

ESTTA Tracking number: **ESTTA573224**

Filing date: **11/26/2013**

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	John Middleton Co.
Granted to Date of previous extension	11/27/2013
Address	6603 West Broad Street Richmond, VA 23230 UNITED STATES

Attorney information	Joel D. Leviton Fish & Richardson P.C. 60 South Sixth Street, Suite 3200 Minneapolis, MN 55402 UNITED STATES leviton@fr.com, altrialtm@fr.com, trademarkgroup@altria.com Phone: 612-335-5070
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### Applicant Information

Application No	85857007	Publication date	07/30/2013
Opposition Filing Date	11/26/2013	Opposition Period Ends	11/27/2013
Applicant	Sinbad Grand Cafe, L.L.C. 21060 Coolidge Highway Oak Park, MI 48237 MI		

### Goods/Services Affected by Opposition

Class 034. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Hookah tobacco; Tobacco

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4298617	Application Date	11/30/2010
Registration Date	03/05/2013	Foreign Priority Date	NONE
Word Mark	BLACK & MILD JAZZ		

Design Mark	<b>BLACK &amp; MILD JAZZ</b>
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2012/08/15 First Use In Commerce: 2012/08/15 Tobacco Products, Namely, Cigars

U.S. Registration No.	3095386	Application Date	05/18/2005
Registration Date	05/23/2006	Foreign Priority Date	NONE
Word Mark	WINE BERRY		
Design Mark	<b>WINE BERRY</b>		
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2005/08/15 First Use In Commerce: 2005/08/15 cigars and pipe tobacco		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	JAZZ		
Goods/Services	Tobacco Products, Namely, Cigars		

Attachments	85187140#TMSN.jpeg( bytes ) 78632173#TMSN.jpeg( bytes ) JAZZBERRY MIX Notice of Opposition and Exhibits.pdf(5557211 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	/Joel D. Leviton/
Name	Joel D. Leviton
Date	11/26/2013

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

In the matter of Application Serial No. 85/857,007  
Filed on February 22, 2013  
For the mark JAZZBERRY MIX  
Published in the *Official Gazette* on July 30, 2013

JOHN MIDDLETON CO.,

Opposer,

v.

SINBAD GRAND CAFE, L.L.C.,

Applicant.

**NOTICE OF OPPOSITION**

**NOTICE OF OPPOSITION**

Opposer John Middleton Co. believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes the same pursuant to the provisions of 15 U.S.C. § 1063.

The grounds for opposition are as follows:

**THE PARTIES**

1. Opposer John Middleton Co. ("Middleton") is a Pennsylvania limited liability company with a place of business at 6603 West Broad Street, Richmond, Virginia 23230. Middleton manufactures tobacco products, including cigars and smoking tobacco, sold to adult tobacco consumers.

2. Upon information and belief, Applicant Sinbad Grand Cafe, L.L.C. ("Applicant") is a Michigan limited liability company with a place of business at 21060 Coolidge Highway, Oak Park, Michigan 48237 that allegedly intends to sell hookah tobacco and tobacco.

## FACTUAL BACKGROUND

3. Middleton is a leading provider of cigars and smoking tobacco to adult tobacco consumers. In August 2012, Middleton introduced its BLACK & MILD JAZZ brand of cigars. Since that time, Middleton has consistently and prominently used the marks JAZZ and BLACK & MILD JAZZ on and in connection with tobacco products offered to adult tobacco consumers.

4. In addition to its common law rights in its JAZZ and BLACK & MILD JAZZ trademarks, Middleton owns Registration No. 4,298,617 for the mark BLACK & MILD JAZZ for “Tobacco Products, Namely, Cigars,” which issued on March 5, 2013, with a November 30, 2010 priority date. A copy of Registration No. 4,298,617 is attached at Exhibit A.

5. Middleton also owns the trademark WINE BERRY for cigars and pipe tobacco, which Middleton has used since at least as early as August 2005. In addition to its longstanding common law rights in the WINE BERRY mark for tobacco products, Middleton owns Registration No. 3,095,386 for the mark WINE BERRY for “cigars and pipe tobacco,” which issued on May 23, 2006, with a priority date of May 18, 2005, and which has achieved incontestable status. A copy of Registration No. 3,095,386 is attached at Exhibit B.

