

ESTTA Tracking number: **ESTTA1122069**

Filing date: **03/22/2021**

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

Proceeding	91264929
Party	Plaintiff Top Tobacco, L.P.
Correspondence Address	ANTONY J MCSHANE NEAL GERBER & EISENBERG LLP 2 N LASALLE STREET SUITE 1700 CHICAGO, IL 60602 UNITED STATES Primary Email: <a href="mailto:ecfdocket@nge.com">ecfdocket@nge.com</a> Secondary Email(s): <a href="mailto:amcshane@nge.com">amcshane@nge.com</a> , <a href="mailto:aflores@nge.com">aflores@nge.com</a> , <a href="mailto:temanuelson@nge.com">temanuelson@nge.com</a> , <a href="mailto:acrawford@nge.com">acrawford@nge.com</a> , <a href="mailto:ecfdocket@nge.com">ecfdocket@nge.com</a> 312-269-8000
Submission	Motion to Strike
Filer's Name	ANTONY J. MCSHANE
Filer's email	<a href="mailto:amcshane@nge.com">amcshane@nge.com</a> , <a href="mailto:aflores@nge.com">aflores@nge.com</a> , <a href="mailto:temanuelson@nge.com">temanuelson@nge.com</a> , <a href="mailto:acrawford@nge.com">acrawford@nge.com</a> , <a href="mailto:ecfdocket@nge.com">ecfdocket@nge.com</a>
Signature	/Antony J. McShane/
Date	03/22/2021
Attachments	Motion to Strike - SUPERMATCH.pdf(163153 bytes )

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

In the Matter of Application Serial No.:  
88/917,699 for SUPERMATCH

Published in the Official Gazette on:  
September 22, 2020

TOP TOBACCO, L.P.,

Opposer,

v.

POTOMAC TOBACCO COMPANY LIMITED,

Applicant.

**Opposition No. 91264929**

**TOP TOBACCO'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES**  
**OF APPLICANT'S AMENDED ANSWER**

Applicant's Amended Answer pleads one affirmative defense – that Opposer is barred from opposing the subject application because Opposer did not oppose an expired registration for the same mark, namely Registration No. 4,434,423, which was owned by an entity allegedly related to the Applicant. (12 TTABVUE). However, the Board previously struck the Applicant's first attempt at asserting this affirmative defense on the basis that Applicant did not adequately plead the *Morehouse*, estoppel, acquiescence or laches defenses. (10 TTABVUE). Here, the Applicant reasserts the same affirmative defense without curing the deficiencies needed to adequately plead any such defenses. Indeed, its reasserted Amended Affirmative is as untenable as those already stricken by the Board. Accordingly, pursuant to Federal Rule of Civil Procedure 12(f) and TBMP § 506, Top Tobacco, L.P. hereby moves for an order striking Applicant's Amended Affirmative Defense, as well.

In its initial answer, Applicant raised as an affirmative defense the fact that Top Tobacco claims ownership of a registration for its SUPERMATIC mark that co-existed on the Principle Register with a registration for Applicant's SUPERMATCH mark allegedly owned by an entity related to Applicant. (4 TTABVUE 3). In granting Top Tobacco's motion to strike, the Board found this defense insufficient as a matter of law. (10 TTABVUE). Specifically, because Registration No. 4,434,423 expired on November 20, 2019 – the day after the sixth anniversary of the registration date – it was not in existence when the subject application was filed. (10 TTABVUE 7). As a result, the *Morehouse* defense is not available. Further, The Board found that “Applicant has not alleged any facts or events occurring between the time its mark was published for opposition and the filing of a notice of opposition” and that Top Tobacco timely opposed the opposition. (10 TTABVUE 7). As such, Applicant's affirmative allegations did not support the affirmative defense of estoppel or acquiescence. With respect to a possible laches defense, the Board held that “Applicant does not sufficiently allege [(i)] that Opposer unreasonably delayed in failing to object to the prior registration during the time [the prior registration] was in existence or [(ii)] whether Applicant suffered material prejudice as a result of the alleged delay.” (10 TTABVUE 9). Thus, Applicant's allegation did not support a laches defense.<sup>1</sup>

Although Applicant's Amended Affirmative Defense is equally unclear as to whether Applicant intends to replead a *Morehouse* defense, estoppel, acquiescence or laches, it cures none of these deficiencies. The prior registration expired on November 20, 2019, almost six months before the subject application was filed. The Amended Affirmative Defense raises no new or

---

<sup>1</sup> As a further and separate basis for its ruling, the Board also held that Applicant did not allege sufficient facts to establish that it was a successor-in-interest to the prior registrant. This is the only holding of the Board's ruling addressed by Applicant's Amended Affirmative Defense.

additional registrations upon which to rest a *Morehouse* defense. As such, the defense is not available to Applicant in this proceeding.

