

ESTTA Tracking number: **ESTTA638698**

Filing date: **11/13/2014**

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	Philip Morris USA Inc.		
Entity	Corporation	Citizenship	Virginia
Address	6601 West Broad Street Richmond, VA 23230 UNITED STATES		

Correspondence information	Joel D. Leviton Attorney for Opposer STINSON LEONARD STREET LLP 150 South Fifth Street, Suite 2300 Minneapolis, MN 55402 UNITED STATES trademark.mpl@stinsonleonard.com, Joel.Leviton@stinsonleonard.com,Laila.Wolfgram@stinsonleonard.com Phone:(612) 335-1562
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**Applicant Information**

Application No	86078721	Publication date	10/21/2014
Opposition Filing Date	11/13/2014	Opposition Period Ends	11/20/2014
Applicant	Sweet Mark, LLC 303 Roxbury Industrial Center Charles City, VA 23030 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: chemical flavorings in liquid form used to refill cartridges used in electronic cigarettes, electronic pipes, and additional electronic smoking devices
Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Electronic cigarettes; electronic smoking pipes; electronic cigars, electronic hookahs, electronic smokeless cigar and cigarette vaporizer pipes


**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	894450	Application Date	08/05/1968
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Registration Date	07/14/1970	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1968/07/24 First Use In Commerce: 1968/07/24 CIGARETTES		

U.S. Registration No.	912374	Application Date	06/18/1969
Registration Date	06/08/1971	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1968/07/24 First Use In Commerce: 1968/07/24 CIGARETTES		

U.S. Registration No.	912375	Application Date	06/18/1969
Registration Date	06/08/1971	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 1968/07/24 First Use In Commerce: 1968/07/24 CIGARETTES

U.S. Registration No.	3780624	Application Date	09/01/2009
Registration Date	04/27/2010	Foreign Priority Date	NONE

Word Mark	VS VIRGINIA SLIMS SUPERSLIMS 20 CLASS ACIGARETTES
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Design Mark	
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Description of	The mark consists of a rectangular design which is divided into two smaller rect-
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Mark	angles, one large white rectangle with a gray paisley design throughout and one small rectangle with a red, yellow, pink, and lavender marbled design throughout. There are vertical silver strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS", in red, are located horizontally in the upper right-hand corner of the large white rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS", in red, are located vertically on the left-hand side of the large white rectangle. The words "20 CLASS A CIGARETTES", in silver, are located vertically in the lower right-hand corner of the large white rectangle.
Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes


U.S. Registration No.	3789794	Application Date	09/01/2009
Registration Date	05/18/2010	Foreign Priority Date	NONE

Word Mark	VIRGINIA SLIMS SUPERSLIMS VS 20 CLASS A CIGARETTES
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Design Mark	
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Description of Mark	The mark consists of a rectangular design which is divided into two smaller rectangles, one large rectangle with a paisley design throughout and one small rectangle with a marbled design throughout. There are vertical strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS" are located horizontally in the upper right-hand corner of the large rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS" are located vertically on the left-hand side of the large rectangle. The words "20 CLASS A CIGARETTES" are located vertically in the lower right-hand corner of the large rectangle.
Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes

U.S. Registration No.	3787090	Application Date	09/01/2009
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Registration Date	05/11/2010	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20CLASS A CIGARETTES		
Design Mark			
Description of Mark	<p>The mark consists of a rectangular design which is divided into two smaller rectangles, one large white rectangle with a gray paisley design throughout and one small rectangle with a yellow, green, light green, blue, light blue, and dark blue marbled design throughout. There are vertical silver strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS", in green, are located horizontally in the upper right-hand corner of the large white rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS", in green, are located vertically on the left-hand side of the large white rectangle. The word "MENTHOL", in green, is located vertically in the lower right-hand corner of the large white rectangle. The words "20 CLASS A CIGARETTES", in silver, are located vertically to the right of the word "MENTHOL" in the lower right-hand corner of the large white rectangle.</p>		
Goods/Services	Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes		

U.S. Registration No.	3783883	Application Date	09/01/2009
Registration Date	05/04/2010	Foreign Priority Date	NONE
Word Mark	VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20CLASS A CIGARETTES		

