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

Proceeding	91253787
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

REPUBLIC TECHNOLOGIES (NA), LLC)
)
 Opposer,)
)
 v.)
)
VAPEWEAR, INC.,)
)
 Applicant)
)

Opposition No. 91253787

OPPOSER'S TRIAL BRIEF

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I. SUMMARY STATEMENT

For more than 40 years, Republic Technologies (NA), LLC and its predecessors (“Republic”) have successfully and exclusively sold cigarette papers, used for rolling hand-made cigarettes, bearing the trademark JOKER. Republic’s JOKER mark is protected by two federal trademark registrations covering cigarette papers (Reg. Nos. 1087438 and 2661926), the older of which dates back to 1978, and both of which have long been incontestable pursuant to 15 USC §1065.

When Republic acquired the JOKER mark in 2018, it had long been a well-known and successful brand. Since then, Republic has continued to build on the significant consumer goodwill associated with the mark. As a result of Republic’s substantial and successful efforts to market and distribute its JOKER products, as well as Republic’s strict quality control standards, the mark is widely recognized as signifying a distinctive, high-quality paper for roll-your-own tobacco consumers.

Recently, Applicant applied under Section 1(b) of the Lanham Act to register the mark NOJOKE for use with electronic cigarettes, vaporizers and e-liquids. In light of the long history of use and strength of the JOKER mark, the highly similar commercial impression arising from the associative terms JOKER and NOJOKE, the use and intended use of the marks with closely related goods, the channels of trade and target consumers for the relevant goods (which Applicant admits are identical), the lower level of purchaser consideration, and the intent of Applicant in adopting the NOJOKE mark, confusion between the JOKER and NOJOKE marks is likely, and Application No. 88608744 should be refused.

II. DESCRIPTION OF THE RECORD

Republic has made the following evidence of record:

- A. United States Patent and Trademark Office Registration No. 1087438 for



JOKER (stylized):

- B. United States Patent and Trademark Office Registration No. 2661926 for JOKER
& Design: .



- C. The deposition transcript of Michael Willner, Applicant's President, taken on February 12, 2021 (Dkt. No. 13).
- D. Website printouts from third-party sellers of Opposer's products, including www.amazon.com, www.smokersoutletonline.com, www.windycitycigars.com, www.tobaccostock.com, www.ryosupply.com, www.ebay.com, www.rcdwholesale.com, www.bnbtobacco.com, and www.fandfwholesale.com;
- E. Website printouts from third-party e-commerce sites offering a variety of smokers' articles, including www.wildbillstobacco.com, www.tbcolle.com, www.janesvillesmokeshop.com, www.primewholesale.com, www.biglakesmokeshop.com, www.vapersandpapers.com, www.saintlucias.com,

www.shelbywholesale.com, www.tobaccobarntucson.com,
www.vapensmokeshop.com, www.randys.com, www.1percent.com,
www.smokea.com, www.shopluvbucks.com, www.hippiebutler.com, and
www.jokersmokershop.com;

- F. Website printouts of articles from periodicals and trade publications observing trends in contemporary tobacco users' preferences, including www.ncbi.nlm.nih.gov, www.bmcpublichealth.biomedcentral.com, www.sciencedirect.com, and www.annualreviews.org (collectively, Dkt. No. 14).
- G. United States Patent and Trademark Office ("USPTO") Trademark Electronic Search System ("TESS") records showing existing third-party trademarks registered for goods that include cigarette papers, electronic cigarettes and vaporizer products as well as other smokers' articles (Dkt. No. 15).
- H. Applicant's Answers to Opposer's First Set of Interrogatories (cited as "App.'s Ans. to Int. No. __");
- I. Applicant's Supplemental Answers to Opposer's First Set of Interrogatories (cited as "App.'s Supp. Ans. to Int. No. __");
- J. Applicant's Second Supplemental Answers to Opposer's First Set of Interrogatories (cited as "App.'s Sec. Supp. Ans. to Int. No. __") (collectively, Dkt. No. 16).
- K. Declaration of Sachin Lele, Vice President – Legal for Republic, and the exhibits introduced therein (cited as "Lele Dec. __") (Dkt. No. 17).

Applicant has made the following evidence of record:

- A. Republic's Answers to Defendant's Interrogatories (Dkt. No. 18).

B. Declaration of Michael Willner, Applicant’s President (cited as “Willner Dec. ___”) (Dkt. No. 19).

III. STATEMENT OF ISSUE

Whether Applicant’s NOJOKE mark so resembles Republic’s strong JOKER mark such that, when the marks are used in connection with closely related products and sold through identical trade channels to the same targeted consumers, it is likely to cause confusion.

