UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 8, 2011

Opposition No. 91195724

BRITISH AMERICAN TOBACCO ITALIA S.P.A.

v.

Robert A. Casey, Ajmar S. Johal

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On November 9, 2010, opposer filed a motion to strike[1] applicant's amended answer and affirmative defenses as set forth in applicants' submission entitled "Registrant's Answer and Affirmative Defense," which was filed on October 21, 2010. Applicants have not submitted a response to opposer's motion to strike. However, in view of applicants' apparent interest in contesting this proceeding as shown by their asserted agreement to extend trial dates herein (see opposer's motion to extend time filed on October 26, 2010, discussed *infra*), the Board exercises its discretion to

[1] On September 23, 2010, opposer filed a motion to strike applicant's "answer" filed on August 26, 2010. In response to opposer's motion, applicant filed its amended answer discussed herein. In view thereof, opposer's motion to strike filed on September 23, 2010 is moot. Neither the motion, nor applicant's initial answer will be given any further consideration.

consider opposer's motion to strike on its merits. *See* Trademark Rule 2.127(a).

Motion to Strike

Opposer argues that the Board should enter default judgment against applicants for their failure to timely file an answer in this proceeding on the ground that the amended answer is untimely. Specifically, opposer contends that the amended answer is not timely because it was filed more than twenty-one days after the filing of the original answer without either opposer's consent thereto or the Board's leave to file an amended pleading as required under Fed. R. Civ. P. 15(a). Additionally, opposer essentially argues that the affirmative defense of laches should be stricken because applicant's allegations do not provide fair notice to opposer of the basis of the asserted defense and because laches does not apply in this proceeding inasmuch as the present opposition was filed shortly after publication of the opposed application.

As to opposer's motion that the Board should grant default judgment in its favor on the basis that applicants' answer should be stricken *in toto*, the Board first considers the nature of applicants' submissions and, if applicants are in default, should the default for failure to file a timely answer be discharged.

The Board notes that applicants timely filed a purported "answer," that opposer filed its first motion to strike, and that applicants submitted a revised answer within eight days of the correct deadline for responding to opposer's first motion to strike. Thus, applicants are in default because they did not file an answer that appears to comply with Federal Rule 8(b) until well after the August 29, 2010 deadline originally set by the Board. Nonetheless, in view of the dates on which applicants submitted documents to the Board, applicants' failure to timely file an answer to the notice of opposition does not appear to be the result of willful inattention or bad faith. Further, there is no evidence of record that opposer is prejudiced by applicants' late filing of the amended answer; rather, the parties have been in evident agreement that the trial schedule should be continued (see opposer's motion to extend time, discussed *infra*). Moreover, because the law favors deciding cases on their merits, the Board is reluctant to grant judgments of default and tends to resolve all doubts by setting aside default. *See Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990); *and Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556 (TTAB 1991).

In view of the foregoing, there is good cause to set aside applicants' default for failing to file a proper

answer by August 29, 2010. *See* Fed. R. Civ. P. 55(c). *See also* TBMP § 312.02 (2d ed. rev. 2004). Accordingly, to the extent opposer's motion to strike requests that the Board enter default judgment in favor of opposer, said motion is denied.

Turning to opposer's motion to strike applicants' affirmative defenses, pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP § 506 (2d ed. rev. 2004). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims not

stricken). Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See, generally,* Wright & Miller, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008). Nonetheless, the Board grants motions to strike in appropriate instances.

