

ESTTA Tracking number: **ESTTA189445**

Filing date: **01/29/2008**

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

Proceeding	91179298
Party	Defendant SYLMARK HOLDINGS LIMITED
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Date	01/29/2008
Attachments	SylmarkOppositiontoMotiontoAmend.pdf ( 4 pages )(381581 bytes ) SylmarkExhibitA.pdf ( 2 pages )(229406 bytes )



consisting of or incorporating descriptive terms relating to a contemplated new product, numerous intent to use applications to register marks which ultimately were not actually used, an excessive number of intent to use applications in relation to the number of products that applicant is likely to introduce under the applied-for marks during the pendency of the applications, or applications unreasonably lacking in specificity in describing the proposed goods. Other circumstances may also indicate the absence of genuine bona-fide intent to actually use the mark.” *Salacuse, supra*, 1997 WL 687373, at \*4, *citing Lane Ltd. v. Jackson Int’l. Trading Co.*, 33 U.S.P.Q. 2d 1351, 1355 (T.T.A.B. 1994), *quoting from* S. Rep. No. 100-515, 100<sup>th</sup> Cong. 2d Sess. At 23-24 (1988).

Here, neither Walgreen’s proposed amended pleading nor its Motion to Amend contain any factual allegations even remotely close to the examples described above. Walgreen instead supports its Motion to Amend by citing to *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha Opposition*, 26 U.S. P.Q. 2d 1503, 1507 (T.T.A.B. 1993). Specifically, Walgreen cites *Commodore* for the proposition that “absence of documentary evidence of an applicant’s intent to use its mark in commerce without adequate explanation is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce.”<sup>1</sup>

Apparently, Walgreen contends that Sylmark had no intent to use the mark because Sylmark has no documentary evidence of its intent to use the mark. However, this allegation is nowhere to be found in the proposed amended pleading. Moreover, the reason Walgreen does not make the specific allegation in its proposed amended opposition is that it *cannot* make such an allegation in its amended pleading.

Specifically, Sylmark has already produced some documentary evidence “supportive of or bearing upon its claimed intent to use its mark in commerce.” In response to Walgreen’s document requests, Sylmark produced to Walgreen a 250 page

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<sup>1</sup> The actual holding from *Commodore* is as follows: “we hold that absent other facts which adequately explain or outweigh failure of an applicant to have *any* documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of *any* documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intent to use its mark in commerce as required by Section 1(b) (*Commodore*, at 1507 (Emphasis added)).

trademark search report for the proposed mark. (The title page of the search report, Bates labeled S00003, is attached hereto as Exhibit A). A trademark search report commissioned by the applicant is some documentary evidence which supports, and bears upon, Sylmark's claimed intent to use the mark.

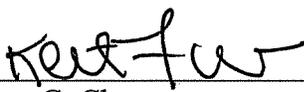
Accordingly, Walgreen's allegation, even if it were contained in the amended pleading, that Sylmark lacked an intent to use the mark because it has failed to produce any documentary evidence of such intent, has already been disproven by Sylmark's production of such documentary evidence.

While leave to amend is usually liberally granted, "[w]here a moving party seeks to add a new claim, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board will normally deny the motion for leave to amend." *Giersch v. Scripps Networks, Inc., Cancellation*, 2007 WL 1653585, \*5 (T.T.A.B, June 6, 2007).

Here, based on the established record in this case, Walgreen has not alleged, and cannot allege, any specific facts that, if proven, would establish that Sylmark did not have an intent to use the proposed mark. Accordingly, Walgreen cannot, as a matter of law, prevail on its proposed new claim that Sylmark lacked intent to use. Therefore, the proposed amended pleading is futile and the Motion to Amend should be denied.

Sylmark Holdings Limited

Dated: January 29, 2008

By:   
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION** has been served on Mark A. Niede by mailing said copy on January 29, 2008, via First Class U.S. Mail, postage prepaid to:

Mark A. Niede, Esq.  
LEYDIG, VOLT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
Chicago, IL 60601

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed on January 29, 2008 at Los Angeles, California



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Dori Dellisanti

**In Re**

**WALGREEN COMPANY**

**v.**

**SYLMARK HOLDINGS, LIMITED**

**OPPOSITION NO. 91179298**

**EXHIBIT A**

**IN SUPPORT OF  
APPLICANT'S OPPOSITION  
TO OPPOSER'S MOTION FOR LEAVE  
TO AMEND NOTICE OF OPPOSITION**

# Trademark Research Report

**Mark Searched:** CALGREENS

**Client Name:** SYLMARK

**Type Of Search:** FULL SEARCH

**Formatted:** By Source

**Attention:** KATHY MOJIBI

**Our File:** 138132711 -56

**Date Completed:** May 8, 2007

**Date Received:** May 4, 2007

**Received by:** Telephone

**Goods/Services:**

NUTRITIONAL SUPPLEMENTS

We have taken all reasonable steps to ensure the completeness and accuracy of this report. However, for various reasons, including the subjective nature of trademark searching and the possibility of incomplete and inaccurate data provided by the United States Patent & Trademark Office and other national trademark offices, the Secretary of States' Offices, and all of the many vendors and publishers of trademark and business information used in compiling search reports, we cannot warrant that this report is complete or error free. AS A RESULT, WE DISCLAIM ALL WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE. This search is valid only for the mark and goods noted above. If the mark or goods that were the subject of this search change, even slightly, a new search should be performed.

Any liability arising out of the preparation of this report is limited to a refund of the search fee paid. Acceptance of this search constitutes an acceptance of the aforesaid terms, conditions and limitations. This report in no way constitutes a legal opinion. The ranking of cited references into groups based on their relative relevance to the mark searched is for the convenience of our clients in reviewing the search report and is not intended to convey an opinion regarding the legal significance of any cited reference.

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WALGREEN v. SYLMARK  
OPP NO. 91179298  
EXH. A TO APP'S OPPOSITION RE MOT  
FOR LEAVE TO AMEND NOT OF OPP.

S00003