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Filing date: **11/09/2010**

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.
Correspondence Address	PAOLO A STRINO LUCAS & MERCANTI LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016 UNITED STATES info@lmiplaw.com
Submission	Motion to Strike
Filer's Name	Paolo A. Strino
Filer's e-mail	info@lmiplaw.com
Signature	/PAS/
Date	11/09/2010
Attachments	SKMBT_C45110110914020.pdf ( 20 pages )(472971 bytes )

By: Perlo Albin

Date: November 9, 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  
Published in the Official Gazette on June 22, 2010

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BRITISH AMERICAN	:	
TOBACCO ITALIA S.P.A.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91195724
	:	
Mr. Ajmar S. Johal,	:	
and	:	
Mr. Robert A. Casey,	:	
	:	
Applicants.	:	
	:	
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**MOTION TO STRIKE APPLICANTS' AMENDED ANSWER AND AFFIRMATIVE DEFENSES, AND MEMORANDUM IN SUPPORT**

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 Amended Answer to the Notice of Opposition ("Amended Answer") filed by Applicants in this Opposition proceeding on October 21, 2010. The Amended Answer was not timely filed or served and fails to comply with the rules governing pleadings in an opposition. Specifically, it contains insufficient defenses and other redundant and immaterial matters.

Having failed to file and serve a proper answer, Appellants are in default. In the interest of fairness and justice, therefore, Opposer respectfully requests that the Board enters a default judgment against Applicants.

**PRELIMINARY STATEMENT**

Applicants have filed two purported pleadings in this proceeding, neither of which complies with the rules governing oppositions or with the Federal Rules of Civil Procedure. The Original Answer dated August 24, 2010 (“Original Answer”) was procedurally and substantively defective, and, thus, does not constitute a proper responsive pleading. Furthermore, Applicants failed to meet the deadline for filing an amended answer and did not seek Opposer’s consent or file a motion for a leave from the Board to file an untimely amended answer. Moreover, the affirmative defenses in Applicants’ Amended Answer are not properly pled. Therefore, Applicants’ Amended Answer is invalid and should be stricken. A default judgment should be entered against Applicants.

**RELEVANT FACTS**

On February 7, 2010, Applicants filed with the United States Patent and Trademark Office (“USPTO”) under Ser. No.: 77/929,917, an application to register the trademark MS. MENTHOL in conjunction with cigarettes in Class 34. This application was published for opposition on June 22, 2010.

On July 20, 2010, Opposer filed a Notice of Opposition against the above-mentioned application alleging *inter alia* lack of *bona fide* intent to use the mark MS. MENTHOL in U.S. commerce, falsely suggesting a connection with Opposer, and likelihood of confusion with a well-known mark.

Subsequently, Applicants sent Opposer a letter dated August 24, 2010, containing a number of self-serving legal and factual statements. Opposer consulted the Trademark Trial and Appeal Board Inquiry System (“TTABVUE”) and confirmed that the letter did not appear in the records.

Several days later, while performing a routine check of the TTABVUE records, Opposer noted that a different version of Applicants’ letter had been updated on the TTABVUE. The TTABVUE labeled Applicants’ correspondence as “Answer”. The letter filed with the TTAB was not served on Opposer and included Exhibits that Applicants never served to Opposer.

On September 23, 2010, Opposer filed a motion to strike Applicants’ Answer.

Applicants did not respond or object to Opposer’s Motion to Strike. Applicant did not request leave from the Board to amend the Original Answer. Instead, on October 21, 2010, nearly two months later, Applicants filed a document entitled “REGISTRANT’S ANSWER AND AFFIRMITIVE DEFENSE” and served the same to Opposer.

Opposer interprets this document as Applicants’ attempt to submit an Amended Answer and now moves to strike said Amended Answer.

### **ARGUMENT**

#### **I. APPLICANTS’ ORIGINAL ANSWER IS NOT A VALID RESPONSIVE PLEADING AND THEREFORE SHOULD BE STRICKEN**

Applicant’s purported Original Answer fails to comply with the rules of the Trademark Office for oppositions or the Federal Rules of Civil Procedure, which are incorporated therein, and, thus, should be stricken.<sup>1</sup> Rule 2.106(b) requires 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

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<sup>1</sup> Opposer incorporates herein the arguments set forth in its September 23, 2010 Motion to Strike Applicants’ Original Answer. For the Board’s convenience, those arguments are summarized herein.

upon which the opposer relies”. Appellants’ Original Answer does not meet the requirements of Rule 2.106. Rather, Applicants’ purported Answer is a rambling letter in which Applicant sets out self-serving factual and legal conclusions, without addressing the allegations set forth in the Notice of Opposition at all much less in an orderly fashion. As such, the entire Original Answer is cluttered with insufficient defenses, redundant and immaterial matter and should be stricken pursuant to Fed R. Civ. P 12(f).

