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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Opposition No. 119,030

Lane Limited

v.

Richard D. Merhar

Before Simms, Wendel, and Holtzman, Administrative  
Trademark Judges.

By the Board:

On August 11, 2000, Lane Limited filed a notice of  
opposition to Application Serial No. 75/75/644,671 on the  
ground that applicant's mark ROLL YOUR OWN is merely  
descriptive of applicant's goods, "tobacco".<sup>1</sup> The Board  
instituted this proceeding on August 19, 2000. On  
February 21, 2001, opposer filed a motion seeking summary  
judgment on the descriptiveness of the mark as applied to

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<sup>1</sup> Application Serial No. 75/75/644,671, filed on the basis of  
applicant's allegation of a bona fide intent to use the mark in  
commerce, was published in the *Official Gazette* on April 11,  
2000 with goods listed as "tobacco, cigarette papers and  
cigarettes". By examiner's amendment dated May 24, 2000, the  
goods were amended to "tobacco".

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the goods. On March 30, 2001<sup>2</sup>, applicant (*pro se*) filed its response opposing the motion for summary judgment.

In this proceeding, opposer has challenged applicant's right to register ROLL YOUR OWN as a trademark for tobacco. In the opposition, opposer asserts that opposer is in the business of manufacturing and selling smoker's articles, including tobacco products; that opposer sells goods known as "roll your own tobacco", and "roll your own cigarette papers", and that the cigarettes made from such tobacco and papers are known as "roll your own cigarettes"; that applicant's asserted mark ROLL YOUR OWN is merely descriptive of "tobacco, cigarette papers, and cigarettes"; and that registration of applicant's asserted mark ROLL YOUR OWN would be inconsistent with opposer's right to describe its goods.

In his answer, applicant denied most of the allegations of the opposition. In response to opposer's allegation that registration of the term ROLL YOUR OWN would be inconsistent with opposer's right to describe its goods, applicant's answer states "that he will not seek to assert his trademark rights against descriptive

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<sup>2</sup> Applicant's response states "Note, this is being mailed within the twenty day extention agreed to by Mr. Robins". Accordingly,

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uses of the terms 'roll your own tobacco', 'roll your own cigarette papers', and/or 'roll your own cigarettes'".

Turning to opposer's motion for summary judgment, we find that there is no genuine issue of material fact as to whether opposer has standing to bring this proceeding. To show standing, it is necessary for opposer to prove that it is engaged in the sale of goods of which the applied-for mark is allegedly descriptive. *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). Here, the record establishes that opposer uses the term "roll your own" in connection with its manufacture and sale of tobacco products, and thus has standing to oppose.

Opposer next argues that there is no genuine issue of material fact concerning the mere descriptiveness of the term ROLL YOUR OWN when used on tobacco. In support of its motion, opposer submitted two affidavits with attached exhibits. The affidavit of Robert Pless, Vice President of opposer, states that opposer's tobacco is used by consumers in rolling their cigarettes; that tobacco and cigarette papers are generally known as "roll your own tobacco" and "roll your own cigarette papers",

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we accept applicant's response to the motion for summary judgment as timely.

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and that the cigarettes made from such tobacco and papers are generally known as "roll your own cigarettes"; that in the trade this category is known as the "roll your own" or "roll-your-own" category; and that for many years opposer's price list has included "roll your own" categories. Opposer's current price list, an exhibit to the affidavit, shows "roll your own domestic brands", "roll your own imported brands", and "roll your own accessories" categories.

The affidavit of Albert Robin, attorney for opposer, states that the official publication of the Retail Tobacco Dealers Association, *Tobaccionist*, has several examples showing "roll your own" as an industry term indicating a category of tobacco products, and that the Patent and Trademark Office has issued at least two registrations in which the term "roll your own" appears in the identification of goods. Pages from the *Tobaccionist*, exhibits to the affidavit, show references to "roll your own" in conjunction with an editorial on tobacco markets, as a tobacco sales category in a chart, as a tobacco revenue category listed in an article, as a goods listing used by a tobacco trade show exhibitor, and as a category of goods advertised by five of opposer's competitors. Of the two printouts from the Patent and

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Trademark Office TARR database attached to the affidavit, one shows that Registration 2,006,488 identifies the goods as, inter alia, "roll-your-own tobacco" and one shows that application Serial No. 75/686,820 identifies the goods as, inter alia, "roll-your-own cigarette kits".

The burden is on the party moving for summary judgment to show the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); and *Celotex Corp. v. Catrett*, 477

U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. In considering the propriety of summary judgment, the Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

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In *inter partes* proceedings before the Board, once opposer has presented a *prima facie* case, applicant has the burden of going forward (burden of production) to rebut the *prima facie* case. *Auburn Farms Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1999); *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241 (TTAB 1989); *Continental Grain Co. v. Strongheart Products Inc.*, 9 USPQ2d 1238 (TTAB 1988).

Upon careful consideration of the record, we find that opposer has presented a *prima facie* case that the term ROLL YOUR OWN is merely descriptive of tobacco and tobacco products; that there are no genuine issues of material fact; and that opposer is entitled to judgment as a matter of law. Aside from a personal attack upon counsel for opposer,

applicant's response to the motion for summary judgment provides nothing to rebut opposer's evidence.<sup>3</sup>

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<sup>3</sup> Implicit in applicant's response to opposer's motion for summary judgment is applicant's belief that opposer and the Board are somehow required to adopt the examining attorney's conclusion that applicant is entitled to registration. To the contrary, the Trademark Act clearly provides that the registrability of a mark approved by an examining attorney and published by the Office is subject to challenge in an opposition proceeding brought before the Board. See Trademark Act §13. In

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Accordingly, opposer's motion for summary judgment is granted, and judgment is entered against applicant. The opposition is accordingly sustained, and registration to applicant is refused.

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an *inter partes* opposition proceeding, where the Board usually has before it more evidence than the examining attorney had, the Board necessarily has the authority to reach whatever decision is supported by the record. *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).