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

Proceeding	92050296
Party	Plaintiff Altadis U.S.A. Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 3,233,835
Issued on April 24, 2007

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Altadis U.S.A. Inc.,	:	
	:	
Petitioner,	:	
v.	:	Cancellation No.: 92050296
	:	
Wentworth E. Miller,	:	
	:	
Registrant.	:	
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MEMORANDUM OF LAW IN RESPONSE TO
“REGISTRANT REQUEST FOR CORRECTION OF
USPTO MISIDENTIFICATION OF GOODS IN
TRADEMARK REGISTRATION CERTIFICATE AND
REGISTRANT MOTION FOR RECONSIDERATION OF
THE BOARD’S MARCH 9, 2010 DECISION GRANTING CANCELLATION”

Petitioner Altadis U.S.A. Inc. (“Altadis” or “Petitioner”) respectfully submits this response to Registrant’s recently filed document, Registrant [sic] Request for Correction of USPTO Misidentification of Goods in Trademark Registration Certificate and Registrant [sic] Motion for Reconsideration of the Board’s March 9, 2010 Decision Granting Cancellation (“Registrant’s Motion for Reconsideration”).

The Trademark Trial and Appeal Board’s Manual of Procedure makes clear that a request for reconsideration “may not be used to introduce additional evidence, nor should it be devoted simply to reargument of the points presented in the requesting party’s brief on the case.” TBMP §543. Despite this language from the Board’s Manual, this is exactly what Registrant seeks to do in Registrant’s Motion for Reconsideration.

Registrant's Motion for Reconsideration is nothing more than Registrant's attempt to:

- 1) reargue the same points previously considered by the Board; and
- 2) introduce Registrant's untimely filed arguments which were not considered by the Board (see Footnote 3 in the Board's Opinion dated March 9, 2010 ("Opinion")).

Further, Registrant seeks to use Registrant's Motion for Reconsideration as a vehicle to improperly try to amend the description of goods in Registrant's CIGARETTESAVER trademark registration now that Registrant's trademark registration has been ordered cancelled by the Board.

With respect to rearguing the same points, Registrant has once again asserted that he disagrees that there are similarities between Petitioner's CIGAR SAVOR mark and Registrant's CIGARETTESAVER mark. (*See* Registrant's Motion for Reconsideration, p. 3-5). The Board duly considered Registrant's and Petitioner's arguments regarding the similarities of the marks and found that under a likelihood of confusion analysis the marks of Petitioner and Registrant are similar. (*See* Opinion, p. 10-12). Specifically, the Board stated in its Opinion that:

We do not find respondent's attempts at distinguishing the marks persuasive. The marks both consist of a combination of two words...Consumers would view the source of the goods as the same due to the similarities in the marks, with one being for cigarettes and one for cigars. Moreover, to the extent that consumers notice the difference between the words CIGAR and CIGARETTE, they may mistakenly believe that CIGARETTESAVER is a variation of CIGAR SAVOR. (Opinion, p. 11-12).

Registrant also, once again, asserts his position that he disputes that Petitioner's CIGAR SAVOR mark is a double entendre conveying both "saving" and "savoring" a cigar. (*See* Motion for Reconsideration, p. 3-5). The Board has duly considered the arguments of Petitioner and of Registrant in this regard and found that Petitioner's mark is a double entendre. (*See*

Opinion, p. 11-12). Registrant simply refuses to accept the facts that:

- 1) Petitioner's mark contains the word "SAVOR"; and
- 2) the goods speak for themselves inasmuch as they are tubes for "storing" or "saving" cigars. (*See* Opinion, p. 12-13).

These are facts and not "utterly self-serving, specious and unsupported contention[s]" as Registrant erroneously asserts. (Registrant's Motion for Reconsideration, p. 4).

Registrant further asserts, again, that the "OR" in Petitioner's CIGAR SAVOR mark and the "ER" in Registrant's CIGARETTESAVER mark are different. (*See Id.* at p. 4-5). This is also nothing more than a re-hashing of Registrant's previous arguments which the Board duly considered. The Board cited the relevant law stating that "arguments regarding a particular pronunciation of a term cannot be relied upon to avoid a likelihood of confusion." (Opinion, p. 12) (citations omitted).

Registrant is likewise wrong in his assertion that "Petitioner's mark, recognized by the Board [i]s 'highly descriptive, if not generic' (p. 11)." (Registrant's Motion for Reconsideration, p. 5). What the Board actually said was that the first word of **both** Petitioner's and Registrant's marks "is the name of a smokeable item...[t]he first words, CIGAR and CIGARETTE are highly descriptive." (Opinion, p. 11). Accordingly, the Board went on to say that "**[c]onsumers would view the source of the goods as the same** due to the similarities in the marks, with one being for cigarettes and one for cigars." (Opinion, p. 11-12) (emphasis added).

