

ESTTA Tracking number: **ESTTA658261**

Filing date: **02/26/2015**

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	ZippMark, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1105 North Market Street, Suite 1300 Wilmington, DE 19801 UNITED STATES		

Attorney information	David S. Elkins, Joseph P. Grasser Squire Patton Boggs (US) LLP 600 Hansen Way Palo Alto, CA 94304 UNITED STATES Dav- id.Elkins@squirepb.com,Joseph.Grasser@squirepb.com,Amanpreet.Kaur@squ irepb.com,trademark@squirepb.com Phone:650.856.6500
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**Applicant Information**

Application No	86270209	Publication date	02/03/2015
Opposition Filing Date	02/26/2015	Opposition Period Ends	03/05/2015
Applicant	Lorillard Technologies, Inc. 714 Green Valley Road Greensboro, NC 27408 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarette batteries and electronic cigarette battery chargers
Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: cartridges sold filled with chemical flavorings in liquid form
Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarettes and components thereof, namely, refill cartridges sold empty, cartomizers, atomizers; empty refill cartridges, carrying cases for electronic cigarettes and holders for electronic cigarettes; electronic cigarette starter kits comprised primarily of electronic cigarettes, electronic cigarette batteries, electronic cigarette battery chargers, and cartridges sold filled with chemical flavorings in liquid form; electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges sold empty, cartomizers, and atomizers; empty refill cartridges for electronic cigarettes; carrying cases for electronic cigarettes; holders for electronic cigarettes

**Applicant Information**

Application No	86270213	Publication date	02/03/2015
Opposition Filing Date	02/26/2015	Opposition Period Ends	03/05/2015
Applicant	Lorillard Technologies, Inc. 714 Green Valley Road Greensboro, NC 27408 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarette batteries and electronic cigarette battery chargers
Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: cartridges sold filled with chemical flavorings in liquid form
Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarettes and components thereof, namely, refill cartridges sold empty, cartomizers, atomizers; empty refill cartridges, carrying cases for electronic cigarettes and holders for electronic cigarettes; electronic cigarette starter kits comprised primarily of electronic cigarettes, electronic cigarette batteries, electronic cigarette battery chargers, and cartridges sold filled with chemical flavorings in liquid form; electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges sold empty, cartomizers, and atomizers; empty refill cartridges for electronic cigarettes; carrying cases for electronic cigarettes; holders for electronic cigarettes

### Applicant Information

Application No	86291961	Publication date	02/03/2015
Opposition Filing Date	02/26/2015	Opposition Period Ends	03/05/2015
Applicant	Lorillard Technologies, Inc. 714 Green Valley Road Greensboro, NC 27408 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarette batteries and electronic cigarette battery chargers
Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: cartridges sold filled with chemical flavorings in liquid form
Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarettes and components thereof, namely, refill cartridges sold empty, cartomizers, atomizers; empty refill cartridges, carrying cases for electronic cigarettes and holders for electronic cigarettes; electronic cigarette starter kits comprised primarily of electronic cigarettes, electronic cigarette batteries, electronic cigarette battery chargers, and cartridges sold filled with chemical flavorings in liquid form; electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges sold empty, cartomizers, and atomizers; empty refill cartridges for electronic cigarettes; carrying cases for electronic cigarettes; holders for electronic cigarettes

### Applicant Information

Application No	86270221	Publication date	02/10/2015
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Opposition Filing Date	02/26/2015	Opposition Period Ends	03/12/2015
Applicant	Lorillard Technologies, Inc. 714 Green Valley Road Greensboro, NC 27408 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarette batteries and electronic cigarette battery chargers
Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: cartridges sold filled with chemical flavorings in liquid form
Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarettes and components thereof, namely, refill cartridges sold empty, cartomizers, atomizers; empty refill cartridges, carrying cases for electronic cigarettes and holders for electronic cigarettes; electronic cigarette starter kits comprised primarily of electronic cigarettes, electronic cigarette batteries, electronic cigarette battery chargers, and cartridges sold filled with chemical flavorings in liquid form; electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges sold empty, cartomizers, and atomizers; empty refill cartridges for electronic cigarettes; carrying cases for electronic cigarettes; holders for electronic cigarettes

