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

Proceeding	91176935
Party	Defendant Premier Manufacturing, Inc. Premier Manufacturing, Inc. 17998 Chesterfield Airport Road Chesterfield, MO 63005
Correspondence Address	MICHAEL A. THORNE SPENCER FANE BRITT & BROWNE LLP 1 N BRENTWOOD BLVD STE 1000 SAINT LOUIS, MO 63105-3925 trademark@spencerfane.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Michael A. Thorne
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Date	06/01/2007
Attachments	Premier Manufacturing Motion.pdf (28 pages)(954377 bytes)

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

TRADEMARK HOLDINGS
CORPORATION, a Florida corporation

Opposer,

Opposition No. 91176935
Mark: WILDHORSE
Serial No. 78/887914
Published: 12/26/2006

PREMIER MANUFACTURING, INC., a
Missouri corporation

Applicant.

UNOPPOSED MOTION TO SUSPEND PROCEEDINGS, OR, IN THE ALTERNATIVE, FOR AN ENLARGEMENT OF TIME IN WHICH TO RESPOND TO OPPOSER'S NOTICE OF OPPOSITION

Pursuant to 37 C.F.R. §§ 2.117 and 2.120 and T.B.M.P. §§ 509 and 510, Applicant, Premier Manufacturing, Inc. ("Premier") moves to suspend this Opposition No. 91176935 (the "Opposition") pending resolution of the Opposer, Trademark Holdings Corporation's ("THC"), Verified Complaint (attached hereto as Exhibit "A") filed in the United States District Court for the Western District of Kentucky styled Trademark Holdings Corporation v. Premier Manufacturing, Inc., Case No.: 07-125-s, dated March 7, 2007 (the "Federal Court Action"), or, in the alternative, for an Order enlarging the time in which to respond to THC's complaint until August 15, 2007, and as grounds in support states:

The Board's rules dictate that this proceeding should be suspended pending resolution of the Federal Court Action. The Federal Court Action involves the same mark and causes of action that are the subject of the Opposition. As such, the outcome of the Federal Court Action will have a direct bearing on the parties' rights to the trademark and trade dress at issue, if not be

completely dispositive of the issues in the Opposition. Accordingly, the Board should suspend the Opposition pending the outcome of the Federal Court Action.

In the alternative, Applicant requests entry of an order enlarging the time in which to respond to THC's complaint until August 15, 2007, subsequent to the disposition of THC's Motion for a Preliminary Injunction in the Federal Court Action. Premier's request for an enlargement of time in which to respond to THC's complaint is not necessitated by a lack of diligence or unreasonable delay.

BACKGROUND

Applicant Premier applied to register the trademark "WILDHORSE" for use in connection with its Wildhorse brand cigarettes. Premier's application for WILDHORSE was assigned Serial No.: 78/887914. THC is the owner of the trademark "BRONCO", Serial No.: 75/846595 and for the trade dress Registration No.: 2,736,034 for use in connection with its Bronco and Silver brand cigarettes.

THC filed the Verified Complaint against Premier in the Federal Court Action, seeking to recover damages and to obtain injunctive relief under the trademark laws of the United States, 15 U.S.C. §§ 1051 *et seq.*, and under state common law for alleged trademark and trade dress infringement, unfair competition and false designation of origin with respect to Premier's Wildhorse trademark and trade dress. Premier adamantly denies all allegations.

LEGAL ARGUMENT

Pursuant to T.B.M.P. § 510.02(a), the Board may suspend a proceeding whenever it comes to the Board's attention that the parties are "involved in a civil action which may be dispositive of the Board's case." Indeed, it has long been the practice of the Board to suspend the opposition or cancellation proceeding "pending the outcome of [a] court action . . . between

the same parties involving related issues." *See, e.g., General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q. 2d 1933 (TTAB 1992); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 686 (C.C.P.A. 1961).

The outcome of the Federal Court Action will have a direct bearing on the parties' rights to the trademark and trade dress at issue, if not be completely dispositive of the matter. A comparison of the Verified Complaint to the Notice of Opposition demonstrates that the Federal Court Action and the Opposition involve the same parties, marks and issues. *See Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (granting motion to suspend because civil action seeking to enjoin applicant from using mark that was subject of opposition would have a "direct bearing on the question of the rights of the parties . . . and may in fact completely resolve all of the issues" before the Board).

