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

Proceeding	91195724
Party	Plaintiff BRITISH AMERICAN TOBACCO ITALIA S.P.A.
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Date	09/23/2010
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By: Paola Atkins

Date: September 23, 2010

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

In re Serial No.: 77/929,917
Mark: MS. MENTHOL
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BRITISH AMERICAN TOBACCO ITALIA S.P.A. Opposer, v. Mr. Ajmar S. Johal, and Mr. Robert A. Casey, Applicants.	Opposition No. 91195724

MOTION TO STRIKE APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Pursuant to Fed. R. Civ. P. 12(f), Opposer, BRITISH AMERICAN TOBACCO ITALIA S.P.A. ("Opposer") moves to strike the Answer to the Notice of Opposition filed by Mr. Robert A. Casey ("Respondent") in this proceeding. The proceedings of the Trademark Trial and Appeal Board are governed by the Federal Rules of Civil Procedure. 37 C.F.R. § 2.116.

Similar to court proceedings, the parties of an opposition proceeding are expected to comply with such rules and are charged with their knowledge. Even when a party is not represented by legal counsel and appears *pro se*, such as it seems in this case, the ignorance of the rules is no excuse.

Particularly, the opposer in an opposition proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding shall be in the position of defendant. 37 C.F.R. § 2.116(b). The answer in an opposition proceeding corresponds to the answer in a court proceeding. 37 C.F.R. § 2.116(c).

I. RESPONDENT HAS FAILED TO ANSWER PROPERLY TO OPPOSER'S ALLEGATIONS AND HIS ANSWER SHOULD BE STRICKEN

Rule 12(f) allows the court to strike "from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." *See* T.B.M.P § 506.

Respondent's Answer to Opposer's Notice of Opposition follows none of the requirements set forth by the Federal Rules of Civil Procedures. It should be therefore stricken.

The entire Answer is in fact confusing and unintelligible. It contains a series of digressing statements in which Respondent postulates self-serving factual and legal conclusions, without addressing orderly the allegations set forth in the Notice of Opposition. As such, the entire Answer is cluttered with insufficient defenses, redundant, immaterial or impertinent matters.

An answer needs not follow a particular format. However, it must meet the requirements for the particular type of submission to the Board (Rule § 2.126(a) for paper). *See* T.B.M.P. §311.01(a).

37 C.F.R. § 2.126 (a)(1) provides that:

> *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet.*

Respondent's Answer is a paper submission. However, the page format is not double-spaced as required under 37 C.F.R. § 2.126 (a)(1).

37 C.F.R. § 2.126 (5) provides that:

All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in §2.123(g)(2);

37 C.F.R. §2.123(g)(2) requires that:

Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.

The pages in Respondent's Answer have not been numbered. The exhibits to the Answer have not been numbered nor marked in the manner prescribed under 37 C.F.R. §2.123(g)(2).

In addition, Respondent has violated every other requirement governing the format of the answer and the proper service of process. For example, the copy of the Answer served to Opposer's counsel does not contain the required information at the top of the heading: "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD" T.B.M.P 311.01(a). See Exhibit A. For some time, this omission led Opposer to believe that the Answer was a communication directed to Opposer, rather than a responsive pleading. Opposer recognized that the original Answer had been actually filed and contained the required heading information, only upon performing a routine check of the TTAB electronic records.

Respondent did not include a description of the capacity in which he was signing. T.B.M.P. 311.01(b). The copy that was served to Opposer did not include any of the exhibits submitted to the Board. T.B.M.P. 311.01(c). Respondent did not make his admissions or denials in numbered paragraphs corresponding to the numbered paragraphs in the complaint. T.B.M.P. 311.02(a).

Turning to the content of the answer, 37 C.F.R. §2.106 (b)(1) provides that:

> *An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials shall fairly meet the substance of the averments denied.*

Respondent's Answer does not state in short and plain terms his defenses to each claim that Opposer asserted in the Notice of Opposition. Rather, Respondent's Answer is a disorganized dissertation that argues the merits of the allegations. As the Board's rules state, "The defendant should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied." T.B.M.P. § 311.02(a). A party that intends in good faith to deny only part of an allegation must admit the part that is true and deny the rest. *See* Rule 8(b)(4).

Respondent's neither admits nor denies, specifically or generally, Opposer's allegations regarding:

(1) The global reputation for quality enjoyed by Opposer's trademarks (Notice of Opposition ¶1);

(2) The length and extent of use of Opposer's trademarks (Notice of Opposition ¶1);

(3) The similarity of Opposer's trademarks and Respondent's trademarks; the relatedness of the goods sold under the respective marks and the resulting likelihood of confusion between the marks (Notice of Opposition ¶10);

(4) The extent and duration of the advertisement of Opposer's mark, including in the U.S. (Notice of Opposition ¶12);

(5) The risk that Opposer's trademarks will be diluted by tarnishment or by blurring (Notice of Opposition ¶13);

(6) The fact that Respondent's trademarks will falsely suggest a connection with Opposer (Notice of Opposition ¶16).