### Applicant Information

Application No	86278810	Publication date	02/10/2015
Opposition Filing Date	02/26/2015	Opposition Period Ends	03/12/2015
Applicant	Lorillard Technologies, Inc. 714 Green Valley Road Greensboro, NC 27408 UNITED STATES		


### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarette batteries and electronic cigarette battery chargers
Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: cartridges sold filled with chemical flavorings in liquid form
Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: electronic cigarettes and components thereof, namely, refill cartridges sold empty, cartomizers, atomizers; empty refill cartridges, carrying cases for electronic cigarettes and holders for electronic cigarettes; electronic cigarette starter kits comprised primarily of electronic cigarettes, electronic cigarette batteries, electronic cigarette battery chargers, and cartridges sold filled with chemical flavorings in liquid form; electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges sold empty, cartomizers, and atomizers; empty refill cartridges for electronic cigarettes; carrying cases for electronic cigarettes; holders for electronic cigarettes


### Grounds for Opposition

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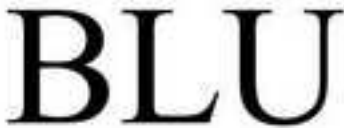
## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3299190	Application Date	06/30/2005
Registration Date	09/25/2007	Foreign Priority Date	NONE
Word Mark	BLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2005/06/30 First Use In Commerce: 2007/03/16 Lighters not of precious metal		

U.S. Registration No.	3469390	Application Date	06/30/2005
Registration Date	07/15/2008	Foreign Priority Date	NONE
Word Mark	BLU		


Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2007/04/24 First Use In Commerce: 2007/04/24 Hand-held cigarette and utility lighters of precious metal		


U.S. Registration No.	3606674	Application Date	06/19/2007
Registration Date	04/14/2009	Foreign Priority Date	NONE

Word Mark	BLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2007/10/02 First Use In Commerce: 2007/10/02 FUEL FOR LIGHTERS		

U.S. Registration No.	3680360	Application Date	06/19/2007
Registration Date	09/08/2009	Foreign Priority Date	NONE
Word Mark	BLU		

Design Mark	<h1>BLU</h1>		
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2007/03/16 First Use In Commerce: 2007/03/16 LIGHTERS NOT OF PRECIOUS METAL; LIGHTERS OF PRECIOUS METAL		

U.S. Registration No.	3299195	Application Date	07/01/2005
Registration Date	09/25/2007	Foreign Priority Date	NONE
Word Mark	ZIPPOBLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2005/07/01 First Use In Commerce: 2007/03/16 Lighters not of precious metal		

U.S. Registration No.	3464056	Application Date	07/01/2005
Registration Date	07/08/2008	Foreign Priority Date	NONE
Word Mark	ZIPPOBLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2007/04/24 First Use In Commerce: 2007/04/24 Cigarette and utility lighters of precious metal		

Related Proceedings	US Patent and Trademark Office Trademark Trial and Appeal Board Proceedings, Nos. 91215582, 91204186, and 91219830; UNITED STATES DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA, Case No. 2:14-CV-02596 RGK (FFMx)
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Attachments	78662091#TMSN.png( bytes ) 78662100#TMSN.png( bytes ) 77209860#TMSN.png( bytes ) 77209871#TMSN.png( bytes ) 78662768#TMSN.png( bytes ) 78662779#TMSN.png( bytes ) Consolidated Notice of Opposition.pdf(14198 bytes ) Exhibit A.pdf(421032 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	/David S. Elkins/
Name	David S. Elkins, Joseph P. Grasser
Date	02/26/2015

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos. 86/270,209; 86/270,213; 86/291,961; 86/270,221; and 86/278,810

Published in the Official Gazettes of February 3 and February 10, 2015

Marks: **BLU TANK, BLU +, BLU ECIGS PLUS+ (stylized), BLU PLUS, and BLU PLUS+**

ZIPPMARK, INC.,

Opposer,

v.

LORILLARD TECHNOLOGIES, INC.,

Applicant.