6. On February 22, 2013, Applicant filed an intent-to-use application to register the mark JAZZBERRY MIX in connection with “hookah tobacco; tobacco” in class 34 (“Applicant’s Goods”), which was designated Application Serial No. 85/857,007 (the “Application”). In the Application, Applicant disclaimed the word “MIX,” confirming that JAZZBERRY is the only distinctive component of the JAZZBERRY MIX mark.

7. Applicant filed the Application based on an alleged intent to use and has not, to Middleton’s knowledge, filed an allegation of use in connection with Application.

8. The Application was published for opposition in the *Official Gazette* on July 30, 2013. Thereafter, Middleton sought and obtained an extension of time to oppose the Application until November 27, 2013. Consequently, this Notice of Opposition is timely filed.

## **GROUND FOR OPPOSITION**

### **Priority and Likelihood of Confusion**

9. There is no issue as to priority. Middleton has been using the JAZZ and BLACK & MILD JAZZ marks in commerce since at least as early as August 15, 2012, and its WINE BERRY mark in commerce since at least as early as August 15, 2005, whereas Applicant's priority is based on its February 22, 2013, intent-to-use application filing date. By virtue of its federal registrations, Middleton enjoys nationwide rights in its BLACK & MILD JAZZ mark dating back to November 30, 2010, and nationwide rights in its WINE BERRY mark dating back to May 18, 2005. Upon information and belief, Applicant has not yet used the proposed JAZZBERRY MIX mark in commerce. Applicant's common law and statutory priority dates precede the priority date of the Application and, upon information and belief, any priority date on which Applicant may rely.

10. Middleton prominently features its JAZZ and BLACK & MILD JAZZ marks both on tobacco products as well as on point-of-sale material used with its tobacco products, with the JAZZ portion prominently displayed, as shown by the point-of-sale materials depicted below:





Middleton's JAZZ and BLACK & MILD JAZZ marks are distinctive of the tobacco products manufactured by Middleton.

11. Middleton's JAZZ mark enjoys a high degree of distinctiveness in the field of tobacco products. Middleton's registration for BLACK & MILD JAZZ is the only existing registration with the United States Patent and Trademark Office in class 34 for a mark that contains the JAZZ designation.

12. Applicant allegedly intends to use the mark JAZZBERRY MIX, which wholly incorporates Middleton's distinctive JAZZ mark and combines it with the BERRY component of Middleton's WINE BERRY mark. The disclaimed and non-distinctive term "MIX" in the JAZZBERRY MIX mark is not sufficient to distinguish the JAZZBERRY MIX mark from Middleton's prior JAZZ, BLACK & MILD JAZZ, and WINE BERRY marks.

13. Applicant allegedly intends to use the JAZZBERRY MIX mark on tobacco products, in particular hookah tobacco and tobacco. The goods Applicant allegedly intends to

offer under the mark JAZZBERRY MIX are similar and related to the goods Middleton offers under its JAZZ and BLACK & MILD JAZZ marks and identical to goods Middleton offers under its WINE BERRY mark.

14. Middleton's tobacco products offered under its JAZZ, BLACK & MILD JAZZ, and WINE BERRY marks are sold to adult tobacco consumers. Upon information and belief, Applicant's hookah tobacco and tobacco products are intended to be sold to adult tobacco consumers.

15. Consumers are likely to believe that JAZZBERRY MIX tobacco products originate from Middleton or are somehow affiliated with Middleton and its JAZZ, BLACK & MILD JAZZ, and WINE BERRY brands, as the JAZZBERRY MIX mark combines Middleton's highly distinctive JAZZ mark with a component of its WINE BERRY mark. As such, Applicant's JAZZBERRY MIX mark so resembles Middleton's previously used JAZZ, BLACK & MILD JAZZ, and WINE BERRY marks, and previously registered, BLACK & MILD JAZZ and WINE BERRY marks, as to be likely, when used in connection with Applicant's Goods, to cause confusion, to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the products Applicant allegedly intends to sell under the JAZZBERRY MIX designation are produced, sponsored, endorsed, or approved by Middleton, or are in some way affiliated, connected, or associated with Middleton, all to the detriment of Middleton. Registration of Applicant's mark, therefore, should be refused under 15 U.S.C. §§ 1052(d) and 1063.

