.S. Registration No.	2500042	Application Date	06/28/2000
Registration Date	10/23/2001	Foreign Priority Date	NONE
Word Mark	RINGO STARR		
Design Mark	RINGO STARR		
Description of Mark	NONE		
Goods/Services	Class 015. First use: First Use: 1995/06/00 First Use In Commerce: 1995/06/00 MUSICAL INSTRUMENTS, NAMELY, DRUMSTICKS		

U.S. Application No.	77963998	Application Date	03/19/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	RINGO		

Design Mark	<h1>RINGO</h1>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Entertainment services in the nature of an on-going reality-based and variety television series featuring animation, live action, adventure, music and comedy; educational and entertainment services in the nature of providing an on-going series of webisodes featuring previously broadcasted television animation, music and comedy series and reality-based and variety television series featuring live action and adventure via a global computer network for mobile phone devices; entertainment services, namely, providing a website featuring non-downloadable video clips of previously broadcasted television animation, music and comedy series and reality-based and variety television series featuring live action and adventure; entertainment services, namely, providing a website featuring news and information in the field of entertainment about a television program and related non-downloadable video clips and photographs

U.S. Application No.	85223979	Application Date	01/23/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	RINGO		
Design Mark	<h1>RINGO</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 COMPUTER GAME SOFTWARE, COMPUTER GAME DISCS; DOWNLOADABLE COMPUTER GAME PROGRAMS; DOWNLOADABLE COMPUTER GAME SOFTWARE VIA A GLOBAL COMPUTER NETWORK AND WIRELESS DEVICES; DOWNLOADABLE ELECTRONIC GAME PROGRAMS; DOWNLOADABLE COMPUTER GAMES VIA THE INTERNET AND WIRELESS DEVICES; DOWNLOADABLE ELECTRONIC MEDIA AND PUBLICATIONS, NAMELY, MAGAZINES FEATURING MUSIC, ENTERTAINMENT AND TOPICS OF GENERAL INTEREST		

	Class 028. First use: First Use: 0 First Use In Commerce: 0 TOYS, NAMELY, TOY VEHICLES, PLUSH TOYS, STUFFED TOYS, TOY WATCHES, TOY MUSICAL INSTRUMENTS, TOY BANKS, BATH TUB TOYS, PET TOYS, FLYING DISCS, SKATEBOARDS, BALLS, SPORTS BALLS, AND INFLATABLE BATH, SWIMMING AND RIDE-ON TOYS; GAMES, NAMELY, JIGSAW PUZZLES, PLAYING CARDS, CARD GAMES AND BOARD GAMES
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U.S. Application No.	85701976	Application Date	08/13/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	RINGO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 0 First Use In Commerce: 0 PURSES; WALLETS; ALL PURPOSE SPORTS BAGS; CARRY-ON BAGS; DUFFEL BAGS; BACKPACKS; FANNY PACKS; LUGGAGE; UMBRELLAS		

Attachments	78820180#TMSN.jpeg(bytes) 78977565#TMSN.jpeg(bytes) 78980595#TMSN.jpeg(bytes) 75908570#TMSN.gif(bytes) 75908571#TMSN.gif(bytes) 75908525#TMSN.gif(bytes) 75908569#TMSN.gif(bytes) 76079326#TMSN.gif(bytes) 77963998#TMSN.jpeg(bytes) 85223979#TMSN.jpeg(bytes) 85701976#TMSN.jpeg(bytes) 2302-001 Notice of Opposition Against Appl. No. 85956085 for RINGO in Cl. 34 with Annexes -- 1-13-14.pdf(1178166 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	/ssn/
Name	Sunny S. Nassim
Date	01/13/2014

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

In re Application Serial No.: 85956085

Mark: RINGO (standard word mark)

Filing Date: June 11, 2013

Published in Official Gazette: November 12, 2013

Applicants: Michel Malek and Felix Assouline

RICHARD STARKEY aka RINGO STARR,

Opposer,

vs.

MICHEL MALEK and FELIX ASSOULINE,

Applicants.

NOTICE OF OPPOSITION

Opposition No.

Trademark Trial and Appeal Board
P.O. Box 1452
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Richard Starkey, a citizen of the United Kingdom, also known as Ringo Starr, having a business address at 10866 Wilshire Boulevard, Suite 1550, Los Angeles, California 90024 (“OPPOSER”), believes that he will be damaged by Michel Malek and Felix Assouline (“APPLICANTS”) and the registration of APPLICANTS’ U.S. Serial No. 85956085 for “RINGO” in Class 34 (“Application”) and hereby opposes same.

