

ESTTA Tracking number: **ESTTA718818**

Filing date: **01/06/2016**

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 | Tu Estilo Tobacco Limited Liability Comp |
| Granted to Date of previous extension | 01/06/2016 |
| Address | 838 Main Avenue Passaic, NJ 07055 UNITED STATES |
| Party who filed Extension of time to oppose | Ruben De La Cruz |
| Relationship to party who filed Extension of time to oppose | Opposer is the assignee of U.S. Appl. Ser. No. 86/639,310 for MORIR SOÑ#ANDO in cl. 34 from the prior owner, Ruben de la Cruz, who filed the Extension of Time to Oppose in this matter. As a result, Opposer may file this Notice of Opposition as it is in privity with the party granted the previous extension, pursuant to Section 206.02 of the TBMP. |

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|----------------------|--|
| Attorney information | Robert J. deBrauwere, Esq. Pryor Cashman LLP 7 Times Square New York, NY 10036 UNITED STATES mhuq@pryorcashman.com, tmdocketing@pryorcashman.com, jalbrink@pryorcashman.com Phone:212 421 4100 |
|----------------------|--|

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86601654 | Publication date | 09/08/2015 |
| Opposition Filing Date | 01/06/2016 | Opposition Period Ends | 01/06/2016 |
| Applicants | Isalguez, Ana No. 2 Weehawken, NJ 07086 UNITED STATES Isalguez, Catherine No. 2 Weehawken, NJ 07086 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cream liqueurs; Distilled Spirits; Liqueurs; Liquor; Liquor and liqueur beverages, namely, an orange and cream based drink |
|---|

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Mark Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|---|-----------------------|------------|
| U.S. Application No. | 86639310 | Application Date | 05/22/2015 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | MORIR SOÑ#ANDO | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 034. First use: First Use: 2015/04/10 First Use In Commerce: 2015/04/10 Flavored tobacco; Hookah tobacco; Tobacco | | |

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|-------------|--|
| Attachments | 86639310#TMSN.png(bytes) 21137-00001(2016-01-06 18-43-28).pdf(81259 bytes) |
|-------------|--|

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 | /mhuq/ |
| Name | Muzamil Huq |
| Date | 01/06/2016 |

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

In the Matter of Trademark Application Serial No. 86/601,654
 Mark: MORIR SOÑANDO
 Filed: January 6, 2016

| | | |
|-----------------------------|---|-----------------------------|
| -----X | | |
| TU ESTILO TOBACCO | : | |
| LIMITED LIABILITY COMPANY, | : | |
| | : | |
| Opposer, | : | Opposition No. |
| | : | |
| -against- | : | |
| | : | |
| | : | <u>NOTICE OF OPPOSITION</u> |
| Ana and Catherine Isalguez, | : | |
| | : | |
| Applicant. | : | |
| -----X | | |

Opposer Tu Estilo Tobacco Limited Liability Company (“Opposer”), a New Jersey limited liability company, with an address at 838 Main Ave., Passaic, New Jersey 07055, believes that it will be damaged by registration of the mark shown in Application Serial No. 86/601,654 and hereby opposes the same. The grounds for Opposition are as follows:

1. Opposer is a company that provides high quality tobacco flavors.
2. Opposer has continuously used the mark MORIR SOÑANDO (“Opposer’s Mark”) in connection with tobacco products in interstate commerce since at least as early as April 10, 2015.
3. Opposer is the owner of the U.S. Appl. Ser. No. 86/639,310 for Opposer’s Mark covering “Flavored tobacco; Hookah tobacco; Tobacco” in International Class 34 (the “Application”). Opposer is the assignee of the Application from the prior owner, Ruben de la Cruz, who filed the Extension of Time to Oppose in this matter. As a result, Opposer may file

this Notice of Opposition as it is in privity with the party granted the previous extension, pursuant to Section 206.02 of the TBMP.

4. A copy of the TSDR printout for the Application is attached hereto as Exhibit A. Opposer hereby gives notice in accordance with Trademark Rules of Practice 2.122(d)(2) that it will rely upon this application as evidence in this proceeding, and a status copy showing present title will be introduced into evidence on Opposer's behalf during Opposer's testimony period.

