

June 3, 2014

BY FEDEX® COURIER AND ELECTRONIC MAIL

Skylar Shatz  
SkyGraphX  
8 Falmouth Road  
Yonkers, NY 10710  
Phone: (914) 557-4808  
Email: skygraphx@yahoo.com

Re: Unauthorized Use of MARLBORO® Roof Design

Dear Mr. Shatz:

We represent Philip Morris USA Inc. ("PM USA") in certain trademark matters. Our client recently learned that your company, SkyGraphX, advertises, sells, offers for sale, and/or distributes a t-shirt (the "Infringing T-Shirt") that infringes the famous MARLBORO® Roof Design, as described herein. A screen capture from <http://www.skygraphx.bigcartel.com/product/population-filter-t> is attached hereto as Exhibit A. On PM USA's behalf, we must demand that SkyGraphX refrain in the future from advertising, selling, offering to sell, and/or distributing the Infringing T-Shirt or any other products bearing the MARLBORO® Roof Design or any other marks confusingly similar thereto.

As SkyGraphX undoubtedly knows, MARLBORO® is the most recognized brand of cigarettes in the United States. In addition to the MARLBORO® word mark, one of the distinctive features of the MARLBORO® brand is the Roof Design. This design features a five-sided figure with a horizontal top and two vertical sides with two upwardly and inwardly sloping diagonals. To enhance its rights in the MARLBORO® Roof Design, PM USA has obtained from the United States Patent and Trademark Office several federal trademark registrations incorporating the mark, including Registration No. 938,510, in which the roof portion of the design is claimed in the color red and Registration No. 4,170,978 for the Roof Design without the other elements of the trade dress. Copies of the registration certificates for these registrations are attached hereto as Exhibit B. The MARLBORO® Roof Design is famous and distinctive, and PM USA has made extensive use of this mark.

The Infringing T-Shirt misappropriates PM USA's Roof Design. As shown in Exhibit A, the Infringing T-Shirt displays a design confusingly similar to the

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# ARNOLD & PORTER LLP

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MARLBORO<sup>®</sup> Roof Design in the color red, a color that PM USA often uses for the MARLBORO<sup>®</sup> Roof Design. SkyGraphX's use of PM USA's Roof Design in this manner demonstrates that SkyGraphX intended to replicate PM USA's mark. SkyGraphX's conduct is thus calculated to mislead consumers into believing that PM USA endorses, sponsors, licenses or otherwise is affiliated with SkyGraphX or the products it sells. Thus, SkyGraphX's use of the Infringing T-Shirt constitutes trademark infringement, unfair competition, and dilution under the Lanham Act, 15 U.S.C. §§ 1051 *et seq.*, and corresponding state law, and may subject SkyGraphX to liability for both injunctive relief and monetary damages.

We hope we can resolve this matter amicably. We must, however, have your immediate assurance that SkyGraphX will comply with our demands. Please provide us with such assurance by signing and returning a copy of this letter to us no later than two weeks from the date of this letter affirming that SkyGraphX will: (1) immediately cease any and all sales and distribution of items, including, but not limited to, the Infringing T-Shirt, that bear PM USA's, the MARLBORO<sup>®</sup> Roof Design, any other mark or trade dress confusingly similar thereto, or any other PM USA trademark or trade dress; (2) immediately deliver up for destruction at a place designated by PM USA any and all products bearing the MARLBORO<sup>®</sup> Roof Design, or any other PM USA trademark or trade dress that are in SkyGraphX's possession or under its control, and confirm, under penalty of perjury, that SkyGraphX has fully complied with this demand; and (3) refrain in the future from selling or distributing any product bearing the MARLBORO<sup>®</sup> Mark, any mark or trade dress confusingly similar thereto, or any other mark or trade dress owned by PM USA. Contingent upon our receipt of a countersigned letter confirming SkyGraphX's intent to comply with our demands, PM USA will refrain from taking further action in this matter.

Nothing in this letter should be construed as a waiver, relinquishment or election of rights or remedies by PM USA. PM USA expressly reserves all rights and remedies under all applicable federal and state laws.

Sincerely,

  
Roberta L. Horton

Enclosures

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cc: Timothy Hofmeyer, Esq.  
Altria Client Services Inc.

By signing below, I represent that I am authorized to bind SkyGraphX, as well as myself, and that I and SkyGraphX agree to the above listed terms:

Agreed: \_\_\_\_\_

Signature

\_\_\_\_\_  
Printed Name

\_\_\_\_\_  
Title

\_\_\_\_\_  
Date

**EXHIBIT A**

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### POPULATION FILTER T

**\$10.00 ON SALE**

This shirt is pretty self explanatory. I think the grim reaper should take off his hood and put on a cowboy hat. Design may vary slightly from pictured.

Front print on 100% soft white cotton shirt.

[Click the photo for a larger view.](#)

#### Mens Size Chart

Size	Width	Length
S	18"	27"
M	20"	28"
L	22"	29"
XL	24"	31"
2XL	26"	32"
3XL	28"	33"

Medium

[ADD TO CART](#)

**EXHIBIT B**

Int. Cl.: 34

Prior U.S. Cl.: 17

Reg. No. 986,910

United States Patent and Trademark Office

Registered July 25, 1972

Corrected

CG Date June 14, 2011

TRADEMARK  
PRINCIPAL REGISTER



PHILIP MORRIS USA INC (VIRGINIA  
CORPORATION)  
6601 WEST BROAD STREET  
RICHMOND, VA 23290

OWNER OF U.S. REG NOS 66,502,  
65,660 AND OTHERS

APPLICANT DISCLAIMS THE WORDS  
"FILTER CIGARETTES" APART FROM  
THE MARK AS SHOWN.

THE DRAWING IS LINED TO INDI-  
CATE THE COLORS RED AND GOLD  
AND THESE COLORS ARE USED AND  
CLAIMED AS A FEATURE OF THE  
MARK.

FOR CIGARETTES, IN CLASS 17  
(INT CL 34)  
FIRST USE 6-9-1954; IN COMMERCE  
9-4-1954  
SER. NO. 72-357,834, FILED 3-30-1971



*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on June 14, 2011.*

*David J. Kyfas*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,170,978**

**Registered July 10, 2012**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

PHILIP MORRIS USA INC. (VIRGINIA CORPORATION)  
6601 WEST BROAD STREET  
RICHMOND, VA 23230

FOR: TOBACCO PRODUCTS, NAMELY, CIGARETTES, SMOKELESS TOBACCO, AND  
SNUS, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 0-0-1954; IN COMMERCE 0-0-1954.

OWNER OF U.S. REG. NOS. 854,007, 3,695,125 AND OTHERS.

THE MARK CONSISTS OF A FIVE-SIDED FIGURE WITH A HORIZONTAL TOP AND TWO  
VERTICAL SIDES WITH TWO UPWARDLY AND INWARDLY SLOPING DIAGONALS.

SER. NO. 85-464,568, FILED 11-4-2011.

ELLEN BURNS, EXAMINING ATTORNEY



*David J. Kyffes*

Director of the United States Patent and Trademark Office