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

Proceeding	91210176
Party	Defendant NORTH ATLANTIC OPERATING COMPANY, INC.
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Attachments	Top Tobacco, L.P. v. North Atlantic Operating Company, Inc. - Applicant's Motion to Strike Notice of Opposition and Motion to Suspend Proceeding Pending Decision.pdf(551712 bytes)

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

In re Application Serial No. 85/414,445
Filed: April 10, 2013
For Mark: ZIG ZAG (& Design)

TOP TOBACCO, L.P. Opposer, v. NORTH ATLANTIC OPERATING COMPANY, INC. Applicant.	:	**OPPOSITION NO. 91210176**

APPLICANT'S MOTION TO STRIKE NOTICE OF OPPOSITION AND MOTION TO SUSPEND PROCEEDINGS PENDING DECISION

REQUEST AND MOTION

Applicant, North Atlantic Operating Company, Inc. ("Applicant") hereby respectfully § requests that the Board order Opposer Top Tobacco, L.P. ("Opposer" or "Top") to file a proper Notice of Opposition against Application Serial No. 85/414,445 (the "Application"), and moves to strike pursuant to Rule 12(f) and TBMP §506.01 Opposer's Notice of Opposition dated April 10, 2013, (the "Notice") as setting forth immaterial claims and does not, in fact, comply with the Federal Rules of Civil Procedure or the TBMP.

Applicant further requests that this proceeding be suspended pending the decision of the Board on this motion and that the relevant answer, discovery and trial dates be reset once a decision is reached.

MEMORANDUM IN SUPPORT OF MOTION

Pursuant to 37 C.F.R. § 2.104(a)(1), "[a]n opposition must set forth a short and plain statement why he believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for the opposition".

Opposer's Notice should be stricken because Opposer has neither specifically or clearly set forth precise allegations in the Notice why it is damaged by *this* mark, the mark at issue in this opposition, namely, ZIG ZAG for "loose tobacco, cigars, cigarillos, chewing tobacco, snuff, and cigar wraps." Rather, the allegations are ambiguous and unclear as to whether such allegation applies to the mark at issue or Other Marks (as defined below), all of the goods for which the mark is applied for, or only "cigar wraps". For example, as further set forth herein, in only 4 of the first 13 paragraphs is there even a mention of the ZIG ZAG mark- let alone the instant stylized design). The rest of the paragraphs in Opposer's Notice contain references to either a different applicant, NTC, Other Marks or no marks at all. Applicant requests that Opposer be instructed to "set forth" only allegations directed to the Applicant and the mark at issue herein.

I. OPPOSER'S NOTICE CONTAINS IMPROPER IMMATERIAL ALLEGATIONS

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any…redundant, immaterial, impertinent, or scandalous matter." (3d ed. Rev. 2011). *See also* Fed. Rule Civ. Pro. P. 12(f). Rule 12 is designed to reinforce the requirement in Rule 8 that pleadings be simple, concise and direct. 5A Charles Allen Wright & Arthur R. Miller, *Federal Practice and Procedure*, § 1380 (2d. ed. 1990). Under the Federal Rules of Civil Procedure the function of pleadings is to give fair notice of the claim asserted--preferably, as provided by Fed.R.Civ.P. 8(a)(2), in a form which contains

"a short and plain statement of the claim." While it has been said that a party is allowed reasonable latitude in its statement of its claims, matter will be stricken from a pleading when it is clear that it can have no possible bearing upon the subject matter of the litigation. 2A *Moore's Federal Practice*, Section 12.21[2] (2nd ed. 1985).

On this basis, Applicant moves that the entirety of the Notice, or, if not, then paragraphs 1, 3, 5, 6, 7, 8, 9, 10, 11, 12, (to the extent it alleges allegations as to the STRAIGHT UP mark instead of the mark applied for herein), 13 (to the extent the allegations are made based on a comparison to the Other Marks, as defined below).

Specifically, in said paragraphs 1, 3, 5, 6, 7, 8, 9, 10, 11, 12, and 13 Opposer sets forth purported allegations relating to a different entity, NTC, and different marks, in particular APPLE BLITZ, STRAWBERRY BLAST, PEACH FRENZY, BLUE JUJU, CHERRY RUSH, MELON BURST, STRAIGHT UP and PURPLE THUNDER ("Other Marks"). Not only are these Other Marks immaterial in this proceeding, they were applied for by a *different applicant* than the current applicant. And, except for the STRAIGHT UP mark, said other applications been expressly abandoned (for lack of continued intention to use).

Furthermore, paragraphs 14, 15, 16, 17, 18, 19, 20, 21, 22, 23[1], 24 and 25 make not one mention of the mark opposed herein and also contain material which is immaterial and scandalous.

None of these allegations have any bearing on the application herein opposed and are furthermore, prejudicial and immaterial.

The lack of particular allegations as to the mark applied for herein, ZIG ZAG

[1] The name "ZIG ZAG" appears in paragraph 23, but there is no precise allegation that such reference is to the current mark applied for herein, nor is there an "allegation" in such paragraph pertaining to such mark.

(& Design), applied for by the *instant* Applicant make responding to such allegations nearly, if not completely impossible, unnecessarily burdensome, and would make discovery and the proceedings herein more burdensome.

Based upon the foregoing, and for the reasons discussed below, the Board should strike the entirety of the Notice, or, at the very least, these paragraphs of the Notice.

