

ESTTA Tracking number: **ESTTA637950**

Filing date: **11/10/2014**

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

| | |
|------------------------|--|
| Proceeding | 91218588 |
| Party | Defendant Cross Farms Inc. |
| Correspondence Address | JORDAN LAVINE FLASTER GREENBERG PC 1600 JOHN F KENNEDY BOULEVARD, 2ND FLOOR PHILADELPHIA, PA 19103 UNITED STATES linda.ladzenski@flastergreenberg.com, jordan.lavine@flastergreenberg.com, alexis.arena@flastergreenberg.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Jordan LaVine |
| Filer's e-mail | jordan.lavine@flastergreenberg.com,linda.ladzenski@flastergreenberg.com |
| Signature | /jordan lavine/ |
| Date | 11/10/2014 |
| Attachments | Answer Kiss Your Ash Goodbye.pdf(23673 bytes) |

Registration Subject to the filing

| | | | |
|-----------------|---|-------------------|------------|
| Registration No | 4084198 | Registration date | 01/10/2012 |
| Registrant | Smoke Inn, LLC Suite 305 West Palm Beach, FL 33409 UNITED STATES | | |

Goods/Services Subject to the filing

Class 025. First Use: 2006/07/01 First Use In Commerce: 2006/07/01

All goods and services in the class are requested, namely: Clothing, namely, headwear, pants, shorts, shirts, jackets, sweaters, pullovers, coats, neckwear, footwear, and outerwear, namely, jackets and coats

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|--------------------|---|---------------------------------------|
| Smoke Inn, LLC, | : | |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | Opposition No. 91218588 |
| | : | Re: Application Serial No. 86/104,216 |
| Cross Farms, Inc., | : | |
| | : | |
| Applicant. | : | |
| | : | |
| | : | |
| | : | |

ANSWER TO NOTICE OF OPPOSITION

Applicant, Cross Farms., Inc. (“Applicant”), responds to the Notice of Opposition as follows:

1. Admitted.
2. Admitted.
3. Applicant is without knowledge or information concerning the allegations of paragraph three, and so denies the same.
4. Applicant is without knowledge or information concerning the allegations of paragraph four and so denies the same. Applicant additionally responds that, based upon information and belief, the purported registration no. 4,084,198 of Opposer was obtained through the committing fraud on the U.S. Patent and Trademark Office, as further alleged in Applicant’s Counterclaim.
5. Applicant is without knowledge or information concerning the allegations of paragraph five and so denies the same.
6. Applicant is without knowledge or information concerning the allegations of paragraph six and so denies the same.

7. Applicant is without knowledge or information concerning the allegations of paragraph seven and so denies the same.

8. Applicant is without knowledge or information concerning the allegations of paragraph eight and so denies the same.

9. Applicant is without knowledge or information concerning the allegations of paragraph nine and so denies the same.

10. Applicant is without knowledge or information concerning the allegations of paragraph ten and so denies the same.

11. Denied.

12. Denied.

13. Denied.

14. Denied.

15. Denied.

16. Denied.

17. Denied.

18. Denied.

WHEREFORE, Applicant requests that Opposer's Notice of Opposition be dismissed and that Applicant's application be permitted to proceed to registration.

APPLICANT'S COUNTERCLAIMS FOR FRAUD

1. Applicant, a corporation organized and existing under the laws of Delaware, with its principal place of business at 222 Delaware Avenue, Suite 1200, Wilmington, Delaware 19081, believes it will be damaged by the continued registration of Opposer's registration no. 4,084,198 for "clothing, namely, headwear, pants, shorts, shirts, jackets, sweaters, pullovers, coats, neckwear, footwear, and outerwear, namely, jackets and coats," issued on January 10,

2012.

2. Applicant is a leading independent manufacturer, distributor and retailer of tobacco-related products and accessories. Applicant has recently expanded into the field of electronic cigarettes.

3. Applicant owns pending application Serial No. 86/104,216 for the mark **Kiss Your Ash Goodbye** for products in International Classes 30 and 34.