**CONSOLIDATED NOTICE OF OPPOSITION**

ZippMark, Inc., (“Opposer” or “ZippMark”), a corporation organized under the laws of Delaware and located at 1105 North Market Street, Suite 1300, Wilmington, DE 19801, believes it will be damaged by registration of the following marks for which Lorillard Technologies, Inc. (“Applicant” or “LTI”) has applied (the “Opposed Marks”):

<b>Mark</b>	<b>App. Serial No.</b>
BLU TANK	86/270,209
BLU +	86/270,213
BLU ECIGS PLUS+ (stylized)	86/291,961
BLU PLUS	86/270,221
BLU PLUS+	86/278,810

ZippMark opposes registration of each Opposed Mark in this Consolidated Notice of Opposition under Trademark Board Manual for Procedure §305, *et seq.* and 37 CFR §2.104(b). In particular, ZippMark believes that registering the Opposed Marks would give rise to a likelihood of



confusion with ZippMark's existing domestic and international BLU registered and common law trademarks in violation of 15 U.S.C. §§ 1052(d) and §43(a).

The grounds for opposition are as follows:

1. ZippMark and its related company, Zippo Manufacturing Co. ("ZMC"), manufacture and offer for sale their world famous flip-top lighters and other goods under the equally famous ZIPPO trade name. The company has done so for nearly eight decades.
2. As detailed below, ZippMark and ZMC have expanded into new designs using their distinctive BLU trademarks.
3. ZippMark and ZMC have been using the BLU trademarks by exclusively distributing, advertising and selling their lighters and other related products bearing their BLU trademarks since at least 2007, before Applicant's claimed use of the marks in the intent to use applications at issue. As a result, ZippMark has developed common law rights to BLU.
4. In addition to its common law rights, ZippMark owns six trademark registrations for BLU in various forms and classes, including:
  - a. U.S. Registration No. 3299190 for BLU and design for lighters not of precious metal in International Class 034, filed on June 30, 2005 and registered September 25, 2007;
  - b. U.S. Registration No. 3469390 for BLU and design for hand-held cigarette and utility lighters of precious metal in International Class 014, filed on June 30, 2005 and registered July 15, 2008;
  - c. U.S. Registration No. 3606674 for BLU for fuel for lighters in International Class 004, filed on June 19, 2007 and registered on April 14, 2009;

- d. U.S. Registration No. 3680360 for BLU for lighters not of precious metal and lighters of precious metal in International Class 034, first used in commerce on March 16, 2007, filed on June 19, 2007, and registered on September 8, 2009;
- e. U.S. Registration No. 3299195 for ZIPPOBLU and design for lighters not of precious metal in International Class 034, filed on July 1, 2005 and registered September 25, 2007; and
- f. U.S. Registration No. 3464056 for ZIPPOBLU and design for cigarette and utility lighters of precious metal in International Class 014, filed on July 1, 2005 and registered July 8, 2008.

(collectively the “ZippMark BLU registrations”). Copies of the ZippMark BLU registration certificates are attached as Exhibit A.

5. ZippMark and its related companies have sold significant numbers of Zippo lighters and related products bearing the Zippo BLU marks throughout the United States since at least 2007. ZippMark and its related companies have also extensively advertised and promoted the Zippo BLU marks and products in the United States and throughout the world. Indeed, products bearing the BLU mark, as well as the BLU mark itself, have been the subject of press reports.

6. By virtue of such extensive domestic and international sales, advertising, promotion, and press coverage, the BLU marks have brought, and continue to bring, significant goodwill to ZippMark and ZMC.

7. Applicant filed three applications (serial numbers 86/270,209, 86/270,213, and 86/270,221) on May 2, 2014; one application (serial number 86/278,810) on May 12, 2014; and

one application (serial number 86/291,961) on May 27, 2014. Each of these applications claims the following goods and services:

- a. “[E]lectronic cigarette batteries and electronic cigarette battery chargers” in International Class 009;
- b. “[C]artridges sold filled with chemical flavorings in liquid form” in International Class 030; and
- c. “[E]lectronic cigarettes and components thereof, namely, refill cartridges sold empty, cartomizers, atomizers; empty refill cartridges, carrying cases for electronic cigarettes and holders for electronic cigarettes; electronic cigarette starter kits comprised primarily of electronic cigarettes, electronic cigarette batteries, electronic cigarette battery chargers, and cartridges sold filled with chemical flavorings in liquid form; electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges sold empty, cartomizers, and atomizers; empty refill cartridges for electronic cigarettes; carrying cases for electronic cigarettes; holders for electronic cigarettes” in International Class 034.