Moreover, Applicants violated every other requirement governing the format of the answer and the proper service of process. Specifically, Applicant’s Original Answer violated the rules in the following ways:

- Although Applicants’ Original Answer was a paper submission, the page format was not double-spaced, and the pages were not numbered as required under 37 C.F.R. § 2.126 (a)(1).
- The exhibits to the Answer were neither numbered nor marked in the manner prescribed under 37 C.F.R. §2.123(g)(2).
- The copy of the Original Answer served to Opposer’s counsel did 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.
- The signer of the Original Answer did not include a description of the capacity in which he was signing. It is unclear whether the Original Answer was submitted on behalf of both owners appearing in the 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).
- Appellants/Respondents did not make their admissions or denials in numbered paragraphs corresponding to the numbered paragraphs in the complaint. T.B.M.P. 311.02(a).

For these reasons, Applicants' Original Answer is entirely insufficient and cannot be considered a responsive pleading to Opposer's allegations in its Notice of Opposition. Accordingly Applicants' Original Answer should be stricken.

## **II. APPLICANTS' AMENDED ANSWER IS UNTIMELY AND SHOULD BE STRICKEN**

Under 37 C.F.R. § 2.107(a) and Fed. R. Civ. P. 15 (a)(1)<sup>2</sup>, a party may amend its pleadings once as a matter of course (*i.e.*, without the consent of either the opposing party or the Board) at any time before a responsive pleading is served. If the pleading is one to which no responsive pleading is permitted, the party may amend it as a matter of course within 21 days after it is

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<sup>2</sup> 37 C.F.R. § 2.107(a) provides that:

*Pleadings in an opposition proceeding against an application filed under Section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed.*

As amended effective December 1, 2009, Fed R. Civ. P. 15(a)(1) states that:

*A party may amend its pleading once as a matter of course within:*

*(A) 21 days after serving it, or*

*(B) if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier.*

served. Fed. R. Civ. P. 15(a)(1). Otherwise, a party may amend the party's pleading only by written consent of every adverse party or by leave of the Board, which can be requested by motion. A signed copy of the proposed amended pleading should accompany a motion for leave to amend a pleading. T.B.M.P. § 507.01.

Applicants' amended pleading is an Answer to Opposer's Notice of Opposition. As such, applicant's amended pleading is one to which no responsive pleading is permitted. Indeed, the plaintiff may not serve a reply unless it obtains permission from the Board. *See* Fed. R. Civ. P. 7(a).

Applicants' Original Answer was filed on August 26, 2010. Applicant had until September 16, 2010 to amend their answer as of right. Applicants did not do so. Instead they waited 56 days and filed a purported Amended Answer on October 21, 2010. In order for their Amended Answer to have been considered timely Applicants would have needed Opposer's written consent or leave of the Board. Applicants sought neither.

Applicants' Amended Answer, therefore, is untimely and should be stricken.

**III. APPLICANTS' AFFIRMATIVE DEFENSE IS INSUFFICIENTLY PLEADED AND 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. Applicants' Affirmative Defense of "LACHES" is insufficiently pleaded and should be stricken.

Under the Federal Rules of Civil Procedure, a party must identify the basis for its Affirmative Defenses with sufficient detail, in order to provide the other party and the Board with fair notice of the predicate for those defenses. Specifically, TTAB Rule 311.02(b) requires

that "[t]he elements of a defense should be stated simply, concisely, and directly" and a defense "should include enough detail to give the plaintiff fair notice of the basis for the defense."<sup>3</sup>

Bald and conclusory allegations are insufficient under this standard, in that they neither give fair notice of the basis for a claim nor set forth sufficient facts that, if proven, support the claim.