Before addressing the affirmative defenses at issue, the Board has considered the sufficiency of the answer and finds that it is sufficient. In accordance with Fed. R. Civ. P. 8(b), it is incumbent on applicants to answer the notice of opposition by admitting or denying the allegations contained in each paragraph. Here, applicants have admitted opposer's allegations in paragraphs 4 and 6; and have explicitly stated that they are without sufficient knowledge and therefore deny the allegations in paragraphs 5, 12, 13, 14 and 16. Applicants' responses to paragraphs 1, 2, 8, 9, 10, 11 and 15 are argumentative in nature or provide information. Thus, said responses are in the nature of a general denial of those particular allegations in the notice of opposition and will be treated as such. Applicant's responses, *viz.* "Realize" as to ¶3 and "Admit not presently engaged, but do intend to be engaged in manufacture …" as to ¶7, are deemed to constitute admissions by applicants of the corresponding assertions in the notice of opposition. In view of the foregoing, the Board finds that applicants have

sufficiently answered the allegations in the notice of opposition.

Nonetheless, with respect to opposer's motion to strike the affirmative defense of laches, said motion is granted. *See* Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a). It is well established that laches is generally unavailable in an opposition proceeding.[2] However, with respect to applicants' assertion with respect to opposer's pending applications, said assertion appears to be related to applicants' theory of priority and, thus, merely functions to amplify or explain applicants' denials of opposer's claims. In view thereof, opposer's motion to strike is denied as to that particular assertion in the answer.

Accordingly, except with respect to applicants' assertions with respect to the equitable defense of laches which are hereby *stricken*, applicants' answer filed on October 21, 2010 will be accepted as its pleading of record, *as long as applicants comply with the Board's following order with respect to the signature on the amended answer.*

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[2] *See, e.g., National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); and *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 n.3 (TTAB 1999) ("the U.S. Court of Appeals for the Federal Circuit has held that in trademark opposition and cancellation proceedings, laches begins to run when the mark in question is published for registration").

Signature on Answer Must Be Perfected

The opposed application identifies Robert A. Casey and Ajmar S. Johal as individuals and sets forth their respective citizenships. In view thereof, the USPTO will presume that applicants' "entity" is that of joint applicants. *See* TMEP § 803.03(d) (7th ed. 2010).

Under Trademark Rule 2.193(c)(1)(iii), 37 C.F.R. § 2.193(c)(1)(iii), **an answer submitted in a Board proceeding must be signed by joint applicants, unless one joint applicant is the authorized representative of the other joint applicant**. *See* Trademark Rule 2.119(e), 37 C.F.R. § 2.119(e) ("Every paper filed in an *inter partes* proceeding, … must be signed by the party filing it, or by the party's attorney or other authorized representative").[3] *Cf.* TMEP § 712.03 (7th ed. 2010) ("If the person who signed the response was authorized to sign, the applicant's reply to the notice of incomplete response should state the nature of the relationship of the signer to the applicant. If the signer has legal authority to bind the applicant, the person

[3] *See also* Trademark Rule 2.193(e)(2)(ii), 37 C.F.R. § 2.193(e)(2)(ii) ("… In the case of joint owners who are not represented by a qualified practitioner, all must sign"); and Trademark Rule 2.193(e)(9)(ii), 37 C.F.R. § 2.193(e)(9) ("If the applicant or registrant is not represented by a practitioner qualified to practice before the Office under § 11.14, the individual applicant or registrant or someone with legal authority to bind the applicant or registrant (*e.g.*, a corporate officer or general partner of a partnership) must sign. *In the case of joint applicants or joint registrants, all must sign.*" [Board emphasis]).

should so state, and should set forth his or her title or position.")

Here, applicants did not both sign the amended answer submitted in this proceeding. In view of the foregoing, applicants are allowed until **TWENTY DAYS** from the mailing date of this order to submit a copy of the answer filed on October 21, 2010 that is executed by both Mr. Casey and Mr. Johal, ***or*** applicant Casey must submit an amended answer which states that he is the authorized representative of Mr. Johal and the reason therefor, e.g., he has a power of attorney to execute such documents on Mr. Johal's behalf. *See* Trademark Rule 2.119(e), 37 C.F.R. § 2.119(e) ("an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office"). Upon receipt of the properly executed answer, the Board will discharge applicants' default for failure to file a timely answer. **Should applicants fail to respond to this order, the Board may enter judgment against applicants by default, sustain the opposition, and refuse registration to applicants**. *See* Fed. R. Civ. P. 55 and Trademark Rule 2.106(a), 37 C.F.R. § 2.106(a).