Further, the additional matter contained in Applicant's Amended Affirmative Defense pertains solely to the alleged relatedness of Applicant and the owner of the prior registration. It contains no allegations of "facts or events occurring between the time its mark was published for opposition and the filing of a notice of opposition." (10 TTABVUE 7). As such, it cannot support an estoppel or acquiescence defense.

Finally, Applicant's Amended Affirmative Defense does not raise any facts to establish that Top Tobacco unreasonably delayed during the time the prior registration was in existence or that Applicant suffered material prejudice as a result of the alleged delay. As the opposition was timely filed in this matter, there was no delay once the subject application was published and the period of delay started over anew. *See Aquion Partners Ltd. P'ship v. Envirogard Prods.*, 43 U.S.P.Q.2D (BNA) 1371, 1373 n. 8 (TTAB 1997) (Stating in relation to a laches defense based on a prior registration that "the period of delay ended with the expiration of that [prior] registration and did not recommence ... until the date of publication of applicant's mark in connection with its present application."). Moreover, even with respect to the time during which the prior registration was in existence, the defense of laches requires the Applicant to show it suffered "material prejudice" due to the delay. *Id.* at 1374. The defense "usually requires factual development beyond the content of the pleadings. The facts evidencing unreasonableness of the delay and material prejudice to the defendant cannot be decided against the plaintiff based solely on presumptions." *Id.* at 1373. "Mere delay in asserting a trademark right does not constitute laches." *Id.* at 1374. Here, Applicant's Amended Affirmative Defense does not allege anything more than a delay by

Top Tobacco, nor any facts to show a “material prejudice” due to the delay. As such, the allegation cannot support a laches defense.

Notably, Applicant’s Amended Affirmative Defense contains two allegations that actually belie its viability as a defense. First, it suggests that Applicant was assigned rights in the prior registration on May 14, 2020. (12 TTABVUE 4). By that date, however, the registration had already expired; there was nothing to assign to Applicant. Second, it alleges that Applicant relied on the fact that “the filing of the subject application overlapped with the existing registration” in commencing use of the mark “on some of the goods” in the application. (12 TTABVUE 4). In fact, the two did not overlap. The registration expired on November 20, 2019. The subject application was filed on May 15, 2020. Moreover, by this statement the Applicant admits that it did not rely on the Opposer’s actions until after the subject application was filed, and therefore did not use the SUPERMATCH mark until sometime after it filed the subject application.

### **CONCLUSION**

The affirmative defense in Applicant’s Amended Answer to the Notice of Opposition has no legitimate basis in this proceeding and will serve merely to unduly complicate it. Striking it will best serve the interests of the parties and the Board by removing irrelevant and unnecessary issues from the proceeding and allowing this case to move forward in an efficient and focused manner.

WHEREFORE, Top Tobacco respectfully requests that the Board enter an Order granting this Motion and: (1) strike the affirmative defense of Applicant’s Amended Answer to the Notice of Opposition; and (2) grant Top Tobacco any such additional and further relief that the Board deems proper.

Respectfully submitted,

Dated: March 22, 2021

By:           /Antony J. McShane/          

One of the Attorneys for Opposer  
Top Tobacco, L.P.

Antony J. McShane  
Abigail E. Flores  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street, Suite 1700  
Chicago, Illinois 60602-3801  
(312) 269-8000

**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing MOTION TO STRIKE APPLICANT’S AFFIRMATIVE DEFENSES OF APPLICANT’S AMENDED ANSWER upon the Applicant’s counsel listed below via email this 22<sup>nd</sup> day of March, 2021.

KATHRYN JENNISON SHULTZ  
JENNISON & SHULTZ PC  
3918 PROSPERITY AVE SUITE 215  
FAIRFAX, VA 22031  
UNITED STATES  
kjs@jennisonlaw.com, jennisonlaw@jennisonlaw.com

/Antony J. McShane/  
Antony J. McShane