To the extent that the Answer does not contain specific or general denial of Opposer's allegations, these allegations should be deemed admitted. Fed. R. Civ. Proc. 8(d) ("Averments in a pleading to which a responsive pleading is required ... are admitted when not denied in the responsive pleading.").

For these reasons, the Answer is entirely insufficient and cannot be considered a pleading responsive to Opposer's allegations in its Notice of Opposition. Accordingly, Petitioner asks that the Board strike the Answer. In the alternative, if the Board chooses not to strike the Answer, the Board should deem the allegations in the Notice that are not specifically denied in the Answer, to be admitted by Respondent. Fed. R. Civ. P. Sed); T.B.M.P. 311.02(a) ("An answer that fails to deny a portion of an allegation may be deemed admitted as to that portion.").

II. CONCLUSION

Respondent's Answer to the Notice of Opposition is procedurally and substantively deficient as explained above. It should therefore be stricken in its entirety. In the alternative, any allegation not specifically denied in the Answer should be deemed admitted by Respondent.

Respectfully Submitted,

Dated: September 23, 2010

By: Paolo A Strino

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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing MOTION TO STRIKE APPLICANT'S ANSWER TO NOTICE OF OPPOSITION, including any exhibits thereof, has been served on Applicants, by mailing said copy on September 23, 2010, via First Class Mail, postage prepaid to Applicants' addresses or record at 28 Frederick Street Carteret, NJ, USA 07008 and 52 Woodview Drive Howell NJ, USA 07731.

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ATTORNEY FOR OPPOSER

EXHIBIT A

Paolo A. Strino
LUCAS & MERCANTI LLP
475 Park Avenue South
New York, NY 10016

Robert A. Casey
52 Woodview Drive
Howell, NJ 07731
Casey77@optonline.net
August 24, 2010

Ms. Elizabeth Winter,

My name is Robert A. Casey and I am responding to the Notice of Opposition #91195724. My trademark application # is 77929917.

I would like to start by noting that a major principle of the United States trademark law and that of other countries is that trademark protection is national in nature and does not extend beyond a country where the mark is used and registered. In this case, my opposer's foreign mark is neither in use nor registered here in the United Sates. It is my belief that my opposer's trademark application is a direct response to mine. As you are aware my application submission date is 5 months prior to my opposers'. From my understanding, for that reason, I have the initial rights to pursue this trademark and my American dream of manufacturing and selling cigarettes in the United States. Moreover, my opposer, an owner of a foreign mark who seeks protection here in the U.S. should have taken the necessary steps to ensure that their trademark rights were recognized where they seek to assert them.

I believe that under the Famous Marks Doctrine, my opposer's brand is not covered. I question, what percent of American consumers in the cigarette market are familiar with my opposer's foreign mark? In order to be covered the brand should have a level of recognition. My opposer's brand is not common, ordinary, nor widespread amongst the American smoking public. Their mark in the U.S. is unknown. Under this doctrine the mark needs to be common and since it is not in the U.S. there would be no cause for confusion from the consumers' stand point therefore should not be protected under this doctrine. In their opposition to me, they openly admit that they do not manufacture or sell their products here in the U.S. nor do they intend to. The Trademark Trial and Appeals Board has dismissed cases such as this where the opposer is not protected under the Famous Marks Doctrine, as an example, Bayer Consumer Care AG V. Belmora LLC. In April 2009 the Trade Mark Trial and Appeal Board held that there was no Famous Marks Doctrine in the U.S.

To further address this notice of opposition, I, Robert Casey have spent the last 33 years of my life selling cigarettes in the U.S. As a salesman in the cigarette industry, wouldn't you think that I would have had knowledge of this brand if it was recognized in U.S.?

I intend to use my extensive experience and knowledge of the cigarette industry to manufacture and sell my pending trademark. To further solidify my intentions of engaging in the cigarette business I should make you aware that I also currently have a Notice of Allowance on Mr. Menthol, application # 77756877, which I also will manufacture and sell.

Manufacturing my pending trademark in the U.S. will no impact on their foreign business in Italy or surrounding countries. My opposer claims they will suffer great damage and irreparable harm. Since my opposer does not have a market in the U.S. and my intentions are to market my pending trademark here in the U.S., how would my opposer ~~stand~~ suffer damages?

In closing, based upon my response to this notice of opposition, it is clear that my opposer has applied 5 months after mine and shouldn't be entitled to protection under the United States Trademark laws.

Sincerely,

Robert A. Casey - Aug 24th 2010

Robert A. Casey

CERTIFICATE OF SERVICE

I hereby certify that a copy of my response to opposition has been sent to my opposer's attorney, Paolo A. Strino of Lucas & Mercanti LLP 475 Park Avenue South, New York, NY 10016. Mailed August 24, 2010 via certified return receipt mail.

Robert A. Casey
52 Woodview Drive
Howell, NJ 07731
Casey77@optonline.net

Robert A. Casey
8-24-10