

ESTTA Tracking number: **ESTTA1045429**

Filing date: **03/27/2020**

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	REPUBLIC TECHNOLOGIES (NA), LLC		
Entity	LIMITED LIABILITY COMPANY	Citizenship	DELAWARE
Address	2301 Ravine Way Glenview, IL 60025 UNITED STATES		

Attorney information	ANTONY J. MCSHANE NEAL, GERBER & EISENBERG, LLP 2 North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES amcshane@nge.com, bnathan@nge.com, temanelson@nge.com, acrawford@nge.com, ecfdoctet@nge.com 312.269.8000		
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**Applicant Information**

Application No	88752749	Publication date	03/10/2020
Opposition Filing Date	03/27/2020	Opposition Period Ends	04/09/2020
Applicant	Don Distro, Inc. 340 Cherry Ave Long Beach, CA 90802 UNITED STATES		

**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 and hookah accessories, namely, hookah hoses
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**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.	3687424	Application Date	11/30/2006
Registration Date	09/22/2009	Foreign Priority Date	NONE
Word Mark	EL REY		

Design Mark	<h1>EL REY</h1>		
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1960/12/31 First Use In Commerce: 1991/03/31 Cigarette tubes [ ; machines allowing smokers to make cigarettes by themselves ]		

U.S. Registration No.	3030950	Application Date	04/04/2000
Registration Date	12/20/2005	Foreign Priority Date	NONE

Word Mark	EL REY
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0 [ Cigarette papers; cigarette rolling papers; ] cigarette tubes; [ pocket machines for rolling cigarettes; pocket machines for filling cigarette paper tubes and cigarette filters ]
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Attachments	77977628#TMSN.png( bytes ) 76017473#TMSN.png( bytes ) NOTICE OF OPPOSITION - REY.pdf(101046 bytes ) EX A - REY opposition.pdf(82210 bytes )
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Signature	/Antony J. McShane/
Name	ANTONY J. MCSHANE
Date	03/27/2020

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

In the Matter of Application Serial No.  
88/752,749 for REY

Published in the Official Gazette  
on March 10, 2020

REPUBLIC TECHNOLOGIES (NA), LLC,

Opposer,

v.

DON DISTRO, INC.

Applicant.

**NOTICE OF OPPOSITION**

This Notice of Opposition is submitted in the matter of Application Serial No. 88/752,749 for registration by Don Distro, Inc. (“Applicant”) of the mark REY for use in connection with “hookah and hookah accessories, namely, hookah hoses” in Class 34. The application was published for opposition in the Official Gazette on March 10, 2020. Republic Technologies (NA), LLC, having a place of business at 2301 Ravine Way, Glenview, Illinois 60025, believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. For many years, and long before the acts of Applicant alleged herein, Republic Technologies (NA), LLC and its predecessors (“Republic”) have been engaged, *inter alia*, in the manufacture, distribution and sale of smokers’ articles, including tobacco, cigarette papers, cigarette filters, cigarette tubes, and cigarette rolling, injector and making machines, which are distributed throughout the United States through tobacco shops, drugstores, tobacco outlets, convenience and other retail stores.

2. For decades, and long prior to the acts of Applicant herein alleged, Republic has devoted substantial resources, time and effort in marketing and distributing cigarette tubes under the mark EL REY.

3. As a result of consistent and successful efforts to promote, distribute and sell such smokers' articles under and in connection with its EL REY mark, and the continuous and exclusive use of the EL REY mark with such smokers' articles, Republic has developed considerable consumer recognition and goodwill in its EL REY mark, which has come to be recognized by customers as identifying and distinguishing Republic's smokers' articles, and Republic's smokers' articles alone.

4. To protect its rights, Republic owns and maintains the following federal registrations for its EL REY mark in the United States Trademark Office, which are now incontestable pursuant to 15 U.S.C. §1065:

<b>Mark</b>	<b>Registration No.</b>	<b>Registration Date</b>	<b>Goods and Services</b>
EL REY	3,687,424	September 22, 2009	Cigarette tubes
EL REY (Design)	3,030,950	December 20, 2005	Cigarette tubes

Printouts from the U.S. Patent and Trademark Office website showing the current status and title of the above-listed registrations are attached hereto collectively as Exhibit A.

5. On January 9, 2020, long after Republic began use of its EL REY mark, Applicant filed an application to register the mark REY based on its intent to use the mark in connection with "hookah and hookah accessories, namely, hookah hoses" in Class 34 (*see* App. Serial No. 88/752,749).

