

TYAR

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



BOLLORÉ,

11-27-2001

Opposer

U.S. Patent & TMO/TM Mail Rpt Dt. #66 Serial No. 76/042,035

v.

)  
)  
)  
)  
)  
)

Opposition No. 124,073  
Mark: ZIGARETTES

THE HAVANA GROUP, INC.,

Applicant.

ANSWER TO NOTICE OF OPPOSITION

Now comes Applicant, The Havana Group, Inc., by its attorneys, hereby answers the allegations set forth in the Notice of Opposition as follows:

1. Opposer is a French Corporation with a place of business at Odet 29500 Ergue Gaberic, Commune D'Ergue Gaberic, France.

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and, therefore, denies said allegations.

2. For a hundred years, long before applicant's filing date, Opposer and its predecessors have continuously and extensively used the mark ZIG ZAG® in connection with a wide variety of smoking products, including cigarette paper, cigarette tubes, tobacco injector machines, cigarette tubes, cigarette filter tips and cigarette lighters.

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and, therefore, denies said allegations.

3. Opposer has exercised great care and diligence in the conduct of its business activities in connection with the ZIG ZAG® mark.

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 3 of the Notice of Opposition and, therefore, denies said allegations.

T.A.

4. The long, extensive and continuous use of the ZIG ZAG® mark by Opposer and the extensive advertising, promotion and commercial success of products sold under the ZIG ZAG® mark have caused the mark to achieve enormous secondary meaning in the minds of the public. Opposer's ZIG ZAG® mark has achieved nation-wide recognition as identifying goods originating exclusively from Opposer, has achieved outstanding commercial success, and constitutes a famous trademark entitled to the broadest scope of protection, including protection against dilution within the meaning of 15 U.S.C. §1125(c).

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition and, therefore, denies said allegations.

5. The long, extensive and continuous nationwide use of the ZIG ZAG® mark by Opposer, and the extensive advertising, promotion and commercial success of products sold under the ZIG ZAG® mark, have caused the mark to become famous within the meaning of 15 U.S.C. §1125(c).

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 5 of the Notice of Opposition and, therefore, denies said allegations.

6. The ZIG ZAG® mark is the subject of various United States Trademark Registrations, all of which are owned by Opposer and all of which are valid and subsisting. Specifically, Opposer is the owner of the following federal trademark registrations: U.S. Registration No. 610,530 for the mark ZIG ZAG (stylized), registered August 16, 1955, which has obtained incontestable status; U.S. Registration No. 1,127,946 for the mark ZIG ZAG, registered December 18, 1979, which has obtained incontestable status; U.S. Registration No. 2,309,274 for the mark ZIG ZAG, registered January 18, 2000; and U.S. Registration No. 2,309,438 for the mark ZIG ZAG, registered January 18, 2000.

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 6 of the Notice of Opposition and, therefore, denies said allegations.

7. Applicant filed the instant application for the mark ZIGARETTES for "cigarette

,making machines for packing cigarette tobacco into cigarette tubes” and also for “cigarette tubes” on May 5, 2000 on a use basis. Applicant’s proposed mark ZIGARETTES was published in the Official Gazette on August 7, 2001. Opposer has timely filed requests for extension of time to file a notice of opposition, up through and including November 4, 2001.

ANSWER: Applicant admits that the goods description of its Application Serial No. 76/042,035 recites “cigarette making machines for packing cigarette tobacco into cigarette tubes, cigarette tobacco, cigarette tubes in International Class 34,” that Application Serial No. 76/042,035 was filed on May 5, 2000 as a use-based application for registration, and that the ZIGARETTES trademark was published in the Trademark Office Official Gazette on August 7, 2001. Applicant has insufficient knowledge or information as to the truth of the remaining allegations set forth in Paragraph 7 of the Notice of Opposition and, therefore, denies said allegations.

8. Well before Applicant’s alleged date of first use in its application, Opposer adopted and commenced commercial use of its ZIG ZAG® mark.

ANSWER: Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 8 of the Notice of Opposition and, therefore, denies said allegations.