4. Opposer has opposed the registration of Applicant's aforementioned application based, in part, upon its ownership of registration no. 4,084,198 for the mark **Kiss My Ash**, issued January 10, 2012.

5. Opposer's application that matured to registration no. 4,084,198 was originally filed on May 13, 2008 as an intent to use application under Section 1(b), *i.e.*, based upon Opposer's *bona fide* intent to use the mark in commerce.

6. On November 9, 2011, prior to securing registration No 4,084,198, Opposer filed its Statement of Use for its **Kiss My Ash** trademark alleging use of the mark in commerce for all of the goods identified in the application at that time, namely, "clothing, namely, headwear, pants, shorts, shirts, jackets, sweaters, pullovers, coats, neckwear, footwear, and outerwear, namely, jackets and coats" since at least as early as July 1, 2006. Opposer's alleged date of first use in commerce of July 1, 2005, preceded by nearly two years the May 13, 2008 filing date of Opposer's intent-to-use application for the mark

7. Based upon information and belief gathered through Applicant's investigation of Opposer's business and its website, notwithstanding the allegations contained in Opposer's Statement of Use filed on November 9, 2011, Opposer has never used its alleged **Kiss My Ash** trademark with any of the following goods: pants, shorts, jackets, sweaters, pullovers, coats, neckwear, footwear, and outerwear, namely, jackets and coats.

8. At the time Opposer filed its Statement of Use for *Kiss My Ash* trademark, it was not using the trademark in connection with all of the goods included within the Statement of Use and knew that it was not using the mark with all of the goods for which it alleged use in the Statement of Use.

9. Upon information and belief, and based upon the results of Applicant's investigation and based upon the goods currently available for sale at Opposer's website and through Applicant's review of archival copies of Opposer's website, Opposer knowingly made false, material misrepresentations of fact in procuring registration of its *Kiss My Ash* trademark that is the subject of registration no. 4,084,198 with the intent to defraud the U.S. Patent and Trademark Office. Specifically, Opposer knew that the *Kiss My Ash* trademark was not in use in commerce in connection with the majority of the goods identified in the application at the time the Statement of Use was filed, yet still alleged use of the mark in commerce with those goods, namely, pants, shorts, jackets, sweaters, pullovers, coats, neckwear, footwear, and outerwear, namely, jackets and coats.

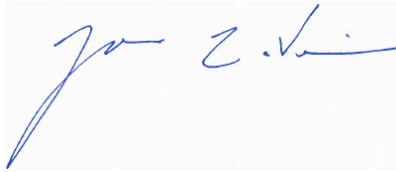
10. Based upon the aforementioned acts, Opposer committed fraud in obtaining registration no. 4,084,198, which is the only subsisting registration upon which the instant opposition proceeding is pending.

11. By virtue of the foregoing, if the aforementioned registration is permitted subsist, with all the presumptions afforded to a registration issued on the Principal Register, the registration will serve as a basis for opposing Applicant's registration of its *Kiss Your Ash Goodbye* trademark and subject Applicant to damage.

Wherefore, Applicant respectfully requests that this Counterclaim be sustained and that registration no. 4,084,198 be cancelled on the basis that it was procured through fraud.

Respectfully submitted,

FLASTER/GREENBERG, P.C.

A handwritten signature in blue ink, appearing to read "Jordan A. LaVine", is written over a light gray rectangular background.

Dated: November 10, 2014

Jordan A. LaVine
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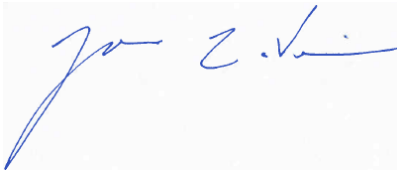
ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Answer and Counterclaim were served on the following counsel this 10th day of November, 2014, via regular U.S. Mail:

KEVIN M DRUCKER
MENDELSON DRUCKER & DUNLEAVY PC
1500 JOHN F KENNEDY BLVD, SUITE 312
PHILADELPHIA, PA 19102

By:



Jordan A. LaVine

Dated: November 10, 2014