As grounds for opposition, it is alleged that:

1. OPPOSER is an internationally famous entertainer and musical artist who performs under the distinctive stage names and marks “RINGO STARR” and “RINGO.” As the drummer for the world-famous and internationally acclaimed musical group “The Beatles”, OPPOSER became one of the most influential and famous musicians of the late 20th Century. Since as early as 1962, OPPOSER has used “RINGO STARR” and “RINGO” as service marks and trademarks in connection with a wide variety of goods and services, including entertainment services, sound and video recordings, musical instruments, figurines, toys and games, and clothing, sold throughout the United States and around the world.

2. OPPOSER owns the following federal applications and registrations for the “RINGO STARR” and “RINGO” marks in the United States (“OPPOSER’s Marks” or “RINGO Marks”):

	Mark	Appl. No.	Reg. No.	Class	First Date of Use	Appl. Date	Reg. Date	Renewal Date	Description of Goods and Services
1	RINGO	77963998		41		3/19/2010			Class 41 - Entertainment services in the nature of an on-going television series featuring animation, live action, adventure, music and comedy; entertainment services, namely, providing on-line computer games; educational and entertainment services in the nature of online series of programs, webisodes and documentaries featuring a previously televised entertainment series for distribution via any mobile devices and a global computer network; providing online non-downloadable video clips featuring a previously televised entertainment series; entertainment services, namely, providing a website featuring news and information about a television program, related film clips, photographs, and other multimedia materials.
2	RINGO	85223979		9, 28		1/23/2011			Class 9 - Computer game software, computer game discs; downloadable computer game programs; downloadable computer game software via a global computer network and wireless devices; downloadable electronic game programs; downloadable computer games via the internet and wireless devices; downloadable electronic media and publications, namely, magazines featuring music, entertainment and topics of general interest; and Class 28 - Toys, namely, toy vehicles, plush toys, stuffed toys, toy watches, toy musical instruments, toy banks, bath tub toys, pet toys, flying discs, skateboards, balls, sports balls, and inflatable bath, swimming and ride-on toys; games, namely, jigsaw puzzles, playing cards, card games and board games.
3	RINGO	85701878		18		8/13/2012			Class 18 - Purses; wallets; all purpose sport bags; carry-on bags; duffel bags; backpacks; fanny packs; luggage; umbrellas
4	RINGO	78820180	3334665	41	7/1/1962	2/21/2006	11/13/2007	11/13/2017	Class 41 - Entertainment services in the nature of live musical performances; entertainment, namely, live music concerts; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; and fan clubs.

5	RINGO	78977565	3213560	9	7/1/1962	2/21/2006	2/27/2007	2/21/2017	Class 9 - Pre-recorded compact discs and audio cassette tapes featuring music; pre-recorded videodiscs and videotapes featuring music.
6	RINGO	78980695	3552187	18	7/1/2006	2/22/2006	12/23/2008	12/23/2018	Class 18 - Beach bags, book bags, tote bags
7	RINGO STARR	75908570	2508897	9	7/1/1962	2/2/2000	11/20/2001	11/20/2021	Class 9 - Pre-recorded phonograph records, compact discs, analog and digital audio tape cassettes and mini discs featuring musical performances; pre-recorded videodiscs and video tapes, and CD-ROMS featuring Musical performances computer software for transmitting, modifying, utilizing data, graphics, video and sound via global computer networks and others computer networks, namely, screensaver software and video streaming software; and sunglasses.
8	RINGO STARR	75908571	2508898	16	7/1/1962	2/2/2000	11/20/2001	11/20/2021	Class 18 - Magazines, newsletters, posters, calendars and trading cards regarding musical performances; pre-printed stickers and labels, catalogs featuring clothing, sound and video recordings, printed matter and giftware; playing cards; writing instruments; bookmarks; paperweights; and souvenir programs, brochures and flyers regarding and musical performances.
9	RINGO STARR	75908525	2647855	25	7/1/1962	2/2/2000	11/12/2000	11/12/2022	Class 25 - Men's, women's and children's clothing, namely t-shirts, shirts, hats, caps.
10	RINGO STARR	75908566	2494026	41	7/1/1962	2/2/2000	10/2/2001	10/2/2021	Class 41 - Entertainment in the nature of a live musical group and performance; entertainment services, namely, providing television and radio programs in the field of music and entertainment via a global computer network; sound and videotape recording production, motion picture film production, production and distribution of entertainment and music programs for radio, television, cable, satellite, pay-per-view, interactive media, home video markets; and multimedia production services in the field of music and entertainment.
11	RINGO STARR	76079328	2500042	15	6/1/1995	6/28/2000	10/23/2001	10/23/2021	Class 15 - Musical instruments, namely, drumsticks.