Alternatively, Applicant requests an enlargement of time up to and until August 15, 2007 to respond to the complaint. Opposer will not be prejudiced in any way by the granting of Applicant's requested enlargement of time. Applicant will be significantly prejudiced, however, if it is forced to defend the WILDHORSE trademark in two separate proceedings simultaneously.

Applicant's counsel has conferred with counsel for the Opposer. Mr. Mark E. Stein, Opposer's attorney of record in this case, stated that Opposer agrees to Applicant's request to suspend the Opposition pending the outcome of the Federal Court Action.

CONCLUSION

For the foregoing reasons, Premier requests that the Board enter an Order suspending the Opposition pending the disposition of the Federal Court Action between Premier and THC, or alternatively, requests that the Board enter an Order enlarging the time in which to serve its response to THC's Notice of Opposition until August 15, 2007.

Submitted June 1, 2007:

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was furnished via facsimile and U.S. Mail on June 1, 2007 to:

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APPLICANT'S ATTORNEY

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF KENTUCKY
AT LOUISVILLE

TRADEMARK HOLDINGS CORPORATION, Plaintiff, v. **PREMIER MANUFACTURING, INC.**, and **PREMIER INTERNATIONAL HOLDINGS, INC.** Defendants.	Case No.: _3:07cv-125-S_ **VERIFIED COMPLAINT** Electronically Filed

Plaintiff, TRADEMARK HOLDINGS CORPORATION ("Plaintiff" or "Trademark Holdings"), through counsel and for its Complaint against Defendants, PREMIER MANUFACTURING, INC. ("Premier Manufacturing") and PREMIER INTERNATIONAL HOLDINGS, INC. ("Premier International Holdings") (collectively "Defendants"), states as follows:

NATURE OF THE ACTION

1. This is an action to recover damages and to obtain injunctive relief under the trademark laws of the United States, 15 U.S.C. §§ 1051, *et. seq.*, and under state common law for trademark and trade dress infringement, unfair competition and false designation of origin.

JURISDICTION AND VENUE

2. This Court has exclusive original jurisdiction over this action pursuant to 15 U.S.C. § 1121, 28 U.S.C. § 1338 (a) and (b), and 28 U.S.C. § 1331 and 1332.

3. This Court has supplemental jurisdiction over this action pursuant to 28 U.S.C. § 1367(a) with respect to claims under state law, because such claims are so related to other claims over which this Court has exclusive original jurisdiction that they form part of the same case or controversy under Article III of the United States Constitution.

4. This Court maintains personal jurisdiction over Defendants because they sell products bearing the infringing trademark and trade dress in Kentucky.

5. Venue is proper in the Western District of Kentucky pursuant to 28 U.S.C. § 1391 and L.R. 3.2, because Defendants sell the infringing products in the Western District of Kentucky, in Louisville, Kentucky.

THE PARTIES

6. Plaintiff, Trademark Holdings, is a corporation duly organized and existing under the laws of the State of Florida and has its principal place of business at 2980 N.W. 108th Avenue, Miami, Florida 33172.

7. Upon information and belief, Defendant Premier Manufacturing is a corporation duly organized and existing under the laws of the State of Missouri and has its principal place of business at 17988 Chesterfield Airport Road, Chesterfield, Missouri 63005.

8. Upon information and belief, Defendant Premier International Holdings is a corporation duly organized and existing under the laws of the State of Missouri and has its principal place of business at 17988 Chesterfield Airport Road, Chesterfield, Missouri 63005.

FACTUAL BACKGROUND

9. Trademark Holdings is a Miami-based company that, itself and through its licensee Vibo Corporation d/b/a General Tobacco, manufactures, markets, sells and distributes several well-known brands of cigarettes, all of which are sold at deeply-discounted prices.

10. Trademark Holdings is the owner of the federal trademark registration for the **Horse Design**, Registration No. 2,736,034, in respect of "cigarettes" in International Class 34. The **Horse Design** is depicted below:

A true and correct copy of the federal registration information from the United States Patent and Trademark Office ("USPTO") TESS electronic database for the **Horse Design** is attached hereto as Exhibit A and incorporated herein by reference.

