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

Proceeding	91210176
Party	Plaintiff Top Tobacco L.P.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TOP TOBACCO L.P.,	)	
	)	Opposition No. 91,210,176
Opposer,	)	
	)	
v.	)	Mark: ZIG ZAG
	)	Application S/N: 85/414,445
NORTH ATLANTIC OPERATING COMPANY, INC.	)	
	)	
Applicant.	)	

OPPOSER'S MOTION TO CONSOLIDATE

This proceeding, involving the mark ZIG ZAG used with "cigar wraps," and Opposition Proceeding No. 91,201,176, involving the mark STRAIGHT UP used with "cigar wraps," are between the same parties (or their close affiliates) and involve the same legal and factual issues – namely whether the goods associated with marks are actually "blunt wraps" falsely described as "cigar wraps." Accordingly, in the interests of convenience, efficiency, and judicial economy, Opposer Top Tobacco, L.P. ("Top Tobacco") hereby moves the Trademark Trial and Appeal Board pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a) for an order consolidating the instant Opposition proceeding with Opposition No. 91,201,176.

The Instant ZIG ZAG Opposition

1. In this proceeding, Top Tobacco opposes the registration of the mark ZIG ZAG for "cigar wraps" by North Atlantic Operating Company, Inc. ("NAOC").

2. The basis of Top Tobacco's opposition is that "cigar wraps" are either (i) flavored component parts of cigarettes, in violation of the Food, Drug and Cosmetic Act, or (ii) blunt wraps, which are a class of products used to make a marijuana cigarette and which violate the

Controlled Substances Act. *See* ZIG ZAG Not. Opp. ¶¶ 18 and 23. In either event, NAOC will not be using the mark in lawful use, which renders it unregistrable. *See* ZIG ZAG Not. Opp. ¶26.

3. As an additional basis for opposition, Top Tobacco also asserts that NAOC intentionally, falsely described its products as "cigar wraps" to obtain the imprimatur of a federal trademark registration and with the intent of deceiving the Trademark Office into believing its products are legitimate. In doing so, NAOC committed fraud on the Trademark Office. *See* ZIG ZAG Not. Opp. ¶¶ 28 – 35.

4. Accordingly, central to the resolution of this Opposition will be the factual determinations of what NAOC's "cigar wraps" actually are, *i.e.*, whether they are appropriately classified as "cigar wraps," "blunt wraps," or flavored cigarette wraps, and what NAOC's intent was in branding the products "cigar wraps."[1]

The STRAIGHT UP Opposition

5. In the STRAIGHT UP Opposition, No. 91,203,352, Top Tobacco opposes the registration of the mark for the same products – "cigar wraps" – by National Tobacco Company ("NTC"). NTC is a subsidiary of North Atlantic Trading Company, which is in turn a subsidiary of North Atlantic Holding Co., Inc.[2] *See* ZIG ZAG Answer, ¶ 3. The "cigar wraps" that NTC markets under the mark STRAIGHT UP also bear the mark ZIG ZAG:

[1] In denying NAOC's motion to strike Top Tobacco's Notice of Opposition in its entirety, the Board found that Top Tobacco's Notice of Opposition alleged a valid basis upon which to oppose the registration of the subject mark. *See* ZIG ZAG Mar. 4, 2014 Order. The Board reached the same conclusion when it denied NTC's motion for summary judgment in related proceedings involving other marks for NTC "cigar wraps" that Top Tobacco opposed on the same grounds. *See* Opposition No. 91,194,926 Dkt No. 23, Sept. 5, 2012 Order.

[2] NAOC is a also subsidiary of North Atlantic Holding Co. Inc. *See* ZIG ZAG Answer, ¶ 3.

Thus, both Oppositions involve the use of the subject marks with the same product.

6. The basis of Top Tobacco's opposition in the STRAIGHT UP proceeding is the same. Top Tobacco alleges that NTC's "cigar wraps" are blunt wraps, which violate the Controlled Substances Act and thus, the mark will not be used in lawful use, which renders it unregistrable. *See* STRAIGHT UP Not. Opp. ¶¶ 14-16. Similarly, Top Tobacco also asserts that NTC intentionally falsely described its products as "cigar wraps" to obtain the imprimatur of a federal trademark registration and with the intent of deceiving the Trademark Office into believing its products are legitimate, and thereby committed fraud on the Trademark Office

7. Accordingly, in the STRAIGHT UP opposition, too, central to the resolution of the STRAIGHT UP Opposition will be the factual determinations of what NTC's "cigar wraps" actually are and what NTC's intent was in branding the products "cigar wraps."

The Oppositions Should Be Consolidated

8. "When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases." TBMP § 511; *see also* Fed. R. Civ. P. 42(a) ("If actions before the court involve a common question of law or fact, the court may . . . consolidate the actions . . . ."); *Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite differences in marks and goods). In determining whether to consolidate, the Board should consider the savings in time, effort, and expense to be gained from consolidation as well as whether any actual prejudice will result from consolidation. *See* TBMP § 511; *see also World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975) (ordering consolidation where issues were substantially the same and consolidation benefited both parties). Finally, while identity of the parties is not required for consolidation, it is a factor that may be considered by the Board in determining whether consolidation should be ordered. TBMP § 511; *see also New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

10. Here, the grounds for opposition are identical (although the ZIG ZAG opposition involves an additional grounds not asserted in the STRAIGHT UP opposition, namely, in the alternative, that if the Applicant's products are not "blunt wraps," then they are flavored cigarette papers). Further, not only are the Applicants both subsidiaries of the same holding company, but their respective marks appear on the same packaging for the same products. As a result, both proceedings center on identical factual determinations (i) whether these products are appropriately classified as "blunt wraps" and (ii) what the intent of the closely related Applicants was in branding them "cigar wraps." These determinations will likely involve the same documents, admissions, interrogatory responses, deposition testimony, and expert reports and

testimony. Moreover, as the products in the proceedings are the same, consolidation will ensure that the products are not inconsistently found to be "cigar wraps" in one proceeding and "blunt wraps" in the other. Thus, consolidation will serve the interest of judicial consistency, as well as save the Board and the parties time, effort, and expense. *See, e.g., Rio Energy Int'l, Inc. v. Hilton Oil Transport*, 776 F. Supp. 120, 122 (S.D.N.Y. 1991) (ordering consolidation where common questions of law and fact existed as well as the danger of conflicting findings).

11. Finally, there is no prejudice that would result from consolidation to weigh against these potential savings. TBMP §511 ("In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby."); *see also Rio Energy*, 776 F. Supp at 122 (holding that, to defeat a motion for consolidation, a party must show prejudice that is sufficient to outweigh the advantages.) While written discovery is ongoing, discovery depositions have not yet been conducted in either proceeding, nor have expert witnesses been disclosed.

WHEREFORE, for the foregoing reasons, Opposer respectfully requests that the Board enter an Order pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a) consolidating Opposition No. 91/210,176 with Opposition No. 91/203,352, and granting such other relief as the Board deems appropriate.

Respectfully submitted,

Date: August 1, 2014

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CERTIFICATE OF SERVICE

I, Katherine Dennis Nye, state that I served a copy of the foregoing ***Opposer's Motion to Consolidate*** via first class U.S. mail, postage pre-paid, upon:

Arlana S. Cohen
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on this 1st day of August 2014.

/Katherine Dennis Nye /
Katherine Dennis Nye

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