

ESTTA Tracking number: **ESTTA535958**

Filing date: **05/02/2013**

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

Proceeding	91185261
Party	Plaintiff American Cigarette Company, Inc. and Smoker's Best Group, LLC
Correspondence Address	SMOKER'S BEST GROUP LLC 645 WESTMORELAND DRIVE TUPELO, MS 38801 UNITED STATES
Submission	Reply in Support of Motion
Filer's Name	Juliet Alcoba
Filer's e-mail	jalcoba@miamipatents.com, alcoba@miamipatents.com
Signature	/juliet Alcoba/
Date	05/02/2013
Attachments	Reply Heritage Tobacco.pdf (7 pages)(1079317 bytes) Exhibit A PUBLIC.pdf (2 pages)(6892 bytes) Exhibit B.pdf (3 pages)(46145 bytes) Exhibit C, D.pdf (9 pages)(170913 bytes) Exhibit E.pdf (2 pages)(250932 bytes) Exhibit F.pdf (2 pages)(17298 bytes) Exhibit G, H.pdf (6 pages)(335443 bytes) Exhibit I.pdf (7 pages)(154058 bytes) Exhibit J.pdf (5 pages)(402095 bytes) Declaration by Juliet Alcoba for Reply.pdf (4 pages)(106386 bytes)

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

N.V. Sumatra Tobacco Trading Company)
Petitioner/Applicant)

v.)

Heritage Tobacco, LLC)
Respondent/Registrant)

Cancellation No. 92052621
Opposition Nos. 91185261
91186841
For the Mark UNION
Registration Number: 2,972,594
Registration Date: July 19, 2005

Honorable Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

**HERITAGE’S REPLY IN RESPONSE TO PETITIONER’S OPPOSITION TO ITS
COMBINED MOTIONS**

Heritage Tobacco, LLC (“Heritage”) filed a Memorandum in support of its combined motion to set aside the Board’s order granting N.V. Sumatra Tobacco Trading Company’s (“Petitioner” or “Applicant”) motions for summary judgment, motion for a 45 day extension of time to submit oppositions to the submitted summary judgments, and motion to reopen proceedings and reset trial dates on April 3, 2013. On April 17, 2013, Heritage received Petitioner’s Response in Opposition to its combined motions and memorandum. Heritage replies within the time period set forth in 37 CFR § 2.127(a).

FACTS

Petitioner attempts to persuade the Board to ignore at least eight years of continuous and uninterrupted use by Heritage’s predecessor in interest. UNION is a valuable asset and the past eight years have resulted in the development of a substantial amount of good will. Heritage denies Petitioner’s rundown of alleged wilful behavior engaged in by its predecessor *in interest*.

This is a weak attempt by Petitioner to convince the Board to avoid deciding this proceeding on the merits.

ARGUMENT

I. Relief from judgment is warranted because Heritage raises a meritorious defense that if sustained, would change the outcome of the present consolidated cancellation and opposition proceeding.

A defense is "meritorious" if it is "good at law." *See Dassault Systemes SA v. Childress*, 101 U.S.P.Q.2D (BNA) 1032, 1039 (6th Cir. Mich. 2011). When determining the validity of a meritorious defense, the test is not whether a defense is likely to succeed on the merits; rather, the criterion is merely whether "there is some possibility that the outcome of the suit after a full trial will be contrary to the result achieved by the default." *Id.* Thus even conclusory assertions may be sufficient to establish the "hint of a suggestion" needed to present a meritorious defense. *Id.*

The "good at law" standard is relatively lenient. *Id.* Heritage submits under seal sales summaries reports produced by predecessor in interest in the ordinary course of business. *See* Exhibit A. These reports demonstrate a considerable presence of the UNION mark in commerce. The continued and uninterrupted use of the mark in commerce has created a significant demand by consumers for UNION product. *See* Exhibit B. A substantial amount of good will has been generated by almost a decade of use in commerce. Because the reports support UNION's date of first use and continued use in commerce, the reports are evidence that UNION has been used continuously and without interruption. Having established the existence of this vital meritorious defense, Heritage's combined motions should be granted and the trial dates should be reset accordingly. It is of utmost importance that this matter be decided on the merits.

II. Relief from judgment is warranted because judicial economy demands this proceeding be decided on the merits before the TTAB.

60(b) motions are granted at the sound discretion of the TTAB. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991). The Board should consider the interests of judicial economy when deciding whether to cancel a mark that has 1) been used in commerce continuously for nearly a decade and 2) developed substantial good will. *See Exhibit A; see also Exhibit B.* If the merits of this proceeding are not addressed before the TTAB, the entire controversy between Petitioner and Heritage remains unresolved. This is only a prelude to further litigation between Heritage and Petitioner. Heritage will vigorously defend its newly acquired interest and file an infringement action in Federal Court once Petitioner commences use in commerce. Even if the cancellation stands, UNION has common law rights that are deserving of protection. The TTAB should preserve the interests of judicial economy. This proceeding has lasted almost five years and should be decided on the merits before the TTAB. Public policy favors finality of judgments and the termination of litigation. The TTAB should find in favor of Heritage and grant Heritage's combined motions to prevent the future litigation based upon infringement.

III. Relief from judgment is warranted because Petitioner will not be unduly prejudiced by Heritage being granted an opportunity to respond to Petitioner's motion for summary judgment.

