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

Proceeding	91157248
Party	Defendant NORTH ATLANTIC OPERATING CO., INC.
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Submission	Opposition/Response to Motion
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Date	09/16/2008
Attachments	CLASSIC AMERICAN BLEND Reply to Renewed Motion for Sanctions.pdf (15 pages)(455311 bytes)

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

TOP TOBACCO, L.P.,

Opposer-Petitioner,

v.

NORTH ATLANTIC OPERATING CO., INC.,

Applicant-Respondent.

Opposition Nos. 91157248
91157250

Cancellation No. 92043186

Consolidated Proceeding No. 91157248

REPLY IN OPPOSITION TO RENEWED MOTION FOR ENTRY OF THE SANCTION OF DEFAULT AND DEFAULT JUDGMENT

Applicant-Respondent North Atlantic Operating Co., Inc. ("NAOC") hereby respectfully submits its reply to Opposer-Petitioner Top Tobacco L.P.'s ("Top") Renewed Motion for the Entry of the Sanction of Default and Default Judgment:

Top has renewed its motion for sanctions on the basis of language in the Board's July 25, 2008 order (the "July Order") that "if it has not already fully complied with the Board's prior order [of August 13, 2007], defendant is ordered to provide full and complete responses to the outstanding discovery requests noted above ten (10) days from the mailing date of this order, failing which plaintiff may file a renewed motion for sanctions." Top has misleadingly failed to point out the first clause of this statement in its present motion, however, since NAOC has already fully complied with the Board's order of August 13, 2007 (the "August Order"), it was not required to provide any further information within 10 days of the Board's July 25, 2008 order and Top's renewed motion for sanctions is inappropriate.

Applicant Has Complied with the Board's August Order

In its August 13, 2007 order, the Board required NAOC to provide the following information to Top:

- With respect to Interrogatory No. 9, whether the document NAOC previously provided in response was confidential or privileged and whether Applicant had any further information or documents responsive to the interrogatory
- With respect to Interrogatory No. 21, further detail regarding the person most knowledgeable with respect to polls, surveys, consumer study or market research.
- With respect to Document Request No. 9, all documents that identify the persons most knowledgeable concerning the date of first use of CLASSIC AMERICAN BLEND
- A privilege log "where appropriate" if NAOC is invoking a claim of privilege

In its letters to Top's counsel dated October 19, 2007, October 29, 2007 and December 14, 2007, copies of which were attached to Top's present motion, NAOC provided the following information:

- A list of trade shows in which NAOC participated from 2001 through proposed participation in 2008, designating said list "confidential attorneys' eyes only," in complete response to Interrogatory No. 9.
- The names and contact information for the persons most knowledgeable about Interrogatory No. 21 and Document Request No. 9.
- The statement that a review of all documents produced by NAOC to its counsel did not reveal any documents being withheld as privileged and thus no privilege log was necessary.

The information which NAOC has provided since the Board's August Order has sufficiently satisfied the requirements of that order. Top now possesses all of the information which it sought to the extent it was within NAOC's ability to provide. Top's only outstanding complaints are that (1) Top's counsel does not believe NAOC's statement that none of its produced documents are privileged, (2) NAOC did not sufficiently restrict the information it provided in response to Interrogatory No. 9 to trade shows featuring the CLASSIC AMERICAN BLEND mark and (3) NAOC has failed to further verify its responses.

With respect to Top's first complaint, in response to the Board's August Order requesting a privilege log if appropriate, NAOC has clearly answered that none of the documents it has produced may be classified as privileged and thus the order for a privilege log is moot. Top attacks this statement by alleging that such a statement is incredible or NAOC has violated its obligation to provide all documents in its possession, custody or control but Top's mere suspicion is insufficient to counter NAOC's response that it has produced what has been requested and nothing which has been produced may be labeled as privileged. Thus, Top's base assertion does not alter the fact that NAOC has complied with the Board's August Order.