II. THE NOTICE CONTAINS IMPROPER SCANDALOUS AND PREJUDICIAL ALLEGATIONS

In addition, many of the allegations in Top's Notice serve the only purpose of attempting to paint Applicant in a scandalous light, and are thus improper. Relief under Rule 12 is particularly appropriate to address scandalous allegations. 5A Charles Allen Wright & Arthur R. Miller, *Federal Practice and Procedure* § 1380 (2d. ed. 1990) (noting that scandalous matter "often will be stricken from pleadings in order to purge the court files and protect the subject of the allegations.").

Allegations should also be stricken when they would have a "prejudicial" effect. *Feinberg,* 2002 U.S. Dist. LEXIS 13771, at *63; *Dannenberg*, 1996 U.S. Dist. LEXIS 10679, at *5. Protoons' conspiracy allegations, supported by nothing more than rank speculation, are prejudicial to Counterclaim Defendants, and should be stricken on the ground as well. *Feinberg*, 2002 U.S. Dist. LEXIS 13771, at *65 (striking allegations that had no bearing on the claims but served "merely to inflame the reader against [defendants.]"); *Impulsive Music v. Pomodoro Grill, Inc.,* No. 08-CV-6293 (MAT), 2008 U.S. Dist. LEXIS 94148, at *7-8 (W.D.N.Y. No. 19, 2008) (striking allegation concerning previous litigation because its inclusion would be prejudicial to defendants and did not bear on the issues in the action).

Here, as set forth above, there are 35 allegations, many of which have nothing to do with the instant Applicant or the instant mark. Certain of these allegations are so immaterial and

scandalous that Applicant felt compelled to make this motion. Specifically, several allegations are so patently immaterial, or worse, grossly inflammatory that they must be stricken. Although Applicant believes the entirety of Opposer's Notice was written such that each and every paragraph was meant to impugn Applicant, and, none of the allegation are capable of being separated from the rest of the Notice as a whole, in particular paragraphs 14, 15, 16, 17, 18, 19, 20,21, 22, 23, and culminating in paragraph 24 are so overly and grossly inflammatory as to demand them stricken. It reads:

24. "In addition to violating the Controlled Substances Act, and the Federal Food, Drug and Cosmetic Act, Applicant's "cigar wraps" violate an increasing number of state and municipal bans on flavored tobacco products and blunt wraps. *See* Me. Rev. Stat. Ann. tit. 22, §1560 (2010)(banning flavored cigars); New York, NY Admin. Code §17-715 (2009) (banning all flavored tobacco products); Jackson Cty., Fla. Res. (2010) (banning all flavored tobacco products); Chicago, Ill. Mun. Code §7-24-091 (2008) (banning drug paraphernalia); Philadelphia, Penn. Stat. §9-629 (2007) (banning flavored and unflavored blunt wraps); D.C. Code §48-1103 (2010) (banning blunt wraps); Boston, Mass. Pub. Health Commission Reg.(2008)"

Applicant is fully able to justify the sale of each and every product it, and indeed its affiliates sell and applicant is fully confident that in the end, the instant opposition will fail. Nevertheless, Opposer should not be allowed to file a trademark opposition pleading which contains such grossly mischaracterized allegations, such as the one above; an allegation which begins with stating "Applicant's cigar wraps violate"...but which is then followed, in each instance, by a list of *different products* in the parenthetical that follows, as being illegal in several states.

Further, these "allegations" are argument as to the merits of the Opposition. Such extraneous, argumentative language in Opposer's Notice, constitutes "immaterial" and "impertinent" matter that should be stricken pursuant to Fed. R. Civ. P. 12(f). *See also*, TBMP 506.01 (same); *McCormick & Co., Inc. v. Hygrade Food Products Corp.*, 16 U.S.P.Q. 124 (T.T.A.B. 1959) (striking listings of third party registrations and uses from answer). With all due

respect, neither Opposer nor Opposer's attorney is competent to set forth "testimony" as to the state of all of tobacco law in existence in the U.S. in a Notice of Opposition.

For all the foregoing reasons, Applicant cannot determine from Opposer's Notice what Opposer's allegations are as to the instant application. There are allegations as to marks not owned by Applicant (¶5, 6, 7, 8, 9, 10, 11), applications no longer in existence (due to a abandonment for non-use), alleged discovery battles between different parties (¶10), products not at issue herein (i.e, blunt wraps, flavored tobacco, flavored cigars) or allegations which allegedly set forth the current state of tobacco laws of the U.S., The Controlled Substance laws, state laws, and tax laws (¶14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24). All of the offending paragraphs, or, more properly, the Notice as a whole should be stricken.

Conclusion

In light of the foregoing, Applicant respectfully requests that Opposer be ordered to promptly file a proper Notice that clearly and precisely sets forth claims only as to the mark at issue, filed by the instant Applicant. Additionally, Applicant requests that the proceeding be suspended pending decision on this motion and that the answer, discovery and trial dates be reset once a decision is rendered.

Dated: New York, New York
October 17, 2013

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 17, 2013, I caused a true copy of **OPPOSER'S MOTION TO STRIKE NOTICE OF OPPOSITION** to be served by mailing a true and correct copy thereof to Opposer's attorneys to: Antony J. McShane, NEAL, GERBER & EISENBERG, Two North LaSalle Street, Suite 1700, Chicago, Illinois 60602-3801.