11. Trademark Holdings has continuously used the **Horse Design** in commerce since as early as January, 2000 and has continuously used this trademark as a central feature of the packaging of its **BRONCO** brand of cigarettes since as early as June, 2000.

12. **The Horse Design** is famous within the meaning of the Lanham Act, and has been famous in the United States since well before Defendants' use of the **Single Wildhorse Trade Dress,** described hereafter.

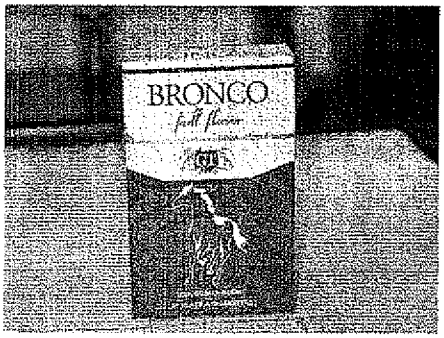
13. The **Horse Design** includes a realistic outline of a horse that is moving in a gallop, trot or a canter. The horse's front, left leg is bent and the horse appears to be

looking to its right side. The horse's mane and tail are shaded more darkly than the rest of the image.

14. Trademark Holdings, itself or through its licensee, began to promote, advertise, market, offer to sell and sell its **BRONCO** Brand of cigarettes as early as June 2000.

15. Trademark Holdings owns a federal trademark for the BRONCO word mark, Serial No. 75/846595, in respect of "cigarettes" in International Class 34. A true and correct copy of the information from the USPTO TESS electronic database for the **BRONCO** word mark is attached hereto as Exhibit B

16. Since that time, **BRONCO** cigarettes have always been promoted, advertised, marketed, offered for sale and sold in the same packaging. The packaging for full flavor **BRONCO** cigarettes is depicted below:



17. Trademark Holdings also owns a federal trademark application for the **Bronco Trade Dress**, Serial No. 78/411,187, in respect of "cigarettes" in International Class 34. A true and correct copy of the information from the USPTO TESS electronic database for the **Bronco Trade Dress** is attached hereto as Exhibit C.

18. The **Bronco Trade Dress** includes the following features: the **Horse Design**, which is prominently featured on the lower half of all packages of **BRONCO**

mane, eyes, nose and front hooves. The image of the horse's head, front legs and hooves appears on the bottom half of the cigarette package, and it is portrayed behind the word **SILVER**.

23. Trademark Holdings has continuously used the **Silver Trade Dress** in commerce since at least as early as June, 2002.

24. All of the trademark registrations identified above are valid. Each trademark identified above is owned by Trademark Holdings.

25. Trademark Holdings has built up valuable goodwill in **Horse Design, Bronco Trade Dress, BRONCO** word mark and **Silver Trade Dress** (hereinafter collectively the "**Horse Trademarks and Trade Dress**").

26. The public readily associates the **Horse Trademarks and Trade Dress** with the cigarettes manufactured, promoted, advertised, marketed, offered for sale, sold and distributed by Trademark Holdings or its licensee, General Tobacco.

DEFENDANTS' WRONGFUL ACTIONS

27. Upon information and belief, Defendants promote, advertise, market, offer for sale, sell and distribute cigarettes and other tobacco products. Defendants' cigarettes, like those sold by Trademark Holdings and its licensee, are sold at deeply-discounted prices.

28. One of the brands of cigarettes promoted, advertised, marketed, offered for sale, sold and distributed by Defendants is the **WILDHORSE** brand. The **WILDHORSE** brand is marketed and sold in numerous places around the country, including Louisville, Kentucky.

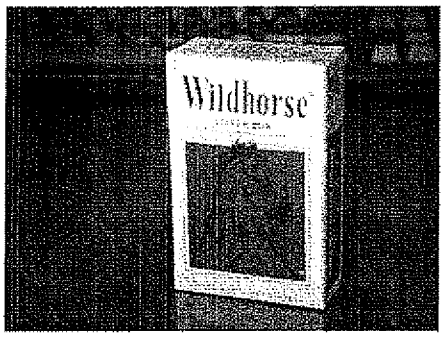
29. Upon information and belief, Defendants, through themselves or their predecessor-in-interest, began to sell or offer for sale the **WILDHORSE** brand of cigarettes after Trademark Holdings, itself or through its licensee, began to sell the **BRONCO** and **SILVER** brands of cigarettes.