Design Mark	
Description of Mark	<p>The mark consists of a rectangular design which is divided into two smaller rectangles, one large rectangle with a paisley design throughout and one small rectangle with a marbled design throughout. There are vertical strips on the left-hand and right-hand sides of the small marbled rectangle which is located on the left-hand side of the design. The letters "VS" are located horizontally in the upper right-hand corner of the large rectangle which is located on the right-hand side of the design. The words "VIRGINIA SLIMS SUPERSLIMS" are located vertically on the left-hand side of the large rectangle. The word "MENTHOL" is located vertically in the lower right-hand corner of the large rectangle. The words "20 CLASS A CIGARETTES" are located vertically to the right of the word "MENTHOL" in the lower right-hand corner of the large rectangle.</p>
Goods/Services	<p>Class 034. First use: First Use: 2009/08/17 First Use In Commerce: 2009/08/17 Tobacco Products, Namely, Cigarettes</p>

Attachments	<p>72330405#TMSN.png( bytes )  72330406#TMSN.png( bytes )  77817162#TMSN.png( bytes )  77817170#TMSN.png( bytes )  77817181#TMSN.png( bytes )  77817187#TMSN.png( bytes )  VIRGINIA HERITAGE Notice of Opposition - Final.PDF(922240 bytes )</p>
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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	/laila s. wolgram/
Name	Laila S. Wolfgram
Date	11/13/2014






## FACTUAL BACKGROUND

3. PM USA manufactures the famous VIRGINIA SLIMS brand of cigarettes, which are sold to adult smokers. VIRGINIA SLIMS cigarettes have been marketed and sold to adult smokers for more than four decades, since at least as early as 1968.

4. In addition to its longstanding common law rights in its VIRGINIA SLIMS trademark, PM USA owns numerous federal trademark registrations for marks comprising or containing the distinctive VIRGINIA SLIMS trademark, including the following trademarks (the “VIRGINIA SLIMS Marks”):

Trademark	Registration No.	Date Registered	Goods
VIRGINIA SLIMS	Incontestable Reg. No. 894,450	July 14, 1970	Cigarettes
	Incontestable Reg. No. 912,374	June 8, 1971	Cigarettes
	Incontestable Reg. No. 912,375	June 8, 1971	Cigarettes
	Reg. No. 3,780,624	April 27, 2010	Tobacco products, namely, cigarettes



	Reg. No. 3,789,794	May 18, 2010	Tobacco products, namely, cigarettes
	Reg. No. 3,787,090	May 11, 2010	Tobacco products, namely, cigarettes
	Reg. No. 3,783,883	May 4, 2010	Tobacco products, namely, cigarettes

Copies of printouts from the Trademark Status and Document Retrieval system showing the current status of these marks are attached to this Notice of Opposition and marked as Exhibit A.

5. The VIRGINIA SLIMS Marks are distinctive, valid, and subsisting, and several of the registrations for these marks are incontestable.

6. PM USA has spent substantial time, effort, and money advertising and promoting the VIRGINIA SLIMS trademark, the VIRGINIA SLIMS Marks, and VIRGINIA SLIMS cigarettes to adult smokers. Through its longstanding, continuous use of the VIRGINIA SLIMS Marks, PM USA has developed significant goodwill in the VIRGINIA SLIMS Marks, which the public associates exclusively with PM USA and the cigarette products that it markets and sells to adult smokers.

7. PM USA's VIRGINIA SLIMS trademark for cigarettes has become famous, and VIRGINIA SLIMS is, to this day, one of the best-selling and most recognizable cigarette brands in the United States.

8. On September 30, 2013, Applicant filed an application to register the mark VIRGINIA HERITAGE in connection with "chemical flavorings in liquid form used to refill cartridges used in electronic cigarettes, electronic pipes, and additional electronic smoking devices" in Class 30 and "electronic cigarettes; electronic smoking pipes; electronic cigars, electronic hookahs, electronic smokeless cigar and cigarette vaporizer pipes" in Class 34, which was designated Application Serial No. 86/078,721 (the "Virginia Heritage Application").

9. On January 21, 2014, an Attorney Advisor informed the Examining Attorney that Opposer filed a letter of protest against the Virginia Heritage Application on the basis of a likelihood of confusion with several of the VIRGINIA SLIMS Marks.

10. The Examining Attorney issued an office action on February 6, 2014 refusing registration of the Virginia Heritage Application on the basis of a likelihood of confusion with the VIRGINIA SLIMS Marks. The Applicant filed a response to this office action on August 6, 2014, and the Examining Attorney subsequently withdrew the refusal to register the VIRGINIA HERITAGE mark.