IV. RECITATION OF FACTS

A. The Strength of Republic’s Rights in its JOKER Mark

For many decades continuing to the present day, Republic Technologies, through its predecessors and its exclusive distributor, Republic Tobacco, now known as Republic Brands LP (“Republic Brands”), has sold a variety of smokers’ articles aimed at users who roll or make their own cigarettes (“roll-your-own” products). *Lele Dec.* ¶ 3. These articles include cigarette papers, cigarette filters, cigarette tubes, and cigarette rolling, injecting and making machines. *Id.*

Republic’s JOKER mark likewise has a long commercial history. The mark was first used in commerce in connection with cigarette papers by Robert Burton Associates, Ltd., at least as early as 1975, and it was registered as a federal trademark in 1978. *Id.* ¶ 7. Over the course of more than 45 years of continuous use, the JOKER mark has become a very well-known and highly successful brand. *Id.* Republic acquired the JOKER mark from Robert Burton Associates in March 2018, and with it the significant goodwill associated with JOKER brand’s consumer recognition and market success at that time. *Id.*

Since acquiring the JOKER mark and brand, Republic has continued to build its goodwill. Republic’s JOKER cigarette papers are made of a proprietary blend that consistently delivers a specific texture, thickness, porosity, and adhesive that are preferred by cigarette smokers who roll or make their own cigarettes. *Id.* ¶ 10. To maintain the brand’s integrity, Republic enforces

exact quality standards for its JOKER products. *Id.* JOKER products are inspected, compared to specifications, and reviewed for quality of packaging to ensure that JOKER products are undamaged and live up to the JOKER brand's reputation for quality. *Id.* It may only take one imperfection in the glue or a rip in one rolling paper for a smoker to decide to switch to a different brand of cigarette paper. *Id.* Consumers continue to use JOKER because of the consistently high quality of each paper sold. *Id.*

In addition to maintaining strict quality control, Republic has devoted significant resources to promoting cigarette papers under the JOKER mark, as set forth in more detail below. *Id.* ¶ 11. As a result of its quality control measures, its consistent and successful promotional efforts, and its (and its predecessors') long-standing continuous and exclusive use of the JOKER mark in connection with cigarette papers, consumers recognize the mark as identifying and distinguishing Republic's cigarette papers from smokers' articles provided by other companies. *Id.* ¶ 11. The resulting goodwill in the JOKER mark, developed over more than four decades, is substantial. *Id.*

B. Republic's Promotional Efforts and Channels of Trade

Within the limits of the law, Republic advertises its JOKER cigarette papers extensively and widely. Like advertising of all tobacco products, consumer-facing advertising of roll-your-own products such as cigarette papers is significantly restricted by federal law. For example, in April 1970, Congress passed the Public Health Cigarette Smoking Act of 1969 banning the advertising of cigarettes on television and radio. *See* Pub. L. 91-222; 15 USC § 1335. In addition, manufacturers of tobacco products, including roll-your-own, may not engage in youth marketing. *See* 21 CFR § 1140 *et seq.* The 1997 Tobacco Master Settlement Agreement between the Attorneys General of the 46 settling States and participating manufacturers of tobacco products further restricts manufacturers' marketing activities, prohibiting outdoor advertising such as on billboards and public transportation. Republic and its exclusive distributor, Republic Brands, ensure that all

of their products and advertising comply with all applicable restrictions at all times. Lele Dec. ¶ 22.

Republic promotes its JOKER brand vigorously within these constraints. On behalf of Republic Technologies, Republic Brands extensively advertises cigarette papers in connection with the JOKER mark to wholesalers and retailers at trade shows and through monthly promotional fliers, fact sheets and other promotional material and price lists delivered to actual and potential retailer customers. *Id.* ¶ 13.

Republic Brands also promotes and advertises its products, including cigarette papers in connection with the JOKER mark, to consumers as allowed by law. *Id.* ¶ 14. For retailers generally open to people of all ages, like convenience or drug stores, Republic Brands is restricted to “point-of-sale” promotional materials. *Id.* Republic Brands distributes JOKER cigarette papers in booklets bearing the JOKER word mark. *Id.* These booklets are contained in boxes and/or bowls. *Id.* The boxes are designed to be opened and folded in such a way as to display and highlight the JOKER word and design marks at the time of selection and purchase of the booklets in the retail environment. *Id.* Similarly, the bowls, typically located on the counter of retail stores, have collars that also highlight the JOKER marks. *Id.* Other point-of-sale promotional materials include posters and counter mats, which Republic Brands has used to promote the JOKER brand both by itself and as part of its broader line of products. *Id.* Republic Brands also plans to use product displays, which act as shelving or product stands, and “shelf danglers,” which stick to shelves and draw consumers’ eyes toward products, to promote its JOKER brand in retail stores. *Id.* For adults-only retailers, such as specialty tobacco shops, Republic Brands promotes its products through additional materials such as banners and other signage, and will do so for the JOKER brand in the future. *Id.* ¶ 15.