30. Since approximately November, 2002, Defendants, through themselves or their predecessor-in-interest promoted, advertised, marketed, offered for sale, sold and distributed the **WILDHORSE** brand of cigarettes using the **Three Wildhorse Trade Dress** that is depicted below.

31. The **Three Horse Trade Dress** included the following elements: a small, rectangular-shaped image in the center of a cigarette package; a whimsical, stick figure like drawing of a sun and mountain range at the top of the package; three small horses, each depicted in a different color (pink, red and black) and pointed to the left of the carton, galloping in a row, on the lower half of the rectangle; eight (8) tiny stars in a horizontal line underneath the three horses.

32. Recently, Defendants, through themselves or their predecessor-in-interest, have abandoned the **Three Horse Trade Dress** used on its **WILDHORSE** Brand. More specifically, during the latter part of 2006, Defendants began marketing and selling its **WILDHORSE** brand with a new **Single Wildhorse Trade Dress** on its cigarette

packages which is confusingly similar to Trademark Holdings' **BRONCO** and **SILVER** cigarettes. The **Single Wildhorse Trade Dress** as depicted on the full flavor product is depicted below:



33. The **Single Wildhorse Trade Dress** prominently features the image of one horse that is jumping or rearing with its front hooves lifted partially off of the ground. The horse is looking to its left side, and the horse's mane and tail are shaded more darkly than the rest of the image. A true and correct copy of the **Single Wildhorse Trade Dress** is attached hereto as Exhibit E and incorporated herein by reference.

34. Defendants are currently promoting, advertising, marketing, offering for sale and selling Wildhorse cigarettes with the **Single Wildhorse Trade Dress** appearing on cigarette packages and promotional materials. Defendants are promoting, advertising, marketing and offering for sale cigarettes with the **Single Wildhorse Trade Dress** in the same markets and channels for good as the cigarettes sold by Plaintiff or its licensee.

35. Defendant Premier Manufacturing filed a federal trademark application to register the **Single Wildhorse Trade Dress**: application Serial No. 77/029,656, in respect of "cigarettes" in International Class 34, filed on October 26, 2006. A true and correct copy of information from the USPTO TESS electronic database for the **Single Wildhorse Trade Dress** is attached hereto as Exhibit F.

36. Upon information and belief, Defendants have intentionally, willfully and with full knowledge of Trademark Holdings' **BRONCO** and **SILVER** cigarette brands and Trademark Holding's rights in and to the **Horse Trademarks and Trade Dress,** advertised, promoted, marketed, offered for sale and sold throughout the United States and within the Western District of Kentucky **WILDHORSE** cigarettes containing the **Single Wildhorse Trade Dress.**

37. Defendants' use of the **Single Wildhorse Trade Dress** to identify its **WILDHORSE** cigarettes has been and continues to be without license or other authorization from Trademark Holdings.

38. Defendants' use of the **Single Wildhorse Trade Dress** to identify its **WILDHORSE** brand of cigarettes is likely to result in confusion, mistake or deception among purchasers and prospective purchasers and indeed has caused such confusion, as to the source or origin of the **WILDHORSE** cigarettes.

39. Defendants' acts are ongoing, have caused, and will continue to cause Trademark Holdings irreparable harm for which there is no remedy at law unless enjoined by this Court.

40. The actions of Defendants were undertaken for the purpose of, and with the intent of, trading upon the goodwill associated with Trademark Holdings' **Horse Trademarks and Trade Dress,** passing off **WILDHORSE** cigarettes as emanating from Trademark Holdings or its licensee, and confusing purchasers and prospective purchasers as to the source or origin of the **WILDHORSE** cigarettes.

COUNT I

TRADEMARK INFRINGEMENT UNDER 15 U.S.C.§ 1114

41. Plaintiff incorporates by reference paragraphs 1 through 40 of the Complaint as though fully set forth herein.

42. Trademark Holdings is the owner of all right, title and interest in the **Horse Design** trademark and incontestable U.S. Registration Number 2,736,034, in and to the **Horse Design** trademark.

