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

Proceeding	92055738
Party	Plaintiff J J Holand Limited
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Signature	/Keith McCulloch/
Date	04/15/2013
Attachments	POTOMAC Response to Respondents Motion to Dismiss KMM signed.pdf (5 pages)(202533 bytes)

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

In the matter of trademark Registration No. 3,409,520
For the mark YES
Date registered: April 8, 2008

In the matter of trademark Registration No. 3,418,779
For the mark YES INTERNATIONAL
Date registered: April 29, 2008

J J HOLLAND LIMITED,	:	
	:	
Petitioner,	:	Cancellation No. 92055738
	:	
v.	:	
	:	
POTOMAC TOBACCO COMPANY, LTD.	:	
	:	
Registrant.	:	

PETITIONER’S RESPONSE TO REGISTRANT’S MOTION TO DISMISS

Petitioner hereby responds to Registrant’s latest Motion to Dismiss for alleged failure to comply with the Board’s February 12, 2013 Order.

Registrant alleges that Petitioner’s Amended Petition has not complied with the Board’s order to comply with Rule 2.112(a) and to omit immaterial and inappropriate allegations. Registrant further alludes that Petitioner’s 14 page Amended Petition is not compliant. The Amended Petition is a consolidated complaint seeking cancellation of two trademarks of Registrant, and, by raising multiple bases for cancellation under the Lanham Act, challenging Respondent’s right to register with concrete facts and properly plead arguments, leading inter alia to Petitioner’s knowledge and belief, it can hardly be said that 14 pages is unreasonable under the circumstances.

Registrant falsely states on page 2 of its Motion that Petitioner had previously abandoned its prior YES! Trademark application; nothing of the sort occurred as Registrant and Registrant’s counsel is well aware. If for no other reason but to provide the Board easy access to truth, the Board should reject the Registrant’s efforts to further remove truth from these proceedings. Registrant must accept that certain

facts are facts and they do not become irrelevant or immaterial just because they support the allegations of fraud, abandonment or other good cause for cancellation of its registrations. See for example paragraphs 26, 27, 28, 29, 34, 35, 37, 38, 41, 42, 45, 46, 53, 55, to all of which Registrant directs the Board's attention in its Motion, and which present inconvenient truths for Registrant which Registrant would rather pretend that they have no possible relevance. In fact said paragraphs have incontrovertible relevance to the causes of action validly raised by the Amended Petition.

Registrant has directed the Board's attention to in total, 24 separate paragraphs of the Amended Petition, implying that said paragraphs violate the Board's Order or the Rules. Petitioner wholly denies that said paragraphs or the Amended Petition, taken in total, violate Rule 2.112(a), or fail to comply with the Board's Order of February 12, 2013.

In addition to instructing the Petitioner on certain items not to include in the Amended Petition, the Board's Order further instructed Petitioner on the requirements to sufficiently plead certain causes of action, such as fraud, priority and likelihood of confusion and abandonment, for example specifically noting the need to avoid conclusory allegations without factual support.

While Registrant would like to pretend that Registrant's failure to comply with any regulations for the sale of its primary product has nothing to do with the Board's authority, Petitioner wholly rejects such as folly. See for example paragraphs 45 and 46 cited by Registrant. Clearly the failure to comply with any regulations which are mandatory requirements before the legal sale of the goods under the subject registrations supports a belief that there is no intention to resume use and the registrations have been abandoned. The clear rules under a 12(b)(6) motion regarding immaterial or inappropriate allegations is that for something to be immaterial or inappropriate it cannot possibly have any relevance.

Registrant urges the Board to give unlawful interpretation to its Order of February 12, 2013, in that it seeks to go beyond what the Board had the legal authority to strike under the Registrant's Motion to Strike. Petitioner in its Motion to Amend has already noted both the obligation to comply with respect to immaterial allegations and also the need to adequately plead its causes of actions. While the Board

may have cited certain allegations that were outside of the scope of its authority in these proceedings, Petitioner rejects the notion that any mention of past facts is outside of the scope of these proceedings, when such facts constitute valid and relevant evidence in these proceedings, such as facts which go to the knowledge of the Registrant, the intent of the Registrant or are mere recitations of facts relating to the application and registration process, such as paragraphs 26, 27 and 28 which somehow offend Registrant.

