

ESTTA Tracking number: **ESTTA257156**

Filing date: **12/23/2008**

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	Holt's Company
Granted to Date of previous extension	12/24/2008
Address	12270 Townsend Road Philadelphia, PA 19154 UNITED STATES

Attorney information	M. Kelly Tillery, Esq. Pepper Hamilton LLP 3000 Two Logan Square 18th and Arch Streets Philadelphia, PA 19103 UNITED STATES tilleryk@pepperlaw.com, olszykc@pepperlaw.com, jensenc@pepperlaw.com Phone:215.981.4401
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Applicant Information

Application No	77371424	Publication date	08/26/2008
Opposition Filing Date	12/23/2008	Opposition Period Ends	12/24/2008
Applicant	Famous Smoke Shop-PA, Inc. 1100 Conroy Place Easton, PA 18040 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: Cigars

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3532512	Application Date	11/15/2005
Registration Date	11/11/2008	Foreign Priority Date	NONE
Word Mark	BENCHMADE		

Design Mark	BENCHMADE
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2008/04/17 First Use In Commerce: 2008/04/17 Cigar bands; Cigar boxes not of precious metal; Cigar cutters; Cigar tubes; Cigars

Attachments	78753820#TMSN.jpeg (1 page)(bytes) BENCHMARK Opposition.pdf (8 pages)(235935 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	/mkt/
Name	M. Kelly Tillery, Esq.
Date	12/23/2008

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

RE: U.S. Trademark Application Serial No. 77/371,424
Published in the Official Gazette on 26 August 2008

HOLT'S COMPANY)	
)	
Opposer)	
)	Opposition No. _____
-v-)	
)	
FAMOUS SMOKE SHOP-PA, INC.)	
)	
Applicant)	
)	
)	
)	

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314-1451

Commissioner:

In the matter of Application Serial No. 77/371,424, filed 14 January 2008 by FAMOUS SMOKE SHOP-PA, INC. ("Applicant") of Easton, Pennsylvania, to register the mark BENCHMARK BY FAMOUS SMOKE SHOP for "cigars" in International Class 34 ("Applicant's Goods"), which was published in the Official Gazette on 26 August 2008. HOLT'S COMPANY ("Opposer") of Philadelphia, Pennsylvania, believes it will be damaged by Applicant's registration of BENCHMARK BY FAMOUS SMOKE SHOP and opposes same. The grounds for this opposition are as follows:

1. Applicant is a Pennsylvania corporation having an address at 1100 Conroy Place, Easton, Pennsylvania 18040. On 14 January 2008, Applicant filed an Intent to Use Application, Serial No. 77/371,424, for the mark BENCHMARK BY FAMOUS SMOKE SHOP, for Applicant's Goods, based on Applicant's intent to use of the mark in commerce.

2. Opposer is the owner of Registration No. 3,232,512, bearing a constructive date of first use of 15 November 2005.

3. Since at least as early as 17 April 2008, Opposer has continuously been using the BENCHMADE Mark in commerce in connection with goods described as *inter alia* "cigars, cigar cutters, cigar boxes and cigar tubes".

4. Opposer has invested substantial resources in advertising and promoting its goods and has acquired substantial goodwill under the BENCHMADE trademark.

5. Opposer's BENCHMADE Mark is arbitrary and inherently distinctive.

6. Opposer will rely upon its ownership of Federal trademark Registration No. 3,532,512 for BENCHMADE, as well as the common law rights it has obtained through prior and continuous use of the BENCHMARK Mark in commerce.

7. Opposer's Mark is not limited by channels of trade or classes of purchasers.

8. Applicant's filing date of 14 January 2008 is subsequent to the constructive first date of first use of U.S. Reg. No. 3,532,512 for BENCHMADE.

9. Since its initial use of Opposer's BENCHMADE Mark, Opposer has made a substantial investment in advertising and promoting Opposer's Goods under its BENCHMADE Mark. Opposer has extensively used, advertised, promoted, offered and sold Opposer's Goods to the public through various channels of trade in commerce. Opposer's customers and the public in general know and recognize Opposer's BENCHMADE branded cigars and associate same with Opposer and/or Opposer's Goods. Opposer has built and continues to build extensive goodwill in connection with the sale of cigars bearing Opposer's BENCHMADE Mark.

10. Applicant's filing of Application Serial No. 77/371,424 for BENCHMARK BY FAMOUS SMOKE SHOP is without license, authorization or permission from Opposer.

**FIRST GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - FEDERAL)**

11. Opposer re-alleges the allegations contained in Paragraphs 1 through 10 of this Notice of Opposition.

12. Applicant's BENCHMARK BY FAMOUS SMOKE SHOP Mark so resembles Opposer's BENCHMADE Mark in sound, appearance and commercial impression as to be likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

13. Applicant's constructive date of first use, the filing date of 14 January 2008 for BENCHMARK BY FAMOUS SMOKE SHOP, claimed in Appl. Ser. No. 77/371,424, is subsequent to Opposer's constructive date of first use, the filing date of 15 November 2005 for the BENCHMADE Mark of Opposer, Reg. No. 3,532,521, as such, priority is not an issue in this proceeding.

14. Opposer's Goods and Applicant's Goods are identical, will be offered and sold through the same channels of trade and purchased and consumed by the same class of purchasers.

15. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Goods offered and marketed under the BENCHMARK BY FAMOUS SMOKE SHOP Mark and misled into believing that such Goods are offered by, emanate from, or are in some way associated with, sponsored by or endorsed by Opposer, to the damage and detriment of Opposer and its reputation.

16. Applicant's disclaimer of the term "SMOKE SHOP" from its BENCHMARK BY FAMOUS SMOKE SHOP mark, leaving the terms BENCHMARK BY FAMOUS as the

remaining protectable element of the mark is further evidence of the likelihood of confusion between Applicant's mark and Opposer's BENCHMADE trademark.