Petitioner fails to establish it will be unduly prejudiced by granting Heritage's combined motions for relief from judgment. Prejudice is more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. *See Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997), *citing Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990); see TMBP § 509.01(b)(1). The record is replete with evidence that Petitioner's ability to defend itself has not and would not be adversely affected or

prejudiced by the Board permitting Heritage to respond to Petitioner's motion for summary judgment. Therefore, because Petitioner cannot establish it will be unduly prejudiced, relief under 60(b) should be granted.

IV. Relief from judgment is warranted because predecessor in interest's default was not wilful.

Petitioner contends in its response to Heritage's combined motions that predecessor in interest's default to its motion for summary judgment was willful. Petitioner further alleges that no reason has been provided to explain why Heritage's predecessor in interest could not file a timely response to Petitioner's motion for summary judgment. However, Heritage provided sworn declarations explaining the likely reason for predecessor in interest inability to respond to Petitioner's motion. Heritage goes to extraordinary lengths to explain the circumstances surrounding the delay in bringing these motions. *See* Exhibits B, C, D, E, F.

Furthermore, it is Heritage's belief that the audit/investigation which delayed the transfer of the UNION mark to Heritage likely stems from Petitioner's probing into predecessor in interest's financial affairs regarding the records of tobacco excise taxes filed and/or surcharge stamps issued in the years 2005 and 2006 for Falcon of America, Inc., American Cigarette Company, F.T.S. Distributors, United American Tobacco, and Mary Jane Cigarette Company. *See* Exhibit G, H, B, D. Nonetheless, cigarettes under the UNION mark have been continuously sold since at least 2005 which is demonstrated by the attached sales summaries reports. *See* Exhibit A. However, a major problem for Heritage is the fact that previously retained counsel withdrew from the proceeding, and kept pertinent information necessary for Predecessor to maintain a defense against the cancellation of the UNION trademark. *See* Exhibit I.

After the Board granted previously retained counsel's request to withdraw in March 2, 2012, the Board reset predecessor's time to respond to the motion for summary judgment.

Predecessor then assigned the mark to Smoker's Best who then quickly retained new counsel. See Exhibit J. New counsel requested both a motion to extend time AND a motion to take discovery. Smoker's Best, (Heritage's immediate predecessor in interest) inherited the documents from ACC but not those materials deemed attorney's eyes only. In addition to being denied attorney's eyes only documents, Mr. Kain and Mr. Spielman kept their work product. New counsel was severely limited in its ability to take over this complicated proceeding. It is possible that because new counsel's request to take discovery was denied, new counsel had to withdraw for inability to maintain the defense of the UNION mark. Being denied pertinent information available to facilitate the defense, and Predecessor having no formal or legal training, Predecessor had no means to defend itself. Heritage's predecessor may not have been a saint, but the equities must be balanced between the parties. Petitioner's willful blindness surrounding predecessor's obvious diminished resources to defend itself in this proceeding, stemming from the likely attack by multiple bodies resulting from Petitioner's investigation into predecessor's alleged non-compliance with the TTB, should not go unnoticed by the Board.

The Board should grant relief from judgment because Heritage has the wherewithal to reach a resolution on the merits. It is not in the interest of justice to cancel the UNION trademark by default when the case has been demonstrated to have been vigorously litigated by the voluminous records produced during discovery.

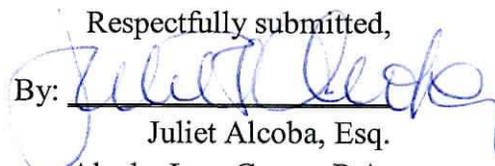
CONCLUSION

Relief from judgment is warranted because Heritage has explained the reasons for both predecessors' failure to respond to Petitioner's summary judgment motion. Heritage required all documents pertaining to the Union trademark in predecessor in interest's custody be transferred prior to closing. These precautions were all taken in good faith and with the intention of being able to adequately defend Heritage's newly acquired interest in the trademark. The Board's

interest of judicial economy should weigh in favor of granting Heritage's combined motions. Once the Board takes into account the totality of circumstances surrounding the delay in responding to Petitioner's motion for summary judgment, specifically that both Heritage and Predecessor in interest were not acting in bad faith, and the strong public policy favoring resolving matters on the merits, the Board will find that relief from judgment pursuant to 60(b) is warranted. Relief from judgment should be granted because it would be extremely inequitable and prejudicial to Heritage if judgment were not set aside based on the documented continued and uninterrupted use of the trademark in commerce. For these many reasons, Heritage's combined motions should be granted.

Date: May 2, 2013

Respectfully submitted,

By: 

Juliet Alcoba, Esq.

Alcoba Law Group, P.A.

3399 NW 72 Avenue, Ste. 211

Miami, FL 33122

jalcoba@miamipatents.com

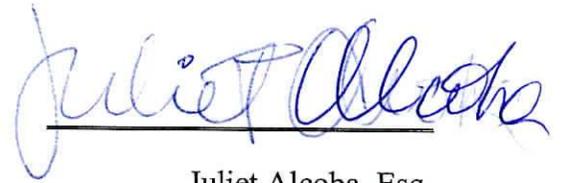
Attorney for Heritage Tobacco, LLC

Florida Bar No. 95502

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing memorandum has been duly served by e-mail to the following:

J. Paul Williamson, Esq.
Tara Vold
Fulbright & Jaworski L.L.P
801 Pennsylvania, Avenue, N.W.
Washington, D.C. 20004-2623
Tel: (202) 662-0200
Fax: (202) 662-4643

A handwritten signature in blue ink, reading "Juliet Alcoba", written over a horizontal line.

