

ESTTA Tracking number: **ESTTA370112**

Filing date: **09/24/2010**

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	RosalieAJacobs
Granted to Date of previous extension	09/26/2010
Address	344 Frogtown Road Hogansburg, NY 13655 UNITED STATES

Attorney information	Eugene Berman Law Offices of Eugene Berman 26 Cedarwood Court Rockville, MD 20852 UNITED STATES eugene.berman@verizon.net Phone:301 461-4635
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### Applicant Information

Application No	77852378	Publication date	03/30/2010
Opposition Filing Date	09/24/2010	Opposition Period Ends	09/26/2010
Applicant	Dunhill Tobacco of London Limited 1A St. Jame's Street London, SW1A1EF UNITED KINGDOM		

### Goods/Services Affected by Opposition


Class 034. First Use: 2007/01/01 First Use In Commerce: 2007/01/01  
All goods and services in the class are opposed, namely: Cigarettes

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	


### Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	77714718	Application Date	04/15/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DIS COUNT LITTLE CIGARS D		

Design Mark			
Description of Mark	The mark consists of the terms "dis" and "COUNT" on the first line, the terms "LITTLE CIGARS" on the second line and the letter "D" in a square box below the term "CIGARS".		
Goods/Services	Class 034. First use: First Use: 2009/03/23 First Use In Commerce: 2009/03/23 Cigars		

U.S. Application No.	77700049	Application Date	03/26/2009
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	DIS COUNT FULL FLAVOR D
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Design Mark			
Description of Mark	The mark consists of the letters "DIS" and the term "COUNT" on a first line, the terms "FULL FLAVOR" on a second line beneath the first line, and the letter "D" in a square beneath the second line.		
Goods/Services	Class 034. First use: First Use: 2006/10/10 First Use In Commerce: 2006/10/10 Cigarettes		

Related Proceedings	Opposition Nos. 91192141 and 91193702, which have been consolidated
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Attachments	77714718#TMSN.jpeg ( 1 page )( bytes ) 77700049#TMSN.jpeg ( 1 page )( bytes ) Attachment D Opposition Sept 26 2010 .pdf ( 4 pages )(81210 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	/eb/
Name	Eugene Berman
Date	09/24/2010

**Attachments to Opposition Against Ser. No. 77/852,378 Filed by Rosalie Ann Jacobs filed September 24, 2010**

1. Opposer (Rosalie Ann Jacobs ) manufactures and sells cigarettes and other tobacco products (hereinafter collectively “Opposer’s tobacco products”) bearing various trademarks containing the term disCOUNT, dis COUNT and dis COUNT D , including but not limited to the marks described below.

2. Applicant, Dunhill Tobacco of London Limited (hereinafter “Dunhill”) manufactures and sells cigarettes and other tobacco products;

3. Opposer is the owner of the common law rights to the trademark dis COUNT FULL FLAVOR D <sup>TM</sup> for cigarettes and has filed an application for this trademark in the United States (Serial No. 77/700,049 filed March 26, 2009 in International Class 034) under Section 1(A), claiming a date of first use of at least as early as October 10, 2006;

4. Application Ser No. 77/700,049 was published for opposition, Dunhill opposed this application (Opposition No. 91192141) on October 5, 2009 and said opposition is pending:

5. Opposer is also the owner of the common law rights to the trademark dis COUNT LITTLE CIGARS D <sup>TM</sup> for cigars and has filed an application for this trademark in the United States (Serial No. 77/714,718 filed April; 15, 2009 in International Class 034) under Section 1(A) claiming a date of first use of at least as early as March 23, 2009;

6. Application Ser. No. 77/714,718 was published for opposition on January 12, 2010 and Dunhill opposed this application by Notice of Opposition filed

February 9, 2010 (Opposition No.91193702); said opposition is pending and was consolidated with Opposition No. 91192141;