8. Applicant’s basis for filing these applications is an intent to use, with no present use in commerce.

9. Applicant’s use of the Opposed Marks is likely to (a) cause confusion, mistake or deception with Zippmark’s BLU marks, and (b) result in the incorrect perception or belief that Applicant or Applicant's BLU electronic cigarette products are in some way associated with or sponsored by ZippMark or ZMC. The Opposed Marks are nearly identical in sound, appearance, meaning, connotation and commercial impression to Opposer’s existing trade name and BLU

marks. The addition of “TANK,” “ECIGS,” “PLUS,” or “+” is of little significance to the commercial impression of the otherwise identical mark particularly because these additions are descriptive of the goods – “ECIGS” is an abbreviated form of “electronic cigarettes;” “TANK,” which is a storage chamber for liquid, is simply another word for the cartridges filled with chemical flavoring; and “PLUS” or “+” represents all “additional” components and accessories for electronic cigarettes. Also critical is the fact that both Applicant and Opposer market to and serve the same or similar consumer populations with their respective products: adults who smoke.

10. Upon information and belief, neither Applicant nor a predecessor or related company made commercial use of the Opposed Marks before the date of any of ZippMark’s BLU registrations.

11. Applicant’s proposed use of and applications to register the Opposed Marks are without Opposer’s consent or permission.

WHEREFORE, Opposer ZippMark, Inc. believes that it would be damaged by the registration by Applicant of the Opposed Marks for the goods identified in Application Serial Nos. 86/270,209; 86/270,213; 86/291,961; 86/270,221; and 86/278,810, and prays that this Opposition be sustained and that said Applications be refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §§ 1052(d).

Opposer hereby appoints David S. Elkins, Joseph P. Grasser and Amanpreet Kaur, all members of the Bar of the State of California and all of the law firm

Squire Patton Boggs (US) LLP  
600 Hansen Way  
Palo Alto, California 94304  
Telephone (650) 856-6500  
Facsimile (650) 843-8777

to transact all business in the Patent and Trademark Office in connection with the above opposition proceeding. Please address all correspondence to:

David S. Elkins  
Joseph P. Grasser  
Amanpreet Kaur  
Squire Patton Boggs (US) LLP  
600 Hansen Way  
Palo Alto, California 94304  
David.Elkins@squirepb.com  
Joseph.Grasser@squirepb.com  
Amanpreet.Kaur@squirepb.com  
trademark@squirepb.com

Date: February 26, 2015

Respectfully Submitted,

By: s/David S. Elkins/  
David S. Elkins  
Joseph P. Grasser  
Amanpreet Kaur  
SQUIRE PATTON BOGGS (US) LLP  
600 Hansen Way  
Palo Alto, California 94304  
Telephone:(650) 856-6500  
Facsimile: (650) 843-8777

Attorneys for Opposer  
ZIPPMARK, INC.

**PROOF OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **CONSOLIDATED NOTICE OF OPPOSITION** has been served on Applicant LORILLARD TECHNOLOGIES, INC. by mailing same via First Class Mail, postage prepaid, addressed to Applicant's counsel as follows:

Eric T. Fingerhut  
Dykema Gossett PLLC  
1300 I ST NW Ste 300  
Washington, D.C. 20005-3314

Executed on February 26, 2015

By: s/David S. Elkins/

# **EXHIBIT A**

**Int. Cl.: 34**

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

**United States Patent and Trademark Office**

**Reg. No. 3,299,190**

**Registered Sep. 25, 2007**

**TRADEMARK  
PRINCIPAL REGISTER**



ZIPPMARK, INC. (DELAWARE CORPORATION)  
103 SPRINGER BUILDING  
3411 SILVERSIDE ROAD  
WILMINGTON, DE 19810

FIRST USE 6-30-2005; IN COMMERCE 3-16-2007.

SN 78-662,091, FILED 6-30-2005.

FOR: LIGHTERS NOT OF PRECIOUS METAL, IN  
CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

KEVON CHISOLM, EXAMINING ATTORNEY



**Int. Cl.: 34**

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

**United States Patent and Trademark Office**

**Reg. No. 3,299,195**

**Registered Sep. 25, 2007**

**TRADEMARK  
PRINCIPAL REGISTER**



ZIPPMARK, INC. (DELAWARE CORPORATION)  
103 SPRINGER BUILDING  
3411 SILVERSIDE ROAD  
WILMINGTON, DE 19810

OWNER OF U.S. REG. NOS. 2,001,509, 2,116,481,  
AND OTHERS.