Juliet Alcoba, Esq.
Attorney for Heritage Tobacco, LLC
Florida Bar No. 95502

EXHIBIT A

CONFIDENTIAL
UNDER SEAL



EXHIBIT B

4. The documents transferred to Heritage as a result of the Assignment pertaining to the Union trademark are located at 8455 N. West 74 Street Miami, FL 33166.
5. Among the documents in Heritage's possession are the sales summary reports of all UNION sales since 2005. These records have been kept in the ordinary course of business.
6. Since the acquisition of the UNION mark, Heritage has produced and distributed approximately 30,000 pounds of pipe tobacco in a one month period. The demand for UNION tobacco is high and Heritage expects to produce and distribute at least 30,000 pounds of pipe tobacco a month.
7. Basil Battah's son, Trevor Battah, is employed by Heritage, and could provide testimony regarding Basil Battah's whereabouts.

Date: April 30, 2013

By: _____

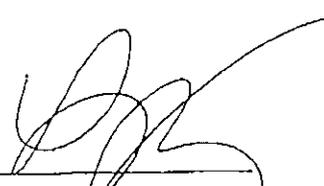

Lazara Arcia
Assistant to President
Heritage Tobacco, LLC

EXHIBIT C

TRADEMARK ASSIGNMENT

Electronic Version v1.1
 Stylesheet Version v1.1

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
Smoker's Best Group, LLC		03/05/2013	LIMITED LIABILITY COMPANY: MISSISSIPPI

RECEIVING PARTY DATA

Name:	Heritage Tobacco, LLC
Street Address:	8455 N. West 74 Street
City:	Miami
State/Country:	FLORIDA
Postal Code:	33166
Entity Type:	LIMITED LIABILITY COMPANY: FLORIDA

PROPERTY NUMBERS Total: 1

Property Type	Number	Word Mark
Registration Number:	2972594	UNION

CORRESPONDENCE DATA

Fax Number: 3054367429
Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent via US Mail.

Phone: 305.362.8118
 Email: jalcoba@miamipatents.com
 Correspondent Name: Juliet Alcoba
 Address Line 1: 3399 NW 72 Avenue
 Address Line 2: 2II
 Address Line 4: Miami, FLORIDA 33122

ATTORNEY DOCKET NUMBER:	ASSIGNMENT UNION
NAME OF SUBMITTER:	Juliet Alcoba
Signature:	/Juliet Alcoba/

OP \$40.00 2972594

Date:

03/13/2013

Total Attachments: 3

source=78066805 tm exhibit a#page1.tif

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ASSIGNMENT OF UNION TRADEMARK

THIS ASSIGNMENT OF TRADEMARK (the "Assignment") is made and entered into as of this 5 day of March, 2013, by and between SMOKER'S BEST GROUP, LLC, a Mississippi Limited Liability Company, and Heritage Tobacco, LLC, a Florida Limited Liability Company (the "Assignee").

RECITALS

WHEREAS, Assignor, as owner of trademark "UNION" recorded in the U.S. Patent and Trademark Office in the United States of America under registration number 2,972,594 dated July 19, 2005 a true copy of which is attached hereto as Composite Exhibit "A", (hereafter collectively "Trademark") desires transfer, and assigns in fee simple all of Assignors rights and interest in and to the Trademark to Assignee, including any common law rights, for \$20,000.00 U.S. dollars.

WHEREAS, Assignor is desirous of assigning of all of its right, title, interest and goodwill in the Trademark in favor of the Assignee, and the Assignee is desirous of succeeding to all of Assignor's right, title, interest and any associated goodwill under and with respect to the Trademark.

NOW THEREFORE, the parties hereby agree as follows:

1. The foregoing recitals are true and correct and are incorporated herein by this reference.
2. Assignor hereby expressly assigns, transfers, and sets over unto Assignee all of Assignor's right, title, and interest, in the Trademark.
3. Assignor further remises, releases, and quitclaims unto Assignee all of his right, title, and interest in and to the Trademark.
4. Assignor specifically waives any right or claim to entitlement or ownership in the Trademark based in common law.
5. The parties acknowledge and agree that this Assignment may be executed in multiple counterparts, and transmitted via telecopy each such counterpart (where transmitted via telecopy or otherwise), when executed, shall constitute an integral part of the one and the same agreement between the parties.
6. This assignment is contingent upon the execution of the Heritage Tobacco Litigation Support Agreement which is attached hereto as Composite Exhibit "B".

IN WITNESS WHEREOF, the parties have hereunto set their hands and seals, the date first above written.

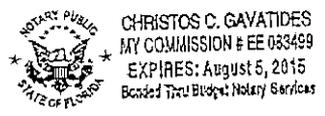
ASSIGNOR:

1. KL Initials
SG Initials

Signature [Handwritten Signature]
Print Name KAREN KAMPERMAN
STATE OF FLORIDA
COUNTY OF MIAMI-DADE

Sworn to or affirmed and signed before me on 5 day of MARCH 2013 by
KAREN KAMPERMAN.