Furthermore, with respect to Top's second complaint, NAOC has provided the information requested by Interrogatory No. 9 to the best of its ability. Although Top insists that it be given a list of just the trade shows that featured the CLASSIC AMERICAN BLEND mark, NAOC's records merely list the trade shows in which it participated but do not further specify what marks were featured at which shows, a fact which is clearly seen by the records provided by NAOC's counsel with its December 14, 2007 letter. NAOC can not provide information

which it does not possess and it has given Top the information which it does possess. Thus, NAOC has again complied with the Board's August Order with respect to this point.

Finally, with respect to Top's third complaint, NAOC believes that its original verification for its interrogatory responses covered the ministerial names, addresses and lists it provided in further clarification of its original responses. However, in the interest of resolving the present discovery dispute, NAOC is attaching formal Supplemental Responses to Interrogatories and Requests for Production of Documents which contain the verification Top seeks for the same information NAOC has previously supplied.

NAOC Has Not Willfully Evaded the Board's Orders

As NAOC has previously argued, by Top's own statements, a party must show willful evasion before a sanction of default judgment may be imposed. See *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1977); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000). However, in the present case, NAOC has done its best to comply with Top's discovery demands. In its July Order, the Board found that since NAOC was unaware of the Board's August Order, the imposition of sanctions would be inappropriate, thus recognizing that NAOC did not willfully violate its August Order. Indeed, as soon as NAOC was made aware of the August Order, it immediately informed Top it would provide the requested information and began to compile that information. NAOC then subsequently did supply Top with the information it sought in a timely manner, namely by October 2007. When Top requested further clarification with respect to that information, NAOC did its best to comply and provided the further clarification by December 2007, as seen from the exhibits to Top's own motion. In this manner, NAOC fully complied with the requirements of the Board's August 2007 order.

NAOC complied with the Board's August Order through its letters of October and December 2007 and thus did not need to take further action with respect to the Board's July Order. The Board's July Order explicitly states that NAOC should comply with the August Order within 10 days only "if it has not already fully complied," and so the Board contemplated its order may have already been moot. NAOC did not willfully violate the Board's July Order but rather took care of its responsibility under the August Order faster than the Board could issue its July Order. Since NAOC provided Top with all of the information it sought, and has now taken the extra step of providing Top with the verifications it unnecessarily demanded, NAOC simply can not be found to have willfully violated the Board's orders and thus a finding of sanctions is grossly inappropriate.

CONCLUSION

For the foregoing reasons, NAOC respectfully submits that Top's renewed motion for the entry of sanction of default and default judgment should be denied in its entirety.

Dated: New York, New York
September 16, 2008

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Heather L. Jensen/
Arlana S. Cohen
Heather L. Jensen
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

CERTIFICATE OF SERVICE

I hereby certify that on September 16, 2008, I placed a true and correct copy of the foregoing Reply in Opposition to Renewed Motion for Entry of the Sanction of Default and Default Judgment in the United States mail, postage prepaid, addressed to:

Lawrence E. James, Jr., Esq.
Neal, Gerber & Eisenberg, LLP
Two North LaSalle Street
Suite 2300
Chicago, IL 60602-3801

/Heather L. Jensen/
Heather L. Jensen

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

TOP TOBACCO, L.P.	:	
Opposer/Petitioner,	:	Opposition No. 91157248 Opposition No. 91157250
v.	:	Cancellation No. 92043186
NORTH ATLANTIC OPERATING CO, INC.	:	
Applicant/Respondent.	:	

SECOND SUPPLEMENTAL RESPONSES
TO APPLICANT'S RESPONSE TO
OPPOSERS' FIRST SET OF INTERROGATORIES

Applicant/Respondent North Atlantic Operating Co., Inc. ("NAOC"), through its attorneys and pursuant to Rule 2.120 of the Trademark Rules and Practice and Rules 26 and 33 of the Federal Rules of Civil Procedure, hereby submits its Second Supplemental Responses to Applicant's Response to Opposer's First Set of Interrogatories:

GENERAL OBJECTIONS

The objections contained in Applicant's Response to Opposer's First Set of Interrogatories are hereby maintained.