This also further reflects that Registrant is simply wrong in his assertion that the Board erred by "ignoring the manifest difference between CIGAR and CIGARETTE, so as to conflate consumers of cigars and consumers of cigarettes into the indistinguishable catchall of 'smokers' (p. 11)." (Registrant's Motion for Reconsideration, p. 6). Registrant seems to misunderstand

the basic tenets of trademark law which the Board explained at length. (*See* Opinion, p. 11-12). Likelihood of confusion “is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the *source* of the goods.” TMEP §1207.01; *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Registrant also seeks to impermissibly rely on Registrant’s Memorandum of Law in Opposition to Petitioner’s Motion for Summary Judgment and in Support of Registrant’s Motion for Summary Judgment in an attempt to introduce additional arguments and evidence into Registrant’s Motion for Reconsideration. (*See* Registrant’s Motion for Reconsideration, p. 5). Such Memorandum of Law cannot be relied upon by Registrant now when the Board specifically said it would be given no consideration because it was untimely filed. (*See* Opinion, footnote 3). To allow Registrant to rely on such Memorandum of Law would be contrary to the Board’s rules regarding motions for reconsideration. *See* TBMP §543 (explaining that a motion for reconsideration may not be used to introduce additional evidence). Accordingly, Registrant’s Memorandum of Law cannot now be considered.

This then underscores the error of Registrant’s argument that the Board must consider all the *du Pont* factors. Where the record does not contain evidence regarding all the *du Pont* factors, all the *du Pont* factors do not need to be considered by the Board. *See* TMEP §1207.01 (explaining that each of the *du Pont* factors may be considered “only if relevant evidence is contained in the record”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003) (explaining that “not all of the *DuPont* factors may be relevant or of equal weight in a given case, and ‘any one of the factors may control a particular case,’” quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997)). Here, the record does not contain evidence as to all the *du Pont* factors, and

Registrant cannot now try to incorporate additional evidence or arguments through its Memorandum of Law which was untimely filed and rejected by the Board because of its untimely filing.

Further, Registrant is wrong in his assertion that the Board “narrow[ed] its focus to but one of the thirteen factors of *E.I. du Pont De Nemours & Co.* in determining likelihood of confusion.” (Registrant’s Motion for Reconsideration, p. 5). Rather, the Board, considered all of the relevant *du Pont* factors of record, namely, the similarity of the goods, the similarity of the channels of trade, the similarity of the classes of consumers, the similarities of the marks and the fact that no evidence of actual confusion was presented. (*See* Opinion, p. 7-13). Accordingly, the Board’s review and consideration of the *du Pont* factors was proper under the law and not in error. *See In re Majestic Distilling Co.*, 315 F.3d at 1315.

Finally, Registrant has the temerity to suggest that the U.S. Patent and Trademark Office is in error for not amending Registrant’s description of goods in Registrant’s trademark application when such description was published. The Board made clear in its Opinion that it was **Registrant** who was at fault for not making sure his description of goods was amended if that was his intent. “At no time did the Office receive a request for a correction of the identification. Thus, for purposes of this opposition, we consider the identification of goods to be that set forth in the registration.” (Opinion, p. 7).

Moreover, even if Registrant’s description of goods were amended to delete the word “cigar,” as asserted by Registrant, the Board’s conclusion would still be the same because the description of goods would then read: “cylindrical **tube** with removable caps at one or both ends for **enclosing and extinguishing** by oxygen deprivation a lighted cigarette, **or similar smokable product**” (emphasis added). Clearly, a similar smokable product would include a cigar. Further,

Registrant seems to miss the fact and the established law that even if Registrant amended its goods to only include “cigarettes,” his registration would still be unacceptable because of the close relatedness of tobacco accessory goods. “The inquiry is whether the goods are related, not identical.” TMEP §1207.01(a)(i). Because of the close relatedness of the goods, consumers would believe the products to emanate from the same source. *See Larus & Brother Co. v. Holiday Designs, Inc.*, 159 U.S.P.Q. 686 (TTAB 1968) (discussing the relatedness of different types of smokers’ articles in applicant’s and registrant’s respective descriptions of goods and finding that because the goods were related, consumers would believe they emanate from a single source).

Based upon the foregoing, Petitioner respectfully requests that Registrant’s Motion for Reconsideration be denied in all respects and that the Board’s Opinion of March 9, 2010 be allowed to stand.

Dated: April 21, 2010

Respectfully submitted,

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CERTIFICATE OF SERVICE AND FILING

The undersigned hereby certifies that a copy of the foregoing Memorandum of Law in Response to “Registrant Request for Correction of USPTO Misidentification of Goods in Trademark Registration Certificate and Registrant Motion for Reconsideration of the Board’s March 9, 2010 Decision Granting Cancellation” was served on the Registrant/Correspondent of Record on the date indicated below by depositing the same with U.S.P.S., First Class Mail, postage prepaid to:

Wentworth E. Miller
823 Chestnut Street
Coraopolis, PA 15108

and further certifies that the aforementioned Memorandum of Law in Response to “Registrant Request for Correction of USPTO Misidentification of Goods in Trademark Registration Certificate and Registrant Motion for Reconsideration of the Board’s March 9, 2010 Decision Granting Cancellation” was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: April 21, 2010

/Susan M. Schlesinger/
Susan M. Schlesinger