JOKER branded cigarette papers are now sold nationwide in more than 50,000 convenience stores, gas stations, mini marts, tobacco stores and outlets, mass merchandisers, cash and carry outlets, and other retail locations. *Id.* ¶ 16. In addition, many of these retailers sell their products online. *Id.* As a result, JOKER cigarette papers are widely available online, through retailer websites as well as third-party e-stores like Amazon and Alibaba. *Id.*; *see also* Opposer’s Second Notice of Reliance, ¶ 1.

C. Similarity of the Goods and Consumers

Republic sells a variety of products for people who smoke tobacco, including an array of accessories and implements for rolling loose tobacco into cigarettes. *Id.* ¶ 18. Republic Brands distributes these articles together with tobacco and other smoking-related accessories in stores across the country. *Id.*

The subject application covers electronic cigarettes, oral vaporizers for smokers, and electronic cigarette liquids (“e-liquids”). These products are closely related to traditional tobacco products and smoking accessories. *Id.* ¶ 19. Most fundamentally, all such products are used for smoking. *Id.* As “vaping” (oral inhalation of vapors produced by heating e-liquids) has grown in popularity in recent years, the Food and Drug Administration has deemed electronic cigarettes and accessories to be “tobacco products” and has regulated them accordingly. *See* 81 FR 28973.

Consolidation in the packaged cigarette market has led to a corresponding reduction of brands. *Lele Dec.* ¶ 19. Whereas previously smokers could switch between several different brands of packaged cigarettes, smokers now are more likely to use a variety of different products. *Id.* Indeed, many studies show that a significant percentage of consumers of tobacco products are “poly users,” i.e., users of two or more tobacco products. *See, e.g.,* Opposer’s Second Notice of Reliance, ¶ 3. The degree of concurrent poly use of specific tobacco products – and poly use of traditional and electronic cigarettes – varies, with some studies finding particularly large

correlations. *See, e.g., id.* ¶ 3.9 (Study finding that “[d]uring 2012–2014, 25.1% of adults were current users of any tobacco product. Among them, 32.5% were poly users with the largest poly use category being dual use of cigarettes and e-cigarettes (30.2%).”).

In the normal course of trade, electronic cigarettes and vaporizers are typically sold by the same wholesalers and retailers as Republic’s JOKER cigarette papers. *Lele Dec.* ¶ 20. Moreover, they are sold by retailers in the same areas within the retail environment (*i.e.*, on the same shelves, counters, end-caps, aisles and areas surrounding or behind cash registers), and they are marketed and sold to the same customers, namely adult smokers. *Id.* Online retailers and e-commerce sites also commonly offer a variety of smoking products and accessories, including roll-your-own cigarette papers and electronic cigarette products. *See, e.g.,* Opposer’s Second Notice of Reliance, ¶ 2. Companies often sell multiple types of smoking devices, such as cigarette papers, roll-your-own cigarette accessories, vaporizers, electronic cigarettes, pipes, and/or cigars. *Id.* ¶ 21. Indeed, there are myriad existing U.S. federal registrations for marks covering goods that include both cigarette papers and electronic cigarettes/vaporizers, as well as other smokers’ articles. *See* Opposer’s Third Notice of Reliance. Accordingly, consumers recognize and expect that makers of cigarette papers or other smoking devices extend their brands into related vaping products. *Lele Dec.* ¶ 21.

D. Applicant’s Adoption and Intended Use of the NOJOKE Mark

Applicant applied to register the NOJOKE mark based on its intent to use the mark in connection with “Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges; Electronic cigarettes and oral vaporizers for smokers” in International Class 34 on September 8, 2019 – more than 40 years after the JOKER mark was originally registered. Applicant’s president has been aware of JOKER cigarette papers “for many years from seeing them at convenience stores.” App’s. Ans. to Int. 11;

see also Willner Dep. 103:22-104:12. He testified that he has seen JOKER products on “multiple occasions,” perhaps spanning “decades.” Willner Dep. 104:10-12, 20-24. Applicant’s president is also aware of other brands of cigarette papers and smoker’s articles distributed by Republic Brands, including Top and JOB. *Id.* 107:2-12.