43. Prior to adopting the use of the name **WILDHORSE**, Defendants had actual and constructive knowledge of Trademark Holdings' **Horse Design** and intentionally used the name **WILDHORSE** to be confusingly similar to Trademark Holdings' **Horse Design**.

44. Defendants' actions as described above and Defendants' use of the name **WILDHORSE** to identify Defendants' **WILDHORSE** brand of cigarettes constitute trademark infringement of Trademark Holdings' **Horse Design** in violation of Sections 32 of the Lanham Act, 15 U.S.C. § 1114, which imposes liability upon any person who shall, without consent, use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, or the reproduction of any counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

45. Defendants' acts are without license or consent of Trademark Holdings.

46. The aforementioned acts and conduct of Defendants were carried out with the intent and purpose of appropriating and trading upon the goodwill and reputation of Trademark Holdings and the goodwill that Trademark Holdings has developed in the **Horse Design**, and with the intent and purpose of passing off Defendants' cigarettes as Plaintiff's cigarettes.

47. Defendants' use of the name **WILDHORSE,** both in its meaning and design, is likely to cause confusion and has indeed caused confusion, mistake, or deceived persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way with Trademark Holdings and its licensee.

48. By reason of the acts of Defendants herein alleged, Trademark Holdings has suffered damages and, unless Defendants are temporarily and permanently restrained from continuing their wrongful acts, will continue to suffer serious and irreparable harm for which it has no adequate remedy at law.

COUNT II

TRADEMARK INFRINGEMENT UNDER 15 U.S.C. § 1114

49. Trademark Holdings incorporates by reference paragraphs 1 through 48 of the Complaint as through fully set forth herein.

50. Trademark Holdings is the owner of all right, title and interest in the **BRONCO** word mark.

51. Prior to adopting the use of the name **WILDHORSE**, Defendants had actual and constructive knowledge of Trademark Holdings' **BRONCO** word mark and intentionally used the name **WILDHORSE** to be confusingly similar to Trademark Holdings' **BRONCO** word mark.

52. Defendants' actions as described above and Defendants' use of the name **WILDHORSE** to identify Defendants' **WILDHORSE** brand of cigarettes constitute trademark infringement of Trademark Holdings' **BRONCO** word mark in violation of Sections 32 of the Lanham Act, 15 U.S.C. § 1114, which imposes liability upon any person who shall, without consent, use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, or the reproduction of any counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

53. Defendants' acts are without license or consent of Trademark Holdings.

54. The aforementioned acts and conduct of Defendants were carried out with the intent and purpose of appropriating and trading upon the goodwill and reputation of Trademark Holdings and the goodwill that Trademark Holdings has developed in the **BRONCO** word mark, and with the intent and purpose of passing off Defendants' cigarettes as Plaintiff's cigarettes.

55. Defendants' use of the name **WILDHORSE,** both in its meaning and design, is likely to cause confusion and has indeed caused confusion, mistake, or to deceive persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way with Trademark Holdings and its licensee.

56. By reason of the acts of Defendants herein alleged, Trademark Holdings has suffered damages and, unless Defendants are temporarily and permanently restrained from continuing their wrongful acts, will continue to suffer serious and irreparable harm for which it has no adequate remedy at law if Defendants' use of the name **WILDHORSE** is not enjoined.

COUNT III

TRADE DRESS INFRINGEMENT UNDER 15 U.S.C. § 1125(a)

57. Trademark Holdings incorporates by reference paragraphs 1 through 56 of the Complaint as through fully set forth herein.

58. Trademark Holdings has built up valuable goodwill in its **Bronco Trade Dress** and **Silver Trade Dress**.

59. Prior to adopting the use of the name **WILDHORSE**, Defendants had actual and constructive knowledge of Trademark Holdings' **Bronco Trade Dress and Silver Trade Dress** and intentionally used the name **WILDHORSE** to be confusingly similar to Trademark Holdings' **Bronco Trade Dress and Silver Trade Dress.**

60. The use by Defendants of the name **WILDHORSE** to describe their **WILDHORSE** cigarettes, described above, constitutes a violation of 15 U.S.C. § 1125(a), which imposes liability for using in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin that is likely to cause confusion, to cause mistake, or to deceive as to the origin, sponsorship, or approval by its services by another person.