9. Applicant’s proposed mark ZIGARETTES closely resembles Opposer’s ZIG ZAG® mark.

ANSWER: Applicant denies the allegations set forth in Paragraph 9 of the Notice of Opposition.

10. Due to the close similarity of the two marks, the virtually identical nature of the goods, and the enormous consumer recognition and goodwill associated with Opposer’s ZIG ZAG® mark, concurrent use of the mark ZIGARETTES by Applicant and the ZIG ZAG® mark by Opposer would likely result in consumer confusion as to source, sponsorship, approval, or affiliation within the meaning of 15 U.S.C. §§1114 and 1125(a), and as such, Opposer is likely to be damaged by the registration of Applicant’s proposed mark within the meaning of 15 U.S.C. §1063(a).

ANSWER: Applicant denies the allegations set forth in Paragraph 10 of the Notice of

Opposition.

11. Use and registration of the mark ZIGARETTES by Applicant will dilute the distinctive quality of Opposer's famous ZIG ZAG® mark within the meaning of 15 U.S.C. §1125(c). As such, Opposer is likely to be damaged by the registration of Applicant's proposed mark within the meaning of 15 U.S.C. §1063(a) (as amended by the Trademark Amendments Act of 1999).

ANSWER: Applicant denies the allegations set forth in Paragraph 11 of the Notice of Opposition.

12. Applicant's proposed mark is unregistrable pursuant to 15 U.S.C. §1052(d), as it so resembles a mark previously used in the United States by another and not abandoned as to be likely to cause confusion, mistake or to deceive.

ANSWER: Applicant denies the allegations set forth in Paragraph 12 of the Notice of Opposition.

#### AFFIRMATIVE DEFENSES

13. There is no likelihood of confusion, mistake or deception because, inter alia, Applicant's mark and pleaded marks of Opposer are not confusingly similar.

14. There is no consumer confusion as to source, sponsorship, approval, or affiliation between Applicant's mark and the pleaded marks of Opposer and, therefore, Opposer will not be damaged by registration of Applicant's mark.

15. Because of Applicant's use of its mark in U.S. commerce, Opposer is barred by laches, acquiescence and estoppel from contesting this Opposition.

WHEREFORE, Applicant prays that the instant opposition (Opposition No. 124,073) be dismissed and its application (Serial No. 76/042,035) for trademark registration be granted.

Respectfully submitted,

THE HAVANA GROUP, INC.

By its attorneys,

Date: 11/27/01



George L. Pinchak (Reg. No. 37,697)

Stephen J. Schultz (Reg. No. 29,108)

William A. Johnston (Reg. No. 47,687)

WATTS, HOFFMANN, FISHER

& HEINKE CO., L.P.A.

1100 Superior Ave., Ste. 1750

Cleveland, Ohio 44114

Telephone: (216) 241-6700

Telecopier: (216) 241-8151

e-mail: [iplaw@wattshoff.com](mailto:iplaw@wattshoff.com)

ATTORNEYS FOR APPLICANT

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing ANSWER TO NOTICE OF OPPOSITION is being served this 27th day of November, 2001, by U.S. Express Mail (Express Mail Label Number **EL860761139US**) in triplicate to the Trademark Trial and Appeal Board and by U.S. first class mail, postage prepaid, on Attorney for Opposer, in separate envelopes addressed as follows:

To Opposer's Attorney:

Jenifer DeWolf Paine, Esq.  
Proskauer Rose LLP  
1585 Broadway  
New York, NY 10036

To the Trademark Trial and Appeal Board:

Box TTAB No Fee  
Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513



George L. Pinchak (Reg. No. 37,697)  
WATTS, HOFFMANN, FISHER  
& HEINKE CO., L.P.A.  
1100 Superior Ave., Ste. 1750  
Cleveland, Ohio 44114  
Telephone: (216) 241-6700  
Facsimile: (216)241-8151  
e-mail: [iplaw@wattshoff.com](mailto:iplaw@wattshoff.com)  
ATTORNEYS FOR APPLICANT