17. Opposer will be damaged by Applicant's registration of BENCHMARK BY FAMOUS SMOKE SHOP as set forth in Application Serial No. 77/371,424, in that the non-disclaimed, dominant portion of mark, "BENCHMARK BY FAMOUS" is similar in appearance, sound and commercial impression to Opposer's BENCHMADE Mark and is intended to be used in connection with goods identical to Opposer's Goods.

18. Applicant's registration of the BENCHMARK BY FAMOUS SMOKE SHOP Mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its BENCHMADE Mark.

**SECOND GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION – COMMON LAW)**

19. Opposer re-alleges the allegations contained in Paragraphs 1 through 18 of this Notice of Opposition.

20. Applicant's BENCHMARK BY FAMOUS SMOKE SHOP Mark so resembles Opposer's BENCHMADE Mark as to be likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

21. Upon information and belief, any date of first use asserted by Applicant will be subsequent to Opposer's constructive date of first use, 15 November 2005, and actual date of first use of the BENCHMADE Mark, at least as early as 17 April 2008. As such, priority is not an issue in this proceeding.

22. Opposer's Goods and Applicant's Goods are identical, will or are likely to be offered through the same channels of trade and purchased and used by the same class of purchasers.

23. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods offered under Applicant's BENCHMARK BY FAMOUS SMOKE SHOP Mark and misled into believing that such Goods are offered by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

24. Opposer will be damaged by Applicant's registration of the BENCHMARK BY FAMOUS SMOKE SHOP Mark as set forth in Application Serial No. 77/371,424, as the dominate and descriptive term BENCHMARK, is nearly identical in sound, appearance and commercial impression to Opposer's BENCHMADE Mark thereby violating Opposer's common law rights to its Mark.

25. Applicant's registration of BENCHMARK BY FAMOUS SMOKE SHOP would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior common law rights of Opposer to its BENCHMADE Mark.

THIRD GROUND FOR OPPOSITION (DESCRIPTIVENESS)

26. Opposer re-alleges the allegations contained in Paragraphs 1 through 25 of this Notice of Opposition.

27. Commencing long prior to the filing date of the subject application, the term "BENCHMARK" has been commonly used by Opposer, others in the tobacco industry, and the public at large, to describe the level of quality or characteristic of the particular product, in this

case, cigars. Specifically, the term “BENCHMARK is commonly defined as “the standard by which something can be measured or judged.”

28. The subject application for registration of the term BENCHMARK BY FAMOUS SMOKE SHOP in connection with Applicant’s Goods is merely descriptive and/or laudatory of the features, qualities and characteristics of Applicant’s Goods.

29. Manufacturers, distributors and consumers readily recognize and associate the term “benchmark” with a certain level of quality of a product, including cigars, and thus the foregoing term is incapable of serving as a source identifier. Accordingly, Applicant’s attempt to obtain registration of the term BENCHMARK, as the dominant element of its BENCHMARK BY FAMOUS SMOKE SHOP Mark amounts to nothing less than an attempt to secure exclusive rights in a term that is descriptive and/or laudatory of not only Applicant’s Goods but also those of numerous third parties.

30. Based in part on the extensive identical and descriptive uses by many in the cigar and tobacco industries, the term which Applicant seeks to register does not and cannot function as a source identifier for Applicant’s Goods or distinguish Applicant’s Goods from similar goods offered by others.

31. Applicant’s alleged mark as a whole lacks sufficient distinctive character, is not inherently distinctive and as an Intent to Use Application, has not acquired the requisite level of secondary meaning to warrant registration.

32. Applicant’s alleged mark fully comprises descriptive and non-distinctive matter that alone or in combination does not function as a trademark and must remain available for others in the trade, including Opposer, to freely use or otherwise face injury.

33. Applicant's mark, when used on or in connection with Applicant's Goods is merely descriptive and should be refused registration under Section 2(e)(1) of the Trademark Act of 1946, as amended, 15 U.S.C. §1052(e)(1).

34. Usage of BENCHMARK as a term to identify a quality or characteristic of a cigar has become so common that the granting of a registration for the mark BENCHMARK BY FAMOUS SMOKE SHOP would result in Applicant receiving the statutory benefits of Section 33(a) of the Lanham Act, 15 U.S.C. §1115(a) to a descriptive term thereby resulting in the injury of Opposer and others.

35. Based upon the allegations above, Opposer has a reasonable basis in fact to believe that it and other members of the public will be damaged by registration of Applicant's mark.

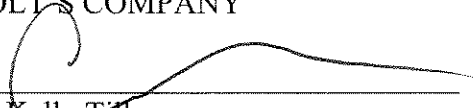
WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 77/371,424 be rejected and that the registration of BENCHMARK BY FAMOUS SMOKE SHOP as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

HOLT'S COMPANY

Date: 12/23/08

By:

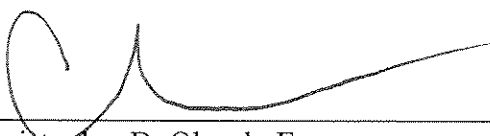

M. Kelly Tillery
Michael J. Leonard
Christopher D. Olszyk, Jr.
Pepper Hamilton, LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103

Attorneys for Opposer

CERTIFICATE OF SERVICE

I, Christopher D. Olszyk, hereby certify that on December 23, 2008, a true and correct copy of the foregoing Notice of Opposition was served via First Class Mail upon the following:

Michael J. Brown. Esq.
Curtis, Mallet-Prevost, Colt & Mosle LLP
101 Park Ave Fl 34
New York, NY 10178-0061



Christopher D. Olszyk, Esq.