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

Proceeding	91197754
Party	Defendant Lavatec, Inc.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application No. 76701998
for the mark: LAVATEC
Published on November 2, 2010

_____)	
Wolf-Peter Graeser,)	
)	
Opposer)	
)	Opposition No. 91197754
v.)	
)	
Lavatec, Inc. (fka Laundry Acquisition Inc.))	
)	
Applicant)	
_____)	

APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO AMEND

Applicant Lavatec, Inc. objects to Opposer’s belated Motion to Amend the Notice of Opposition on the grounds that the motion itself is inadequately supported, the discovery period is now closed and amendment would be prejudicial to Applicant, and the amendment would be futile in its assertion of dilution and fraud.

Opposer has had over a year and half from Opposer’s initial attempt to dissuade the examiner from allowing the opposed Application, and now on the eve of his testimony period with discovery closed, Opposer wants to amend the Notice of Opposition to present facts that were known or available to Opposer at the time of filing the Opposition. No allegation of newly discovered evidence from Applicant can be made. Amendment under the circumstances is unwarranted.

OPPOSER’S MOTION IS INADEQUATELY SUPPORTED

Opposer’s Motion on page 1 lists a series of general reasons for requesting amendment of the Notice of Opposition, and attaches to the Motion as Exhibit A a First

Amended Notice of Opposition in two forms, one apparently a clean copy and another with numerous highlights in red. We assume for the sake of discussion that the highlights show the requested amendments to the original Notice.

Opposer then sets out his justifications for the requested amendments at this late stage of the proceedings. But Opposer never explains which amendments are intended to address which reasons given on page 1. Applicant and the Board are left to their own devices to decide which amendments are for which reasons and how the amendments support and satisfy the reasons.

The Motion should be denied on the basis of inadequate support alone. The presentation of one's arguments and authority should be thorough in the motion or the opposition brief, and not in a reply brief. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989).

APPLICANT WILL BE PREJUDICED BY THE UNTIMELY AMENDMENT

Opposer perfunctorily states that Applicant will suffer no prejudice by the amendment at this late date because too little time has passed and the issues were raised earlier in the original notice. However, Opposer has added several new facts for which no discovery has been conducted. Opposer asserts that the ownership of Opposer's company Lavatec Laundry Technology GmbH by which Opposer claims rights to the LAVATEC mark has changed (Par. 13 of Amended Notice), that people associate LAVATEC products with products made in Germany (Par. 29 of Amended Notice), that the Mark became famous in the 1980's and Applicant is foreclosed from relying upon a priority date prior to 2011 (Par. 38).

With discovery now closed Applicant will not be able to determine what the bases for the allegations are and how Opposer will use them to support his cause. Opposer's statement that he would consent to an extension of discovery to May 21, 2012 is inconsequential since briefing on the Motion will close shortly before that date and a decision on the motion will likely be long after that date.

More importantly issues such as people's perception and the fame of the mark are subjects for surveys. The time required to prepare for and conduct surveys is

months, and experts need to be engaged. A delay of such magnitude in the opposition proceeding at this stage when Opposer should have known the elements for proving a dilution claim in 2010 when the opposition was initiated is not tolerable or justifiable. Furthermore, the likelihood of proving fame in the field before Applicant was formed in 1987, only months after Lavatec Germany, Opposer's "predecessor" was similarly formed (see Opposer's First Amended Notice of Opposition, Par. 12), is extremely remote. The time for designation of experts has also closed.

Opposer claims to have acted promptly (Motion, page 3), but Opposer knew what the bases for his Opposition were at the time of filing, and failed to adequately plead. He should not now be allowed to amend just before his testimony period is scheduled to begin. A long and unexplained delay in filing a motion to amend may render the amendment untimely. TBMP §507.02(a). *Media Online, Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008)(motion denied where delayed amendment was based on facts known to petitioner at time of filing).

Opposer also claims to have recently discovered factual amendments (sic) through the discovery process, a reference to searching his own sources, not discovery from Applicant (page 4 of the Motion). The Opposition has been in process for well over a year. Opposer had ample time prior to filing, and since filing, to uncover evidence for his case. The "multiple extended suspensions" he refers to had nothing to do with his inability to uncover facts from sources in his home country.

OPPOSER'S PROPOSED AMENDMENTS ARE FUTILE

As indicated above the likelihood of proving that the mark LAVATEC became famous in the United States by virtue of Opposer's "predecessor", Lavatec Germany formed in October 1986 (see Opposer's First Amended Notice of Opposition, Par. 12), before the original Applicant entered the field only months later in 1987 (see attached Production Doc. LT0009) is extremely remote. Therefore the dilution claim will fail.

Opposer's amended claim for fraud (Par. 16) is still deficient and fails to adequately set out facts which constitute fraud. The elements of fraud must be plead with particularity. F.R.Civ.P 9(b). Nothing stated in the amended Par. 16 indicates that

a listing in the opposed Application of goods not manufactured or sold by Applicant was anything more than a mistake or misunderstanding.

Moreover the Applicant can amend its Application to eliminate selected goods in the description pursuant to 37 CFR §2.133(a) upon motion granted by the Board. See TBMP §3.156. Therefore, the fraud claim will fail.

CONCLUSION

Opposer has waited too long to file his First Amended Notice based on facts that were for the most part known to Opposer or available to Opposer at the time of filing. The Opposition proceedings are at the eve of the testimony periods. Applicant will be prejudiced if not given further opportunity for discovery. To reopen discovery and allow investigation of the issues raised by the added facts would cause significant delay in the proceedings, and for what purpose. Since the dilution and fraud claims are the only identifiable or principal bases for Opposer wanting to amend, and the claims will fail, amending the Notice will be for naught. The Motion For Leave To Amend should accordingly be denied.

Respectfully requested
LAVATEC, INC., Applicant

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CERTIFICATE SERVICE

The undersigned hereby certifies that a copy of the foregoing

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was sent by electronic mail this 25th day of April 2012, to the following counsel of record:

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