6. Applicant's mark is likely to cause confusion with Republic's EL REY mark. More specifically, as a result of the similarity of the parties' marks, the similarity of the goods associated

with the marks, their associated channels of trade, and the strength of Republic's EL REY mark, *inter alia*, Applicant's use and registration of the REY mark is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe that Applicant's goods are in some way affiliated, connected, or associated with Republic in violation of 15 U.S.C. §§ 1052(d) and 1125(a).

7. Based on the foregoing, Republic believes that it would be damaged by registration of the mark REY for use in connection with "hookah and hookah accessories, namely hookah hoses," and on that basis, Republic opposes registration of the mark by Applicant.

WHEREFORE, Republic requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Date: March 27, 2020

Respectfully submitted,

By: /Antony J. McShane /  
One of the Attorneys for  
Republic Technologies (NA), LLC  
Antony J. McShane  
Bari L. Nathan  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street – Ste. 1700  
Chicago, IL 60602-3801  
(312) 269-8000 (telephone)  
(312) 269-1747 (facsimile)

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that the foregoing **NOTICE OF OPPOSITION** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: March 27, 2020

By: /Bari L. Nathan/  
One of the Attorneys for Opposer,  
Republic Technologies (NA), LLC

30470859.1

# **EXHIBIT A**

**Trademarks > Trademark Electronic Search System (TESS)**

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# EL REY

<b>Word Mark</b>	EL REY
<b>Goods and Services</b>	IC 034. US 002 008 009 017. G & S: Cigarette tubes [ ; machines allowing smokers to make cigarettes by themselves ]. FIRST USE: 19601231. FIRST USE IN COMMERCE: 19910331
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77977628
<b>Filing Date</b>	November 30, 2006
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	April 8, 2008
<b>Registration Number</b>	<b>3687424</b>
<b>Registration Date</b>	September 22, 2009
<b>Owner</b>	(REGISTRANT) Imperial Tobacco (Efka) GmbH & Co. KG CORPORATION FED REP GERMANY Industriestrasse 6 Postfach 1257 Trossingen D78647 FED REP GERMANY  (LAST LISTED OWNER) REPUBLIC TECHNOLOGIES (NA), LLC LIMITED LIABILITY COMPANY DELAWARE 2301 RAVINE WAY GLENVIEW ILLINOIS 60025
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Antony J. McShane
<b>Type of Mark Register</b>	TRADEMARK PRINCIPAL



**Affidavit Text**      SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20191026.  
**Renewal**            1ST RENEWAL 20191026  
**Live/Dead**  
**Indicator**          LIVE

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**Word Mark** EL REY

**Translations** The English translation of the Spanish word "EL REY" in the mark is "the king".

**Goods and Services** IC 034. US 002 008 009 017. G & S: [ Cigarette papers; cigarette rolling papers; ] cigarette tubes; [ pocket machines for rolling cigarettes; pocket machines for filling cigarette paper tubes and cigarette filters ]

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design** 02.07.01 - Groups, males

**Search Code** 02.09.17 - Humans, including men, women and children, depicted riding horses and other animals; Riding animals, humans  
03.03.09 - Camels, dromedaries  
06.05.01 - Desert scenery; Scenery of deserts  
26.11.01 - Rectangles as carriers or rectangles as single or multiple line borders

**Serial Number** 76017473

**Filing Date** April 4, 2000

**Current Basis** 44E

**Original Filing Basis** 1B;44E

**Published for Opposition** October 22, 2002

**Registration Number** 3030950

**Registration Date** December 20, 2005

**Owner** (REGISTRANT) Imperial Tobacco (EFKA) GmbH & Co. KG. CORPORATION FED REP GERMANY  
INDUSTRIESTRASSE 6 TROSSINGEN FED REP GERMANY 78647  
  
(LAST LISTED OWNER) REPUBLIC TECHNOLOGIES (NA), LLC LIMITED LIABILITY COMPANY DELAWARE 2301  
RAVINE WAY GLENVIEW ILLINOIS 60025

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Antony J. McShane  
**Prior Registrations** 1813114;2061670  
**Description of Mark** Color is not claimed as a feature of the mark.  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20160111.  
**Renewal** 1ST RENEWAL 20160111  
**Live/Dead Indicator** LIVE

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