11. The Virginia Heritage Application was published for opposition in the *Official Gazette* on October 21, 2014. This Notice of Opposition is being filed prior to the expiration of the publication period which ends on November 20, 2014 and therefore has been filed in a timely manner.

## **GROUND FOR OPPOSITION**

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

12. There is no issue as to priority. Applicant filed the Virginia Heritage Application as intent-to-use and has not filed an amendment to allege use as of the filing date of this Notice of Opposition. PM USA began using its VIRGINIA SLIMS trademark at least as early as July 24, 1968 and all of PM USA's registrations set forth in Paragraph 4 of this Notice of Opposition issued years before

Applicant filed its Virginia Heritage Application. Upon information and belief, PM USA's common law and statutory priority dates precede any date of first use upon which Applicant may rely.

13. Applicant's VIRGINIA HERITAGE mark is confusingly similar to PM USA's VIRGINIA SLIMS trademark and the collective group of VIRGINIA SLIMS Marks.

14. PM USA's VIRGINIA SLIMS Marks and Applicant's VIRGINIA HERITAGE mark both incorporate the term VIRGINIA. Given the notoriety of the VIRGINIA SLIMS Marks and PM USA's extensive family of VIRGINIA SLIMS Marks used in connection with cigarettes, it is likely that people will mistakenly associate Applicant's use of VIRGINIA in a trademark used in connection with tobacco products as emanating from PM USA.

15. PM USA has developed enormous goodwill in the VIRGINIA SLIMS Marks, and the public has come to associate these marks exclusively with PM USA and its products. Apart from PM USA's VIRGINIA SLIMS Marks, there are very few, if any, registrations for cigarettes in International Class 34 that include "VIRGINIA" as a dominant element of the mark or actually part of the brand name. In addition, to maintain the distinctiveness of the famous VIRGINIA SLIMS trademark, PM USA has a long and successful history of vigorously protecting its VIRGINIA SLIMS trademark, including by objecting to and preventing the use of the term VIRGINIA in or as a trademark for cigarettes, electronic cigarettes and related goods. PM USA's VIRGINIA SLIMS Marks are thus unique and highly distinctive in the field.

16. The Virginia Heritage Application covers products that are similar to the products PM USA offers under its VIRGINIA SLIMS Marks.

17. Upon information and belief, Applicant intends to market its products under the VIRGINIA HERITAGE mark to the same type of consumers that purchase PM USA's VIRGINIA SLIMS cigarettes, namely, adult tobacco consumers, and in the same channels of trade in which PM USA's VIRGINIA SLIMS cigarettes are sold.

18. Applicant's VIRGINIA HERITAGE mark so resembles PM USA's previously adopted, used, and registered VIRGINIA SLIMS trademark and the VIRGINIA SLIMS Marks as to be likely, when used in connection with the goods identified in the Virginia Heritage Application, to cause confusion, to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the tobacco and tobacco-related products Applicant allegedly intends to offer under its VIRGINIA HERITAGE mark are produced, sponsored, endorsed, or approved by PM USA, or are in some way affiliated, connected, or associated with PM USA or the VIRGINIA SLIMS trademark, all to the detriment of PM USA. Registration of Applicant's mark, therefore, should be refused under 15 U.S.C. §§ 1052(d) and 1063.

#### **Likelihood of Dilution**

19. PM USA's VIRGINIA SLIMS trademark is famous and distinctive within the meaning of 15 U.S.C. §1125(c). The VIRGINIA SLIMS trademark became famous and distinctive long before Applicant filed its application on September 30, 2013.

20. Applicant's use of its VIRGINIA HERITAGE mark is likely to dilute the distinctiveness of PM USA's VIRGINIA SLIMS trademark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), by eroding public identification of the VIRGINIA SLIMS trademark with PM USA.

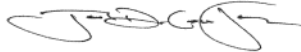
21. Registration of Applicant's proposed VIRGINIA HERITAGE mark would be a further source of damage to PM USA because it would confer upon Applicant various statutory presumptions to which it is not entitled in view of PM USA's long prior use and registration of its well-known VIRGINIA SLIMS Marks.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Opposer PM USA respectfully requests that its opposition be sustained and that registration of the mark shown in Application Serial No. 86/078,721 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 Stinson Leonard Street LLP Account No.19-4409.