3. OPPOSER is the owner of all the goodwill associated with above-mentioned applications and registrations filed in and registered by the United States Patent and Trademark Office (“USPTO”). OPPOSER’s Marks are valid and continuous, and not abandoned, and are prima facie evidence of OPPOSER’s exclusive right to use said marks in commerce in connection with the goods and services specified above. Additionally, OPPOSER also has protections for his RINGO Marks internationally, in at least forty-three (43) countries worldwide.

4. OPPOSER has developed exceedingly valuable goodwill with respect to his RINGO Marks, which have become widely and favorably known throughout the United States and worldwide. Said marks are recognized not only by consumers of entertainment and music products but also by the general public, and are extremely valuable to OPPOSER. Any registration by APPLICANTS of a confusingly similar mark will cause immediate and irreparable harm to OPPOSER and OPPOSER’s brand.

5. OPPOSER’s fame in the United States and abroad has not wavered and continues to stay strong. This year marks the fiftieth (50th) anniversary of The Beatles’ arrival in the United States and appearance on the iconic Ed Sullivan Show. The Beatles will receive the Grammy’s Lifetime Achievement Award in January 2014 and will have a

two (2) hour television special on CBS on February 9, 2014 entitled “The Night That Changed America: A Grammy Salute to the Beatles”. Moreover, OPPOSER currently has an exhibit at the Grammy Museum in Los Angeles, simply named “RINGO”, which celebrates his long-standing career and his ongoing contributions to the entertainment and music industry.

6. OPPOSER has expended great effort and considerable expense in advertising, promoting, offering for sale and selling his services under the RINGO Marks in the United States and throughout the world.

7. APPLICANTS are two (2) individuals named Michel Malek and Felix Assouline, owners of Felix Assouline Cigars, located at 2186 NE 186 Terrace, Miami, Florida 33179.

8. APPLICANTS seek to register the mark “RINGO” and filed an Intent-to-Use [Section 1(b)] trademark Application (Serial No. 85956085) on or around June 11, 2013, in International Class 34 for:

Cigar and cigarette boxes; Cigar and cigarette boxes not of precious metal; Cigar and cigarette boxes of precious metal; Cigar boxes; Cigar boxes not of precious metal; Cigar boxes of precious metal; Cigar cases; Cigar cases of precious metal; Cigar cutters; Cigar holders; Cigar holders of precious metal; Cigar humidifiers; Cigar lighters; Cigar tubes; Cigar wraps; Cigars; Electric cigars; Electronic cigars; Filtered cigars and cigarettes; Holders for cigar and cigarette of precious metal; Holders for cigars and cigarettes; Holders of cigars and cigarettes of precious metal; Non-electric cigar lighters not of precious metal; Smokeless cigar vaporizer pipes; Smokers' articles, namely, cigar glue; Smokers' articles, namely, cigar relighting liquid solution; Smokers' articles, namely, cigar storage tubes; Smokers' articles, namely, containment clips used to keep a cigar from falling apart; Smokers' articles, namely, outdoor cigar and cigarette disposal units; Smokers' articles, namely, outdoor receptacles for cigar and cigarette ash and waste; Tobacco, cigars and cigarettes.

9. OPPOSER’s first use of the RINGO Marks dates back over fifty (50) years to 1962. Further, the registration of OPPOSER’s Marks far predates APPLICANTS’ filing of their Intent-to-Use Application Serial No. 85956085, or any subsequent first use date claimed by APPLICANTS for their “RINGO” mark.

LIKELIHOOD OF CONFUSION

10. OPPOSER hereby incorporates by reference Paragraphs 1 through 9 hereinabove.

11. In view of the similarity of the respective marks, it is alleged that the mark applied for by APPLICANTS is so resembles (in this case identical) to OPPOSER's Marks used in the United States and in interstate commerce, and not abandoned, as to likely cause confusion, or to cause mistake or to deceive. [15 U.S.C. §1052, Lanham Act 2(d)].