Motion to Extend Time; Trial Dates Reset

Opposer's consented motion (filed October 26, 2010) to extend time for thirty days is granted to the extent

indicated below. Trademark Rule 2.127(a).

In view of the passage of time since the filing of the subject motions, and because issues were not set until this order and there is no statement in the record indicating that the parties have conducted their mandatory discovery conference, trial dates are reset, including conferencing and disclosure due dates, as shown in the following trial schedule:

Deadline for Discovery Conference	**3/31/2011**
Discovery Opens	**3/31/2011**
Initial Disclosures Due	**4/30/2011**
Expert Disclosures Due	**8/28/2011**
Discovery Closes	**9/27/2011**
Plaintiff's Pretrial Disclosures	**11/11/2011**
Plaintiff's 30-day Trial Period Ends	**12/26/2011**
Defendant's Pretrial Disclosures	**1/10/2012**
Defendant's 30-day Trial Period Ends	**2/24/2012**
Plaintiff's Rebuttal Disclosures	**3/10/2012**
Plaintiff's 15-day Rebuttal Period Ends	**4/9/2012**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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The following information is provided to applicants as a courtesy:

Nature of a Opposition Proceeding

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. **No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.**

Legal Representation Is Strongly Encouraged

It should also be noted that while Patent and Trademark

Rule 10.14 permits any person to represent him or him/herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

It is recommended that applicants obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. These rules may be viewed at the USPTO's trademarks page: http://www.uspto.gov/main/trademarks.htm. The Board's main webpage, http://www.uspto.gov/web/offices/dcom/ttab/, includes information on the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to The Trademark Trial and Appeal Board Manual of Procedure (the TBMP).

Further, all Board proceedings and other information regarding the Trademark Trial and Appeal Board may be accessed at the following URLs: http://ttabvue.uspto.gov/ttabvue/ and http://www.uspto.gov/trademarks/process/appeal/index.jsp.

All Parties Must Comply with Board Deadlines

While it is true that the law favors judgments on the

merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991).

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.[4]

Applicants' Correspondence Address

Applicants are reminded that it is their responsibility to ensure that the Board has their current correspondence address. *See* TBMP § 117.07 (2d ed. rev. 2004) (If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party).

Mailed Submissions to the Board; Using ESTTA is Encouraged

Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing (see sample in footnote[5]). The actual date of receipt by the Office will

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[4] Applicants are reminded that all pages of a paper submission to the Board must be numbered. Trademark Rule 2.126(a)(5), 37 C.F.R. § 2.126(a)(5).

[5] Certificate of Mailing
I hereby certify that this correspondence

be used for all other purposes, *including electronically filed documents*.

The Board encourages the use of Electronic System for Trademark Trials and Appeals (ESTTA), available through the USPTO website, for the filing of all documents with the Board. See the following URL: http://estta.uspto.gov/.

General Information on Discovery Conferences

Applicant is referred to the Board's institution order in this proceeding and to the following URL: http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf, see, e.g., pp. 42245, 42246, 42248 and 42252. During the conference, the following topics must be discussed:

> (1) the nature of and basis for their respective claims and defenses;
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> (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and;
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> (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case.

Either party may request the participation of the Board in the discovery conference. *See* Trademark Rule 2.120(a)(2), 37 C.F.R. § 2.120(a)(2).

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Postal Service with sufficient postage as
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

on _____ (Date), _____ (Signature),
_____ (Typed or printed name)

Information on Initial Disclosures

The parties are referred to the following web addresses to obtain information regarding initial disclosures: http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf and to http://edocket.access.gpo.gov/2006/pdf/06-197.pdf or to http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf. *See* Notice of Final Rulemaking ("Miscellaneous Changes to Trademark Trial and Appeal Board Rules") in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 10, 2501 (January 17, 2006).

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