Before deciding to adopt the NOJOKE mark, Applicant conducted an internet search for potentially conflicting marks, but limited its searching to the exact term NOJOKE (by itself and with other generic product terms). *Id.* 73:13-74:6. Applicant “probably” also conducted a similar search of USPTO records. *Id.* 74:7-10. However, Applicant, despite being led by a licensed attorney who was well aware of Republic’s long-standing JOKER mark, did not seek advice from a practicing intellectual property attorney with respect to its adoption of the NOJOKE mark. *Id.* 75:11-22; 103:7-20.

There are no limitations set forth in the application as to the nature, channels of trade, or class of purchasers of the covered goods (beyond “for smokers”). Accordingly, “it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers.” TMEP § 1207.01(a)(iii). As discussed above, Republic’s JOKER cigarette papers also travel through the normal channels of trade for smokers’ articles, namely distributors and retail outlets such as convenience stores, drug stores, gas stations, mini-marts, and specialty stores featuring smokers’ articles. Lele Dec. ¶¶ 13-16.

Applicant’s testimony confirms that, like Republic, it intends to sell its products through distributors, including large distributors of convenience-store products such as Eby-Brown. Willner Dep. 63:18-64:10. Like Republic, Applicant intends to sell to end consumers through retail outlets such as convenience stores, drug stores, gas stations, mini-marts and specialty shops. *Id.*

53:8-54:23; 90:7-18. Indeed, Applicant views retail sales as the most important channel of trade for its products and critical to their success. *Id.* 63:16-21; 90:21-91:20. Applicant is aware that electronic products such as vaporizers are now commonly sold alongside cigarette papers and other smoker's articles in retail locations, and Applicant intends its products to be sold alongside these items. *Id.* 107:2-24; *see also* Lele Dec. ¶ 20.

Consistent with the broad phrasing "for smokers" in the identification of covered goods, Applicant intends to target smokers of traditional combustible cigarettes, including roll-your-own cigarettes, as consumers for its products. Willner Dep. 93:9-94:3. Applicant views all tobacco smokers, regardless of their means of smoking, as potential consumers. *Id.* 94:9-12; 94:18-95:7; *see also* Lele Dec. ¶ 20. Applicant intends to promote its products through point-of-sale materials, its website, and via social media outlets such as Facebook, Instagram and Twitter. Willner Dep. 90:21-91:5; 91:21-92:11; 115:1-9.

Although the application is based on intent to use the NOJOKE mark in commerce, Applicant began offering a fruit-flavored e-liquid under the mark after filing the application. The product was available for purchase on Applicant's website for approximately three months in late 2019 and early 2020, at a price point of \$18.99 for a pack of four pods of e-liquid. *Id.* 56:18-57:23 and Exs. 7-8. Applicant also shipped samples of the product to potential retailers. *Id.* 49:7-50:7; 52:3-12. Applicant designed a point-of-sale product display highlighting the NOJOKE e-liquid product to be placed in the retail locations identified above, either in the smoker's articles section or on or behind the counter, to attract consumers' attention. *Id.* 52:13-54:23 and Ex. 7. These are the same areas where consumers encounter Republic's products, including JOKER cigarette papers. Lele Dec. ¶ 20. In addition to the point-of-sale product displays, Applicant intends to

provide retailers with other point-of-sale promotional materials, such as posters and counter mats, upon request. Willer Dep. 115:1-116:20.

V. ARGUMENT

A. Republic's Trademark Rights and Standing to Oppose

Any person who believes that they would be damaged by the registration of a mark may oppose the registration. 15 U.S.C. §1063(a). For such a person to have standing, they must have a real interest in the outcome of the proceeding, and a reasonable belief that their rights would be damaged as a result of registration. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

Republic has standing to oppose the subject application to register the NOJOKE mark on the basis of its long-standing prior rights in the JOKER mark, including but not limited to its registrations therefor. *See* Notice of Opp. The application is based on intent to use, and it is undisputed that Republic (and its predecessors) have continuously used its JOKER mark for more than 40 years prior to Applicant's filing date. *Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1283-84 (TTAB 1998) (plaintiff may rely on its registration to prove that the mark was in use at least as early as the filing date of the application which matured into its registration). As discussed further herein, the NOJOKE mark is likely to cause confusion with the JOKER mark. Accordingly, registration by Applicant will cause harm to Republic, and Republic has a real interest in the outcome of this proceeding.