7. Opposer first used Opposer's dis COUNT FULL FLAVOR D <sup>TM</sup> for cigarettes marks in interstate commerce for the Opposer's tobacco products at least as early as October 10, 2006 (including use of this mark on Opposer's tobacco products' packaging) and has continuously used this mark on its tobacco products since that date;

8. Dunhill filed four (4) U. S. trademark applications (S.N.'s 78/550,155, 78/550,175, 78/550,183 and 78/550,188, all on January 19, 2005 for the single letter "D" (with no other terms, but including specific graphic design elements) for tobacco products and each were abandoned on June 8, 2009;

9. Dunhill filed application Ser. No. 77/733,894 on May 11, 2009 for the mark D DUNHILL INTERNATIONAL for cigarettes and other tobacco products, under Section 1(B) and 44D claiming a priority date of April 7, 2009, and claiming ownership of two prior registrations for the term DUNHILL alone or with associated other terms and design elements;

10. Dunhill filed application Ser. No. 77/852,378 (the application being opposed herein) on October 20, 2010 for the singular letter D (with no other terms, but including specific graphic design elements) mark for cigarettes, under Section 1(A), claiming a date of first use of January 1, 2007, with the specimen of alleged use being a D DUNHILL INTERNATIONAL tobacco product label (the mark applied for in said Ser. No. 77/733,894);

11. The USPTO published application Ser. No. 77/852,378 for opposition on March 30, 2010, and extensions for filing this opposition were granted by the TTAB until September 26, 2010;

12. Dunhill filed its application Ser. No. 77/852,378 (1) after it had abandoned its above-identified four (4) prior application's for the singular letter D for tobacco products and (2) after it become aware of Opposer's dis COUNT Full Flavor D mark ;

13. It is not evident that Dunhill has used or has had a bona fide intent to use the singular letter D for cigarettes without inclusion of additional terms as part of a unitary mark including the letter D;

14. Dunhill cannot properly claim the exclusive prior rights to singular letter D for cigarettes (without inclusion of additional terms as part of a unitary mark including the letter D),, as a mark in of itself, anymore than it could claim the exclusive right to use the any of the individual other letter per se of the associated terms of its unitary DUNHILL marks (e.g.; the letter N or the letter L);

15. Upon information and belief, Dunhill was motivated to file its application Ser. No. 77/852,378, by learning of Opposer's use of the letter "D" as part of its marks, after it abandoned its earlier attempts to secure protection for the singular D for tobacco products and the filing was made in attempt to secure some perceived strategic advantages in its pending Opposition 91192141 against Opposer herein;

16. Opposer has continuously used Opposer's dis COUNT FULL FLAVOR D™ mark for cigarettes prior to the date of first use alleged by Dunhill is

application S.N. 77/852,378 and has also continuously used its dis COUNT LITTLE CIGARS D<sup>TM</sup> mark since its date of first use;

17. Dunhill alleged singular letter D mark as applied for in application S.N. 77/852,378 would be confusingly similar [under 15 U.S.C. §1052(d)] to Opposer's dis COUNT FULL FLAVOR D<sup>TM</sup> and dis COUNT LITTLE CIGARS D<sup>TM</sup> mark, in view the attempted coverage of the singular letter D without any of the accompany terms set forth in Dunhill's other tobacco product marks and the identical goods or related goods in Class 034 upon which the marks are used, which are likely to cause confusion, to cause mistake or to deceive;

18. Dunhill cannot legally or equitably claim the exclusive use of the singular letter D mark, or claim prior rights thereto, under the facts herein;

19. Opposer would be harmed by the registration of the singular letter D mark and Applicant's use of said mark; and

20. For the foregoing reasons, Applicant is not entitled to registration of its alleged singular D mark for cigarettes and is not entitled to the exclusive use thereof ;

**WHEREFORE,** Opposer respectfully requests that this opposition be sustained and the registration of the singular letter D (Ser. No. 77/852,378) be refused.