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

Proceeding	91212024
Party	Plaintiff Republic Technologies (NA), LLC
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Signature	/Antony McShane/
Date	06/12/2014
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial
No. 85/551,808 for S.O.B.

Published in the Official Gazette
on July 23, 2013

REPUBLIC TECHNOLOGIES (NA),
LLC,

Opposer,

v.

BROOKS ENTERTAINMENT, INC.,

Applicant.

Opposition No. 91212024

**OPPOSER'S MOTION FOR LEAVE TO
FILE AN AMENDED NOTICE OF OPPOSITION**

Pursuant to Trademark Rule 2.107 and Rule 15(a) Fed. R. Civ. P., Opposer, Republic Technologies (NA), LLC, moves to amend its Notice of Opposition in this proceeding to add additional grounds for opposition, established during the course of discovery, that (1) Applicant did not use the mark in commerce in the United States at the time Applicant filed its application, and (2) Applicant does not have a legitimate basis for registration under § 44(e) because Applicant cannot claim the Dominican Republic as a country of origin. A copy of Opposer's Amended Notice of Opposition is attached as Exhibit A.

In support of its Motion, Opposer states as follows:

1. Rule 15(a) of the Federal Rules of Civil Procedure and Rule 2.107 of the Trademark Rules of Practice provide that "leave [to amend] shall be freely given when justice so requires." Fed. R. Civ. P. 15(a); *Froman v. Davis*, 371 U.S. 178, 182 (1962) ("If the underlying

facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits.”) “Amendments to pleadings should be allowed with great liberality at any stage of the proceeding ... unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” *Commodore Electronics. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d (BNA) 1503, 1505 (TTAB 1993). Accordingly, when deciding to grant an opposer’s motion for leave to amend, the Board must consider whether there is any undue prejudice to the applicant and whether the amendment is legally sufficient. *Id.*

2. During the discovery period of this opposition, Opposer learned that Applicant did not use the mark at issue in commerce in the United States at the time Applicant filed its application. Applicant stated in its application, dated February 24, 2012, that it first used the mark “[a]t least as early as” June 16, 2011. Opposer served interrogatories and document requests directing Applicant to identify and describe its first use of the mark and requesting all documents related to such activities. The documents produced by Applicant in response to the requests establish that Applicant did not use the mark in interstate commerce in 2011 or 2012. Rather, Applicant’s responses and concurrently produced documents show that it did not begin using the mark in interstate commerce, if at all, until 2013.¹

Applicant’s responses demonstrate that Applicant does not have any evidence whatsoever of sales or shipments of cigars bearing the S.O.B. mark before 2013. Applicant could not produce any invoices, receipts, or tax records indicating that it sold any cigars in 2011 or 2012. Applicant does not have any import records showing that it caused cigars to be shipped to the U.S. in 2011 or 2012. Indeed, Applicant could not produce any documents containing so much as

¹ A more detailed discussion of Applicant’s discovery responses and documents is set forth in Opposer’s Motion for Summary Judgment, filed contemporaneously herewith.

a single reference to its purported use of the S.O.B. mark in connection with cigars in 2011 or 2012. Applicant's documents, however, do include a contract to begin production of the cigars dated September 3, 2013. Applicant issued press releases in May and July 2013 highlight an impending product launch. As of June 6, 2013, Applicant's website solicited "preorders leading up to our NEW launch" (emphasis in original). Applicant did not file mandatory tobacco import reports with the Department of the Treasury until June 2013, indicating that Applicant did not have a permit to import cigars from its Dominican manufacturer before then. In short, it is clear from Applicant's discovery responses and document production that Applicant's use of the S.O.B. mark in commerce in connection with cigars began, if at all, in 2013, well after it filed its use-based application.

3. Opposer also learned during discovery that Applicant cannot legitimately claim the Dominican Republic as a country of origin and therefore cannot use its Dominican trademark registration as a basis for United States registration under § 44(e). Applicant admits that it is not domiciled in the Dominican Republic and is not a Dominican national. Accordingly, pursuant to § 44(c), Applicant cannot invoke § 44(e) as a basis for registration unless Applicant had a bona fide and effective industrial or commercial establishment in the Dominican Republic as of February 15, 2012, the date of issuance of its Dominican trademark registration.

