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

Proceeding	91179298
Party	Plaintiff Walgreen Co.
Correspondence Address	Mark A. Niede Leydig, Voit & Mayer, Ltd. Two Prudential Plaza Suite 4900 Chicago, IL 60601 UNITED STATES mniede@leydig.com
Submission	Reply in Support of Motion
Filer's Name	Mark A. Niede
Filer's e-mail	mniede@leydig.com
Signature	/Mark A. Niede/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WALGREEN CO.,)
Opposer,)
) Serial No. 77/179411
v.)
) Opposition No. 91179298
SYLMARK HOLDINGS LIMITED,)
Applicant.)

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

Opposer seeks to file an Amended Notice of Opposition to raise a new claim that Applicant has no bona fide intent to use its mark. This new claim is based upon facts—or more appropriately the lack thereof—disclosed in discovery thus far. See Opposer's Motion for Leave to Amend. Applicant Sylmark has responded to Opposer's Motion for Leave to File by asserting several unsupported arguments that have no bearing on Opposer's Motion or the availability of amendment. Rather, Applicant tries to prematurely attack the legal sufficiency of Opposer's proposed Amended Notice of Opposition, contending that the proposed new claim fails "as a matter of law," fails to allege specific facts, and that Opposer cannot *prove* facts to establish its claim. These arguments are entirely unpersuasive.

As a general matter, as Opposer initially argued and as a cornerstone proposition, Applicant readily admits that leave to amend should be liberally granted. See Applicant's Opposition Brief at page 3. Given this admission, the Board should grant Opposer's Motion.

Despite recognizing the liberal availability of the right to amend, Applicant raises arguments based on two theories. First, Applicant argues that the new claim fails as a matter of law and is futile because Opposer has not alleged any specific facts indicating that Applicant has

no bona fide intent to use the CALGREENS mark. This argument fails for two significant reasons. As an initial matter, this argument is an attack on the legal sufficiency of Opposer's new claim. Attacks on the legal sufficiency of a new claim are better suited for a motion to dismiss, summary judgment or trial. They have no bearing on the ability of a party to amend a pleading to assert a new claim. Applicant is trying to challenge Opposer's right to amend its Notice of Opposition by, essentially, arguing summary judgment. *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536 (T.T.A.B. 2007).

Second, Applicant suggests that Opposer has not pled adequate facts to support its new claim. However, it is well settled that under the concept of notice pleading, a party need not plead every singly fact supportive of its claims, but only plead what is sufficient to put the opponent on notice of the nature of the claim it must defend. *Fair Indigo, supra*. In the instant matter, Opposer's Amended Notice of Opposition absolutely contains sufficient notice to Applicant of the nature of Opposer's new claim. Indeed, Applicant's own brief tacitly admits as much; since Applicant identifies and, both erroneously and prematurely, contends that claim must fail as a matter of law. Since the Amended Notice of Opposition clearly put Applicant on notice of the nature of Opposer's new claim, the Amended Notice satisfies the standards of Notice Pleading and, accordingly, the Board should grant Opposer's Motion.

Applicant's arguments an attack on the legal sufficiency of Opposer's new claim. These attacks are inappropriate at this time and better suited for Summary Judgment or a Motion to Dismiss. *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536 (T.T.A.B. 2007). Accordingly, the Board should grant Opposer's Motion for Leave to File and, if Applicant wishes, it can move to dismiss the new claim, or simply develop its case and succeed on the merits. *Id.*

Applicant's second line of argument is factual. On top of challenging the legal sufficiency of the new claim, Applicant goes further and argues that Opposer cannot *prove* its new claim because—despite providing no information regarding planned products, markets, consumers or advertising—Applicant produced a single document (a trademark search report) that somehow in and of itself supports its alleged bona fide intent to use the mark. Applicant insinuates that, based on this one document, *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (T.T.A.B. 1993) does not apply, since the facts of *Commodore* involved an applicant who had absolutely no documentary evidence whatsoever to support a claim of bona fide intent to use its mark. Here, Applicant attempts to distinguish *Commodore* because Applicant has produced one document and, without factual or legal support, contends that one document shows a bona fide intent to use the CALGREENS mark.

Analogous to the instant matter, *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536 (T.T.A.B. 2007), is instructive on this issue. There, Opposer sought to amend its Notice of Opposition to assert a claim that Applicant had no bona fide intent to use its mark. *Id.* at 1538. Applicant responded to the request to amend by submitting evidence of a design patent application allegedly related to the mark and contending that the presence of the design patent application showed a bona fide intent to use the mark and thus rendered Opposer's claim futile. *Id.* at 1539. The Board disagreed, stating that Applicant's evidence and arguments were "...of no import in considering opposer's motion to amend, but are more appropriate on summary judgment or for submission as evidence during its testimony period and for argument in its trial brief." *Id.* at 1539. As a result, the Board granted opposer's request to amend.

Applicant Sylmark's argument is identical to that presented in *Fair Indigo*. As in that case, the import of Applicant's single document is irrelevant to Opposer's Motion to Amend.

Applicant can raise its arguments in summary judgment or in its trial brief. They have no bearing on Opposer's Motion to Amend. Accordingly, the Board should disregard Applicant's argument and grant Opposer's Motion.

Accordingly, Opposer Walgreen Co. respectfully requests the Board grant its Motion for Leave to File an Amended Notice of Opposition in the form attached to that Motion as Exhibit A.

Respectfully submitted,

Date: 2-15-03

By: 

Mark J. Liss
Mark A. Niede
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza - Suite 4900
Chicago, Illinois 60601
Phone: (312) 616-5600
Fax: (312) 616-5600
Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that a copy of the attached Opposer's Motion For Leave To Amend Notice Of Opposition was electronically filed with the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals, "ESTTA," on the date shown below:

Dated: February 15, 2008



CERTIFICATE OF SERVICE

I hereby certify that a copy of the attached Opposer's Motion For Leave To Amend Notice Of Opposition was served on counsel for Applicant via United States Postal Service First Class Mail, postage prepaid, on the date indicated below to the following address:

Bruce G. Chapman
Connolly Bove Lodge & Hutz LLP
Wells Fargo Center
South Tower, Suite 2300
333 South Grand Avenue
Los Angeles, CA 90071

Dated: February 15, 2008