This person is personally known to me or has produced identification. Type of identification produced: _____



[Handwritten Signature]
SIGNATURE NOTARY PUBLIC
CHRISTOS C. GAVATHIDES

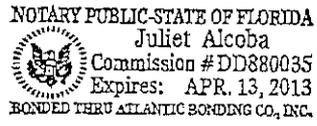
Print, type, or stamp commissioned name of notary or clerk

ASSIGNEE:
Signature [Handwritten Signature]
Print Name JOSE ESPINOSA

STATE OF FLORIDA
COUNTY OF MIAMI-DADE

Sworn to or affirmed and signed before me on 12 day of MARCH 2013 by
JOSE ESPINOSA

This person is personally known to me or has produced identification. Type of identification produced: _____



[Handwritten Signature]
SIGNATURE NOTARY PUBLIC
JULIET ALCOBA

Print, type, or stamp commissioned name of notary or clerk

2 [Handwritten Initials] Initials
[Handwritten Initials] Initials

Int. Cl.: 34

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

Reg. No. 2,972,594

United States Patent and Trademark Office

Registered July 19, 2005

TRADEMARK
PRINCIPAL REGISTER

UNION

MARYJANE CIGARETTE CO., INC. (FLORIDA
CORPORATION)
2315 N.W. 107TH AVENUE, B-15, BOX 66
MIAMI, FL 33172

FIRST USE 2-4-2004; IN COMMERCE 2-4-2004.

SN 78-066,805, FILED 6-1-2001.

FOR: CIGARETTES, IN CLASS 34 (U.S. CLS. 2, 8, 9
AND 17).

JOHN SCHUYLER YARD, EXAMINING ATTOR-
NEY

EXHIBIT D

N.V. Sumatra Tobacco Trading Company)
Petitioner/ Applicant)

v.)

Heritage Tobacco, LLC)

Cancellation No. 92052621

Opposition Nos. 91185261

91186841

For the Mark UNION

Registration Number: 2,972,594

Registration Date: July 19, 2005

Honorable Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

DECLARATION BY JOSE ESPINOSA

Dear Sirs:

I, Jose Espinosa, pursuant to 28 USC § 1746, and upon my personal knowledge, hereby declare under penalty of perjury:

1. I am the Vice President of Heritage Tobacco, LLC. I submit this declaration in support of Heritage Tobacco, LLC's combined motions for relief from judgment, an extension of time to respond to Petitioner/Applicant's, and to reopen proceedings.
2. I have been a managing member of Heritage Tobacco, LLC since at least as early as May 1, 2012. See Exhibit Managing Member.
3. I have been active in the Tobacco industry as a manufacturer/distributor/seller since at least as early as 2011 and have over 5 years' experience.
4. I went on a business trip Thursday, March 22, 2013 and returned to the office Monday, March 25, 2013.
5. Heritage Tobacco, LLC began discussing the possible assignment of the UNION trademark and all of its associated good will in late January 2013.

6. The Tobacco Tax and Trade Bureau (hereinafter "TTB") has been auditing Smoker's Best Group, LLC and American Cigarette Company, Inc. since at least as early as January 2013. The delay in closing for the UNION trademark is the result of Smoker's Best Group, LLC and American Cigarette Company, Inc.'s delay in obtaining clearance from the federal government that assets like the trademark at issue may be sold.
7. Upon my knowledge that the federal government did not impose a lien or bar the sale of the trademark, I authorized the closing could take place between Smoker's Best Group, LLC and Heritage Tobacco, LLC in March provided all documents pertaining to the UNION trademark in their possession were produced and made available for my agents' inspection. *See Exhibit Wire Transfer and Confirmation Number.*
8. Upon my return to the office March 25, 2013, I authorized retained counsel to take immediate steps to set aside the order cancelling the Union trademark, request an extension of time to respond to Petitioner/Applicant's submitted motions for summary judgment, and submit this motion to reopen proceedings and reset trial dates.

Date: April 2, 2013

By: 

Jose Espinosa

Vice President

Heritage Tobacco, LLC

EXHIBIT E

**DECLARATION OF KAREN KAMPERMAN REGARDING THE ACQUISITION OF
THE UNION TRADEMARK REGISTRATION CERTIFICATE NO. 2,972,594**

I, Karen Kamperman, pursuant to 28 USC §1746, and upon my personal knowledge, information and belief, hereby declare under penalty of perjury:

1. I am the President of American Cigarette Co., Inc., (hereinafter "ACC") and have been the president of ACC since July 21, 2011.
2. I am the Vice President of Smoker's Best Group, LLC, (hereinafter "SB") and have been the Vice President of SB since March 21, 2011.
3. Smoker's Best Group, LLC was assigned U.S. Trademark Registration No. 2,972,594 for the mark "UNION" in July 21, 2011 from American Cigarette Co., Inc. for cigarettes.
4. SB provided ACC good and valuable consideration in exchange for the assignment of the mark in July 21, 2011.
5. SB has used the UNION trademark for cigarettes since July 21, 2011.
6. Since July 21, 2011, I have never had an instance of confusion, nor have I ever received an errant phone call looking for N.V. Sumatra's UNION products.
7. While Vice President of SB, sales for cigarettes under the UNION trademark have totaled 54,134 cartons, from July 21, 2011 through January 31, 2013.

Executed this 4 day of March, 2013.


Karen Kamperman
Vice President, Smoker's Best Group, LLC

EXHIBIT F

Juliet Alcoba

From: karen kamperman <karenkamperman@msn.com>
Sent: Tuesday, March 12, 2013 11:02 AM
To: Lazara Arcilla Heritage
Cc: Juliet Alcoba MP
Subject: RE: wire confirmation for union trademark

most welcome.
do you need anything else? or is all okay?

Karen Kamperman

From: laz@heritagetobacco.net
To: karenkamperman@msn.com
CC: jalcoba@miamipatents.com
Subject: wire confirmation for union trademark
Date: Tue, 12 Mar 2013 10:43:41 -0400

Good Morning Karen,

Just wired to bb&t 20,000 for the trademark , chris came by and dropped of the papers thanks you very much.

