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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 REPLY IN SUPPORT OF ITS MOTION TO CONSOLIDATE

Nothing in Applicant's brief in opposition to Top Tobacco's motion to consolidate rebuts the plain facts that the ZIG ZAG Opposition and the STRAIGHT UP Opposition are between the same Opposer and closely related Applicants, and involve the same legal and factual issues – namely whether the goods that bear the Applicants' marks are "blunt wraps" falsely described as "cigar wraps." Consolidation of these proceedings will serve the interests of convenience, efficiency, and judicial economy, and will avoid inconsistent judgments.

The standard for consolidation is not whether **all** issues in both proceedings are identical, but rather whether there is "**a** common question of law or fact," Fed. R. Civ. P. 42(a) (emphasis added); *see also* TBMP § 511; *Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092 (Fed. Cir. 1999) (cases consolidated despite differences in marks and goods). Applicant erroneously focuses on a single issue which is present in the ZIG ZAG Opposition and not the STRAIGHT UP Opposition, namely, whether Applicant's sale of flavored "cigar wraps," in addition to violating the Controlled Substances Act, also (or alternatively) violates the Food, Drug, and Cosmetic Act. In so doing, Applicant ignores the fact

that there are identical central issues in both Oppositions, requiring the Board to make 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 these products as "cigar wraps."

Applicant additionally overstates the difference in the proceedings' stages, and can point to no cases where the TTAB refused to consolidate two proceedings that were both in discovery. Indeed, the sole TTAB case Applicant cites for the proposition that two cases should not be consolidated if they are in different stages, *Lever Bros. Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1982), involved one case which was still in the pleading stage and one where testimony periods had expired. By stark contrast, the two proceedings here are both in the discovery period, and in both proceedings the parties have yet to take any discovery depositions. In the STRAIGHT UP Opposition, some written discovery has been exchanged, and in the ZIG ZAG Opposition, Top Tobacco has propounded written discovery but has not yet received responses. However, the consolidation of these proceedings will allow the parties to rely on those responses twice, rather than continuing to propound and respond to discovery that is largely repetitive or identical.

Applicant "do[es] not dispute that NAOC and NTC are affiliated companies," but argues that, because their respective counsel are located in different cities, consolidation would be "burdensome and inefficient." Applicant also relies on the fact that NAOC and NTC, though related companies, have each identified a different single witness to provide discoverable information. However, Opposition Nos. 91210176 (ZIG ZAG) and 91203352 (STRAIGHT UP) involve the very same product:

Given this fact, counsel for NAOC and NTC will need coordinate regardless of whether the proceedings are consolidated in order to avoid inconsistent statements, and ultimately, inconsistent judgments. Indeed, counsel for Applicant was apparently able to coordinate with counsel for NTC to obtain a copy of its Initial Disclosures, and sufficiently confident in the coordination to be able to aver that the copy provided is true and correct. Moreover, Applicant cites no case law to stand for the proposition that the geographic distance between counsel is relevant in deciding a motion to consolidate. Certainly, then, the modicum of coordination required by the counsel for these two closely affiliated parties is immaterial to the present motion.

The fact that NAOC has identified Mr. James Murray in its Initial Disclosure and NTC identified Mr. Curtis Berry is similarly immaterial. Because Messrs. Berry and Murray have

both been identified as having relevant information regarding the nature of the product at issue in both proceedings, their testimony will be relevant in both proceedings. Accordingly, Top Tobacco is likely to call both men to testify in both proceedings. Thus, rather than indicating that consolidation is unwarranted, this unnecessary double expenditure of resources indicates that consolidation is required to serve the interests of efficiency and judicial economy.

Applicant proposes that Top Tobacco might avoid duplication of effort by means of introducing trial testimony from one proceeding in the other pursuant to Trademark Rule §2.122(f). However, Applicant does not provide a means by which the parties (and the Board) can avoid the duplication of efforts that will be caused by the parties exchanging identical or largely overlapping document requests, interrogatories, requests for admissions, and responses thereto. In fact, no such mechanism exists. Moreover, Applicant does not provide any means by which the parties and the Board can be assured that the "cigar wraps" that NTC markets under the mark STRAIGHT UP, and which also bear the mark ZIG ZAG, will be adjudged the same way in both proceedings. In this case, consolidation is necessary to ensure consistency, and to 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).

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 29, 2014

By: /Antony J. McShane/
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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 29th day of August 2014.

/Katherine Dennis Nye /
Katherine Dennis Nye

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