5. Furthermore, Opposer owns common law rights in and to Opposer's Mark for use in connection with tobacco products through Opposer's use of the mark in United States commerce since at least as early as April 10, 2015.

6. Opposer has spent substantial time, effort and money promoting Opposer's goods under Opposer's Mark. As a result, Opposer's Mark has become well-known by the general public and in the relevant industries, are recognized and relied upon as identifying Opposer's goods and as distinguishing them from the goods and services of others, and have come to represent and symbolize extremely valuable goodwill belonging exclusively to Opposer.

7. Upon information and belief, Applicant Ana and Catherine Isalguez ("Applicant") are U.S. citizens with an address at 17-50th Street, No. 2, Weehawken, New Jersey. Upon information and belief, on April 17, 2015, Applicant filed an intent-to-use application for the mark MORIR SOÑANDO covering "Cream liqueurs; Distilled Spirits; Liqueurs; Liquor; Liquor and liqueur beverages, namely, an orange and cream based drink" in International Class 33 ("Applicant's Mark").

8. Opposer has continuously and exclusively used Opposer's Mark in connection with its goods prior to the date on which Applicant filed its intent-to-use application on April 17, 2015. As such, Opposer has priority.

9. Applicant's MORIR SOÑANDO mark is identical to Opposer's MORIR SOÑANDO mark in sight, sound, meaning and commercial impression.

10. Applicant's Mark is intended to be used in connection with related goods with which Opposer uses its MORIR SOÑANDO mark.

11. Neither Applicant's application nor the Application are limited with respect to channels of trade, therefore, the parties' goods will presumably travel through the same channels of trade.

12. Upon information and belief, Opposer and Applicant will market and promote their respective goods to the general consuming public without regard to sophistication.

13. Applicant's use of the MORIR SOÑANDO mark is likely to cause confusion, mistake or deception with consequent injury to Opposer and the public. Such use and registration of the MORIR SOÑANDO mark is likely to cause consumers to mistakenly believe that Applicant's goods emanate from Opposer or that Applicant is in some way associated with or connected to Opposer, when, in fact, no such relationship exists.

14. If Applicant is granted registration for the MORIR SOÑANDO mark, it would obtain, thereby, at least a prima facie exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer.

15. Registration should be refused pursuant to Section 2(d) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(d), on the grounds that Applicant's MORIR SOÑANDO

mark so resembles Opposer's MORIR SOÑANDO mark as to cause confusion, mistake and/or deception, all to the damage of Opposer.

16. Applicant's MORIR SOÑANDO mark and Opposer's MORIR SOÑANDO mark are sufficiently similar, and therefore, Applicant's Mark impairs and is likely to impair the distinctiveness of Opposer's Mark.

WHEREFORE, Opposer, by its undersigned attorneys, requests that its opposition to Application Serial No. 86/601,654 be sustained and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds necessary and just in the circumstances.

Opposer appoints as its attorneys in these proceedings Robert J. deBrauwere and Muzamil A. Huq of the firm Pryor Cashman LLP, 7 Times Square, New York, New York 10036, to whom all correspondence in this proceeding should be addressed. Please charge Deposit Account No. 500932 for the filing fee for this Notice of Opposition and for any other fees that may be due.

Dated: January 6, 2016

Respectfully submitted,

PRYOR CASHMAN LLP

By: /mhuq/
Robert J. deBrauwere
Muzamil A. Huq
7 Times Square
New York, New York 10036
(212) 421-4100

*Attorneys for Opposer Tu Estilo Tobacco
Limited Liability Company*

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's NOTICE OF OPPOSITION and corresponding Exhibit A was served on Applicant's counsel by First Class Mail, postage prepaid, on January 6, 2016 as follows:

Elizabeth Oliner, Esq.
Oliner Law
345 Grove St Fl 2
San Francisco, CA 94102-4462

/mhuq/
Muzamil A. Huq

EXHIBIT A

Generated on:

This page was generated by TSDR on 2016-01-06 18:39:50 EST

Mark: MORIR SOÑANDO

Morir Soñando

US Serial Number: 86639310

Application Filing Date:

May 22, 2015

Filed as TEAS Plus: Yes

Currently TEAS Plus:

Yes

Register:

Principal

Mark Type:

Trademark

Status:

An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date:

Sep. 05, 2015

Mark Information

Mark Literal Elements:

MORIR SOÑANDO

Standard Character Claim:

Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type:

4 - STANDARD CHARACTER MARK

Translation:

The English translation of Morir Soñando in the mark is Die Dreaming.

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For:

Flavored tobacco; Hookah tobacco; Tobacco

International Class(es): 034 - Primary Class

U.S Class(es):

002, 008, 009, 017

Class Status:

ACTIVE

Basis:

1(a)

First Use: Apr. 10, 2015

Use in Commerce:

Apr. 10, 2015

Basis Information (Case Level)

| | | |
|--------------------|------------------------|-----------------|
| Filed Use: Yes | Currently Use: Yes | Amended Use: No |
| Filed ITU: No | Currently ITU: No | Amended ITU: No |
| Filed 44D: No | Currently 44D: No | Amended 44D: No |
| Filed 44E: No | Currently 44E: No | Amended 44E: No |
| Filed 66A: No | Currently 66A: No | |
| Filed No Basis: No | Currently No Basis: No | |

Current Owner(s) Information

Owner Name:

De La Cruz, Ruben

Owner Address:

41 Sherman Street
Passaic, NEW JERSEY 07055
UNITED STATES

Legal Entity Type: INDIVIDUAL

Citizenship:

UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Alan Feldstein

Attorney Primary Email Address: trademarks@cmgesq.com

Attorney Email Authorized:

Yes

Correspondent

Correspondent Name/Address:

ALAN FELDSTEIN
Collins McDonald & Gann Pc
138 Mineola Blvd
Mineola, NEW YORK 11501-3918
UNITED STATES

Phone: (516) 294-0300

Fax:

(516) 294-0477

Correspondent e-mail: trademarks@cmgesq.com

Correspondent e-mail Authorized:

Yes

Domestic Representative - Not Found

Prosecution History

| Date | Description | Proceeding Number |
|---------------|--|-------------------|
| Sep. 05, 2015 | NOTIFICATION OF LETTER OF SUSPENSION E-MAILED | 6332 |
| Sep. 05, 2015 | LETTER OF SUSPENSION E-MAILED | 6332 |
| Sep. 05, 2015 | SUSPENSION LETTER WRITTEN | 73370 |
| Sep. 03, 2015 | ASSIGNED TO EXAMINER | 73370 |
| May 30, 2015 | NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM | |
| May 26, 2015 | NEW APPLICATION ENTERED IN TRAM | |

TM Staff and Location Information

TM Staff Information

TM Attorney: BENMAMAN, ALICE MEDINA

Law Office Assigned:

LAW OFFICE 116

File Location

Current Location: TMO LAW OFFICE 116 - EXAMINING
ATTORNEY ASSIGNED

Date in Location:

Sep. 05, 2015

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Applicant:

De La Cruz, Ruben

Assignment 1 of 1

Conveyance:

ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 5691/0574

Pages:

Date Recorded: Dec. 16, 2015

Supporting Documents:

No Supporting Documents Available

Name: DE LA CRUZ, RUBEN

Assignor

Execution Date:

Dec. 02, 2015

Legal Entity Type: INDIVIDUAL

Citizenship:

UNITED STATES

Assignee

Name:

TU ESTILO TOBACCO LIMITED LIABILITY COMPANY

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized:

NEW JERSEY

Address:

838 MAIN AVE.
PASSAIC, NEW JERSEY 07055

Correspondent

Correspondent Name:

MUZAMIL A. HUQ

Correspondent Address:

C/O PRYOR CASHMAN LLP, 7 TIMES SQUARE
NEW YORK, NY 10036

Domestic Representative - Not Found