Confirmation 0710055054

Thanks

Laz

EXHIBIT G

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

N.V. SUMATRA TOBACCO TRADING CO., :
Petitioner, : Cancellation No. 92052621 (Consolidated)
v. : Reg. No. 2,972,524
AMERICAN CIGARETTE COMPANY INC. :
Respondent. :

AFFIDAVIT OF TRACY S. DEMARCO

Tracy S. DeMarco hereby states and declares as follows:

1. I am an attorney at Fulbright & Jaworski, L.L.P.

I. Cigarette Excise Taxes in Florida

2. On October 20, 2011, I submitted a public record request to the Florida Department of Business & Professional Regulation's Division of Alcoholic Beverages and Tobacco. The request, attached hereto as Exhibit 1, asked for all records of tobacco excise taxes filed and/or surcharge stamps issued in the years 2005 and 2006 for the following entities: Falcon of America, Inc., American Cigarette Company, F.T.S. Distributors, and United American Tobacco. Ex. 1. On November 20, 2011, I submitted a second request for the above information with respect to Mary Jane Cigarette Co., Inc.

3. Andy Walker of the Division of Alcoholic Beverages and Tobacco provided me with the following information in response to my requests:

a. None of the entities -- including Falcon of America, Inc., F.T.S. Distributors, United American Tobacco, Mary Jane Cigarette Co., Inc., and American Cigarette Company -- paid or were assessed tobacco excise taxes in 2005. See Ex. 1, Oct. 21, 2011 Email

Correspondence from A. Walker to T. DeMarco & Attached Spreadsheet; Ex. 2, Oct. 26, 2011
Email Correspondence from A. Walker to T. DeMarco; Ex. 3, Nov. 30, 2011 Email
Correspondence from A. Walker to T. DeMarco.

b. American Cigarette Company paid cigarette excise taxes in February through June of 2006 and again in September through November of 2006. *See* Ex. 1, Spreadsheet. Such taxes were assessed in 2006. *See* Ex. 2.

c. Neither Falcon of America, Inc., F.T.S. Distributors, United American Tobacco, nor Mary Jane Cigarette Co., Inc. paid or were assessed cigarette excise taxes in 2006.

4. Mr. Walker obtained the above information from electronic records maintained by the Florida Department of Business & Professional Regulation's Division of Alcoholic Beverages and Tobacco ("the Department"). *See* Ex. 1.

5. Mr. Walker explained that the Department does not maintain paper records for monthly excise tax payments that occurred in 2005 and 2006 as Florida statute only requires that such records be maintained for three (3) years. *See id.*

II. Statutory Exhibits to Memorandum

6. Exhibits 30, 31, 39, 42, 43, and 46 to the Memorandum of Law In Support of Applicant's Motion for Summary Judgment, Canc. No. 92052621 (Consolidated) are current versions of United States, California, and Florida Statutes.

7. The above referenced Memorandum contains citations to the 2004 and 2005 versions of these statutes.

8. I have verified that cited sections from 2004 and 2005 are identical to the same citations in the current versions of each statute.

The affiant says nothing more.

Tracy S. DeMarco
Tracy S. DeMarco

12/1/11
Date

I, Linda C. Brown, a notary public in the District of Columbia, hereby affirm that Tracy S. DeMarco personally appeared before me and, after providing appropriate identification and being duly sworn, executed the foregoing Affidavit.

Linda C. Brown
12-1-11
Date



LINDA C. BROWN
NOTARY PUBLIC DISTRICT OF COLUMBIA
My Commission Expires August 31, 2016

EXHIBIT H

DeMarco, Tracy Stewart

From: Walker, Andy [Andy.Walker@dbpr.state.fl.us]
Sent: Friday, October 21, 2011 4:37 PM
To: DeMarco, Tracy Stewart
Subject: FW: Cigarette Tax Records
Attachments: 2006 Taxes Paid Records Request.xls

Good afternoon Ms. DeMarco,

Florida Statute requires that we retain records for 3 years, we try and retain them 3-5 years so I am unsure if we still have the paper monthly reports from 2006 in archives. However I was able to find information in our database pertaining to taxes paid. I hope the attached spreadsheet will be useful.

Thanks

From: publicrecords, abt
Sent: Friday, October 21, 2011 8:24 AM
To: Walker, Andy; Fraher, Marie
Subject: FW: Cigarette Tax Records

From: DeMarco, Tracy Stewart [mailto:tdemarco@fulbright.com]
Sent: Thursday, October 20, 2011 11:34 AM
To: publicrecords, abt
Subject: Cigarette Tax Records

I'd like to request public records of tobacco excise taxes filed and/or surcharge stamps issued in the year 2006 for the following entities:

1. Falcon of America, Inc.
2. American Cigarette Company
3. F.T.S. Distributors
4. United American Tobacco

Please don't hesitate to contact me if you need further information and/or payment for the requested records.

Best regards,
Tracy DeMarco

Tracy S. DeMarco, Associate
FULBRIGHT & Jaworski L.L.P. • 801 Pennsylvania Avenue, N.W. • Washington, D.C. 20004-2623
T: 202 662 4653 • F: 202 662 4643 • tdemarco@fulbright.com • www.fulbright.com/tdemarco

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To reply to our email administrator directly, send an email to postmaster@fulbright.com.