B. Registration of the NOJOKE Mark is Likely to Cause Confusion

Under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), the Trademark Office should refuse to register a trademark that is so similar to a registered mark 'as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.'" *M2 Software, Inc. v. M2 Comm'ns, Inc.*, 450 F.3d 1378, 1381, 78 USPQ2d 1944, 1946

(Fed. Cir. 2006). The Board’s determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973) (listing numerous factors to consider, hereinafter the “*duPont* factors”); *see also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 1314, 65 USPQ2d 1201,1203 (Fed. Cir. 2003) (applying the *duPont* factors). It is not necessary that every factor weigh in favor of the plaintiff in order to find confusion likely: “[w]hile it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). *See also Brown Shoe Co. v. Robbins*, 90 USPQ 2d 1752, 1754 (TTAB 2009) (“[t]wo key considerations are the similarities between the marks and the similarities between the goods.”) The most relevant *duPont* factors in this proceeding are: (1) the strength of the JOKER mark; (2) the similarity of the marks at issue; (3) the closely related nature of the goods; (4) the identical channels of trade and classes of intended consumers; (5) the level of care involved in the purchase of the products; and (6) Applicant’s intent in deciding to adopt the NOJOKE mark.

“The challenger’s burden of proof in both opposition and cancellation proceedings is a preponderance of the evidence.” *General Motors Corp. v. Aristide & Co.*, 87 USPQ2d 1179, 1187 (TTAB 2008); *quoting Eastman Kodak Co. v. Bell & Howell Document Management Products Co.*, 994 F.2d 1569, 26 USPQ2d 1912, 1918 (Fed. Cir. 1993). However, any doubts about the likelihood of confusion should be resolved against the junior user because newcomers have the opportunity and the duty to avoid confusion with existing marks. *In re Chatam Int’l Inc.* 380 F.3d 1340, 1345, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004).

Here, all of the evidence of record weights in favor of finding a likelihood of confusion. The record shows that the JOKER mark is strong; Applicant's NOJOKE mark is highly similar to the JOKER mark and that the marks are associative; the goods covered by the instant application are closely related to Republic's JOKER cigarette papers; Applicant's products will be sold in the same channels of trade as Republic's JOKER cigarette papers; and consumers cannot be expected to exercise a high degree of care or examination in purchasing the products. As such, the record evidence establishes that Applicant's NOJOKE mark is likely to cause confusion as to source, sponsorship or affiliation.

1. The JOKER Mark Is Strong

"The strength of the senior prior mark plays a 'dominant' role in the process of balancing the *duPont* factors." *Recot Inc. v. M.C. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (citing cases). "The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name." *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984).

The JOKER mark is undoubtedly a very strong mark. First, it is an arbitrary designation when used with smokers' articles, and is therefore considered inherently strong. *See In re Wilson*, 57 USPQ2d 1863, 1865 (TTAB 2001). Moreover, Republic and its predecessors have been marketing and selling cigarette papers continuously under the JOKER mark since at least as early as 1975. *See* U.S. Reg. No. 1087438, asserted in Notice of Opp. Republic's JOKER mark is valid and subsisting, and has long become incontestable pursuant to 15 U.S.C. § 1065. *Id.* During the past 46 years, Republic's JOKER trademark has established a significant amount of consumer recognition and goodwill. Lele Decl. ¶ 11.

In spite of the challenges in marketing tobacco and related products to consumers caused by federal regulations and the Master Settlement Agreement, Republic and its exclusive distributor, Republic Brands LP, invest significant time and resources annually in promoting JOKER products through permitted means such as point-of-sale displays and other materials, promotional fliers, fact sheets, price lists, and industry trade shows. *Id.* ¶¶ 13-15. As a result of the significant investment of resources Republic has made in the JOKER brand, JOKER cigarette papers are available nationwide in more than 50,000 retail outlets such as convenience stores, gas stations, mini marts, tobacco stores and outlets, mass merchandisers, cash and carry outlets, and others. *Id.* ¶ 16. JOKER cigarette papers are also widely available online through retailers' websites and third-party e-stores such as Amazon and Alibaba. *Id.* The JOKER mark enjoys widespread consumer recognition as identifying a distinctive brand of high-quality cigarette papers. *Id.* ¶ 17. Indeed, Applicant's president testified that he himself has been aware of JOKER cigarette papers "for many years from seeing them at convenience stores." App's. Ans. to. Int. 11; *see also* Willner Dep. 103:22-104:12.

Accordingly, Republic's long-standing JOKER mark is very strong, and this factor weighs heavily in favor of likelihood of confusion.