SUPPLEMENTAL RESPONSES

Interrogatory No. 9

Identify every trade show at which each product identified in response to Interrogatory No. 5 has been or will be advertised and/or promoted

Supplemental Response to Request 9:

NAOC is unable to identify which specific products were advertised or promoted at any particular trade show as it does not keep records with that information. However,

NAOC can identify that it has participated or intends to participate in the following national trade shows since 2001:

Year	Show	Location	Date
2001	AWMA	New Orleans	Feb. 15–17
	NACS	Las Vegas	Oct. 20-23
	NATO	Las Vegas	March 27-29
	RTDA	Tampa	Aug. 15-18
	SAWD	Atlanta	May 29 – June 2
2002	AWMA	Dallas	Feb. 1-2
	NACS	Orlando	Oct. 5-8
	NATO	Las Vegas	March 26-28
	SAWD	Memphis	May 29 – June 2
2003	AWMA	Las Vegas	Feb. 27-28
	NACS	Chicago	Oct. 12-14
	NATO	Las Vegas	March 25-27
	RTDA	Las Vegas	July 22-25
	SAWD	Atlanta	May 28 – June 1
2004	AWMA	San Antonio	Feb. 18-20
	NACS	Las Vegas	Oct. 17-20
	NATO	Las Vegas	March 23-25
	RTDA	Las Vegas	July 27-29
	SAWD	New Orleans	June 10-11
2005	AWMA	Las Vegas	Feb. 24-25
	NACS	Las Vegas	Nov. 16-18
	NATO	Las Vegas	March 30-31
	RTDA	New Orleans	Aug. 6-10
	SAWD	Atlanta	June 17-19
2006	AWMA	Las Vegas	March 16-17
	NACS	Las Vegas	Oct. 9-12
	NATO	Las Vegas	March 28-29
	RTDA	Las Vegas	July 20-22
	SAWD	Myrtle Beach	June 15-16
2007	AWMA	Las Vegas	Feb. 22-23
	TOB+	Las Vegas	April 26-27
	SAWD	Charleston	June 8-9
	RTDA	Houston	Aug. 5-8
	NACS	Atlanta	Nov. 7-9

2008	AWMA	Las Vegas	Feb. 20-22
	TOB+	Las Vegas	April 24-25
	SAWD	Nashville	June 13-14
	RTDA	Las Vegas	July 14-17
	NACS	Chicago	Oct. 5-7

Interrogatory No. 21

Describe in detail each poll, survey, consumer study or market research effort initiated by or on behalf of Applicant relating in any way to the designation CLASSIC AMERICAN BLEND, or to the packaging, labeling or advertising of the products identified in response to Interrogatory No. 5, and identify all persons involved in or knowledgeable of such poll, survey, consumer study or market research, as well as all documents relating thereto.

Supplemental Response to Interrogatory No. 21

Opposer/Petitioner has requested that NAOC supplement its prior response with the contact information for Mr. Thomas Helms III, the person identified in the response. NAOC now states that Mr. Thomas Helms III may be contacted at National Tobacco Company, L.P., 3029 Muhammad Ali Blvd., Louisville, KY 40212.

Applicant/Respondent maintains the right to supplement these responses should new information and/or documentation becomes available.

Dated: September 16, 2008

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Heather L. Jensen
Arlana S. Cohen
Heather L. Jensen
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9237

Attorneys for Respondent
North Atlantic Operating Co., Inc.

CERTIFICATION

I, LeAnne Moore, being first duly sworn, hereby state that I am the duly authorized Assistant Secretary of North Atlantic Operating Co., Inc. and have been authorized to make this Certification on its behalf.

