

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

In the Matter of )  
 Registration No. 2,989,935 )  
 )  
 TOP TOBACCO, L.P., )  
 )  
 Petitioner, )  
 v. )  
 NORTH ATLANTIC OPERATING CO., INC. )  
 )  
 Respondent. )



02-06-2006

U.S. Patent & TMO/TM Mail Rpt. Dt. #11

Cancellation No. 92044953

76. 357, 525

**PETITIONER'S MOTION FOR JUDGMENT ON THE PLEADINGS**

Petitioner Top Tobacco, L.P., ("Top") hereby moves for judgment on the pleadings pursuant to Trademark Trial and Appeal Board Manual of Procedure §504 and Federal Rule of Civil Procedure 12(c). Respondent North Atlantic Operating Co., Inc. ("NAOC"), has failed to admit a key fact in these proceedings, namely that it is not using the mark CLASSIC AMERICAN BLEND in connection with the goods for which it obtained registration, cigarettes. Instead, as more fully set forth below, specifically to avoid making an admission, NAOC has intentionally provided an ambiguous, equivocal response to Top's allegation of non-use and, hence, NAOC has failed to meet its burden of specifically admitting or denying the averment. Accordingly, the response in question should be deemed an admission, rendering Top entitled to judgment as a matter of law.

**I. NAOC'S IMPROPER DENIALS SHOULD BE DEEMED ADMISSIONS.**

On September 15, 2005, Top filed its petition to cancel Registration No. 2,989,935 on the grounds of non-use and confusing similarity to Top's CLASSIC CANADIAN mark. A copy of the petition is attached hereto as Exhibit A. Top twice consented to NAOC's requests for

extensions of time to answer the petition, allowing NAOC nearly 80 days to respond to the petition. On December 7, 2005, NAOC filed its answer, a copy of which is attached hereto as Exhibit B.

The answer intentionally avoids admitting the central allegation of this proceeding, namely that NAOC is not using the mark in commerce in connection with the goods for which it is registered. Instead, the answer contains an improper equivocal denial designed circumvent this allegation. Indeed, NAOC has conceded that it is not using the mark in connection with cigarettes, which are the only goods covered by the registration in question.

It is axiomatic under Federal Rule of Civil Procedure 8(b) that "[a] party shall state in short and plain terms the party's defenses *to each claim asserted* and shall admit or deny the averments upon which the adverse party relies." Fed. R. Civ. P. 8(b) (emphasis added).<sup>1</sup> Furthermore, "denials shall fairly meet the substance of the averments denied." *Id.* And, when a petition sets forth paragraphs containing multiple allegations, "[i]t is incumbent on applicant to answer these paragraphs by specifically admitting or denying the allegation(s) contained in each one. If [respondent] is without sufficient knowledge or information on which to form a belief as to the truth of any of the allegations, it should so state ... " Thrifty Corp. v. Bomax Enter., 228 USPQ 62, 63 (TTAB 1985).

It is equally well-settled that "an answer which attempts to evade the pleading requirements of Rule 8 by the tactic of an equivocal admission or denial is an admission." Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024, 1030 (CCPA 1982). See also 2 Moore's Fed. Practice 3d, §8.08[1] (2005) ("[a]n equivocal or otherwise improper denial will be deemed an admission"); Household Fin. Corp. v. Clark, No. 91-CA-10, 1991 Ohio App. LEXIS 5592, at \*4 (Ohio Ct. App. 1991) (noting while addressing identical state court rule that equivocal

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<sup>1</sup> Fed.R.Civ.P. 8(b) is made applicable to this proceeding by CFR §2.1169(a).

admissions or denials that attempt to circumvent Rule 8 requirements are admissions). The purpose of the requirement Rule 8 is clear: to prohibit evasive denials. See Lipton, 670 F.2d at 1030. When a respondent such as NAOC attempts to avoid this requirement and answers with deliberately evasive denials, it should be held to the fair pleading standards of Rule 8 and these responses should be deemed admissions.