2. The JOKER and NOJOKE Marks are Similar Associative Terms

To gauge their similarity, marks are compared in terms of their appearance, sound, and commercial impression. *In re duPont*, 177 USPQ at 567. The marks should be compared as a whole. *See Estate of Beckwith, Inc v. Comm'r of Patents*, 252 U.S. 538, 545-546 (1920) ("[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail."). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the

respective marks is likely to result. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). However, similarity in any one of the elements of sound, appearance or connotation can be sufficient to support a determination of likelihood of confusion. *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009). When the marks at issue are used in connection with closely related goods, as set forth below, the degree of similarity necessary to support a likelihood of confusion declines. *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

Here, the shared element “JOKE” makes the marks similar in appearance and sound. Moreover, when considering the marks as a whole, the “JOKE” element is central to the meaning and commercial impression of both marks. The marks approach the theme of a joke from different directions – JOKER in the affirmative and NOJOKE in the negative – but both call to mind the same concept. This makes the marks “associative terms,” which by itself constitutes sufficient similarity to support a finding of likelihood of confusion.

It is well established that marks composed of “associative terms” may create similar commercial impressions such that consumers would be likely to assume that the products offered under them emanate from the same source “or are, in some way, affiliated therewith.” *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (UPTOWNER and DOWNTOWNER, each for motels, were confusingly similar because “up and down are associative terms in that one word creates the image or idea of the other.”); *In re Cal. Costume Collections, Inc.*, 2011 WL 4090445 at *4 (TTAB Sept. 1, 2011) (non-precedential) (DISENCHANTED PRINCESS and ENCHANTED PRINCESS, each for “closely related toys,” evoked similar commercial impressions: “the ‘enchanted princess’ is under a spell, and the ‘disenchanted princess’ is free from the spell.”); *see also P&G Co. v. Conway*, 57 CCPA 865, 868-69, 419 F.2d 1332, 1335-36 (CCPA

1970) (MISTER STAIN and MR. CLEAN, each for cleaning products, were confusingly similar because the terms “CLEAN” and “STAIN” “both...pertain to a state of cleanliness). Associative terms may “possess different dictionary meanings,” *Downtowner Corp.*, 178 USPQ 105 at *6—even *opposite* meanings, *P&G Co.*, 57 CCPA at 868; *Cal. Costume Collections*, 2011 WL 4090445 at *4—yet are capable of creating confusion in the marketplace “where the marks convey the same general idea or stimulate the same mental reaction.” *H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc.*, 202 USPQ 62, 65 (TTAB 1979) (BLUE NUN and BLUE ANGEL, each for wines, were confusingly similar owing to the shared religious connotation of the terms “NUN” and “ANGEL.”). Thus, “[s]imilarity in meaning or significance alone is sufficient to indicate a likelihood of confusion, especially where...the marks are coined or arbitrary.” *H. Sichel Sohne*, 202 USPQ 62 at *9, citing *Hancock v. The American Steel & Wine Company of New Jersey*, 97 USPQ 330, 203 F.2d 737 (CCPA 1953).

As in each of these cases, the marks at issue here—NOJOKE and JOKER, each for smokers’ articles—consist of confusingly similar terms in that each “creates the image or idea of the other.” *Downtowner Corp.*, 178 USPQ 105 at *6. Particularly given retail circumstances in which consumers frequently purchase smokers’ articles, described in more detail below – where consumers exercising a low level of care would encounter both products in close proximity – consumers are likely to view Applicant’s NOJOKE mark as a play on, or in dialogue with, Republic’s well-established JOKER mark.

The Board’s decision in *Cal. Costumes Collections* (cited above), although non-precedential, is nonetheless instructive. There, the Board found the negative term DISENCHANTED to be confusingly similar to the term ENCHANTED because “[t]he words are associative, and both marks engender similar overall commercial impressions, namely of princess-

like toys marketed under a shared theme of fairytale magic and spells.” 2011 WL 4090445 at *4. Here, consumers are likely to make a similar association with the shared theme of “joking” and mistakenly believe that Applicant’s NOJOKE branded products emanate from the same source or are somehow affiliated with Republic’s JOKER branded products – for example, consumers may interpret the NOJOKE mark as indicating a new tobacco-free, electronic extension of or companion to the traditional JOKER brand. Accordingly, the similarity of the marks weighs strongly in favor of finding a likelihood of confusion.