61. Defendants' acts are without license or consent of Trademark Holdings.

62. Defendants' use of the name **WILDHORSE,** both in its meaning and design, is likely to cause confusion and has indeed caused confusion, mistake, or to

deceive persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way with Trademark Holdings and its licensee.

63. Trademark Holdings has been directly damaged by Defendants' violation of U.S.C. § 1125(a) and will suffer irreparable harm if Defendants' use of the name **WILDHORSE** is not enjoined.

COUNT IV

TRADEMARK INFRINGEMENT UNDER 15 U.S.C.§ 1114

64. Plaintiff incorporates by reference paragraphs 1 through 63 of the Complaint as though fully set forth herein.

65. Trademark Holdings is the owner of all right, title and interest in the **Horse Design** trademark and incontestable U.S. Registration Number 2,736,034, in and to the **Horse Design** trademark.

66. Prior to adopting the use of the **Single Wildhorse Trade Dress**, Defendants had actual and constructive knowledge of Trademark Holdings' **Horse Design** and intentionally used the **Single Wildhorse Trade Dress** to be confusingly similar to Trademark Holdings' **Horse Design**.

67. Defendants' actions as described above and Defendants' use of the **Single Wildhorse Trade Dress** to identify Defendants' **WILDHORSE** brand of cigarettes constitute trademark infringement of Trademark Holdings' **Horse Design** in violation of Sections 32 of the Lanham Act, 15 U.S.C. § 1114, which imposes liability upon any person who shall, without consent, use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, or the reproduction of any counterfeit, copy, or colorably imitate a registered mark and apply

such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

68. Defendants' acts are without license or consent of Trademark Holdings.

69. The aforementioned acts and conduct of Defendants were carried out with the intent and purpose of appropriating and trading upon the goodwill and reputation of Trademark Holdings and the goodwill that Trademark Holdings has developed in the **Horse Design**, and with the intent and purpose of passing off Defendants' cigarettes as Plaintiff's cigarettes.

70. Defendants' use of the **Single Wildhorse Trade Dress,** is likely to cause confusion and has indeed caused confusion, mistake, or to deceive persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way with Trademark Holdings and its licensee.

71. By reason of the acts of Defendants herein alleged, Trademark Holdings has suffered and, unless Defendants are temporarily and permanently restrained from continuing their wrongful acts, will continue to suffer serious and irreparable harm for which it has no adequate remedy at law.

COUNT V

TRADEMARK INFRINGEMENT UNDER 15 U.S.C. § 1114

72. Trademark Holdings incorporates by reference paragraphs 1 through 71 of the Complaint as through fully set forth herein.

73. Trademark Holdings is the owner of all right, title and interest in the **BRONCO** word mark.

74. Prior to adopting the use of the **Single Wildhorse Trade Dress**, Defendants had actual and constructive knowledge of Trademark Holdings' **BRONCO** word mark and intentionally used the **Single Wildhorse Trade Dress** to be confusingly similar to Trademark Holdings' **BRONCO** word mark.

75. Defendants' actions as described above and Defendants' use of the **Single Wildhorse Trade Dress** to identify Defendants' **WILDHORSE** brand of cigarettes constitute trademark infringement of Trademark Holdings' **BRONCO** word mark in violation of Sections 32 of the Lanham Act, 15 U.S.C. § 1114, which imposes liability upon any person who shall, without consent, use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, or the reproduction of any counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

76. Defendants' acts are without license or consent of Trademark Holdings.

77. Defendants' use of the **Single Wildhorse Trade Dress** is likely to cause confusion, has indeed caused confusion, to cause mistake, or to deceive persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way with Trademark Holdings and its licensee.

78. Trademark Holdings has been directly damaged by Defendants' violation of U.S.C. § 1114 and will suffer irreparable harm if Defendants' use of the **Single Wildhorse Trade Dress** is not enjoined.

COUNT VI

TRADE DRESS INFRINGEMENT UNDER 15 U.S.C. § 1125(a)

79. Trademark Holdings incorporates by reference paragraphs 1 through 78 of the Complaint as through fully set forth herein.

