

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

PUEBLO INTERNATIONAL, INC.,

Opposer,

OPPOSITION NO. 91152004

vs.

IFS FINANCIAL CORPORATION

Applicant.



11-29-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #7

Application Serial No. 75/899,318

Mark: PUEBLO FINANCIAL CORPORATION

Filed: January 19, 2000

Published: February 12, 2002

Assistant Commissioner for Trademarks
BOX TTAB – NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION

Pursuant to Fed. R. Civ. P. 15(a), 37 C.F.R. § 2.107, and TBMP § 507, Opposer Pueblo International, Inc. ("Pueblo") hereby moves the Board for leave to file a First Amended Notice of Opposition to add an additional ground of opposition and would show the Board as follows:

BACKGROUND

On June 10, 2002, Pueblo filed its Notice of Opposition against Applicant IFS Financial Corporation's ("IFS") Application Serial No. 75/899,318. The Opposition was based on a likelihood of confusion between Pueblo's registered marks for PUEBLO and PUEBLOXTRA on supermarket services and its use of the PUEBLO brand on food products and IFS' proposed mark PUEBLO FINANCIAL CORPORATION, as well as dilution of Pueblo's marks.

Having further investigated IFS' use of its mark, Pueblo now believes that IFS is no longer using its mark and has effectively abandoned it. Pueblo therefore moves the Board to allow it to file its First Amended Notice of Opposition in order to add allegations related to IFS' abandonment of the mark as an additional ground for opposition pursuant to TBMP § 312.03, TBMP § 308.01, and 15 U.S.C. § 1064(3). Opposer's First Amended Notice of Opposition accompanies this Motion.

ARGUMENT AND AUTHORITIES

Fed. R. Civ. P. 15(a) allows for amendment of pleadings upon leave of the court, which "shall be freely given when justice so requires." The Board follows this Rule and liberally grants leave to amend pleadings at any stage in a proceeding as long as the adverse party is not prejudiced. TBMP § 507. *See e.g., United States Olympic Comm. v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221, 1223 (TTAB 1993) (Board noting that applicant would not be prejudiced because the proceeding was still in the pre-trial phase). The Board regularly allows amendment even when the Opposer seeks to add causes of action that were not part of the original Notice of Opposition. *See e.g., Marmark Ltd. v. Nutrexpa S.A.*, 12 U.S.P.Q.2d 1843, 1844 (TTAB 1989) (Board allowing Opposer to add a claim based on facts discovered after filing the Notice).

In this case, IFS will clearly not be prejudiced by an amendment to the pleadings, as the discovery period is not set to close for several months. *See Focus 21 Int'l Inc. v. Pola Kasei Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (Board finding no undue prejudice where motion to amend to add claims of abandonment filed before opening of movant's testimony period); *Marmark* at 1844 ("We do not accept applicant's contention that, because applicant has already filed interrogatories and requests for production of documents, therefore it

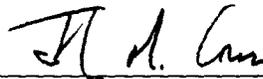
would be prejudiced by the amendment to the notice of opposition.”). Therefore, Pueblo should be allowed to file its First Amended Notice of Opposition.

CONCLUSION

Because the Board freely gives leave to amend pleadings when it will not adversely affect any of the parties, Pueblo respectfully requests that the Board grant it leave to amend its Notice of Opposition as IFS will not be prejudiced by the amendment at this time.

Date: November 26, 2002

Respectfully submitted,



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ATTORNEYS FOR OPPOSER
PUEBLO INTERNATIONAL, INC.

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that the papers enclosed herein are being deposited with the United States Postal Service on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, Box TTAB - No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513.

VICKI MARTIN
(Typed name of person mailing paper)

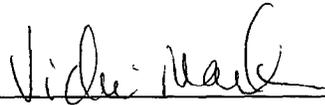
Vicki Martin
(Signature of person mailing paper)

Date: 11-26-02

CERTIFICATE OF SERVICE

I hereby certify that the foregoing was served on this 26th day of November, 2002 via U.S. mail, upon counsel for Applicant:

David M. Bass
Law Offices of David M. Bass
2029 Century Park East
6th Floor
Los Angeles, CA 90067



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FIRST AMENDED NOTICE OF OPPOSITION

Sir:

PUEBLO INTERNATIONAL, LLC, (“Pueblo”) a Delaware limited liability corporation formerly known as Pueblo International Inc. hereby files this First Amended Notice of Opposition to the above-referenced mark and would show the Board as follows:

1. Pueblo has a principal place of business at Campo Rico Avenue, Corner Loiza Expressway, Carolina, Puerto Rico 00982 and a mailing address at G.P.O. Box 3288, San Juan, Puerto Rico 00936.

