

ESTTA Tracking number: **ESTTA509121**

Filing date: **12/05/2012**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	DinaDiCenso
Granted to Date of previous extension	12/05/2012
Address	47 West Devonia Avenue Mount Vernon, NY 10552 UNITED STATES

Name	Eight of Swords, LLC
Granted to Date of previous extension	12/05/2012
Address	115 Grand Street Williamsburg, NY 11249 UNITED STATES

Attorney information	Sidney D. Bluming Meister Seelig & Fein LLP 140 East 45th Street, 19th Floor New York, NY 10017 UNITED STATES sdb@msf-law.com, hsk@msf-law.com, sms@msf-law.com, mreed@meisterseelig.com Phone: 212-655-3500
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**Applicant Information**

Application No	85374056	Publication date	08/07/2012
Opposition Filing Date	12/05/2012	Opposition Period Ends	12/05/2012
Applicant	Dave Wallin 106 Bedford Avenue #4R Brooklyn, NY 11211 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 044. First Use: 2009/06/01 First Use In Commerce: 2009/07/13 All goods and services in the class are opposed, namely: Body piercing services; Cosmetic tattooing services; Providing medical information and news about body art, namely, piercing, tattoos, scarification, subincision, castration through photos and videos; Tattoo parlors; Tattoo studios; Tattooing; Tattooing services
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**Grounds for Opposition**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant is not (and was not at the time of filing the application for registration of the mark) the rightful owner of the mark. Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc., 89 USPQ2d 1262 (TTAB 2008). Applicant has used its mark so as to misrepresent the source of its services. Bayer Consumer Care AG v. Belmora LLC, 90 USPQ2d 1587 (TTAB 2009).

Related Proceedings	DiCenso v. Wallin et al., Index No. 5412/2011, Supreme Court of the State of New York, Kings County
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Attachments	Notice of Opposition - EIGHT OF SWORDS TATTOO.pdf ( 6 pages )(199150 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	/Susan M. Schlesinger/
Name	Susan M. Schlesinger
Date	12/05/2012

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

In the Matter of Application Serial No. 85/374,056  
Published in the *Official Gazette* on August 7, 2012

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Eight of Swords, LLC and	:	
Dina DiCenso	:	
Opposer,	:	
	:	
v.	:	Opposition No.:
	:	
	:	
Dave Wallin,	:	
Applicant.	:	
-----X	:	

**NOTICE OF OPPOSITION**

Eight of Swords, LLC (“Eight of Swords”) and Dina DiCenso (“DiCenso”) (collectively, “Opposer”)<sup>1</sup> believes that it will be damaged by registration of the mark shown in trademark application serial number 85/374,056 and hereby opposes same. The grounds for the opposition are as follows:

**COUNT I**

1. Eight of Swords is a limited liability company organized and existing under the laws of the State of New York having an address at 115 Grand Street, Williamsburg, New York 11249.
2. Dina DiCenso is an individual with an address of 47 West Devonia Avenue, Mount Vernon, New York 10552 and is an owner of Eight of Swords.
3. Eight of Swords was formed to operate a tattoo studio, retail store and art gallery.

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<sup>1</sup> DiCenso is currently involved in bringing a derivative action in the Supreme Court of the State of New York, Kings County. Because that particular form of pleading is not available in the Trademark Trial and Appeal Board, we are filing this opposition on behalf of DiCenso and Eight of Swords to approximate a derivative filing.

4. Eight of Swords is the owner of the EIGHT OF SWORDS TATTOO trademark in connection with a tattoo studio and tattooing services.

5. Applicant, Dave Wallin, (“Applicant”) is another owner of Eight of Swords. Applicant filed a trademark application which was assigned serial number 85/374,056 for EIGHT OF SWORDS TATTOO for “body piercing services; cosmetic tattooing services; providing medical information and news about body art, namely, piercing, tattoos, scarification, subincision, castration through photos and videos; tattoo parlors; tattoo studios; tattooing; tattooing services” in Class 44. However, Applicant filed application serial number 85/374,056 in his individual name as owner.