Contrary to Applicant's affirmative statement in its application, Applicant's documents indicate that it did not maintain an institution or place of business in the Dominican Republic with fixtures and organized staff, as required by § 44(c), when its Dominican registration was issued. Applicant concedes in its discovery responses that Tabaqueria Carbonell CXA, an independent Dominican company in business for more than 100 years, manufactures Applicant's cigars. Applicant could not produce any records showing that it has ever been incorporated or

licensed to do business in the Dominican Republic. Applicant could not produce any documents showing a Dominican address from which it has conducted business activities. Applicant could not produce evidence that it owns or has owned any real property in the Dominican Republic. Applicant could not produce any payroll statements, pay stubs, tax records or other documents indicating that it has had full- or part-time employees in the Dominican Republic.

Applicant's discovery responses and documents clearly show that Applicant did not have, and has never had, a bona fide place of business in the Dominican Republic as contemplated by the statute and thus cannot claim the Dominican Republic as a country of origin for the purpose of § 44(e).

4. The present motion will not prejudice Applicant because Applicant does not need to conduct discovery related to its own use of the SOB mark and its presence in the Dominican Republic, and, in any event, Applicant has already provided discovery on the issue.

5. Opposer has filed this motion in a timely manner after becoming aware that Applicant had not used the mark in commerce in the United States at the time it filed its U.S. application and did not have a bona fide and effective industrial or commercial establishment in the Dominican Republic as of the issuance of its Dominican registration. As described above, Opposer learned of Applicant's lack of use of the mark and lack of a Dominican business establishment after reviewing Applicant's responses to discovery and document production.

6. In order to plead a new ground for opposition, Opposer need only allege in its amended pleading such facts as would, if proven, establish both its standing to challenge Applicant's right to registration and a further statutory ground for opposition to the application. *Commodore*, 26 U.S.P.Q.2d at 1506.

7. Opposer's Amended Notice of Opposition, attached hereto as Exhibit A, is legally

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Dated: June 12, 2014

CERTIFICATE OF SERVICE

I, Andrew S. Fraker, an attorney, state that, pursuant to 37 CFR §§ 2.101, 2.111, and 2.119, I caused a true and correct copy of the foregoing **Opposer's Motion for Leave to File an Amended Notice of Opposition** to be served upon:

Richard B. Jefferson
M.E.T.A.L. Law Group, LLP
Museum Square
5757 Wilshire Blvd., PH 3
Los Angeles, CA 90036

via U.S. Mail, with a courtesy copy sent via email, on June 12, 2014.

/Andrew S. Fraker /
Andrew S. Fraker

NGEDOCs: 2177852.2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposer,

v.

BROOKS ENTERTAINMENT, INC.,

Applicant.

Amended Notice of Opposition

Opposition No. 91212024

This Amended Notice of Opposition is submitted in the matter of Application Serial No. 85/551,808 for registration by Brooks Entertainment, Inc. of the term S.O.B. based upon its use of the term in connection with “cigars” in International Class 34, which was published for opposition in the Official Gazette on July 23, 2013. Republic Technologies (NA), LLC, having a place of business at 2301 Ravine Way, Glenview, Illinois, 60025, believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

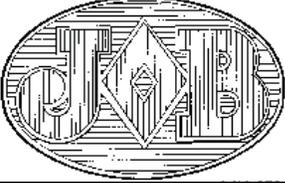
1. Since 1856, Republic Technologies (NA), LLC, including its affiliates and predecessors (“Republic”), has been a preeminent manufacturer and distributor of smokers’ articles, including cigarette papers, cigarette filter tips, cigarette tubes, cigarette injector machines and cigarette rolling machines to consumers across the United States through tobacco shops, drugstores, tobacco outlets, convenience and other retail stores.

