

ESTTA Tracking number: **ESTTA245167**

Filing date: **10/27/2008**

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	North Atlantic Operating Company, Inc.
Granted to Date of previous extension	11/23/2008
Address	3029 West Muhammed Ali Blvd. Louisville, KY 40212 UNITED STATES

Attorney information	Heather L. Jensen Cowan, Liebowitz and Latman 1133 Avenue of the Americas New York, NY 10036 UNITED STATES trademark@cll.com, asc@cll.com, hlj@cll.com Phone:212-790-9200
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Applicant Information

Application No	77316130	Publication date	05/27/2008
Opposition Filing Date	10/27/2008	Opposition Period Ends	11/23/2008
Applicant	NEW IMAGE GLOBAL, INC. 1672 RAILROAD STREET CORONA, CA 92882 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: SMOKING ARTICLES, NAMELY, TOBACCO, TOBACCO LEAVES, FLAVORED TOBACCO LEAVES IN THE FORM OF A SHEET, CHEWING TOBACCO, AND TOBACCO PIPES
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Grounds for Opposition

Other	Please see attached pleadings.
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Attachments	THE PAPER Notice of Opposition.pdf (7 pages)(20576 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	/Heather L. Jensen/
Name	Heather L. Jensen
Date	10/27/2008

2. Opposer is engaged in the manufacture, distribution and/or sale of tobacco and cigarette products throughout the United States, including, most particularly, tobacco and cigarette rolling paper products.

3. Opposer and other third parties engaged in the cigarette rolling paper industry have for several years extensively and continuously manufactured and/or distributed, advertised, promoted and sold in interstate commerce various types of cigarette rolling paper products, which have been and continue to be properly, accurately and generically described by use of the designation “paper”.

4. The designation “paper” and variations thereof, when used by Opposer and/or third parties in the trade fully, completely and accurately describes either product ingredient(s), formulation(s), quality(ies), characteristic(s), effect(s) and/or other feature(s) of the specific product or products in connection with which the said designation is used, including cigarette rolling papers and/or cigarettes rolled in paper.

5. When used in labeling, promotional and advertising materials, with or without other descriptive or identifying proprietary words, the designation “paper” with or without the word “the” is purely descriptive or generic to the trade, consuming public, and public is incapable of functioning as a trademark to distinguish one party’s tobacco products rolled in rolling papers, or for tobacco leaves in the form of a sheet from those of another.

6. By reason of Opposer’s and other’s use of the designation “the paper” in the distribution, labeling, promotion, advertising and sale of Applicant’s Goods, the trade and the consuming public have come to recognize and accept and continue to recognize and accept said designation in such product category and related categories as descriptive terms and/or generic terms.

7. For the reasons hereinabove set forth, the designation “the paper” is merely descriptive within the meaning of 15 U.S.C. § 1052(e) by reason of the fact that it conveys the immediate idea of the significant ingredient(s), product formulation, nature, qualities, characteristics, size, and/or other descriptive features of inter alia, cigarette rolling papers and/or papers from which the cigarettes are rolled, or indicate the results desired, expected and/or produced when such products are utilized by the consuming public.

8. The trademark registration sought by Applicant would be injurious to Opposer, and indeed to the cigarette rolling paper and tobacco industry and trade as a whole, because it will appear to create statutory rights in Applicant with respect to a common designation used descriptively and/or generically by Applicant’s competitors and will provide Applicant with false *prima facie* presumptions attending registration rights, in derogation of the established and continuing rights of Opposer and others in the business to use descriptively, prominently and otherwise the designation “paper” in its ordinary and descriptive sense in connection with the distribution, packaging, promotion, advertising, publicity and sale of their own products. Furthermore, the allowance of the generic or descriptive term “paper” for registration as a trademark regardless of the addition of the word “the” will create the erroneous, misleading and false impression that only Applicant’s goods may be sold bearing that designation.