16. Registration of Applicant's proposed mark JAZZBERRY MIX would be a further source of damage to Middleton because it would confer upon Applicant various statutory



presumptions to which it is not entitled in view of Middleton's prior adoption, use, and registration of its marks.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Opposer John Middleton Co. respectfully requests that its Notice of Opposition be sustained and that the registration of the mark shown in Application Serial No. 85/857,007 be refused.

Please direct all correspondence with respect to this Opposition to Joel D. Leviton at the address below. Please charge the Notice of Opposition fee to the Deposit Account of Fish & Richardson P.C., Account No. 06-1050.

Respectfully Submitted,

Date November 26, 2013

/Joel D. Leviton/  
Joel D. Leviton  
Kathy Tsai  
FISH & RICHARDSON P.C.  
60 South Sixth Street, Suite 3200  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696

Attorneys for John Middleton Co.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served this 26th day of November, 2013, by First Class U.S. Mail, postage prepaid, upon Applicant Sinbad Grand Cafe, L.L.C.'s attorney of record at the following address:

Mary Margaret L. O'Donnell  
Blue Filament Law PLLC  
450 N. Old Woodward Avenue  
First Floor  
BIRMINGHAM, MICHIGAN 48009  
UNITED STATES

/Joel D. Leviton/  
Joel D. Leviton

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# **EXHIBIT A**

# United States of America

United States Patent and Trademark Office

## BLACK & MILD JAZZ

**Reg. No. 4,298,617**

**Registered Mar. 5, 2013**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

JOHN MIDDLETON CO. (PENNSYLVANIA LIMITED LIABILITY COMPANY)  
6603 WEST BROAD STREET  
RICHMOND, VA 23230

FOR: TOBACCO PRODUCTS, NAMELY, CIGARS, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 8-15-2012; IN COMMERCE 8-15-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SEC. 2(F) AS TO "BLACK & MILD".

OWNER OF U.S. REG. NOS. 1,177,552, 2,720,516, AND OTHERS.

SN 85-187,140, FILED 11-30-2010.

TARAH HARDY, EXAMINING ATTORNEY



*Liam Street, Esq.*  
Acting Director of the United States Patent and Trademark Office

# **EXHIBIT B**

Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

United States Patent and Trademark Office

Reg. No. 3,095,386

Registered May 23, 2006

TRADEMARK  
PRINCIPAL REGISTER

WINE BERRY

JMTM, INC. (DELAWARE CORPORATION)  
1105 N. MARKET STREET  
WILMINGTON, DE 198998985

FOR: CIGARS AND PIPE TOBACCO, IN CLASS 34  
(U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 8-15-2005; IN COMMERCE 8-15-2005.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "BERRY", APART FROM THE  
MARK AS SHOWN.

SER. NO. 78-632,173, FILED 5-18-2005.

SUSAN STIGLITZ, EXAMINING ATTORNEY





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## WINE BERRY

<b>Word Mark</b>	WINE BERRY
<b>Goods and Services</b>	IC 034. US 002 008 009 017. G & S: cigars and pipe tobacco. FIRST USE: 20050815. FIRST USE IN COMMERCE: 20050815
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	78632173
<b>Filing Date</b>	May 18, 2005
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	February 28, 2006
<b>Registration Number</b>	3095386
<b>Registration Date</b>	May 23, 2006
<b>Owner</b>	(REGISTRANT) JMTM, Inc. CORPORATION DELAWARE 1105 N. Market Street Wilmington DELAWARE 198998985
	(LAST LISTED OWNER) JOHN MIDDLETON CO. LIMITED LIABILITY COMPANY PENNSYLVANIA 6603 West Broad Street Richmond VIRGINIA 23230
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Timothy G. Hofmeyer
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BERRY" APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	TRADEMARK

**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR).  
**Live/Dead Indicator** LIVE

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