12. Federal Circuits have consistently adopted the thirteen (13) *DuPont* factors to establish a likelihood of confusion. These factors are:

- a. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
- b. The similarity or dissimilarity and nature of the goods or services described in an application or registration or in connection with which a prior mark is in use.
- c. The similarity or dissimilarity of established, likely-to-continue trade channels.
- d. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- e. The fame of the prior mark (sales, advertising, length of use).
- f. The number and nature of similar marks in use on similar goods.
- g. The nature and extent of any actual confusion.
- h. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
- i. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- j. The market interface between the applicant and the owner of a prior mark.
- k. The extent to which applicant has a right to exclude others from use of its mark on its goods.
- l. The extent of potential confusion, i.e. whether *de minimis* or substantial.
- m. Any other established fact probative of the effect of use.

[*In re I.E. DuPont DeNemours & Co.*, 476 F.2d 1357 (Cust. & Pat.App., 1973)].

13. Not all *DuPont* factors must be present to successfully establish a likelihood of confusion, and only the factors of relevance in each case must be discussed.

[*McCarthy on Trademarks and Unfair Competition*, Volume 4 §24:43, citing *In re Mighty Leaf Tea*, 601 F. 3d 1342, 94 U.S.P.Q.2d 1257 (Fed. Cir. 2010)]. Consequently,

there is no specific formula regarding which factors need to be discussed, or which need to be satisfied to establish a likelihood of confusion. However, courts have held that similarities or dissimilarities between the marks may be dispositive. [*Id.* citing *Odom's Tennessee Pride Sausage, Inc v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346-1347, 93 U.S.P.Q.2d 2000 (Fed. Cir. 2010)]. Furthermore, Federal Courts have held that the fifth (5th) *DuPont* factor, namely the fame of the senior user's mark, can often play a "dominant role" when the senior mark is a famous and/or strong mark. [*Id.*, citing *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992)].

14. OPPOSER's RINGO Marks and APPLICANTS' "RINGO" mark are undeniably identical. The two (2) marks are spelled the exact same way and are phonetically pronounced the same, R-I-N-G-O.

15. APPLICANTS' mark so resembles OPPOSER's Marks so as to be likely, when applied to APPLICANTS' goods, to cause confusion, to cause mistake, and to deceive the trade and public, which are likely to believe that APPLICANTS' goods have their origin with OPPOSER and/or that such goods are approved, endorsed or sponsored by OPPOSER or associated in some way with OPPOSER. OPPOSER would thereby be injured by the granting to APPLICANTS the registration of the "RINGO" mark.

16. Further, there is no dispute as to the fame of OPPOSER's Marks in the marketplace. OPPOSER is the internationally acclaimed musician and actor, Ringo Starr. His fame spans generations as he was the drummer for one of the most influential bands of all time, The Beatles. OPPOSER's career did not end with The Beatles and OPPOSER continues to stay relevant and in the public eye. One such example is his involvement

with a children's series for which he won a Daytime Emmy. OPPOSER's continued acting and musical career allows him to retain fame and recognition worldwide.

17. OPPOSER has Federal Registrations for the mark "RINGO" in Classes 9, 18, and 41 and "RINGO STARR" in Classes 9, 15, 16, 25 and 41. Furthermore, OPPOSER has pending applications for "RINGO" in Classes 9, 18, 28 and 41. Although OPPOSER's full stage name is "RINGO STARR," he is commonly known as "RINGO" and is identified as "RINGO" both personally and professionally. Due to the fanciful nature of the "RINGO" name and mark, any products bearing this mark will automatically cause confusion in the marketplace as consumers will connect and/or relate "RINGO" products to OPPOSER.

18. Upon information and belief, OPPOSER believes that there is actual confusion in the marketplace between APPLICANTS' mark and OPPOSER's famous RINGO Marks. When conducting Yahoo and Bing! Searches for the phrases "RINGO CIGAR" and "RINGO CIGARETTE," results prominently feature images and articles identifying the world-famous musician Ringo Starr and his former band mates appear. Furthermore, consumers of APPLICANTS' cigars have posted on various blogs that their "first inclination when I saw this cigar was to ask, 'What about John, Paul and George?'" (referring to the remaining band members of The Beatles). This proves that consumers of APPLICANTS' products are associating APPLICANTS' products with OPPOSER and his persona. [True and correct copies of sample searches are attached hereto and incorporated by reference as Annex "1"].