FOR: LIGHTERS NOT OF PRECIOUS METAL, IN  
CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

SN 78-662,768, FILED 7-1-2005.

FIRST USE 7-1-2005; IN COMMERCE 3-16-2007.

KEVON CHISOLM, EXAMINING ATTORNEY

**Int. Cl.: 14**

**Prior U.S. Cls.: 2, 27, 28, and 50**

**Reg. No. 3,464,056**

**United States Patent and Trademark Office**

**Registered July 8, 2008**

**TRADEMARK  
PRINCIPAL REGISTER**



ZIPPMARK, INC. (DELAWARE CORPORATION)  
SUITE 1300  
1105 NORTH MARKET STREET  
WILMINGTON, DE 19801

FIRST USE 4-24-2007; IN COMMERCE 4-24-2007.

OWNER OF U.S. REG. NOS. 2,001,509, 2,116,481,  
AND OTHERS.

FOR: CIGARETTE AND UTILITY LIGHTERS OF  
PRECIOUS METAL, IN CLASS 14 (U.S. CLS. 2, 27, 28  
AND 50).

SN 78-662,779, FILED 7-1-2005.

KEVON CHISOLM, EXAMINING ATTORNEY

**Int. Cl.: 14**

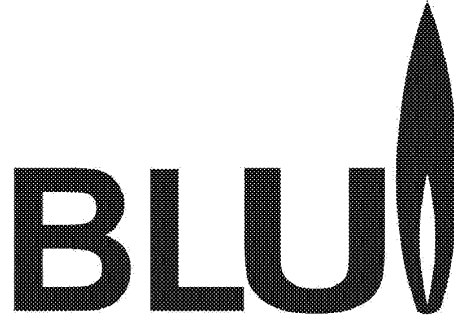
**Prior U.S. Cls.: 2, 27, 28, and 50**

**United States Patent and Trademark Office**

**Reg. No. 3,469,390**

**Registered July 15, 2008**

**TRADEMARK  
PRINCIPAL REGISTER**



ZIPPMARK, INC. (DELAWARE CORPORATION)  
SUITE 1300  
1105 NORTH MARKET STREET  
WILMINGTON, DE 19801

FIRST USE 4-24-2007; IN COMMERCE 4-24-2007.

SN 78-662,100, FILED 6-30-2005.

FOR: HAND-HELD CIGARETTE AND UTILITY  
LIGHTERS OF PRECIOUS METAL, IN CLASS 14  
(U.S. CLS. 2, 27, 28 AND 50).

ATTIYA MALIK, EXAMINING ATTORNEY

**Int. Cl.: 4**

**Prior U.S. Cls.: 1, 6, and 15**

**Reg. No. 3,606,674**

**United States Patent and Trademark Office**

**Registered Apr. 14, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**BLU**

ZIPPMARK, INC. (DELAWARE CORPORATION)  
1105 NORTH MARKET STREET  
SUITE 1300  
WILMINGTON, DE 19801

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

FOR: FUEL FOR LIGHTERS, IN CLASS 4 (U.S.  
CLS. 1, 6 AND 15).

SN 77-209,860, FILED 6-19-2007.

FIRST USE 10-2-2007; IN COMMERCE 10-2-2007.

MICHAEL GAAFAR, EXAMINING ATTORNEY

**Int. Cl.: 34**

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

**Reg. No. 3,680,360**

**United States Patent and Trademark Office**

**Registered Sep. 8, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**BLU**

ZIPPMARK, INC. (DELAWARE CORPORATION)  
1105 NORTH MARKET STREET  
SUITE 1300  
WILMINGTON, DE 19801

FOR: LIGHTERS NOT OF PRECIOUS METAL;  
LIGHTERS OF PRECIOUS METAL, IN CLASS 34  
(U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 3-16-2007; IN COMMERCE 3-16-2007.

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

OWNER OF U.S. REG. NOS. 3,299,190 AND  
3,469,390.

SN 77-209,871, FILED 6-19-2007.

MICHAEL GAAFAR, EXAMINING ATTORNEY