9. For the foregoing reasons, allowance of Application Serial No. 77/316,130 and its passage to registration would cause Opposer and the trade and industry in general damage on a continuing basis by, *inter alia*, inhibiting competition in the sale of both the particular goods at issue and related products and would endanger the freedom of the public, the trade and industry to use the designation at issue. Therefore, to preserve competitive needs and avoid the erroneous claim of exclusive rights by way of registration or otherwise to the use of the generic or

descriptive term by Applicant, Opposer therefore requests that this Notice of Opposition be sustained and that the application for registration of the generic or descriptive designation “the paper” be refused.

COUNT II

Misdescriptiveness

10. Opposer repeats and realleges the allegations contained in paragraphs 1 through 9 hereinabove as though fully set forth herein.

11. In the alternative, Opposer believes it will be damaged by registration of the designation “the paper” because, when used in labeling, packaging, promotional and advertising materials alone or with the word “the” for Applicant’s Goods is deceptively misdescriptive (unless merely descriptive or generic as alleged hereinabove) and given to misunderstanding and misinterpretation by the trade, consuming public, and the public and trade press, and are accordingly incapable of functioning as a trademark to distinguish one party’s goods from those of another.

12. For the reasons hereinabove and hereinafter set forth, the designation “paper” with or without the word “the”, for said products and related products, unless descriptive or generic as alleged hereinabove, are deceptively misdescriptive within the meaning of 15 U.S.C. § 1052(e) by reason of the fact that they falsely indicate and deceptively misdescribe the significant, product formulation, nature, quality(ies), characteristic(s), effect(s) and/or other feature(s) of the specific goods in connection with which Applicant allegedly uses and/or seeks to register this designation, or falsely indicates or otherwise deceptively misdescribes the characteristics of such products because if said designation when so employed by Applicant is deceptively misdescriptive.

13. The trademark registration sought by Applicant would therefore be injurious to Opposer, and indeed to the tobacco and cigarette paper industries and trade as a whole, because it will appear to create statutory rights in Applicant respecting a common word used descriptively and/or generically by Applicant, Opposer and third parties for cigarette rolling paper and/or the paper used to pack cigarettes, and unless used descriptively or as a generic term as alleged hereinabove, are used deceptively misdescriptively by Applicant and will provide Applicant with false *prima facie* presumptions attending registration rights, in derogation of the established and continuing rights of Opposer and others in the business to use accurately and correctly, descriptively, prominently and otherwise the designation “paper” in its ordinary and descriptive generic sense in connection with the distribution, packaging, promotion and advertising, publicity and sale of their own products, to the extent that such usage is accurate and appropriate.

14. Furthermore, the trademark registration sought by Applicant would be contrary to the public interest and public policy in that said term deceptively misdescribes the nature or character of Applicant’s Goods and is confusing, misleading, damaging and injurious to the trade and to all relevant classes of consumers.

15. For the foregoing reasons, allowance of Application Serial No. 77/316,130 and its passage to registration would cause Opposer and the consuming public, the trade and industry in general, great damage on a continuing basis by, *inter alia*, inhibiting competition in the sale of the particular goods at issue and related products and would endanger the freedom of the public, the trade and industry to use the designation at issue, while at the same time affording Applicant the right to deceptively misdescribe its products, and with statutory proprietary rights, to the prejudice and damage of all concerned. Therefore, to preserve competitive needs and avoid the putative and erroneous claim of exclusive right by way of registration or otherwise to the

deceptively misdescriptive use of the generic or descriptive term “paper” by Applicant, Opposer therefore requests that this Opposition be sustained and that the instant application for registration be refused.

Dated: New York, New York
October 27, 2008

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Heather L. Jensen/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 27th day of October, 2008, the foregoing Notice of Opposition was served on Applicant by mailing a true and correct copy thereof to Applicant at:

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Law Office of Edward A. Sokolski
3868 W. Carson Street, Suite 105
Torrance, CA 90503-6706

/Heather L. Jensen/
Heather L. Jensen