6. In the Spring of 2009, DiCenso and Applicant jointly sought to open a tattoo studio business. They were searching for a location for the business prior to registering and using a name for the business and prior to adopting and using a trademark associated with the business. In or about May 2009, DiCenso and Applicant began negotiation for a lease for their business premises at 178 North 8<sup>th</sup> Street, Williamsburg, New York. The Eight of Swords business name and EIGHT OF SWORDS TATTOO trademark were derived out of the street address of the location which DiCenso and Applicant decided to lease for their business. Once the lease terms were agreed to, the prevalence of the number “8” in the street address, i.e., (1+7=8; 8<sup>th</sup> Street), prompted DiCenso and Applicant to register and use Eight of Swords (a tarot card) as their business name and to adopt and use EIGHT OF SWORDS TATTOO as the trademark associated with their tattoo studio, retail store and art gallery.

7. At all times, the EIGHT OF SWORDS TATTOO trademark was owned by Eight of Swords and use of the EIGHT OF SWORDS TATTOO trademark and the goodwill that arose from such use inured to the benefit of Eight of Swords.

8. Applicant unlawfully misappropriated the EIGHT OF SWORDS TATTOO trademark along with other assets of Eight of Swords which is the subject of the state court proceeding currently pending in the Supreme Court of the State of New York, Kings County. See *DiCenso v. Wallin et al.*, Index No. 5412/2011.

9. Applicant has claimed a date of first use of the EIGHT OF SWORDS TATTOO mark as of June 1, 2009 and a date of first use in commerce of the EIGHT OF SWORDS TATTOO trademark as of July 13, 2009. However, such dates of first use of the mark are not those undertaken by Applicant. The date of first use and date of first use in commerce claimed by Applicant are actually the dates of first use of the EIGHT OF SWORDS TATTOO trademark by Eight of Swords.

10. Applicant is not the rightful owner of the EIGHT OF SWORDS TATTOO trademark and, therefore, cannot maintain an application to register the EIGHT OF SWORDS TATTOO trademark.

## COUNT II

11. Opposer repeats and realleges paragraphs 1 through 10 as though fully set forth herein.

12. Despite Eight of Sword's ownership of the EIGHT OF SWORDS TATTOO trademark, Applicant has been using the EIGHT OF SWORDS TATTOO trademark without Opposer's permission or consent.

13. Applicant's use of the EIGHT OF SWORDS TATTOO trademark unlawfully trades on the goodwill of Opposer and is a misrepresentation of the source of services provided under the EIGHT OF SWORDS TATTOO trademark.

14. Because Applicant is using assets that rightfully belong to Eight of Swords, Applicant is using advertising and other promotional materials of Eight of Swords which is a misuse of such materials and constitutes a misrepresentation of source.

### **COUNT III**

15. Opposer repeats and realleges paragraphs 1 through 14 as though fully set forth herein.

16. Applicant was aware of Eight of Sword's EIGHT OF SWORDS TATTOO trademark prior to filing trademark application serial number 85/374,056 for EIGHT OF SWORDS TATTOO.

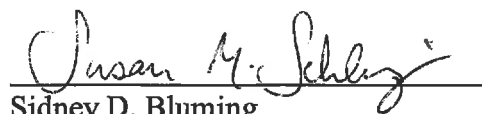
17. Applicant filed the EIGHT OF SWORDS TATTOO trademark application in bad faith where Applicant was aware of Eight of Sword's prior use of EIGHT OF SWORDS TATTOO as a trademark.

18. Upon information and belief, Applicant made a fraudulent representation to the U.S. Patent and Trademark Office by signing the declaration on trademark application serial number 85/374,056 for EIGHT OF SWORDS TATTOO where Applicant was aware that Eight of Sword is the owner of the EIGHT OF SWORDS TATTOO trademark.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Applicant's application to register EIGHT OF SWORDS TATTOO as a mark be denied in all respects.

Dated: December 5, 2012

Respectfully Submitted,

A handwritten signature in cursive script, reading "Susan M. Schlesinger", is written over a horizontal line.

Sidney D. Bluming

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Susan M. Schlesinger

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*Attorneys for Opposer*

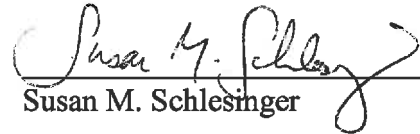
**CERTIFICATE OF SERVICE AND FILING**

The undersigned hereby certifies that a copy of the foregoing Notice of Opposition was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, First Class Mail, postage pre-paid, to Applicant's correspondent address of record:

Aaron H. Pierce  
The Law Offices of Aaron H. Pierce  
302 Bedford Ave., #165  
Brooklyn, NY 11249-4205

and further certifies that the aforementioned Notice of Opposition was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: December 5, 2012

  
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Susan M. Schlesinger