In this case, NAOC has intentionally ignored the directive to answer each allegation specifically and, instead, it has selectively addressed issues raised in the petition. In particular, in answering paragraphs 3, 4, and 5 and the key paragraph 6 of the petition which alleges non-use, NAOC provides the same non-sensical response: "[a]s Petitioner has made multiple statements in paragraph [] to the Petition, Respondent cannot provide a blanket admission or denial of the allegations contained therein, and therefore, denies the same." Answer, ¶¶ 3-6. According to NAOC, eight of the 10 paragraphs in the Petition contain "multiple statements" that it is unable to substantively answer. See Petition, ¶¶ 1-6, 8-9. However, NAOC intentionally chooses to provide evasive answers with this non-sensical basis as to only the four most legally operative of those paragraphs. See Answer, ¶¶ 3-6. The others, NAOC is apparently quite able to answer. See Answer ¶¶ 1, 2, 8 and 9. In these circumstances, NAOC is clearly able to identify individual allegations in a paragraph and respond appropriately, as shown by its responses to paragraphs 1, 2, 8 and 9.

Tellingly, NAOC's improper denial is most egregious for the paragraph concerning non-use, paragraph 6, which contains allegations as to only NAOC and does not require knowledge of any other entity or set of facts beyond its control. Top's allegations in paragraph 6 state as follows:

As demonstrated by the specimen submitted in support of Respondent's registration attached hereto 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 of non-use.

Surely NAOC is capable of admitting or denying each allegation in this paragraph as it pertains to its own actions. Because NAOC has chosen to respond in an evasive fashion when it clearly has the knowledge to provide a response other than one based on some sort of "multiple statements" objection and had nearly 80 days in which to investigate, these improper denials should be deemed admitted. See, generally, Lipton, 670 F.2d at 1030.

## **II. TOP IS ENTITLED TO JUDGMENT AS A MATTER OF LAW.**

Considering the facts set forth in the pleadings, including NAOC's responses which should be deemed admissions, judgment is appropriate at this stage for Top on its claim for cancellation of NAOC's CLASSIC AMERICAN BLEND mark. See, e.g., Burns Int'l Security Servs. v. Int'l Union, 47 F.3d 14, 16 (2d Cir. 1994) (holding that "judgment on the pleadings is appropriate if, from the pleadings, the moving party is entitled to judgment as a matter of law"). Under Federal Rule of Civil Procedure 12(c) and TMBP § 504, a party may be awarded judgment on the pleadings when it establishes that there are no outstanding material issues of fact and that it is entitled to judgment as a matter of law. Ramsey v. AMFAC, Inc., 960 F. Supp. 1424, 1427 (N.D. Cal. 1997).

Here, 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. Indeed, as noted above, NAOC has conceded the same in lamenting its difficulty to answer without admitting this essential fact. It is difficult to be

sympathetic, however, when the net effect of NAOC's "creative pleading" has been to make this proceeding more protracted and time-consuming than it should have been for all involved, including the Board.

WHEREFORE, Top respectfully requests judgment in its favor, that Registration No. 2,989,935 be cancelled, and that an appropriate sanction be levied against NAOC and its counsel.

Respectfully submitted,

Date: February 6, 2006

By: Lee J. Eulgen  
One of the Attorneys for Petitioner,  
Top Tobacco, L.P.

Antony J. McShane  
Lee J. Eulgen  
Hillary A. Mann  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street, Suite 2300  
Chicago, Illinois 60602-3801  
(312) 269-8000



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

In the Matter of  
Registration No. 2,989,935

TOP TOBACCO, L.P.,

Petitioner,

v.

NORTH ATLANTIC OPERATING CO., INC.

Respondent.