TTAB Rule 311.02(b) (citing *McDonnell Douglas Corporation v. National Data Corporation*, 228 U.S.P.Q. 45 (TTAB 1985)). Courts have routinely held that affirmative defenses, including "(l)aches, waiver, estoppel, and unclean hands... must be plead with the specific elements required to establish the defense" or else be stricken. *Software Publr. Ass 'n v. Scott & Scott, LLP*, 2007 U.S. Dist. (LEXIS 59814, N.D. Tex. 2007) (WL 2325585, N.D.Tex., 2007); *Flasza v. TNT Holland Motor Exp., Inc.*, 155 F.R.D. 612, 4 A.D.D. 488 (N.D. Ill. 1994); *Heller Financial, Inc. v. Midwhey Powder Co., Inc.*, 883 F.2d 1286 (C.A.7 Ill. 1989); *Cohn v. Taco Bell Corp.*, No. 95 C 7152, 1995 WL 247996, at \*6, 1995 U.S. Dist. LEXIS 5532, at \*16 (N.D.Ill. Apr. 24, 1995); *Stafford v. Conn. Gen. Life Ins. Co.*, No. 95-C7152, 1996 WL 197677, at \*2, 1996 U.S. Dist. LEXIS 5307, at \*5 (N.D.Ill. Apr. 19, 1996).

Indeed, numerous courts have rejected as insufficiently pleaded affirmative defenses materially identical to the affirmative defenses Applicants purport to raise here. See *In Reis Robotics USA, Inc. v. Concept Industries, Inc.*, 462 F. Supp2d. 897 (N.D. III. 2006); *Morrison v. Executive Aircraft Refinishing, Inc.*, 434 F.Supp.2d 1314 (S.D.Fla., 2005); *Surface Shields, Inc. v. Poly-Tak Protection Systems, Inc.*, 213 F.R.D. 307.

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<sup>3</sup> See also Fed R. Civ. P. 8(b) which provides that: "In responding to a pleading, a party must (A) state in short and plain terms its defenses to each claim asserted against it; and (B) admit or deny the allegations asserted against it by an opposing party."

Applicants' *laches* defense consists of the unsupported statements that "[Opposer has] rested on their [sic] rights and only now are they claiming that they will be harmed by my registration" and that "[Applicants'] registration was nearly eligible for incontestability status however, days before Window opened, opposer's action was filed".

Applicants further argue that Opposer's applications Ser. No. 85/081,592 and 85/081,713 are in response to "[Applicants'] application 77929917 in which opposer's application is junior to [applicant's]" (see Applicants' Amended Answer, page 2). Opposer interprets this defense to essentially restate that Opposer's claim is banned under the doctrine of *laches*.

In *inter partes* proceedings under Lanham Act §19, the defense of *laches* requires the following elements (1) unreasonable delay in assertion of ones' rights against another; and (2) material prejudice to another attributable to that delay. *Lincoln Logs Ltd. v. Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). *See also National Cable Television Association, Inc. v. American Cinema Editors* 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1431 (Fed. Cir. 1991) ("The defense of *laches* in a trademark proceeding recognized under 15 U.S.C. § 1069 requires a showing of undue delay in asserting rights against a claim to a conflicting and prejudice resulting therefrom."). Applicants' Amended Answer does not contain allegations sufficient to allege either element. Nor does it provide the "fair notice" required by the rules.

Moreover, as applied in trademark opposition or cancellation proceedings, the defense of *laches* must be tied to a party's registration of a mark. *Lincoln Logs Ltd. v. Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). Thus, in *inter partes* cases the Federal Circuit has held that *laches* begins to run from the time action could be taken against the

*registration* of the mark in question, regardless of when and if the use of the mark began. In an opposition proceeding, *laches* begins to run no earlier than the date the mark in question was *published* for opposition. *National Cable Television Association, Inc. v. American Cinema Editors* 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1431 (Fed. Cir. 1991).

Applicant's lack of factual allegations and the use of "boilerplate" language do not provide the "fair notice" required under the rules. Applicant has not cited to any Federal Circuit or Board cases that support a finding that a bald assertion of *laches* is sufficient. Finally, such defense should also be dismissed as a matter of law with prejudice to Applicants, since Opposer has clearly brought the Opposition during the publication period. As discussed above, publication is the earliest date allowed under the rules to object to someone else's application to register.

Applicants Affirmative Defense is merely conclusory, without any consideration of the actual applicability of the defense to the allegations in the present case, and without any identification of the factual basis for the defense. It does not comply with Rule 8(b) and TTAB Rule 311.02. and, therefore, should be stricken as insufficiently pled.

**APPLICANTS ARE IN DEFAULT AND A DEFAULT JUDGMENT  
SHOULD BE ENTERED IN FAVOR OF OPPOSER**

Fed. R. Civ. P. 2.106 states that if no answer is filed within the time set, the opposition may be decided as in case of default. As discussed in detail above, Applicant's Original and Amended Answers do not comply with the rules and should be stricken. Applicants, therefore, have not filed or served a proper responsive pleading and are in default. Pursuant to Federal Rule of Civil Procedure 55(b), Opposer therefore moves that default judgment be entered against Defendant.