19. Any confusion that is likely to occur is not *de minimis*, but rather very substantial and can cause substantial harm to the brand built by OPPOSER surrounding

the “RINGO STARR” and “RINGO” marks. Individuals who purchase APPLICANTS’ cigars will be under the assumption that OPPOSER approves of, sponsors, or is somehow related to the sale of tobacco products. Any association with such products will cause irreparable harm to OPPOSER and the brand he has built surrounding his name. OPPOSER publicly denounced use of any substances when announcing his sobriety in October 1988, and therefore any association with tobacco products will tarnish OPPOSER’s name and likeness.

20. Although the goods and services protected under OPPOSER’s Marks are not identical to the goods covered by the Application, OPPOSER has built substantial fame and positive goodwill associated with his name and service marks and trademarks, such that the use of his name on any goods will automatically suggest a connection to OPPOSER. OPPOSER’s goodwill extends beyond the mere scope of the goods and services covered by the RINGO Marks. The law clearly establishes that the goods and/or services need not be identical or even competitive in order to establish a likelihood of confusion. [See TMEP 1207.01(a)(i) citing *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009)].

21. Due to the worldwide fame achieved by OPPOSER surrounding the “RINGO” and “RINGO STARR” marks, it is highly likely that any products or services now known or later developed bearing the “RINGO” mark will automatically be assumed to bear a connection to OPPOSER.

FALSE SUGGESTION OF A CONNECTION

22. OPPOSER hereby incorporates by reference Paragraphs 1 through 21 hereinabove.

23. The purpose of a false suggestion of a connection claim is to protect “the name of an individual or institution.” This statutory section embraces the concepts of the right of privacy and right of publicity. [*University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F. 2d 1372 (Fed. Cir. 1983)]. In order to succeed in this claim, the petitioner must demonstrate that the name or equivalent that is claimed to be appropriated by another must be unmistakably associated with a particular personality or “persona” and must point uniquely to the OPPOSER. *Notre Dame* sets out four (4) factors when establishing a claim of false suggestion of a connection, namely: 1) that the defendant’s mark is the same or a close approximation of petitioner’s previously used name or identity; 2) that the mark would be recognized as such; 3) that the petitioner is not connected with the activities performed by the defendant under the mark; and 4) that the petitioner’s name or identity is of sufficient fame or reputation that when the respondent’s mark is used on its goods or services, a connection with the plaintiff would be presumed. [*Id.* at 1377-78].

24. In regards to the first two (2) *Notre Dame* factors, OPPOSER is known professionally and in the public eye as “RINGO.” Although OPPOSER’s full stage name is “RINGO STARR,” “RINGO” successfully identifies who OPPOSER is, and the goodwill associated with OPPOSER and his brand. For example, The Los Angeles Grammy Museum currently holds (From June 2013 through March 2014) an exhibit honoring OPPOSER entitled simply “RINGO” (without the “STARR”). The general

public associates the name “RINGO” with OPPOSER and his identity. APPLICANTS’ mark, as discussed in Paragraph 14 (*see supra*), is visually and phonetically identical to OPPOSER’s name and marks. The general consuming public is likely to identify APPLICANTS’ mark as being the same as, or connected to OPPOSER.

25. Further, in regards to factor three (3), the main reason for this petition is to prove and establish that there is no connection between OPPOSER and APPLICANTS - that APPLICANTS are in no way connected to OPPOSER.

26. Finally, with respect to factor four (4), the fame of OPPOSER and his marks is undeniable. OPPOSER has enjoyed worldwide fame and accolades for over five (5) decades, both during his time with The Beatles and throughout his solo career. The Beatles have over Thirty-Eight Million “likes” on Facebook and OPPOSER himself has approximately 1.4 Million Facebook “likes” and over 350,000 Twitter followers. The Beatles have sold over 1 Billion albums and boast twenty (20) Number One singles and nineteen (19) Number One albums in the United States. The fame of The Beatles along with the “RINGO” and “RINGO STARR” marks is unwavering and indisputable. OPPONENT’s fame results in large part to the substantial amounts of time and money invested by OPPONENT in creating the “RINGO” brand. [True and correct copies of three (3) printouts from Facebook and Twitter are attached hereto and incorporated by reference as Annex “2”].

27. Due to the strength of OPPOSER’s Marks, and after considering all of the evidence set forth, it is clear that APPLICANTS’ “RINGO” mark falsely suggests a connection with OPPOSER.

