

ESTTA Tracking number: **ESTTA328265**

Filing date: **01/22/2010**

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	Commonwealth Brands, Inc.
Granted to Date of previous extension	01/24/2010
Address	900 Church Street Bowling Green, KY 42101-5112 UNITED STATES

Attorney information	Brewster Taylor Stites & Harbison, PLLC 1199 North Fairfax St. Suite 900 Alexandria, VA 22314 UNITED STATES btaylor@stites.com Phone:703-739-4900
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**Applicant Information**

Application No	77683474	Publication date	07/28/2009
Opposition Filing Date	01/22/2010	Opposition Period Ends	01/24/2010
Applicant	DRL Enterprises, Inc. 2301 Ravine Way Glenview, IL 60025 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 034. All goods and services in the class are opposed, namely: Tobacco; cigarette papers; cigarette filters; cigarette tubes; cigarette rolling machines; hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette tubes, and hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette paper, cigarette filters and cigarette rolling machines
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**Grounds for Opposition**

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23

Attachments	NOTICE OF OPPOSITION.pdf ( 6 pages )(224765 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	/bt/
Name	Brewster Taylor
Date	01/22/2010

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

**IN THE MATTER OF TRADEMARK  
APPLICATION SERIAL NO. 77/683474**

<b>COMMONWEALTH BRANDS, INC.</b>	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No.
	)	
<b>DRL ENTERPRISES, INC.</b>	)	
	)	
Applicant	)	
	)	

**NOTICE OF OPPOSITION**

Commissioner of Trademarks  
Attn: TTAB  
P.O. Box 1451  
Alexandria, VA 22313-1451

SIR:

**COMMONWEALTH BRANDS, INC.**, a corporation organized under the laws of Kentucky with principal offices located at 900 Church Street, Bowling Green, KY 42101-5112 United States (hereinafter "Opposer"), believes that it would be damaged by registration of the alleged mark "1.50" for "tobacco; cigarette papers; cigarette filters; cigarette tubes; cigarette rolling machines; hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette tubes, and hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette paper, cigarette filters and cigarette rolling machines" (Ser. No. 77/683,474).

1. In U.S. Application Serial No. 77/683,474 Applicant seeks registration of the mark “1.50” for “tobacco; cigarette papers; cigarette filters; cigarette tubes; cigarette rolling machines; hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette tubes, and hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette paper, cigarette filters and cigarette rolling machines” (hereinafter “the application”). The application was filed on March 4, 2009, and is based on Applicant’s alleged bona fide intention to use the mark in commerce on said goods under Section 1(b) of the Trademark Act ( 15 U.S.C. §1051(b)).

2. Opposer is a leading manufacturer and seller of cigarette rolling papers in the United States, and for many years Opposer and other manufacturers as well as retailers have used such terms as “1.0”, “1.25”, “1 1/4”, “1.5”, “1 1/2” or “2.0” and descriptions such as “single wide” and “double wide” on packaging for cigarette rolling papers and in advertising and otherwise used such terms descriptively to indicate the widths of cigarette rolling papers. These terms are functionally descriptive terms that are used within the cigarette rolling paper industry to describe the relative sizes of cigarette papers within the lines of different manufacturers. Such functionally descriptive terms relating to size or other characteristics are incapable of becoming trademarks when used in connection with cigarette rolling papers, cigarettes, or products used together with cigarette rolling papers to make cigarettes.

3. Registration of Applicant’s purported mark “1.50” for the goods in the application will give Applicant exclusive rights to terms which are in the public domain and are used descriptively within the cigarette paper industry and will place Opposer at risk of being accused of infringement in continuing to use such descriptive terms as “1 1/2” or other numeric equivalents of “1.50” or other numeric descriptions on its packaging for cigarette papers, in its advertising and other forms of

publication or as components of trademarks identifying its products. Registration of Applicant's alleged mark will cause Opposer injury and damage in the sale of its cigarette rolling papers and other tobacco products and will limit not only Opposer but also retailers of Opposer's cigarette rolling papers in their ability to continue to appropriately describe Opposer's cigarette rolling papers and in their ability to describe products related to "1.50" ("1.5" and "1 1/2") size rolling papers to the consuming public.