**PETITION TO CANCEL**

92044953

This Petition to Cancel is submitted in the matter of Registration No. 2,989,935, which is owned by North Atlantic Operating Co., Inc., located at 257 Park Avenue South, 7<sup>th</sup> Floor, New York, New York 10010 ("Respondent"). On August 30, 2005, Registration No. 2,989,935 issued for the trademark CLASSIC AMERICAN BLEND for use in connection with cigarettes in International Class 34. Top Tobacco, L.P., a Delaware Limited Partnership having a place of business at 2301 Ravine Way, Glenview, Illinois 60025 ("Top Tobacco"), believes that it will be injured by the continued registration of Registration No. 2,989,935 and, therefore, petitions to cancel the same on the following grounds:

**Petitioner's Rights In Its Incontestable CLASSIC CANADIAN Mark**

1. For many years, and long prior to the acts of Respondent alleged herein, Top Tobacco and its affiliates have been engaged in, inter alia, the distribution and sale of smoker's articles, including tobacco and related products such as cigarette papers. Top Tobacco and its affiliates distribute such goods to consumers across the United States through tobacco shops, novelty, convenience and other retail stores, as well as through select restaurants and clubs.

2. Top Tobacco and its affiliates have for many years used the mark CLASSIC CANADIAN in connection with the distribution and sale of smoking tobacco. Top Tobacco and its affiliates, including Republic Tobacco, L.P., have devoted significant resources, time, and effort to marketing and distributing smoking tobacco under the mark CLASSIC CANADIAN. As a result, Top Tobacco's CLASSIC CANADIAN mark has acquired a distinctiveness and secondary meaning signifying Top Tobacco and its goods.

3. Top Tobacco's CLASSIC CANADIAN mark, which has been in use in commerce since at least as early as September 30, 1992, has been registered in the United States Patent & Trademark Office ("PTO") for use in connection with tobacco, Registration No. 1,922,338, and is now incontestable pursuant to 15 U.S.C. § 1065. As a result of the considerable consumer recognition and goodwill that Top Tobacco now owns and that is symbolized by its mark, Top Tobacco's CLASSIC CANADIAN mark and its corresponding registration are among its most valuable assets.

4. On August 30, 2005, Registration No. 2,989,935 issued for cigarettes in International Class 34. For the reasons set forth more fully below, Top Tobacco believes it will be injured by the continued registration of Registration No. 2,989,935, and therefore petitions to cancel the same on the grounds that (i) Respondent has not used the mark in connection with the goods for which it obtained registration, and (ii) the continued registration of Respondent's mark is likely to cause confusion or mistake, or to deceive prospective purchasers.

**Respondent Has Not Used the Mark in Connection with the Goods for Which it Registered**

5. Section 1 of the Lanham Act, 15 U.S.C. § 1051, requires that the mark sought to be registered be used in commerce in order to obtain a federal registration. Non-use of a term for which a registration is obtained is proper grounds for cancellation.



6. As demonstrated by the specimen submitted in support of Respondent's registration attached hereto 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 of non-use.

**Respondent's Mark Is Confusingly Similar to Top Tobacco's CLASSIC CANADIAN Mark**

7. In addition to being cancelled on the grounds of non-use, Registration No. 2,989,935 should also be canceled because Respondent's mark is confusingly similar to Top Tobacco's federally-registered CLASSIC CANADIAN mark.

8. Respondent began its use of its CLASSIC AMERICAN BLEND designation long after Top Tobacco acquired rights in its CLASSIC CANADIAN mark. Accordingly, Top Tobacco and its CLASSIC CANADIAN mark have priority of use over Respondent.

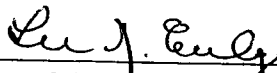
9. Therefore, as a result of, among other things, the similarity of the parties' marks, the similarity of goods with which the marks are actually being used, the similarity in the channels of trade of their respective products, and the strength of Top Tobacco's CLASSIC CANADIAN mark, Respondent's continued registration of CLASSIC AMERICAN BLEND is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe that Respondent's goods are Top Tobacco's goods, or are in some way legitimately connected with, sponsored by, or approved by Top Tobacco in violation of 15 U.S.C. § 1052(d).

10. Respondent's continued registration of its mark, therefore, will result in damage to Top Tobacco, and on that basis as well, Top Tobacco respectfully requests cancellation of Registration No. 2,989,935.

WHEREFORE, Top Tobacco requests that Registration No. 2,989,935 be cancelled and that this Petition for Cancellation be sustained.

Respectfully submitted,

Date: September 15, 2005

By:   
One of the Attorneys for Top Tobacco, L.P.