2. For more than 100 years, and long prior to the acts of Applicant herein alleged, Republic has devoted substantial resources, time and effort in developing, marketing and distributing its smokers' articles under and in connection with its JOB Mark. In particular, Republic has distributed and sold, and continues to distribute and sell, cigarette papers, cigarette filter tips, cigarette tubes, cigarette injector machines and cigarette rolling machines under and in connection with the JOB mark.

3. As a result of its consistent and successful efforts to promote, distribute and sell such smokers' articles under and in connection with its JOB Mark, and its continuous and exclusive use of the JOB Mark with such smokers' articles, Republic has developed considerable consumer recognition and goodwill in its JOB Mark, which has come to be recognized by customers as identifying and distinguishing Republic's smokers' articles, and Republic's smokers' articles alone.

4. As a result of the considerable consumer recognition and goodwill that Republic now owns and which is symbolized by its JOB Mark, the JOB Mark is now among Republic's most valuable assets.

5. To protect its rights, Republic owns and maintains the following federal registrations for its JOB Mark in the United States Trademark Office, all of which are now incontestable pursuant to 15 U.S.C. §1065:

Mark	Registration No.	Registration Date	Goods and Services
JOB	073,124	March 16, 1909	cigarette papers
JOB (Design) 	1,341,384	June 11, 1985	cigarette papers
JOB (Design) 	2,422,747	January 23, 2001	cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes
JOB	2,420,646	January 16, 2001	cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes
JOB (Design) 	2,432,868	March 6, 2001	cigarette tubes; injector machines for filling cigarette tubes and machines for rolling cigarettes, filter tips for cigarettes

6. On February 24, 2012, more than a century after Republic began its use of its JOB Mark, Applicant filed an application to register the mark S.O.B. based its purported use of the mark in connection with “cigars” in International Class 34 “[a]t least as early as” June 16, 2011. Applicant concurrently claimed a priority date of November 16, 2011, based on its ownership of a Dominican Republic registration for the mark pursuant to §§ 1(a) and 44(d) of the Lanham Act (15 U.S.C. §§ 1051(a) and 1126(d)). On February 14, 2013, as part of its petition to revive its abandoned application, Applicant asserted §§ 1(a) and 44(e) of the Lanham Act (15 U.S.C. §§

1051(a) and 1126(e)) as a basis for registration. On May 20, 2013, in response to an Office Action, Applicant amended its application to state that it “ha[d] a bona fide and effective industrial or commercial establishment in the Dominican Republic as of the date of issuance of the foreign registration” in order to perfect its claim under §44(e) of the Lanham Act (15 U.S.C. § 1126(e)).

7. On information and belief, at the time Applicant filed the application, Applicant did not use the S.O.B. mark in commerce in the United States in connection with any of the goods described in the application. Specifically, on information and belief, Applicant did not sell or transport cigars bearing the mark in interstate commerce and did not import such cigars to the United States prior to the date of filing of the subject application. Accordingly, the application is void *ab initio* to the extent that it is based on § 1(a) of the Lanham Act (15 U.S.C. § 1051(a)).

8. On information and belief, Applicant is not a national of the Dominican Republic.

9. On information and belief, Applicant is not a domiciliary of the Dominican Republic.

10. On information and belief, Applicant did not have a bona fide and effective industrial or commercial establishment in the Dominican Republic as of February 15, 2012, the date of issuance of its Dominican trademark registration.

11. On information and belief, Applicant did not have, and has never had, a legitimate Dominican business office or production facility.

12. Applicant cannot claim the Dominican Republic as a country of origin for the purposes of § 44(e) of the Lanham Act (15 U.S.C. § 1126(e)) and therefore does not have a basis for United States registration under that Section.

CERTIFICATE OF SERVICE

I, Andrew S. Fraker, an attorney, state that, pursuant to 37 CFR §§ 2.101, 2.111, and 2.119, I caused a true and correct copy of the foregoing **Amended Notice of Opposition** to be served upon:

Richard B. Jefferson
M.E.T.A.L. Law Group, LLP
Museum Square
5757 Wilshire Blvd., PH 3
Los Angeles, CA 90036

via U.S. Mail, with a courtesy copy sent via email, on June 12, 2014.

/Andrew S. Fraker /
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