



trademark is confusingly similar to Respondent's various CLASSIC AMERICAN BLEND marks.<sup>1</sup>

For the Board's edification, a brief history of the parties' interactions in this matter is instructive. Unbeknownst to Respondent or its counsel, when the Statement of Use for the CLASSIC AMERICAN BLEND registration that is the subject of this petition was filed by Respondent's counsel, those goods upon which the mark is actually being used were accidentally deleted, leaving only "cigarettes" in the identification of goods.<sup>2</sup> After receiving the Certificate of Registration, Respondent's counsel noticed the error. In an effort to correct this error, counsel spoke with representatives from the PTO Commissioner's office, who advised counsel that it was not possible to simply reverse this mistake. Rather, Respondent would have to voluntarily cancel its registration and file a new application. However, before it could do so, Petitioner filed the instant petition, asserting (a) that Respondent had not used the mark on the goods in the registration; and (b) that the mark was confusingly similar to Petitioner's CLASSIC CANADIAN registration and, therefore, should be cancelled.

Respondent's counsel learned of the Petition only one day before an Answer was due (for some reason, a copy of it never reached Respondent's counsel's offices). Respondent's counsel immediately telephoned Petitioner's counsel and discussed the situation and asked that Petitioner grant consent for Respondent to voluntarily cancel this registration. In the alternative, Respondent asked for additional time to prepare and file its Answer. Petitioner refused to

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<sup>1</sup> For purposes of this motion, Respondent is incorporating its registration for ZIG ZAG CLASSIC AMERICAN BLEND. However, Respondent believes that that mark is even less similar than the CLASSIC AMERICAN BLEND marks are to the CLASSIC CANADIAN mark. These actions are the subjects of Consolidated Proceeding No. 91157248.

<sup>2</sup> This was caused by the counter-intuitive form at the E-TEAS site in which goods that are in use are REMOVED from the Statement of Use form.

consent to the cancellation, and, since Respondent could not voluntarily cancel this registration without having a judgment on the merits entered against it, it prepared and filed its Answer.<sup>3</sup>

As discussed in detail below, it is Petitioner's own tortured allegations that caused Respondent to answer as it did, and not an effort to equivocate or otherwise, prejudice Petitioner. In addition, as Respondent will clearly demonstrate, Petitioner has totally failed to show that it is entitled to a judgment as a matter of law since virtually ALL of the material issues of fact in this matter are outstanding.

Finally, and in Respondent's opinion, highly relevant, if Petitioner had simply consented to Respondent's request to voluntarily cancel this registration, neither Respondent's answer nor the instant motion would have been necessary. For these reasons, Petitioner should not be rewarded for its efforts to obtain a judgment to which it is not entitled and for using both Respondent's and the Board's resources in having to deal with a motion which could easily have been avoided with one simple courtesy.

## DISCUSSION

### **A. NAOC's Responses Were Proper Under the Circumstances**

Although Petitioner paints a portrait of Respondent filing "improper" answers to its allegations, in actuality, it is Petitioner's allegations that were vague, contained multiple allegations and were virtually impossible to decipher. For example, paragraph 6 -- the "key" paragraph (as it is referred to by Petitioner) in its Petition to Cancel -- reads as follows:

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<sup>3</sup> In its moving papers Petitioner makes a point of noting how it "twice consented to NAOC's requests for extensions of time to answer the petition, allowing NAOC nearly 80 days to respond to the petition." The two extensions granted by Petitioner totaled 37 days. The original 40 days originated from the Board and which, as Respondent noted above, it was unaware of the existence of this petition until one day prior to the expiration of the original 40 day period of time.

As demonstrated by the specimen submitted in support of Respondent's registration attached as Exhibit A, Respondent uses the mark in connection with a cigarette making kit, which purportedly includes a cigarette making machine, tobacco, cigarette tubes, and a cigarette box. However, Respondent obtained registration for the mark CLASSIC AMERICAN BLEND for use with "cigarettes." See copy of Registration No. 2, 989,935 attached hereto as Exhibit B. Because, upon information and belief, Respondent is not using the mark in connection with the goods for which it sought registration, Registration No. 2,989,935 should be cancelled on the grounds (sic) of non-use.

By Respondent's count, there are four separate allegations in this one paragraph. They are: (1) As demonstrated by the specimen submitted in support of Respondent's registration attached as Exhibit A, Respondent uses the mark in connection with a cigarette making kit; (2) which purportedly includes a cigarette making machine, tobacco, cigarette tubes, and a cigarette box; (3) However, Respondent obtained registration for the mark CLASSIC AMERICAN BLEND for use with "cigarettes." See copy of Registration No. 2, 989,935 attached hereto as Exhibit B; and (4) Because, upon information and belief, Respondent is not using the mark in connection with the goods for which it sought registration, Registration No. 2,989,935 should be cancelled on the grounds (sic) of non-use.