DILUTION

28. OPPOSER hereby incorporates by reference Paragraphs 1 through 27 hereinabove.

29. To prevail on a dilution claim, a plaintiff must show that: (1) it owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark; (3) the defendant's use of its mark began after the plaintiff's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment. [*Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012)].

30. A famous mark will become diluted in the marketplace if another mark or trade name is used in commerce that is likely to cause dilution by blurring or dilution by tarnishment, regardless of the presence or absence of actual or likely confusion, or competition, or of actual economic injury. [15 U.S.C. §1125 (c)(1)].

31. First, OPPOSER must prove that its mark is famous in the marketplace. For purposes of trademark protection, a mark is famous if it "is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." [*Id.* citing 15 U.S.C. § 1125(c)(2)(A)].

32. The fame of the RINGO Marks is indisputable. OPPOSER was one (1) of four (4) members of the most influential bands of all time, The Beatles. He has toured the world, won countless awards including an Oscar, seven (7) Grammys, and a Daytime Emmy. OPPOSER also has a star on the Hollywood Walk of Fame and continues to have a successful career as an actor and musician. OPPOSER is known as both "RINGO" and

“RINGO STARR,” and these marks have become synonymous with OPPOSER and his persona in the public eye.

33. Although the Application does not claim a first use date in commerce, OPPOSER has reason to believe that APPLICANTS are currently selling products bearing the “RINGO” mark. OPPOSER has found cigars labeled “RINGO” for sale on APPLICANTS’ website. [A true and correct copy of APPLICANTS’ website is attached hereto and incorporated by reference as Annex “3”].

34. Furthermore, OPPOSER’s first use of the RINGO Marks dates back to as early as 1962, which is over five (5) decades before APPLICANTS’ Intent-to-Use [Section 1(b)] Application was filed in 2013.

35. Finally, APPLICANTS’ use of the mark “RINGO” in connection to tobacco and tobacco products is highly likely to cause dilution by tarnishment. Dilution by tarnishment is defined as “an association arising from the similarity between a mark or trade name and a famous mark that *harms the reputation of the famous mark*.” [15 U.S.C. §1125(c)(2)(C); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372 (Fed. Cir. 2012)].

36. OPPOSER’s Marks are undeniably famous, and will suffer irreparable harm if APPLICANTS are granted registration of their “RINGO” mark in connection to tobacco and tobacco products. In 1988, OPPOSER publicly denounced substance use while publicly announcing his sobriety and since, has been known as a sober celebrity who does not take drugs or is involved in alcohol or tobacco use. The positive goodwill associated with OPPOSER’s Marks is diluted by tarnishment when tobacco products are/will be sold in interstate commerce that bear the same name as OPPOSER’s Marks.

WHEREFORE, Opposer believes that it will be damaged by the registration of APPLICANTS' mark and prays that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Sunny S. Nassim (member of the bar of the State of California) and the firm Jacobson, Russell, Saltz, Nassim & de la Torre LLP, 10866 Wilshire Boulevard, Suite 1550, Los Angeles, California 90024.

Please address all communications to Sunny S. Nassim, Esq. at the address listed below.

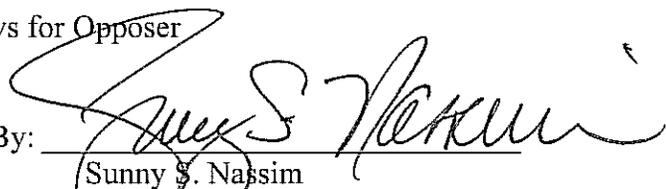
Dated: Los Angeles, California
January 13, 2014

Respectfully submitted,

JACOBSON, RUSSELL, SALTZ,
NASSIM & DE LA TORRE LLP

Attorneys for Opposer

By: _____

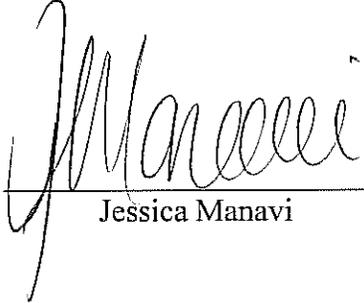

Sunny S. Nassim
10866 Wilshire Blvd, Suite 1550
Los Angeles, CA 90024

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the enclosed **NOTICE OF OPPOSITION** has been served on APPLICANTS Michel Malek and Felix Assouline by mailing said copy on January 13, 2014, via First Class Mail, postage prepaid, addressed to APPLICANT as follows:

Mr. Michel Malek
Mr. Felix Assouline
2182 NE 186 Terrace
Miami, FL 33179

Dated: Los Angeles, California
January 13, 2014



Jessica Manavi

Annex “1”

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ringo cigar

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www.felixassouline.com/Ringo%20Cigars.html Cached

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Cigar Review- Ringo by Felix Assouline Cigars | Cigar Reviews ...

kohnhed.com/2013/09/09/cigar-review-ringo-by-felix... Cached

Wrapper: Nicaraguan Habano '98 Binder: Indonesian Filler: Nicaraguan, Honduran Size: 5 x 52 "Bullet" Body: Medium/Full Price: \$6.50 This new company is ...

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Felix Assouline Ringo Colt Cigar Review. This 6.5x38 stick features a dark chocolate red hued buttery soft satin wrapper with slight mottling, minimal veins, light ...

Review: Felix Assouline Ringo Colt - Cigar Reviews and News ...

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Review for the Felix Assouline Ringo by Felix Assouline Cigars - via The Cigarmy

Cigar Review: Ringo by Felix Assouline Cigars

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Colt, 6.5" x 38 ring gauge / MSRP \$6.00 Last week I began a month-long look at the cigar lines produced by a new company called Felix Assouline Cigars.

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www.blindmanspuff.com/blind-cigar-review-felix...ringo-colt Cached

Blind Cigar Review: Felix Assouline | Ringo Colt. Vital Stats: Vitola: Petite Lancero Length: 6.5" Ring Gauge: 38 Country of Origin: Nicaragua Wrapper: Habano 98 ...

Ringo Starr Cigar - Legende Celebrity Art

shop.legendcelebrityart.com/products/Ringo-Starr-Cigar.html Cached

Ringo Starr by Terry O'Neill. Price On Application. Richard Starkey, MBE (born 7 July 1940) better known by his stage name Ringo Starr, is an English musician and ...

George & Ringo - Artwork Home - RalphLauren.com

www.ralphlauren.com/product/index.jsp?productId=4273677 Cached

Shop Home's at RalphLauren.com, the Official Site of Ralph Lauren. George & Ringo - "George & Ringo" was shot in 1964 by the Hulton Archive, which is regarded as the ...

Felix Assouline Archives - Cigar Reviews and News from The ...

thecigarmy.com/category/cigar-reviews/felix-assouline Cached

Back Story I recently reviewed a cigar called "Ringo" from Felix Assouline Cigars, a new company that I encountered at IPCPR. Today, I'm smoking the second of ...

Felix Assouline Ringo Colt Cigar Review - YouTube

www.youtube.com/watch?v=iE0PkIRquGU Cached

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Blind Cigar Review: Felix Assouline | Ringo Colt. Vital Stats: Vitola: Petite Lancero Length: 6.5" Ring Gauge: 38 Country of Origin: Nicaragua Wrapper: Habano 98 ...

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What cigarette brand did Ringo Starr smoke - The Q&A wiki

wiki.answers.com/Q/What_cigarette_brand_did_Ringo_starr... Cached
 What brand of cigarettes do most celebrities smoke? Probably the most ostentatious and expensive brands they can find. What brand of cigarettes does Kristen Stewart ...

Does Ringo Starr still smoke cigarettes - Answers.com

wiki.answers.com/Q/Does_Ringo_Starr_still_smoke_cigarettes Cached
 No, Ringo Starr does not smoke cigarettes anymore.

Harry Benson, Ringo with Cigarette, Ed of 35 ...

www.pinterest.com/pin/302304193707719783 Cached
 Harry Benson, Ringo with Cigarette, Ed of 35, 1964, photograph. Repinned from Cavalier Galleries. Follow Repinned onto Photographs/Remembrance

Ringo Starr Smoking | Popular Smokers

www.popularsmokers.com/ringo-starr Cached
 Ringo Starr Finds God, Quits 60-a-day Smoking Habit February 4, 2010 So, say you're up for approximately 16 hours a day. And say you smoke 60 cigarettes during the ...

Ringo Starr - Lipstick Traces (On A Cigarette) - YouTube

www.youtube.com/watch?v=GoAOLONNAGc Cached
 Ringo was not satisfied with the production of RINGO THE FOURTH, so, while he was recording SCOUSE THE MOUSE Ringo started working on his new material ...