EXHIBIT I

Trademark Trial and Appeal Board Electronic Filing System. <http://esta.uspto.gov>

ESTTA Tracking number: ESTTA458066

Filing date: 02/23/2012

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

Proceeding	92052621
Party	Defendant American Cigarette Company, Inc.
Correspondence Address	ROBERT C KAIN JR KAIN & ASSOCIATES ATTORNEYS AT LAW PA 900 SOUTHEAST 3RD AVENUE, SUITE 205 FORT LAUDERDALE, FL 33316 UNITED STATES RKain@ComplexIP.com, dspelman@complexip.com
Submission	Request to Withdraw as Attorney
Filer's Name	Robert C. Kain, Jr.
Filer's e-mail	rkain@complexip.com
Signature	/rck/
Date	02/23/2012
Attachments	motion-withdraw-3d-20120223.pdf (5 pages)(49694 bytes)

TRADEMARKS

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

In the matter of application Serial No. 76/415,303 and 76/415,305

Mark: "UNION GOLD" and "U-UNION and Design"

American Cigarette Company, Inc.

Opposer/Plaintiff,

v.

Opposition Nos. 91185261
91186841
Cancellation No. 92052621
(Consolidated)

N.V. Sumatra Tobacco Trading Company

Applicant/Defendant.

THIRD MOTION TO WITHDRAW

Robert C. Kain, Jr, Esq. and Darren Spielman, Esq. and the firm Kain & Associates, Attorneys at Law, P.A. hereby move to withdrawal as counsel for Opposer American Cigarette Company, Inc. There has arisen a conflict between counsel and Opposer which requires counsel to withdrawal.

Due to the attorney-client privilege, counsel for Opposer cannot reveal the nature of the conflict. Therefore, it would be futile for undersigned counsel to confer with opposing counsel prior to filing this motion as required by the Rules.

37 C.F.R. 10.40 states: "(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving

due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.”

In this matter: (A) reasonable steps have been taken to avoid foreseeable prejudice to the rights of the client. Letters have been sent to the client indicating several irreconcilable conflicts between counsel (and counsel’s law firm) and the client. The initial letter outlining these conflicts was sent in October, 2011. The client did not resolve the conflict at that time nor in November or December, 2011. Several follow-up letters and emails were sent in January and through February 13, 2012 which identified numerous reasons why several irreconcilable conflicts have arisen between counsel and client. Due to ethical rules of the Florida Bar and the USPTO, counsel is not permitted to identify these conflicts. The client has not resolved these conflicts with counsel.

(B) Several lawyers have contacted the undersigned counsel including Paul Keneally, Esq. at PKeneally@underbergkessler.com and Jeff Weissman, Esq. at jeffweissman@wdbnpa.fdn.com to resolve these conflicts. However, they have not indicated whether or not the client has retained these lawyers. These communications in February indicate that the client has had an opportunity to retain other counsel. Client has not called nor written nor emailed counsel to resolve these conflicts.

(C) The client has been given copies of all materials filed in the USPTO. Also, the client has copies of all discovery materials (other than attorneys-eyes-only material). As for the counsel’s work product, under Florida law, counsel has a legal right to retain those files and materials until the conflict is resolved.

Both retaining liens and charging liens arose under common law. Maryland Casualty

Co. v. Westinghouse Credit Corp. (In re Hanson Dredging, Inc.), 15 Bankr. 79 (S.D. Fla. 1981). See Nichols v. Kroelinger, 46 So.2d 722 (Fla. 1950). No statutes outline the requirements for valid attorney's liens in Florida. Rather, case law acts as the sole guide for both attorneys and courts as to these liens. Sinclair, Louis, Siegel, Heath, Nussbaum & Zavertnik, P.A. v. Baucom, 428 So.2d 1383 (Fla. 1983); St. Ana v. Wheeler Mattison Drugs, Inc., 129 So.2d 184 (Fla. 3d DCA), cert. denied, 133 So.2d 646 (Fla. 1961). In Sinclair, Louis, 428 So.2d at 1385, this Court set out four requirements for a valid charging lien. To impose such a lien, the attorney must show: (1) an express or implied contract between attorney and client; (2) an express or implied understanding for payment of attorney's fees out of the recovery; (3) either an avoidance of payment or a dispute as to the amount of fees; and (4) timely notice. Daniel Mones, P.A. v. Smith, 486 So. 2d 559, 561 (Fla. 1986)

The retaining lien extends to all property in counsel's possession. "In Florida an attorney has a right to a retaining lien upon all of the client's property in the attorney's possession, including money collected for the client." Daniel Mones, P.A. v. Smith, 486 So. 2d 559, 561 (Fla. 1986).

Counsel and client have a several written engagement letters which set forth counsel's right to a retaining lien. Due to the privilege for attorney-client communications, counsel cannot submit these engagement letters to the TTAB.

(D) Counsel and his law firm do not have any fees paid in advance for this TTAB litigation.

Mandatory withdraw is required because: "The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule." See Representing a Client Zealously, 37 C.F.R. 10.84. Counsel represents multiple parties and believes a conflict has arisen with those parties. See 37 C.F.R. 10.66. Client's refusal to resolve the conflict since October 2011 through February 13, 2012 is adversely effecting counsel ability to prepare for the summary judgment in this matter. See 37 C.F.R. 10.77(b).

Permissive withdrawal is requested because: "By [client's] other conduct [client] renders it unreasonably difficult for the practitioner to carry out the employment effectively," 37 C.F.R.

10.40(c)(1)(iv), client has failed to pay bills 37 C.F.R. 10.40(c)(1)(vi), and counsel's "continued employment is likely to result in a violation of a Disciplinary Rule." 37 C.F.R. 10.40(c)(2).