3. The Goods Are Closely Related

“It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant’s application vis-à-vis the goods identified in the cited registration.” *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008) (“likelihood of confusion may be found based on any item that comes within the identification of goods in the involved application and registration”); *citing In re Shell Oil Co.*, 992 F.2d 1204 (Fed. Cir. 1993). Confusion is likely where “the goods ... are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source.” TMEP § 1207.01(a)(i); *see, e.g., In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Paramount Int’l Export, Ltd. v. Q’Sai Co. Ltd.*, 2017 WL 4155295 at*8 (TTAB Sept. 15, 2017).

Both the JOKER mark and the NOJOKE mark are used in connection with smokers’ articles in International Class 34. The electronic cigarettes, e-liquids and vaporizers covered by the Application are inherently related to the cigarette papers for which the JOKER mark is registered in that all of the products serve the same purpose, namely, facilitating the delivery of nicotine to smokers/vapers. Indeed, the Food and Drug Administration considers electronic cigarettes and

accessories to be “tobacco products” for regulatory purposes. *See* 81 FR 28973. The record evidence shows that many smokers use a variety of different means of delivery, and studies indicate that a considerable portion of traditional tobacco smokers also use electronic smoking products and vice versa. *See* Lele Dec. ¶ 19 and documents set forth in Opposer’s Second Notice of Reliance, ¶ 3; *see also, e.g., Grand River Ent.’s Six Nations Ltd. v. VMR Products LLC*, 2014 WL 2434517 at *13 (W.D. Wis. May 29, 2014) (“The strongest factor weighing [in favor of likelihood of confusion] is [that] cigarettes and e-cigarettes are undoubtedly similar products. ... [C]igarettes and e-cigarettes certainly qualify as similar products that could be attributed to a single source.”).

Moreover, the conditions surrounding the marketing of Republic’s JOKER cigarette papers and Applicant’s products are such that they are likely to be encountered by the same persons under circumstances that would give rise to confusion. As discussed below, Applicant admits that its target consumers are the same as Republic’s, namely, adult smokers. Willner Dep. 93:9-94:3. Applicant plans to sell its products in exactly the same types of retail locations, and in exactly the same areas within those locations, as Republic sells its JOKER cigarette papers. *Id.* 52:13-54:23. Indeed, it is entirely possible, and even likely, that Applicant’s products bearing the NOJOKE mark would be placed directly adjacent to Republic’s JOKER cigarette papers.

These circumstances are exacerbated by the fact that the same companies commonly sell multiple types of smoking devices and smokers’ articles. Lele Dec. ¶ 21. This is supported by the numerous use-based U.S. federal registrations owned by third parties and covering goods including cigarette papers, electronic cigarettes/vaporizers, and other smokers’ articles. The Board has long held such use-based third-party registrations to be probative. *See, e.g., Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424 at *9 (TTAB 2013) (“[U]se-based, third-party

registrations ... have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.”).

The record thus clearly shows that Applicant’s goods and Republic’s JOKER cigarette papers are closely related smokers’ articles. This factor further favors a finding of likelihood of confusion. Further, as noted above, the closely related nature of the parties’ respective goods serves to lessen the degree of similarity between the marks needed to support a finding that a likelihood of confusion exists between the marks. *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004) (“Because the goods are related, the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.”) (internal citation omitted).

4. The Trade Channels and Intended Consumers Are Identical

As noted above, the Application contains no limitations with regard to channels of trade, and it is therefore presumed that Applicant’s goods will move in all the usual channels of trade for smokers’ articles. TMEP § 1207.01(a)(iii). In addition, because Applicant’s goods are closely related to Republic’s cigarette papers, they are presumed to be marketed in the same channels of trade and will be bought by the same classes of purchasers. *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1754-55 (TTAB 2009). This factor would favor a likelihood of confusion based on these presumptions alone.

However, in this case, the presumptions are unnecessary, as it is undisputed that the channels of trade are identical. Republic sells and promotes its JOKER cigarette papers in all of the normal channels of trade for smokers’ articles as permitted by federal regulations and the Master Settlement Agreement: through distributors and in retail outlets such as drug stores, convenience stores, gas stations, mini-marts, and stores specializing in smokers’ articles. Lele Dec. ¶ 16. Applicant admits that these are exactly the same channels through which it will sell its

products, *see* Willner Dep. 53:8-54:23, 63:18-64:10 and 90:7-18, and that it views these channels as the most beneficial for its sales and will therefore rely heavily on them. *Id.* 63:16-21, 90:21-91:20. Indeed, Applicant has shipped samples of NOJOKE e-liquid to potential retailers and designed a point-of-sale display specifically to attract consumer attention on or behind the counter at outlets such as convenience stores or gas stations. *Id.* 49:7-50:7, 52:3-54:23.