I am informed and believe that the information set forth in the foregoing Second Supplemental Responses to Applicant's Response to Opposer's First Set of Interrogatories was obtained and assembled by employees of North Atlantic Operating Co., Inc. from North Atlantic Operating Co., Inc.'s records and files, and from personnel in the appropriate offices and departments of said corporation and from certain outside entities, and on those grounds I allege that the matters stated therein are true or believed to be true.

I am aware that willful false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and may jeopardize the validity of this document.

LeAnne Moore

North Atlantic Operating Co., Inc.
by LeAnne Moore, Assistant Secretary

Executed September 16 2008
at Dresden, TN

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Second Supplemental Responses to Applicant's Response to Opposer's First Set of Interrogatories was duly served upon opposing counsel by first-class mail, postage pre-paid, on September 16, 2008.

Lawrence E. James, Jr., Esq.
Neal Gerber & Eisenberg, LLP
Two North LaSalle Street
Suite 2300
Chicago, IL 60602-3801

/Heather L. Jensen/
Heather L. Jensen

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

TOP TOBACCO, L.P.	:	
Opposer/Petitioner,	:	Opposition No. 91157248 Opposition No. 91157250 Cancellation No. 92043186
v.	:	
NORTH ATLANTIC OPERATING CO, INC.	:	Consolidated under Opposition No. 91157248
Applicant/Respondent.	:	

THIRD SUPPLEMENTAL RESPONSES TO APPLICANT'S RESPONSES TO OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS

Applicant/Respondent North Atlantic Operating Co., Inc. ("NAOC"), through its attorneys and pursuant to Rule 2.120 of the Trademark Rules and Practice and Rules 26 and 34 of the Federal Rules of Civil Procedure, hereby submits its Second Supplemental Responses to Applicant's Responses to Opposer's First Set of Requests for Production of Documents:

GENERAL OBJECTIONS

The objections contained in Applicant's Response to Opposer's First Set of Requests for Production of Documents are hereby maintained.

SUPPLEMENTAL RESPONSES

Request No. 9

All documents that identify or otherwise relate to the person(s) most knowledgeable concerning the date when Applicant first used the designation CLASSIC AMERICAN BLEND in: (a) intrastate commerce; (b) interstate commerce; and (c) foreign commerce (if applicable).

Supplemental Response to Request No. 9

Applicant/Respondent does not have documents which related to the persons most knowledgeable as to when Applicant first used the mark CLASSIC AMERICAN BLEND. However, Applicant/Respondent can identify those persons as Mr. Thomas Helms III, National Tobacco Company, L.P., 3029 Muhammad Ali Blvd., Louisville, KY 40212 and Mr. James Murray, North Atlantic Trading Company, 777 Post Road, Suite 304, Darien, CT 06820-4721.

Dated: September 16, 2008

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Heather L. Jensen/
Arlana S. Cohen
Heather L. Jensen
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9237

Attorneys for Applicant/Respondent
North Atlantic Operating Co., Inc.

CERTIFICATION

I, LeAnne Moore, being first duly sworn, hereby state that I am the duly authorized Assistant Secretary of the North Atlantic Operating Co., Inc. and have been authorized to make this Certification on its behalf.

I am informed and believe that the information set forth in the foregoing Third Supplemental Responses to Applicant's Response to Opposer's First Set of Requests for Production of Documents was obtained and assembled by employees of North Atlantic Operating Co., Inc. from North Atlantic Operating Co., Inc.'s records and files, and from personnel in the appropriate offices and departments of said corporation and from certain outside entities, and on those grounds I allege that the matters stated therein are true or believed to be true.

I am aware that willful false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and may jeopardize the validity of this document.

LeAnne Moore

North Atlantic Operating Co., Inc.
by LeAnne Moore, Assistant Secretary

Executed September 15, 2008
at Dresden, TN

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Third Supplemental Responses to Applicant's Response to Opposer's First Set of Requests for Production of Documents was duly served upon opposing counsel by first-class mail, postage pre-paid on September 16, 2008.

Lawrence E. James, Jr., Esq.
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/Heather L. Jensen/
Heather L. Jensen