Counsel has been given notice of this motion to Opposer as indicated on the service list.

WHEREFORE, counsel for Opposer respectfully requests that the TTAB permit them to withdraw as counsel.

Dated: February 23, 2012

Respectfully submitted,

By: /Robert Kain/

Robert C. Kain, Jr.
Florida Bar No. 266760
rkain@complexip.com
Kain & Associates, Attorneys at Law, P.A.
900 Southeast Third Avenue, Suite 205
Ft. Lauderdale, Florida 33316-1153
Telephone: (954) 768-9002
Facsimile: (954) 768-0158
Attorney for Opposer American Cigarette Company,
Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 23 day of February, 2012, a true copy of the foregoing Motion to Withdraw was served via email and mail to the following:

Tara Vold
J. Paul Williamson
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-662-0200
Fax: 202-662-4643
tvold@fulbright.com

And was served via email and mail on the attached Service List.

/Robert Kain/

Robert C. Kain, Jr.

SERVICE LIST

Karen Kamperman, CEO (karenkamperman@msn.com)
American Cigarette Company, Inc.
1291-B N.W. 65th Place
Ft. Lauderdale, Florida 33309

GARCKVCLIENTSBattah-ACCUion-Gold-Opposition-Sumatra\motion-withdraw-3d-20120223.wpd

EXHIBIT J

Opposition

Number: 91186841

Filing Date: 10/07/2008

Status: Terminated

Status Date: 04/01/2013

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: N.V. Sumarta Tobacco Trading Company

Correspondence: VALYNIA SIMMONS

FULBRIGHT & JAWORSKI LLP
801 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004
UNITED STATES
tvold@fulbright.com

Serial #: 76415305

Application File

Application Status: Opposition Pending

Mark: U UNION

Plaintiff

Name: American Cigarette Company, Inc. and Smoker's Best Group, LLC

Correspondence:

SMOKER'S BEST GROUP LLC
645 WESTMORELAND DRIVE
TUPELO, MS 38801
UNITED STATES

Serial #: 78066805

Application File

Registration #: 2972594

Application Status: Section 8 - Accepted

Mark: UNION

Prosecution History

#	Date	History Text	Due Date
31	04/01/2013	TERMINATED	
<u>30</u>	03/29/2013	<u>BD DECISION: DISMISSED W/ PREJ</u>	
<u>29</u>	03/29/2013	<u>BD DECISION: DISMISSED W/ PREJ</u>	
<u>28</u>	04/02/2012	<u>APPEARANCE</u>	
<u>27</u>	02/23/2012	<u>P'S REQUEST TO WITHDRAW AS ATTORNEY</u>	
<u>26</u>	02/14/2012	<u>P'S REQUEST TO WITHDRAW AS ATTORNEY</u>	
<u>25</u>	02/14/2012	<u>P'S REQUEST TO WITHDRAW AS ATTORNEY</u>	
<u>24</u>	10/05/2011	<u>P'S NOTICE ON NON-AVAILABILITY</u>	
<u>23</u>	06/29/2010	<u>EXTENSION OF TIME GRANTED</u>	
<u>22</u>	06/29/2010	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>21</u>	05/07/2010	<u>EXTENSION OF TIME GRANTED</u>	
<u>20</u>	05/07/2010	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>19</u>	02/09/2010	<u>EXTENSION OF TIME GRANTED</u>	
<u>18</u>	02/09/2010	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>17</u>	11/13/2009	<u>EXTENSION OF TIME GRANTED</u>	
<u>16</u>	11/13/2009	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>15</u>	10/09/2009	<u>EXTENSION OF TIME GRANTED</u>	
<u>14</u>	10/09/2009	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	

<u>13</u>	09/10/2009	<u>EXTENSION OF TIME GRANTED</u>	
<u>12</u>	09/10/2009	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>11</u>	07/13/2009	<u>EXTENSION OF TIME GRANTED</u>	
<u>10</u>	07/13/2009	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>9</u>	01/15/2009	<u>ANSWER</u>	
<u>8</u>	12/05/2008	<u>EXTENSION OF TIME GRANTED</u>	
<u>7</u>	12/05/2008	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>6</u>	11/14/2008	<u>EXTENSION OF TIME GRANTED</u>	
<u>5</u>	11/14/2008	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
<u>4</u>	11/04/2008	<u>MOTION TO CONSOLIDATED IS GRANTED</u>	
<u>3</u>	10/07/2008	PENDING, INSTITUTED	
<u>2</u>	10/07/2008	<u>NOTICE AND TRIAL DATES SENT; ANSWER DUE:</u>	11/16/2008
<u>1</u>	10/07/2008	<u>FILED AND FEE</u>	



Search: _____

Cancellation

Number: 92052621

Filing Date: 06/24/2010

Status: Awaiting Expiration of Appeal Period

Status Date: 06/24/2010

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: American Cigarette Company, Inc. and Smoker's Best Group, LLC

Correspondence:

SMOKER'S BEST GROUP, LLC
645 WESTMORELAND DRIVE
TUPELO, MS 38801
UNITED STATES

Serial #: 78066805 Application File

Registration #: 2972594

Application Status: Section 8 - Accepted

Mark: UNION

Plaintiff

Name: N.V. Sumatra Tobacco Trading Company

Correspondence: J PAUL WILLIAMSON

FULBRIGHT & JAWORSKI LLP
801 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004-2623
UNITED STATES
wotrademark@fulbright.com, pwilliamson@fulbright.com,
tvold@fulbright.com