Antony J. McShane  
Lee J. Eulgen  
Hillary A. Mann  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street, Suite 2300  
Chicago, Illinois 60602-3801  
(312) 269-8000

**Petition to Cancel**  
**In the Matter of**  
**Registration No. 2,989,935**  
**Petitioner's Exhibit A**

STARTER KIT




**ZIG-ZAG**

COMPLETE CIGARETTE MAKING KIT INCLUDES:

ZIG-ZAG FILTER CIGARETTE MAKING MACHINE

ZIG-ZAG CLASSIC AMERICAN BLEND TOBACCO (TWO .75 OZ. POUCHES)

ZIG-ZAG 100 FILTERED CIGARETTE TUBES

ZIG-ZAG POP-TOP™ CIGARETTE BOX 

MAKE YOUR OWN FILTERED CIGARETTES

**Petition to Cancel**  
**In the Matter of**  
**Registration No. 2,989,935**  
**Petitioner's Exhibit B**

**Int. Cl.: 34**

**Prior U.S. Cls.: 2, 8, 9, and 17**

**United States Patent and Trademark Office**

**Reg. No. 2,989,935**

**Registered Aug. 30, 2005**

**TRADEMARK  
PRINCIPAL REGISTER**

**CLASSIC AMERICAN BLEND**

**NORTH ATLANTIC OPERATING CO., INC. (DE-  
LAWARE CORPORATION)  
C/O JAMES W. DOBBINS, ESQ.  
257 PARK AVENUE SOUTH  
NEW YORK, NY 10010**

**NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "AMERICAN BLEND", APART  
FROM THE MARK AS SHOWN.**

**FOR: CIGARETTES, IN CLASS 34 (U.S. CLS. 2, 8, 9  
AND 17).**

**SN 76-357,525, FILED 1-11-2002.**

**FIRST USE 4-1-1999; IN COMMERCE 4-1-1999.**

**TONI HICKEY, EXAMINING ATTORNEY**

**CERTIFICATE OF MAILING**

U.S. Express Mail Number:

Date of Deposit: September 15, 2005

Matter: Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.

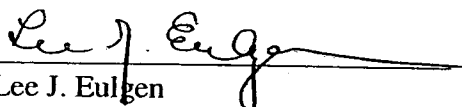
Petition to Cancel Registration No.: 2,989,935

Mark: CLASSIC AMERICAN BLEND

I hereby certify that the above-referenced Petition to Cancel has been deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to:

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Date: September 15, 2005

By:   
Lee J. Eulgen





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

In the matter of trademark registration  
No. 2,989,935 - CLASSIC AMERICAN BLEND

TOP TOBACCO, L.P.,  
Petitioner,  
v.  
NORTH ATLANTIC OPERATING CO., INC.,  
Respondent.

Cancellation No. 92044953

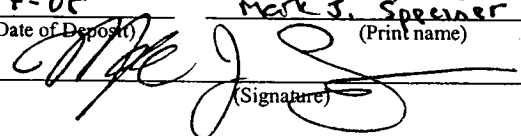
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
Attn: Box TTAB

ANSWER TO PETITION TO CANCEL

Respondent North Atlantic Operating Co., Inc. ("Respondent") as an for its  
Answers to Petitioner Top Tobacco's ("Petitioner") Petition to Cancel ("Petition")  
Registration No. 2,989,935, do hereby states as follows:

Respondent denies the allegations set forth in the pre-amble to the Petition to  
Cancel whereby Petitioner asserts it is injured by the continued registration of  
Registration No. 2,989,935.

1. Respondent is without information sufficient to form a belief as to the  
allegations set forth in the paragraph 1 of the Petition and, therefore, denies the same.

I hereby certify that this correspondence is being deposited with the U.S.  
Postal Service as First Class Mail in an envelope addressed to Commissioner  
for Trademarks, ~~2000 Crystal Drive, Arlington, Virginia 22202-3574~~ on  
P.O. Box 1451, Alexandria, VA 22313-1451  
12-7-05 Mark J. Speiser  
(Date of Deposit) (Print name)  
  
(Signature)

2. Respondent is without information sufficient to form a belief as to the allegations set forth in the paragraph 2 of the Petition and, therefore, denies the same.

