

ESTTA Tracking number: **ESTTA599308**

Filing date: **04/18/2014**

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

Proceeding	92055738
Party	Defendant Potomac Tobacco Company Limited
Correspondence Address	KATHRYN JENNISON SHULTZ JENNISON & SHULTZ PC 2001 JEFFERSON DAVIS HWY, SUITE 1102 ARLINGTON, VA 22202 UNITED STATES kjs@jennisonlaw.com
Submission	Response to Board Order/Inquiry
Filer's Name	Kathryn Jennison Shultz
Filer's e-mail	kjs@jennisonlaw.com
Signature	/Kathryn Jennison Shultz/
Date	04/18/2014
Attachments	Response to Board order _001.pdf(615345 bytes)

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

J J HOLLAND LIMITED,	:	
	:	
Petitioner,	:	Cancellation No. 92/055,738
	:	Reg. Nos. 3409520 and
v.	:	3418779
	:	
POTOMAC TOBACCO COMPANY, LTD.,	:	
	:	
Respondent.	:	

RESPONSE TO MARCH 19, 2014 BOARD ORDER WITH AMENDED
ANSWER TO THE AMENDED CONSOLIDATED PETITION TO CANCEL

Respondent Potomac Tobacco Company, Ltd. hereby responds to the Board's March 19, 2014 order. Its Amended Answer to the Amended Consolidated Petition to Cancel is submitted herewith.

Respectfully submitted,

POTOMAC TOBACCO COMPANY, LTD.

Date: April 18, 2014

By: 

Kathryn Jennison Shultz
Jennison & Shultz, P.C.
Attorneys for Respondent

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

J J HOLLAND LIMITED,	:	
	:	
Petitioner,	:	Cancellation No. 92/055,738
	:	Reg. Nos. 3409520 and
v.	:	3418779
	:	
POTOMAC TOBACCO COMPANY, LTD.,	:	
	:	
Respondent.	:	

AMENDED ANSWER TO THE AMENDED CONSOLIDATED
PETITION TO CANCEL

Respondent Potomac Tobacco Company, Ltd., answers the Amended Consolidated Petition to Cancel, filed March 14, 2013, by Petitioner JJ Holland Limited, as follows:

Respondent denies the allegation set forth in the opening paragraph. Respondent admits the allegations set forth in the second paragraph with the exception that the office for Jennison & Shultz, P.C. is located at 2001 Jefferson Davis Highway, Suite 1102, Arlington, Virginia 22202.

Respondent responds to the grounds for cancellation as follows:

1. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 1 and therefore denies the same, and leaves Petitioner to its proof.
2. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 2 and therefore denies the same, and leaves Petitioner to its proof.

3. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 3 and therefore denies the same, and leaves Petitioner to its proof.
4. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 4 and therefore denies the same, and leaves Petitioner to its proof.
5. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 5 and therefore denies the same, and leaves Petitioner to its proof.
6. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 6 and therefore denies the same, and leaves Petitioner to its proof.
7. Respondent admits the allegation set forth in paragraph 7.
8. Respondent admits the allegation set forth in paragraph 8.
9. Respondent denies the allegations forth in paragraph 9.
10. Respondent admits that an office action was issued suspending Potomac's YES application and denies the remaining allegations set forth in paragraph 10.
11. Respondent denies the allegations set forth in paragraph 11.
12. Respondent admits the allegations set forth in paragraph 12.
13. Respondent admits the allegations set forth in paragraph 13.
14. Respondent denies the allegations set forth in paragraph 14.

15. Respondent admits that an office action was issued suspending Potomac's YES INTERNATIONAL application and denies the remaining allegations set forth in paragraph 10.
16. Respondent denies the allegations set forth in paragraph 16.
17. Respondent admits the allegation set forth in paragraph 17.
18. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in the first sentence of paragraph 18 and therefore denies the same, and leaves Petitioner to its proof. Respondent admits the allegation set forth in the second sentence of paragraph 18.
19. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 19 and therefore denies the same, and leaves Petitioner to its proof.
20. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in paragraph 20 and therefore denies the same, and leaves Petitioner to its proof.
21. Respondent admits the allegations set forth in the first sentence of paragraph 21. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegation set forth in paragraph 21 and therefore denies the same, and leaves Petitioner to its proof.
22. Respondent admits the allegations set forth in paragraph 22.
23. Respondent admits the allegations set forth in paragraph 23.

24. Respondent denies the allegations set forth in the first and third sentences set forth in paragraph 24. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegation set forth in the second sentence set forth in paragraph 24 and therefore denies the same, and leaves Petitioner to its proof.
25. Respondent admits the allegations set forth in paragraph 25.
26. Respondent admits the allegations set forth in paragraph 26.
27. Respondent denies the allegations set forth in paragraph 27.
28. Respondent admits that it received notices of publication from the USPTO for its YES and YES INTERNATIONAL applications.
29. Respondent denies the allegations set forth in paragraph 29.
30. Respondent admits the allegations set forth in paragraph 30.
31. Respondent admits the allegations set forth in paragraph 31.
32. Respondent admits the allegations set forth in paragraph 32.
33. Respondent admits the allegations set forth in paragraph 33.
34. Respondent admits the allegations set forth in paragraph 34.
35. Respondent admits the allegations set forth in paragraph 35.
36. Respondent admits that it filed its Statement of Use within the first six months after the issuance of the Notice of Allowance and deleted "cigars and tobacco" from the applications to register YES and YES INTERNATIONAL.
37. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the incomprehensible allegation set forth in paragraph 37 and therefore denies the same, and leaves Petitioner to its proof.