80. Trademark Holdings has built up valuable goodwill in its **Bronco Trade Dress** and **Silver Trade Dress.**

81. Prior to adopting the use of the **Single Wildhorse Trade Dress,** Defendants had actual and constructive knowledge of Trademark Holdings' **Bronco Trade Dress and Silver Trade Dress** and intentionally used the **Single Wildhorse Trade Dress** to be confusingly similar to Trademark Holdings' **Bronco Trade Dress and Silver Trade Dress.**

82. The use by Defendants of the **Single Wildhorse Trade Dress,** described above, constitutes a violation of 15 U.S.C. § 1125(a), which imposes liability for using in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin that is likely to cause confusion, to cause mistake, or to deceive as to the origin, sponsorship, or approval by its services by another person.

83. Defendants' acts are without license or consent of Trademark Holdings.

84. Defendants' use of the **Single Wildhorse Trade Dress,** is likely to cause confusion and has indeed caused confusion, mistake, or to deceive persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way with Trademark Holdings and its licensee.

85. Trademark Holdings has been directly damaged by Defendants' violation of U.S.C. § 1125(a) and will suffer irreparable harm if Defendants' use of the **Single Wildhorse Trade Dress** is not enjoined.

COUNT VII

FALSE DESIGNATION OF ORIGIN UNDER 15 U.S.C. § 1125(a)

86. Plaintiff incorporates by reference paragraphs 1 through 85 of the Complaint as though fully set forth herein.

87. Trademark Holdings owns valid trademark registrations for the **Horse Design** and the **Silver Trade Dress** and owns a trademark application for the **Bronco Trade Dress.**

88. Defendants' actions as described above and Defendants' creation, adoption and use of the **Single Wildhorse Trade Dress** to identify cigarettes constitutes a false designation of origin in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125.

89. Defendants' use of the **Single Wildhorse Trade Dress** to identify its **WILDHORSE** cigarettes is likely to cause confusion, and has indeed caused confusion, mistake, or deceived persons into the erroneous belief that Defendants' **WILDHORSE** cigarettes are authorized, sponsored by, or connected in some way associated with Trademark Holdings' **Horse Trademarks and Trade Dress.**

90. By reason of the acts of Defendants herein alleged, Trademark Holdings has suffered and, unless Defendants are restrained from continuing their wrongful acts, will continue to suffer serious and irreparable harm for which it has no adequate remedy at law.

COUNT VIII

DILUTION UNDER 15 U.S.C. 1125(c)

91. Plaintiff incorporates by reference paragraphs 1 through 90 of the Complaint as though fully set forth herein.

92. Trademark Holdings is the owner of all right, title and interest in and to the **Horse Design** stylized trademark and incontestable U.S. Registration No. 2,736,034, therefore.

93. The **Horse Design** mark is famous, as that term is used and defined in 15 U.S.C. § 1125(c) (Lanham Act § 43(c)).

94. Defendant has offered for sale and has sold goods bearing the **Single WildHorse Design**.

95. Defendant's use of the **Single Wildhorse Trade Dress** began long after Trademark Holdings' **Horse Design** had become famous.

96. Defendants' commercial use of the **Single Wildhorse Trade Dress** in commerce has caused dilution in violation of 15 U.S.C. § 1125(c).

97. Defendant has willfully intended to trade on Trademark Holdings and its licensee's reputation and to cause dilution of the distinctive quality of the famous **Horse Design.**

98. Trademark Holdings has been directly damaged by Defendants' dilution of the distinctive quality of the **Horse Design** and will continue to be damaged in the future unless Defendants' actions are enjoined.

COUNT IX

COMMON LAW UNFAIR COMPETITION

99. Plaintiff incorporates by reference paragraphs 1 through 98 of the Complaint as though fully set forth herein.

100. Trademark Holdings has built up valuable goodwill in its **BRONCO** word mark and **Horse Trademarks and Trade Dress**.

101. Defendants' **Single Wildhorse Trade Dress** is confusingly similar to Trademark Holdings' **Horse Trademarks and Trade Dress** and is likely to and does permit Defendants to palm off their goods as those of Trademark Holdings, all to the detriment of Trademark Holdings and the unjust enrichment of Defendants.

102. Defendants, with full knowledge of Trademark Holdings' **Horse Trademarks and Trade Dress,** intended to, did and do trade on the goodwill associated with the **Horse Trademarks and Trade Dress** and have misled and will continue to mislead the public into assuming a connection between Trademark Holdings' and Defendants' goods.