PHILIP MORRIS USA INC.

By:



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Joel D. Leviton  
Laila S. Wolfgram  
STINSON LEONARD STREET LLP  
150 South Fifth Street, Suite 2300  
Minneapolis, MN 55402  
Tel: (612) 335-1562  
Fax: (612) 335-1657

Attorneys for Philip Morris USA Inc.

Dated: November 13, 2014

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition was served on November 13, 2014, upon the following attorney for Applicant via FedEx overnight courier:

IAN D. TITLEY  
SCHRODER FIDLOW, PLC  
1901 E. FRANKLIN STREET, SUITE 107  
RICHMOND, VIRGINIA 23223-6966

*Laila S. Wolfgram*  
\_\_\_\_\_  
Laila S. Wolfgram

Dated: November 13, 2014

# EXHIBIT A

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**Mark:** VIRGINIA SLIMS

No Image exists  
for this case.

**US Serial Number:** 72304382

**Application Filing Date:** Aug. 05, 1

**US Registration Number:** 894450

**Registration Date:** Jul. 14, 19

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Jul. 06, 2010

## Mark Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 232616603  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** VIRGINIA



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**[Maintenance Filings or Post Registration Information](#)**

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**Mark:** VIRGINIA SLIMS



**US Serial Number:** 72330405

**Application Filing Date:** Jun. 18, 19

**US Registration Number:** 912374

**Registration Date:** Jun. 08, 19

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Jun. 02, 2011

## Mark Information

## Related Properties Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 232616603  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** VIRGINIA

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**[Prosecution History](#)**

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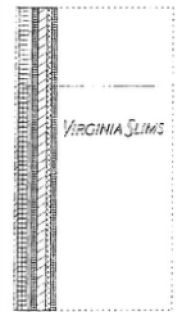
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**Mark:** VIRGINIA SLIMS



**US Serial Number:** 72330406

**Application Filing Date:** Jun. 18, 19

**US Registration Number:** 912375

**Registration Date:** Jun. 08, 19

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Jun. 02, 2011

## Mark Information

## Related Properties Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 23140  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** VIRGINIA

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**Mark:** VS VIRGINIA SLIMS SUPERSLIMS 20 CLASS A CIGARETTES



**US Serial Number:** 77817162

**Application Filing Date:** Sep. 01, 2010

**US Registration Number:** 3780624

**Registration Date:** Apr. 27, 2010

**Register:** Principal

**Mark Type:** Trademark

**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Status Date:** Apr. 27, 2010

**Publication Date:** Feb. 09, 2010

## Mark Information

## Related Properties Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 23230  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

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**Mark:** VIRGINIA SLIMS SUPERSLIMS VS 20 CLASS A CIGARETTES



**US Serial Number:** 77817170

**Application Filing Date:** Sep. 01, 2010

**US Registration Number:** 3789794

**Registration Date:** May 18, 2010

**Register:** Principal

**Mark Type:** Trademark

**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Status Date:** May 18, 2010

**Publication Date:** Mar. 02, 2010

## Mark Information

## Related Properties Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 23230  
UNITED STATES



Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

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**Mark:** VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20 CLASS A CIGARETTES



**US Serial Number:** 77817181

**Application Filing Date:** Sep. 01, 2010

**US Registration Number:** 3787090

**Registration Date:** May 11, 2010

**Register:** Principal

**Mark Type:** Trademark

**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Status Date:** May 11, 2010

**Publication Date:** Feb. 23, 2010

## Mark Information

## Related Properties Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 23230  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

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**Mark:** VIRGINIA SLIMS SUPERSLIMS VS MENTHOL 20 CLASS A CIGARETTES



**US Serial Number:** 77817187

**Application Filing Date:** Sep. 01, 2010

**US Registration Number:** 3783883

**Registration Date:** May 04, 2010

**Register:** Principal

**Mark Type:** Trademark

**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Status Date:** May 04, 2010

**Publication Date:** Feb. 16, 2010

## Mark Information

## Related Properties Information

## Goods and Services

## Basis Information (Case Level)

## Current Owner(s) Information

**Owner Name:** Philip Morris USA Inc.

**Owner Address:** 6601 West Broad Street  
Richmond, VIRGINIA 23230  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: VIRGINIA

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