2. Pueblo believes that it might be damaged by the registration of the above referenced mark to Applicant IFS FINANCIAL CORPORATION (“IFS”).

3. Pueblo has used the name and mark PUEBLO in relation to its supermarket business since at least as long ago as 1955, and owns registered trademarks consisting of or including PUEBLO, including U.S. Registration Nos. 1,997,786 for the mark PUEBLO and 2,509,402 for the mark PUEBLOXTRA, each for use in connection with “supermarket and retail grocery store services.” Pueblo also sells PUEBLO brand food products and owns registrations of PUEBLO for those products in many countries of Central America.

4. Other goods and services available to consumers at Pueblo’s supermarkets and retail grocery stores include commercial and financial transactions such as money transfers, mail services, bill paying services, banking services, and entertainment services.

5. Pueblo uses a variety of means to advertise its stores and the broad range of goods and services available at its stores, including but not limited to print and visual media, print advertisements, mail, and event sponsorships.

6. PUEBLO and PUEBLOXTRA stores are universally known in Puerto Rico and the U.S. Virgin Islands and to people from those islands now residing on the United States mainland.

7. IFS’s business, operated under the name Pueblo Financial Corporation, uses names and marks consisting of or including the word PUEBLO, and markets services promoting consumer goods and services of others through direct mailing, telemarketing, print advertising, event sponsorships, radio and television advertising, and advertising on a global computer network.

8. IFS’s business targets Hispanic consumers in the United States.

9. People from Puerto Rico and the U.S. Virgin Islands make up a substantial part of the U.S. Hispanic market. These people are likely to associate IFS's business with that of Pueblo, given the broad range of goods and services offered in Pueblo's stores.

10. Pueblo has invested many years and substantial sums of money in creating and developing goodwill for its PUEBLO and PUEBLOXTRA brand among the Puerto Rican and Virgin Islands communities. Potential customers for IFS's services are likely to be confused, deceived or mistaken in thinking that IFS's services are in some way associated, affiliated, sponsored or approved by Pueblo.

11. Pueblo's marks PUEBLO and PUEBLOXTRA are famous marks. IFS's use of the mark applied for would cause dilution of the distinctive quality of Pueblo's marks.

12. Pueblo Corporation, a company related to IFS and responsible for the sale and promotion of the services on which the mark applied for was to be used, has filed for bankruptcy. The website on which Pueblo Corporation promoted its services is no longer functioning and counsel for Pueblo has not responded to offers from counsel for Petitioner to dispose of this matter.

13. Apart from the use by its related company, Pueblo Corporation, IFS has not used the mark which is the subject of this application. Now that Pueblo Corporation has filed for bankruptcy, IFS has ceased using the mark.

14. IFS has ceased use of the mark applied for with an intent not to resume such use.

WHEREFORE, Pueblo International, LLC prays that application Serial No. 75/899,318 be refused in accordance with the provisions of Section 13(a) of the Lanham Act.

A duplicate copy of this paper and the required fee for opposition are enclosed herewith.

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Respectfully submitted,

Date: November 26, 2002

J. M. Cone

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VICKI MARTIN
(Typed name of person mailing paper)

Vicki Martin
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Vide maQ

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**AKIN GUMP
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Re: *Pueblo International, Inc. v. IFS Financial Corporation*; Opposition No. 91152004
Serial No. 75/899,318 PUEBLO FINANCIAL CORPORATION
Our Ref. No. 072591.0002

TRADEMARK BOARD AND
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Dear Sirs:

Enclosed in duplicate for filing in the above-referenced matter is Opposer's Motion for Leave to File Amended Notice of Opposition and First Amended Notice of Opposition.

Regards,

Vicki Martin
Legal Assistant

Enclosures

cc: David M. Bass

DD