38. Respondent admits the allegations set forth in paragraph 38.
39. Respondent admits that it filed its Statement of Use for the YES Application on January 8, 2008, alleging first use in Commerce on January 14, 2004. Respondent denies the remaining allegations set forth in paragraph 39.
40. Respondent admits that it filed its Statement of Use for the YES Application on January 8, 2008, alleging first use in Commerce on January 14, 2004. Respondent denies the remaining allegations set forth in paragraph 40.
41. Respondent admits the allegations set forth in paragraph 41.
42. Respondent admits the allegations set forth in the first sentence of paragraph 42 and denies the remaining allegations set forth in paragraph 42.
43. Respondent admits the allegations set forth in paragraph 43.
44. Respondent admits the allegations set forth in paragraph 44.
45. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 45 and therefore denies the same, and leaves Petitioner to its proof.
46. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 46 and therefore denies the same, and leaves Petitioner to its proof.
47. Respondent admits the allegations set forth in paragraph 47.
48. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 48 and therefore denies the same, and leaves Petitioner to its proof.
49. Respondent denies the allegations set forth in paragraph 49.

50. Respondent denies the allegations set forth in paragraph 50.
51. Respondent denies the allegations set forth in paragraph 51.
52. Respondent denies the allegations set forth in paragraph 52.
53. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 53 and therefore denies the same, and leaves Petitioner to its proof.
54. Respondent denies the allegations set forth in paragraph 54.
55. Respondent denies the allegations set forth in the first sentence in paragraph 55. Respondent is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 55 and therefore denies the same, and leaves Petitioner to its proof.
56. Respondent denies the allegations set forth in paragraph 56.
57. Respondent denies the allegations set forth in paragraph 57.
58. Respondent denies the allegations set forth in paragraph 58.
59. Respondent denies the allegations set forth in paragraph 59.
60. Respondent admits the allegations set forth in paragraph 60.
61. Respondent admits the allegations set forth in paragraph 61.
62. Respondent denies the allegations set forth in paragraph 62.
63. Respondent denies the allegations set forth in paragraph 63.
64. Respondent denies the allegations set forth in paragraph 64.
65. Respondent denies the allegations set forth in paragraph 65.
66. Respondent denies the allegations set forth in paragraph 66.
67. Respondent denies the allegations set forth in paragraph 67.

68. Respondent denies the allegations set forth in paragraph 68.

69. Respondent denies the allegations set forth in paragraph 69.

Respondent denies the allegations set out in the remaining paragraphs of the petition.

AFFIRMATIVE DEFENSES

1. Petitioner does not have priority. It has admitted abandonment and non-use of its alleged mark.
2. Respondent has priority.
3. Respondent is the owner of registrations for its YES and YES INTERNATIONAL trademarks in numerous foreign countries.
4. Petitioner had knowledge of Respondent's use and ownership of the YES and YES INTERNATIONAL trademark in connection with cigarettes prior to the filing of its initial application to register the YES mark in the United States.
5. JJH's Second YES! Trademark Application is void on its face. At least one state has obtained judgment against Petitioner as a non-compliant tobacco product manufacturer who is prohibited by court order from selling its tobacco products in or into that state, whether directly or through a distributor, retailer, or similar intermediary or intermediaries.
6. Petitioner's claims are barred by the doctrine of unclean hands in that Petitioner has engaged in inequitable conduct directly related to the subject matter of this action. Upon information and belief, Petitioner has attempted to sell and/or distribute cigarettes using the Respondent's YES! trademark that contain the following statement, "Made in United Arab Emirates under

authority of trademark owner by arrangement with Potomac Tobacco Corp.," which makes it appear that it has a relationship with the respondent and with full knowledge of the existence of Respondent.

7. Upon information and belief, Petitioner's claims are barred by the doctrine of unclean hands in that Petitioner and/or entities related to Petitioner have received judgments by which cigarettes sold/distributed by them using the YES or YES! trademark have been confiscated and ordered destroyed as counterfeits that infringe on Respondent's YES trademark.

WHEREFORE, Respondent Potomac Tobacco Company, Ltd. prays that the Petition for Cancellation be in all respects dismissed with prejudice.

Respectfully submitted,

POTOMAC TOBACCO COMPANY, LTD.

Date: April 18, 2014

By: 

Kathryn Jennison Shultz
Jennison & Shultz, P.C.
Attorneys for Respondent

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the foregoing RESPONSE TO BOARD ORDER and AMENDED ANSWER TO AMENDED CONSOLIDATED PETITION TO CANCEL were served upon Petitioner J J HOLLAND LIMITED, by forwarding same via First Class Mail, postage prepaid, to Keith Murray McCulloch, J J Holland Limited, 87/171 Wireless Road, Pathumvan, Bangkok 10330, Thailand, this 18th day of April, 2014.


Kathryn Jennison Shultz