3. As Petitioner has made multiple statements in paragraph 3 to the Petition, Respondent cannot provide a blanket admission or denial of the allegations contained therein, and, therefore, denies the same.

4. As Petitioner has made multiple statements in paragraph 4 to the Petition, Respondent cannot provide a blanket admission or denial of the allegations contained therein, and, therefore, denies the same.

5. As Petitioner has made multiple statements in paragraph 5 to the Petition, Respondent cannot provide a blanket admission or denial of the allegations contained therein, and, therefore, denies the same

6. As Petitioner has made multiple statements in paragraph 6 to the Petition, Respondent cannot provide a blanket admission or denial of the allegations contained therein, and, therefore, denies the same

7. Respondent denies the allegations set forth in paragraph 7 to the Petition.

8. Respondent is without information sufficient to form a belief as to the allegations set forth in the paragraph 8 of the Petition and, therefore, denies the same.

9. Respondent denies the allegations set forth in paragraph 9 to the Petition.

10. Respondent denies the allegations set forth in paragraph 10 to the Petition.

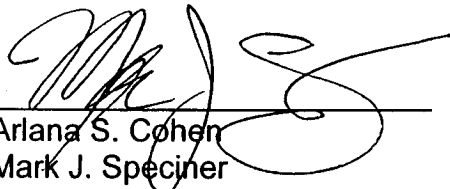
**PRAYER FOR RELIEF**

Respondent herein requests that the Petitioner's Petition be dismissed in its entirety.

Dated: December 7, 2005  
New York, New York

Respectfully submitted,

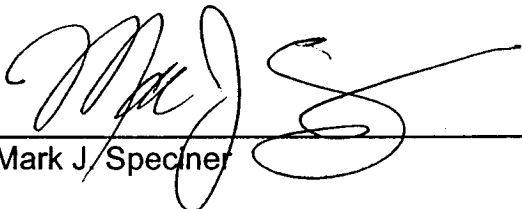
By:

  
Arlana S. Cohen  
Mark J. Speciner  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036  
Tel: (212) 790-9200  
Fax: (212) 575-0671

CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of December, 2005, I placed a true and correct copy of the foregoing Answer to Petition to Cancel in the United States mail, postage prepaid, addressed to:

Lee J. Eulgen, Esq.  
Neal, Gerber & Eisenberg, LLP  
Two North LaSalle Street  
Suite 2300  
Chicago, IL 60602-3801

  
\_\_\_\_\_  
Mark J. Speciner

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as **First Class Mail** in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on

\_\_\_\_\_  
(Date of Deposit)

\_\_\_\_\_  
(Print name)

\_\_\_\_\_  
(Signature)

**CERTIFICATE OF MAILING**

U.S. Express Mail Number: **EV389419275US**

Date of Deposit: February 6, 2006

Matter: Top Tobacco, L.P. v. North Atlantic Operating Co., Inc., Cancellation No. 92044953

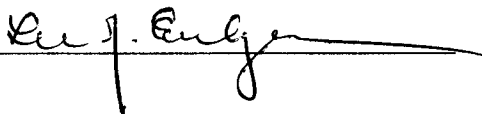
Petition to Cancel Registration No.: 2,989,935

Mark: CLASSIC AMERICAN BLEND

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Date: February 6, 2006

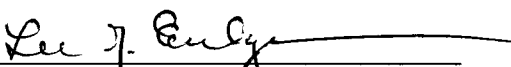
By: 

**CERTIFICATE OF SERVICE**

I, Lee J. Eulgen, an attorney, state that I served a copy of the foregoing Petitioner's Motion for Judgment on the Pleadings upon:

Arlana S. Cohen, Esq.  
Mark J. Speciner, Esq.  
Cowan Liebowitz & Latman, PC  
1133 Avenue of the Americas  
New York, New York 10036-6799

via Federal Express delivery on this 6<sup>th</sup> day of February, 2006.

  
\_\_\_\_\_  
Lee J. Eulgen