**CONCLUSION**

Applicants' Original Answer to the Notice of Opposition and the subsequent Amended Answer are procedurally and substantively deficient as explained above. Therefore, they should be stricken in their entirety. Consequently, Applicants are in default and Opposer respectfully requests that a default judgment against Applicants be entered pursuant to Rule 55(b).

Dated: November 9, 2010

Respectfully Submitted,

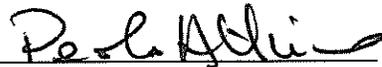
By: 

Paolo A. Strino  
Michael N. Mercanti  
LUCAS & MERCANTI LLP  
475 Park Avenue South  
New York, NY 10016  
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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 APPLICANTS' AMENDED ANSWER AND AFFIRMATIVE DEFENSES, AND MEMORANDUM IN SUPPORT, including any exhibits thereof, has been served on Applicants, by mailing said copy on November 9, 2010, via overnight courier postage prepaid, to Applicants' addresses or record at 28 Frederick Street Carteret, NJ, USA 07008 and 52 Woodview Drive Howell NJ, USA 07731.



Paolo A. Strino  
LUCAS & MERCANTI LLP  
475 Park Avenue South  
New York, NY 10016  
(212) 661-8000  
info@lmiplaw.com

# 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](mailto: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 States. 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,

A handwritten signature in cursive script that reads "Robert A. Casey - Aug 24th 2010". The signature is written in black ink and is positioned above the typed name.

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*

# EXHIBIT B

ESTTA Tracking number: **ESTTA374508**

Filing date: **10/21/2010**

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

Proceeding	91195724
Party	Defendant Robert A. Casey, Ajmar S. Johal
Correspondence Address	ROBERT A. CASEY 52 WOODVIEW DR HOWELL, NJ 07731-3825 UNITED STATES casey77@optonline.net
Submission	Answer
Filer's Name	Robert A. Casey
Filer's e-mail	casey77@optonline.net
Signature	/Robert A. Casey/
Date	10/21/2010
Attachments	Robert A. Casey Answer.pdf ( 3 pages )(66958 bytes )

In the USPTO before the Trademark Trial and Appeal Board

In the matter of Trademark serial No. 77929917

Mark: MS. Menthol

British American  
Tobacco Italia SPA- Opposer  
Petitioner

V.

Mr. Robert A. Casey  
and  
Mr. Ajmar S. Johal  
Registrant

Opposition No. 91195724

**REGISTRANT'S ANSWER AND AFFIRMITIVE DEFENSE**

**COMES NOW, registrant files his Answer in Affirmative Defense to the  
Petition to Cancel as follows:**

1. Registrant totally unaware MS existed in Europe.
2. Understand opposer has filed for Trademark 6 months after I filed.
3. Realize.
4. Admit.
5. Registrant is without sufficient information therefore denies.
6. Admit.
7. Admit not presently engaged, but do intend to be engaged in manufacture of cigarettes.
8. Not true
9. Understood opposer repeats.
10. Registrant

11. Famous Mark Doctrine does not apply. Mark MS is not common and totally unknown.
12. Registrant is without sufficient information therefore denies.
13. Registrant is without sufficient information therefore denies.
14. Registrant is without sufficient information therefore denies.
15. I see that opposer repeats his allegation.
16. Registrant is without sufficient information therefore denies.

### **AFFIRMITIVE DEFENSE**

#### **I. LACHES**

The petitioner claim must fail under Doctrine of Laches. They have rested on their rights and only now are they claiming that they will be harmed by my registration. My registration was nearly eligible for incontestability status however, days before Window opened, opposer's action was filed. Opposer's filing of this action must be barred by Laches.

Their application 85081592 and 85081713 is only a response to my application 77929917 in which opposer's application is junior to mine.

Registrant respectfully requests that cancellation proceeding be dismissed.

Sincerely,

Robert A. Casey  
52 Woodview Drive  
Howell, NJ 07731  
[Casey77@optonline.net](mailto:Casey77@optonline.net)  
(732) 836-9040

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this Answer and Affirmative Defense was filed today, October 21, 2010 on the electronic system for the Trademark Trial and Appeals for the United States Patent and Trademark Office.

Robert A. Casey

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing Answer and Affirmative Defenses to the Petition to Cancel Registration No. 77929917 for MS. Menthol was sent certified mail and emailed October 21, 2010.

Paolo A. Strino  
475 Park Avenue South  
15<sup>th</sup> Floor  
New York, New York 10016  
pstrino@lmiplaw.com

Robert A. Casey  
October 21, 2010