103. Defendants are acting in a manner which permits and accomplishes confusion, misleads and deceives the public as to the source of Defendants' goods, permits and accomplishes palming off of Defendants' goods as those of Trademark Holdings and its licensee, and falsely suggests a connection with Trademark Holdings and its licensee, all of which constitute acts of unfair competition in violation of state law.

104. Trademark Holdings has been damaged and will suffer irreparable harm if Defendants' use of the **Single WildHorse Trade Dress** is not enjoined.

COUNT X

REFUSAL OF DEFENDANTS' TRADEMARK APPLICATION

105. Plaintiff incorporates by reference paragraphs 1 through 104 of the Complaint as though fully set forth herein.

106. This is a claim for refusal of registration pursuant to 15 U.S.C. § 1119, which allows the Court to determine the right to registration.

107. Trademark Holdings is the rightful owner of the **Horse Trademarks and Trade Dress** in respect of cigarettes.

108. By virtue of its October, 2006 federal trademark application to register the **Single Wildhorse Trade Dress**, Application Serial No. 77/029,656, Premier Manufacturing, Inc. has asserted allegedly exclusive rights to trade dress which is confusingly similar to Trademark Holdings' **Horse Trademarks and Trade Dress**.

109. If Premier Manufacturing, Inc.'s application achieves registration, Trademark Holdings will be damaged in that Defendants' use of the **Single Wildhorse Trade Dress** to identify cigarettes is likely to cause confusion, to cause mistake, or to deceive consumers as to the affiliation, connection or association of Defendants with Trademark Holdings or approval or sponsorship of such goods by Trademark Holdings.

110. Such damage to Trademark Holdings will continue unless and until federal registration of that application is refused.

PRAYER FOR RELIEF

WHEREFORE, Trademark Holdings requests:

A. That Defendants, their officers, agents, servants, employees, and attorneys, and all those persons in active concert or participation with them be forthwith preliminarily and thereafter permanently enjoined and restrained from:

1. Using the name **WILDHORSE** or any confusingly similar designation as a trademark, trade dress or otherwise, to market, advertise, or identify Defendants' cigarettes or any good substantially similar thereto;

2. Using the **Single Wildhorse Trade Dress** or any confusingly similar designation as a trademark, trade dress or otherwise, to market, advertise, or identify Defendants' cigarettes or any goods substantially similar thereto;

3. Using the packaging of its **WILDHORSE** cigarettes or any confusingly similar designation as a trademark, trade dress or otherwise, to market, advertise, or identify Defendants' cigarettes or any goods substantially similar thereto;

4. Otherwise infringing Trademark Holding's **Horse Trademarks and Trade Dress** or any other trademarks or trade dress owned by Trademark Holdings;

5. Unfairly competing with Trademark Holdings in any manner whatsoever;

6. Causing a dilution of the distinctive quality of the famous **Horse Design**; and

7. Causing likelihood of confusion or injury to business reputation of Trademark Holdings.

B. That Defendants be directed to file with this Court and serve on Trademark Holdings within ten days after the service of the injunction herein, a report in writing under oath, setting forth in detail the manner and form in which Defendants have complied therewith.

C. That Defendants be required to deliver up and destroy all goods, literature, advertising and other material bearing the infringing designation, and to deliver up for destruction all infringing copies and all patterns, dies, molds, and other paraphernalia used for making such infringing goods or copies.

D. That Trademark Holdings be awarded its actual damages, and that such award be trebled pursuant to 15 U.S.C. § 1117(a).

E. That Trademark Holdings be awarded exemplary and punitive damages in an amount to be determined at trial.

F. That Trademark Holdings recover from Defendants its reasonable attorneys' fees and costs in this suit.

G. That U.S. Trademark Application Serial No. 77/029,656 be refused federal registration.

H. That Trademark Holdings be awarded such other and further relief as the Court may deem just.

DEMAND FOR JURY TRIAL

Trademark Holdings demands a trial by jury on all issues so triable by right, pursuant to Fed. R. Civ. P. 38(b).

Dated: March 7, 2007

Respectfully submitted,

s/Christie A. Moore
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