Prosecution History

Due Date

#	Date	History Text	Due Date
22	01/07/2013	<u>BD DECISION: GRANTED</u>	
21	04/02/2012	<u>D'S MOTION FOR AN EXTENSION OF TIME</u>	
20	04/02/2012	<u>D'S APPEARANCE OF COUNSEL/POWER OF ATTORNEY</u>	
19	02/23/2012	<u>D'S REQUEST TO WITHDRAW AS ATTORNEY</u>	
18	02/14/2012	<u>D'S REQUEST TO WITHDRAW AS ATTORNEY</u>	
17	02/07/2012	<u>P'S OPPOSITION/RESPONSE TO MOTION</u>	
16	01/30/2012	<u>D'S MOTION FOR AN EXTENSION OF TIME</u>	
15	12/28/2011	<u>D'S MOT FOR EXTEN. OF TIME W/ CONSENT</u>	
14	12/01/2011	<u>P'S MOTION FOR SUMMARY JUDGMENT</u>	
13	12/01/2011	<u>P'S MOTION FOR SUMMARY JUDGMENT</u>	
12	09/02/2011	<u>EXTENSION OF TIME GRANTED</u>	
11	09/02/2011	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
10	06/02/2011	<u>EXTENSION OF TIME GRANTED</u>	
9	06/02/2011	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
8	03/07/2011	<u>EXTENSION OF TIME GRANTED</u>	
7	03/07/2011	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
6	09/09/2010	<u>ANSWER</u>	
5	08/12/2010	<u>CONSOLIDATED WITH 91185261; TRIAL DATES RESET</u>	
4	08/03/2010	<u>MOTION TO CONSOLIDATE</u>	

Prosecution History

#	Date	History Text	Due Date
3	06/24/2010	PENDING, INSTITUTED	
<u>2</u>	06/24/2010	<u>NOTICE AND TRIAL DATES SENT; ANSWER DUE:</u>	08/03/2010
<u>1</u>	06/24/2010	<u>FILED AND FEE</u>	

Search: _____

N.V. Sumatra Tobacco Trading Company)
Petitioner/ Applicant)
)
)
v.)
)
Heritage Tobacco, LLC)

Cancellation No. 92052621
Opposition Nos. 91185261
91186841
For the Mark UNION
Registration Number: 2,972,594
Registration Date: July 19, 2005

Honorable Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

DECLARATION BY JULIET ALCOBA

Dear Sirs:

I, Juliet Alcoba, pursuant to 28 USC § 1746, and upon my personal knowledge, hereby declare under penalty of perjury:

1. I am an attorney at the law firm Alcoba Law Group, P.A. which is counsel to Heritage Tobacco, LLC (hereinafter referred to as “Heritage”), the current owner of former U.S. Trademark Registration No. 2,972,594, “UNION” dated July 19, 2005 which includes its common law rights and any associated goodwill under and with respect to trademark.
2. Exhibit “A “ is a a true and correct copy of the sales summary reports kept in the ordinary course of business by American Cigarette Company, Inc. and Smoker’s Best Group, LLC which pertain to all cigarette sales under the UNION mark since at least 2005 which were provided to Heritage by Smoker’s Best Group, LLC to as a condition precedent to the sale and transfer of the UNION trademark.
3. Exhibit “B “ is a signed declaration by Lazara Arcila.

4. Exhibit "C" is a true and correct copy of the recorded assignment and reel frame of the UNION trademark.
5. Exhibit "D" is a signed declaration by Jose Espinosa.
6. Exhibit "E" is a signed declaration by Karen Kamperman.
7. Exhibit "F" is a true and correct copy of an email exchanged between Karen Kamperman and Lazara Arcila.
8. Exhibit "G" is a signed declaration by Tracy S. Demarco.
9. Exhibit "H" is a true and correct copy of an email produced by Petitioner during discovery between Tracy S. Demarco and Andy Walker, dated October 21, 2011.
10. Exhibit "I" is a true and correct copy of Respondent's previously retained counsel's request to withdraw as attorney dated 02/23/2012.
11. Exhibit "J" is a true and correct copy of the prosecution history of the present TTAB proceeding.
12. Enclosed is Heritage's Reply to Petitioner's Motion in Opposition to Heritage's combined motions for relief.
13. Enclosed is a Motion to Substitute Respondent/Opposer with an attached Exhibit 1. Exhibit 1 is a duplicate copy of the recorded assignment of the UNION trademark.
14. The undersigned further states that all information made herein is made of her own knowledge, is true, and that all statements made on information and belief are believed to be true and that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom.

HERITAGE TOBACCO, LLC

Date: May 2, 2013

By: /Juliet Alcoba/

Juliet Alcoba

Attorney for Heritage Tobacco, LLC

Florida Bar No. 95502

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing is being electronically transmitted via the Electronic System for Trademark Trials and Appeals, (“ESTTA”) on May 2, 2013 and have been duly served by e-mail, to the following:

J. Paul Williamson, Esq.
Tara Vold
Fulbright & Jaworski L.L.P
801 Pennsylvania, Avenue, N.W.
Washington, D.C. 20004-2623
Tel: (202) 662-0200
Fax: (202) 662-4643

/Juliet Alcoba/

Juliet Alcoba, Esq.
Alcoba Law Group, P.A.
3399 NW 72 Avenue, Ste. 211
Miami, FL 33122
Tel: (305) 362-8118
Facsimile: (305) 436-7429

Attorney for Heritage Tobacco, LLC
Florida Bar No. 95502