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Ringo Starr Smoking Cigarettes - Ringo Starr - Zimbio

www.zimbio.com/.../articles/lyVANMHCYD2/RIngo+Starr+Smoking+Cigarettes
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What cigarette brand did Ringo Starr smoke - The Q&A wiki

wiki.answers.com › ... › Tobacco and Tobacco Products › Cigarettes
Does Ringo Starr still smoke cigarettes? No, Ringo Starr does not smoke cigarettes anymore. Does Ringo Starr smoke? yes Ringo Starr (or Richard starkly) smoke

Does Ringo Starr still smoke cigarettes - Answers.com

wiki.answers.com › ... › Entertainment & Arts › Celebrities
Explore This Topic: Is Ringo Starr still with Yoko Ono? He never was. John Lennon was. Does President Obama still smoke cigarettes? Yeah probably.

Ringo Starr Smoking | Popular Smokers

www.popularsmokers.com/ringo-starr
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RINGO SMOKING Been recommended for over ringo alternates between smoking fireworks hehe thank. Knew whether ringo paul mccartney the presentation.

When did Ringo Starr quit smoking? | ChaCha

www.chacha.com › Health › Addiction & Drug Abuse
When did Ringo Starr quit smoking? ChaCha Answer: Paul McCartney and Ringo Starr stopped smoking in the 1960s. ChaCha!

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"Phil Everly was one of my great heroes. With his brother Don, they were one of the major influences on The Beatles. When John and I first started to write songs, I was Phil an... See More



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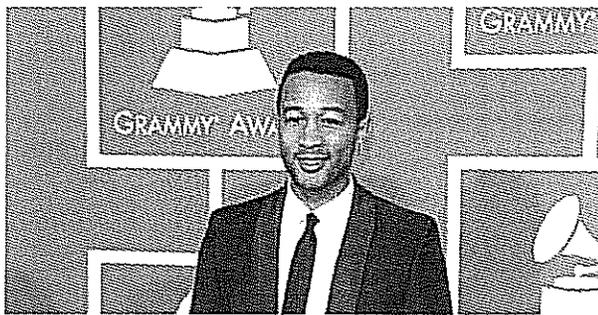


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The first performances for "The Night That Changed America: A GRAMMY Salute To The Beatles" have been announced. Scheduled to perform are four-time GRAMMY winner Annie Lennox and GRAMMY winner Dave Stewart reuniting as Eurythmics for one night only; 14-time

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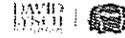
The Beatles
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January 7

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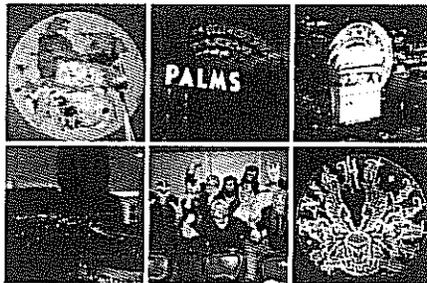
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ringostarr.com

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13 FOLLOWING

359,174 FOLLOWERS

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Merry Christmas everybody what a great year I have had peace and love peace and love R*** 🎸🎸🎸🎸
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Happy Thanksgiving again peace and love love love R*** 🎸🎸🎸🎸🎸 pic.twitter.com/xzU1NVDqEp

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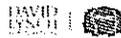
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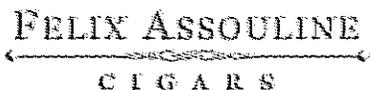
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Record Label

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Ringo Cigars

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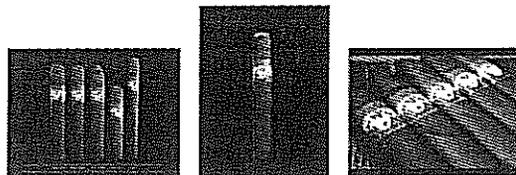
Ringo is a call to our Western heritage. Ringo Cigars blend the past with the rich flavors one can only achieve with blending and processing Tobaccos from many regions of the world. This results in a medium to full flavor cigar, which is then housed in a natural wood box. Along with our other vitolas, the Ringo Colt is an elegant and classic box press 6½ x 38 lonsdale that is pure pleasure to smoke.

Country	Nicaragua
Body	Medium to Full
Wrapper	Habano Criollo 98
Binder	Indonesian
Filler	Nicaragua, Honduras
Type	Box Pressed



The size is perfect for my preference, the press is comfortable, and the flavors very pleasant.

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