4. The term "1.50" in the application is merely descriptive or is deceptively misdescriptive as used in connection with the goods in the application and cannot function to identify or become distinctive of Applicant's products within the meaning of the Trademark Act since it or its exact numeric equivalent has been used by Opposer and others descriptively in connection with identical or closely related products sold in the United States and would be understood by potential purchasers as describing the widths of rolling papers and as describing a feature of tobacco, filters, tubes, machines and kits sold under the term e.g. that such products are for use in making cigarettes with "1.50" width cigarette papers.

5. Applicant is not entitled to Federal registration of its alleged mark "1.50" for "tobacco; cigarette papers; cigarette filters; cigarette tubes; cigarette rolling machines; hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette tubes, and hand-held machines for injecting tobacco into cigarette tubes; kits for making cigarettes comprised primarily of tobacco, cigarette paper, cigarette filters and cigarette rolling machines", and registration of the alleged mark "1.50" in the above-identified applications should be refused under Section 2(e) of the Trademark Act (15 U.S.C. § 1052(e)).

6. Applicant's alleged mark "1.50" in the above-identified application should also be refused registration on the grounds of fraud at least in that the file history of the application shows that a fraudulent declaration and representation was made to the Trademark Office for the purpose of obtaining registration. In the declaration in the application Applicant fraudulently stated that no other person, firm, corporation or association had the right to use Applicant's alleged mark "1.50", though Applicant knew that in fact for many years manufacturers or sellers had used the term "1.5" or other exact numeric equivalents to "1.50" to describe cigarette papers and that such manufacturers and sellers had the right to continue to use them to describe the width of cigarette papers or other features of cigarette papers or other tobaccos, and, in particular, Applicant knew, for example, that Opposer had the right to use the inherently descriptive term "1.50" to describe the width of cigarette papers. The fact that Applicant was fully aware of the many years of use of "1.50" or its exact numeric equivalent to describe the width of cigarette papers and of the inherently descriptive nature of "1.50" for cigarette papers at the time that it filed the application is evident from the fact that prior to filing the application it both obtained registration of "1.5 POINT" stylized for cigarette papers and sought registration of "1.5" for cigarette papers under Section 2(f) of the Trademark Act.

7. On information and belief, the false representation identified in the preceding paragraph was material to the prosecution of the application, and Applicant knew that its representations to the Trademark Office were false. The new application was filed with Applicant's full knowledge that other manufacturers or sellers had the right to use "1.50" to describe their cigarette papers and products used for making cigarettes with the cigarette papers and with full knowledge that "1.50" or its exact numeric equivalent had in fact been used by manufacturers and sellers for many years to describe the size of their cigarette rolling papers. The false representation was made with the

intention of inducing the Examining Attorney to allow the application for publication based on the misrepresentation.

8. The above identified application is invalid not only under Section 2 (e) of the Trademark Act (15 U.S.C. § 1052 (e)) but are also invalid under Section 1 of the Trademark Act (15 U.S.C. § 1051(a)(3) and (b)(3)), since Applicant's declaration that it was the owner of the alleged mark sought to be registered and that no other person had the right to use the alleged marks in commerce was false.

9. On information and belief, the good faith of Applicant's alleged good faith intent to use its alleged mark for the goods listed in the application is not apparent, and Opposer challenges the nature and sufficiency of Applicant's alleged intent to use the marks in commerce under Section 1(b).

18. WHEREFORE, Opposer believes that it would be damaged by grant to Applicant of a registration on Application Serial No. 77/683,474 and prays that the opposition be sustained and that registration be denied.

Respectfully submitted,

**STITES & HARBISON, PLLC**

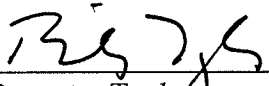
  
Brewster Taylor

**January 22, 2010**

Suite 900  
1199 North Fairfax Street  
Alexandria, Virginia 22314  
(703) 739-4900

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Notice of Opposition is being mailed via first class mail, postage prepaid, to counsel for Applicant, Antony J. McShane, Esquire, Neal, Gerber & Eisenberg LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this 22<sup>nd</sup> day of January 2010.

  
Brewster Taylor