In addition to the identical channels of trade, Applicant's testimony also shows that it intends to target the same consumers as Republic. Through its distributor, Republic offers a variety of products for adult smokers, including JOKER cigarette papers. Lele Dec. ¶ 18. As is common in the industry, *see id.* ¶ 20, Applicant intends to target smokers of traditional cigarettes with its electronic products and views all adult smokers as its potential customer base. Willner Dep. 93:9-94:3, 94:9-12.

In light of Applicant's testimony, which augments the presumptions rising from the nature of Applicant's covered goods, this factor strongly favors a likelihood of confusion and warrants significant weight in the analysis.

5. Purchaser Consideration Level is Low

"When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot*, 54 USPQ2d at 1899; *see also Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1752 (TTAB 2006) (coffee and tea are inexpensive products that may be purchased on impulse without the exercise of significant care). For example, "the bustling, self-service atmosphere of a typical supermarket makes careful examination of products unlikely." *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 216 USPQ 177, 180 (2d Cir. 1982) (finding this fact to favor confusion between grocery products).

The smokers' articles at issue here are relatively inexpensive and may be purchased by ordinary consumers at convenience stores, drug stores, gas stations, mini-marts and similar outlets. Lele Dec. ¶ 9; Willner Dep. 53:8-54:23, 90:7-18. Indeed, Applicant offered its NOJOKE e-liquid at a price point of \$18.99 for four pods of liquid. Willner Dep. 57:5-8. As these smokers' articles are not expensive or complicated and are most commonly purchased in retail environments where customer attention is low and/or divided, consumers may well not exercise significant care in making their purchases, increasing the likelihood that they will be confused when confronted with Republic's JOKER mark and Applicant's NOJOKE mark.

6. Evidence Suggests Applicant May Have Intended to Trade on Republic's Goodwill

The final relevant *du Pont* factor in this case is Applicant's intent in choosing to adopt the NOJOKE mark, and whether it reflects a bad-faith attempt to trade on Republic's long-established goodwill in its JOKER mark. *See, e.g., J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered[.]"). Although Applicant's president asserts that "the fact that cigarette papers bearing the mark JOKER were being sold in the United States" was not considered during Applicant's decision-making process, *see* Willner Dec. ¶ 8, his own testimony suggests otherwise.

Applicant's president admitted that he has been aware of JOKER cigarette papers for "many years," possibly even "decades." App's Ans. to Int. 11; Willner Dep. 103:22-104:12, 104:20-24. Although Applicant conducted an internet search for potentially conflicting marks, that search was limited to the exact term NOJOKE (by itself and with other generic terms). *Id.* 73:13-74:6. Applicant's president, a licensed attorney, was savvy enough to have "probably" conducted a similar search of USPTO records. *Id.* 74:7-10. However, the searches apparently did not include

close variants such as JOKER, despite the fact that Applicant's president was well aware of Republic's mark. Moreover, despite this awareness, Applicant did not seek the advice of intellectual property counsel with respect to any potential conflict. *Id.* 75:11-22, 103:7-20. The testimony suggests that Applicant's president, at the very least, went out of his way to avoid confirming a potential likelihood of confusion with Republic's JOKER mark.

Applicant's mere assertion of a lack of bad faith does not move the needle with regard to the intent factor. *See, e.g., In re LSP Products Group, Inc.*, Serial No. 77204300 (TTAB May 27, 2009) ("Good faith adoption ... is expected of applicants and the mere absence of 'evidence of intent to trade on the goodwill of another' typically does not aid an applicant in establishing that there is no likelihood of confusion."). In light of the circumstantial evidence provided by Applicant's testimony, this factor also favors Republic.

VI. CONCLUSION

For more than 40 years, Republic and its predecessors have invested substantial resources in building significant consumer goodwill in the JOKER brand through successfully marketing and promoting high-quality cigarette papers. As a result, the JOKER mark enjoys widespread recognition among consumers as signifying smokers' articles of the highest standard. Applicant has sought protection for a substantially similar associative mark in connection with closely related goods for smokers. Applicant admits that its goods will be sold through the same standard channels of trade for smokers' articles and that it intends to place its goods in direct proximity to Republic's JOKER cigarette papers in retail locations. Applicant further admits that it intends to market to the same set of target consumers, namely, adult smokers. These target consumers will encounter JOKER and NOJOKE products in inexpensive retail locations where their attention is likely to be divided, such as convenience stores and gas stations. Under these circumstances, there can be no

question that confusion is therefore inevitable, and Republic therefore requests that this opposition be sustained.

Respectfully submitted,

Date: December 15, 2021

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CERTIFICATE OF SERVICE

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