While the Board may have some question at this early stage as to whether any particular allegation will ultimately bear fruit or proof to be relevant, that is not an appropriate basis to strike any allegation individually or more importantly to strike an entire complaint. Petitioner's Amended Petition sets forth valid lawful bases for the cancellation of Registrant's marks, and Registrant's desperation to avoid any of those allegations hearing the light of day is clear, particularly in light of Registrant's counsels' role in such affairs.

Registrant is entitled to proceed, and the full weight of legal authority on Rule 12(b)(6) supports its inclusion of the paragraph numbers noted by Registrant. Such paragraphs are clearly outside of the precedent decisions for material which may be struck from a Petition under a Rule 12(b)(6) motion, and accordingly, it cannot be said that Petitioner's inclusion of such relevant materials is a violation of the Order, it could not be said to be a violation even if the provisions were merely possibly relevant under precedential authority.

Registrant has not violated any lawful Order of the Board, and even if there was some perceived failure to fully comply, the drastic action urged by Registrant would be a great injustice wholly violating the intent of the Federal Rules adopted by Congress and the U.S. Supreme Court. It is difficult to comprehend how Registrant is so significantly harmed by the inclusion of the paragraphs cited in Registrant's motion as potentially immaterial or inappropriate that the Board would be justified in foregoing removal of fraudulently obtained registrations of abandoned trademarks which should not have been granted in any event due to the known likelihood of confusion just to punish Petitioner for including

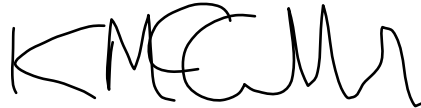
said paragraphs which it feels is relevant and goes to various required elements of its complaint such as knowledge and intent even if someone less informed of the events might think they are not relevant.

Registrant has not cited any paragraphs which are libelous, and such an allegation as made in the Registrant's motion is not a proper basis for seeking a Rule 12(b)(6) motion.

More importantly, Registrant has wholly failed to deny or refute the assertions made in Petitioner's Motion to Amend regarding the Board's improper entertaining of Registrant's first motion to strike dated July 10, 2012, in violation of the Rules since Registrant had not served upon Petitioner said Motion to Strike as clearly required by the Rules. Since the Rules provide that any document not properly served upon the other Party will not be accepted by the Board, the Board should now grant Petitioner's request that the Order of February 12, 2013 be struck, making Registrant's current motion moot in any event.

Petitioner further note that as Registrant's July 2012 Motion was not served upon it and is thus not properly before the Board, Registrant's answer to the Complaint is legally long overdue. As the Amended Petition has now been served upon Registrant for over one month, the Board is requested to deny Registrant's March 27, 2013 Motion for Extension without consent and order default judgment in favor of Petitioner.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K M C U L L O C H', written in a cursive style.

J J Holand Limited

By: Keith Murray McCulloch
Authorized Officer and Representative

Date: April 15, 2013

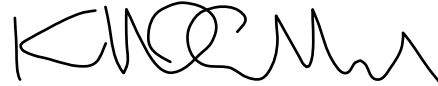
Date: April 15, 2013

Certificate of Service and Certificate of Mailing/Transmission

I hereby certify that a true and complete copy of the foregoing Petitioner's Response To Registrant's Motion To Dismiss has been transmitted to the USPTO - TTAB by using the Board's ESTTA Electronic Filing System on April 15, 2013.

I hereby certify that a true and complete copy of the foregoing Petitioner's Response To Registrant's Motion To Dismiss has been served on Potomac Tobacco Company Ltd by mailing said copy on April 15, 2013, via US First Class Mail to its attorney of record in this matter at the address of record:
JENNISON & SHULTZ, P.C., 2001 JEFFERSON DAVIS HWY, SUITE 1102, ARLINGTON, VA
22202.

BY:



Keith Murray McCulloch –
Authorized Officer and Representative
J J Holand Limited