Simply put, Respondent could not provide a simple admission or denial (or even assert that it was without information sufficient to form a belief as to the truth of the averment) to the multiple allegations set forth in this paragraph. Thus, it answered as best it could – by indicating that because of Petitioner's defective pleading, Respondent could not provide the single admission or denial, and thus, denied the entire assertion.

In its motion, Petitioner places the onus only on Respondent to have been able to decipher the morass of allegations contained in certain of its paragraphs. In support, it cites *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62 (TTAB 1985) for the proposition that "if

respondent is without knowledge or information on which to form a belief as to the truth of the allegations, it should so state . . . “ However, that case only talks of the general principle of asserting a lack of knowledge, and in doing so, denying an allegation. It does not involve an allegation containing multiple allegations for which both admissions and denials would have to be made. Moreover, Respondent has never asserted that it was without knowledge sufficient to form an opinion as to the truth of the matter asserted. Instead, it answered that it could not make a blanket denial or admission based on its inability to unravel the multiple allegations contained in that paragraph and several others.

Petitioner, rather than accept Respondent’s blanket denial and, if unsatisfied with the manner in which it was offered, seek to amend its Petition to make its allegations simpler and clearer, it is attempting, as Respondent will discuss later, to obtain a judgment to which it is not entitled.

Petitioner also attempts to make hay of the fact that Respondent managed to provide a blanket denial to certain other of the paragraphs in which it admittedly makes multiple allegations. Specifically, it points to paragraph 9. However, even a cursory reading of paragraph 9 reveals that in fact, Respondent could deny every single allegation contained therein. Thus, it did. It is only in those paragraphs in which Respondent could not provide a single admission or denial that it was forced to respond as it did.

**B. Petitioner is Not Entitled To Judgment as a Matter of Law**

As the procedural history of this matter was unfolding, the question of why Petitioner did not simply consent to Respondent’s voluntary cancellation of the instant registration was vexing to Respondent. With the filing of this motion, Respondent now has its answer – Petitioner is

attempting to secure a judgment on the issue of likelihood of confusion without actually having to demonstrate that any confusion exists. However, it is patently clear that Petitioner is not entitled to a judgment on the issue of confusion, and since it did not seek a judgment ONLY on the issue of non-use, its entire motion must fail.

As it notes in its moving papers, judgment on the pleadings is appropriate when the moving party establishes that there are no outstanding material issues of fact. However, since no discovery has been taken, there is nothing but outstanding issues of fact as they pertain to the issue of confusion.

Petitioner has not made any sort of showing that any of the factors listed in *In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973), *i.e.*, the strength of its mark, or the similarity of its mark to Respondent's mark in sight, sound and commercial impression. In fact, while Petitioner has taken some discovery, it has not submitted any in support of its assertion that no material issues of fact exist, and in fact recently sent Respondent's counsel a letter clarifying certain of the interrogatory and document requests it proffered upon Respondent. In fact, Petitioner's actions beg the question – why take discovery if none was needed? Under even the most liberal of definitions, it can hardly claim it has demonstrated no issues of fact or law remain with respect to likelihood of confusion.

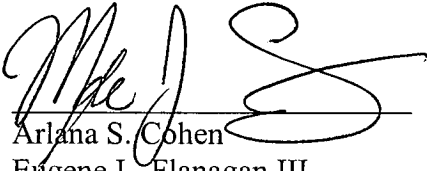
Petitioner attempts to mask its efforts to circumvent its burden of proof on the issue of confusion by combining it with the issue of non-use, and claiming “there are no outstanding material issues of fact because NAOC is not using the mark CLASSIC AMERICAN BLEND in commerce in connection with the goods for which it obtained the registration in question.” However, based upon the record created so far, many questions of material fact remain and/or are simply not addressed by Petitioner, and Petitioner's motion must fail.

CONCLUSION

Petitioner is seeking a judgment on the merits on the ground that Respondent's answer to its overly-convoluted and ultimately-unintelligible allegations about the issue of use of the CLASSIC AMERICAN BLEND mark in connection with "cigarettes." Further, it is attempting to piggy-back what it claims are unresponsive and equivocal pleadings in response to allegations about use into a judgment about likelihood of confusion without providing the necessary proof. Petitioner's motion should be denied in its entirety.

Dated: February 27, 2006  
New York, New York


Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 27th day of February, 2006, I placed a true and correct copy of the foregoing Respondent's Opposition to Petitioner's Motion for Judgment on the Pleadings in the United States mail, postage prepaid, addressed to:

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