

THIS ORDER IS A PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

GCP

Mailed: December 28, 2017

Opposition No. 91204129

Destileria Serralles, Inc.

v.

Kabushiki Kaisha Donq DBA Donq Co., Ltd.

Before Quinn, Lykos and Pologeorgis,
Administrative Trademark Judges.

By the Board:

This proceeding has been fully briefed by the parties and a final disposition on the merits will issue under a separate decision.

In this order, the Board addresses a preliminary matter raised in the parties' final briefs that concerns the number of marks Opposer intends to rely upon in support of its asserted claims in this case, and the scope of Opposer's rights in those marks as pleaded.

As background, Applicant seeks to register the stylized mark ***DONQ*** for a variety of food and beverage items, wholesale and retail store services and providing regional cuisines identified in International Classes 29, 30, 32, 35 and 43. Applicant's involved application is a request for an extension of protection under the Madrid Protocol, based on an international registration, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(a) ("Madrid application"). As grounds for opposition,

Opposer claims likelihood of confusion and dilution with its pleaded registrations for marks consisting of DON Q and DONQ, in whole or in in part, all for rum.

Opposer, in support of its asserted claims of likelihood of confusion and dilution by blurring, has introduced into evidence and argued in its trial brief asserted common law rights in its pleaded DON Q marks used in connection with goods and services other than rum, *inter alia*, rum cakes, chocolates and bar services. In its final brief on the case, Applicant objects to Opposer's attempt "to claim rights to goods or services beyond the 'rum' listed in the registrations cited on the ESTTA cover sheet for this proceeding."¹ 88 TTABVUE 57. Specifically, Applicant contends that insofar as the involved application was filed under Section 66(a), Opposer was obligated to raise and specify all grounds for opposition, including all common law rights it was relying upon, on the ESTTA cover sheet, which was transmitted to the World Intellectual Property Organization ("WIPO"), so as to provide timely notice of the opposition.² In addition, Applicant has objected to any argument that these purported common law rights were tried by consent and has objected to any evidence submitted by Opposer which concerns such common law rights in Opposer's DON Q marks.

In response, Opposer argues that the information required by the Madrid Protocol and sent to the International Bureau ("IB") of WIPO would remain the same if Opposer were allowed to amend its pleading to include its common law rights in its DON Q marks for "rum cakes, chocolates and bar services."³ Specifically, Opposer

¹ ESTTA is the Electronic System for Trademark Trials and Appeals.

² Applicant's Trial Brief, pp. 20-21, 88 TTABVUE 24-25.

³ Opposer's Reply Brief, p. 4; 92 TTABVUE 10.

contends that it does not seek to base the opposition on an entirely new mark or expand the goods or services opposed.⁴ Nor does it seek to add to the opposition an entirely new ground not already at issue.⁵ Instead, Opposer maintains that it seeks to amend its pleading merely to clarify the scope of its rights under the already pleaded DON Q marks to include goods and services associated with rum, yet not specifically covered by the registrations which identify only “rum.”⁶ Opposer further argues that such clarification is not prohibited by the Trademark Act or the Trademark Rules concerning the Madrid Protocol.⁷ Finally, Opposer contends that, in the event the Board does not permit Opposer to amend its notice of opposition to assert its common law rights in its DON Q marks for rum cakes, chocolates and bar services, the Board should still admit and rely upon evidence of Opposer’s common law rights accrued through use of its DON Q marks in connection with these goods and services when analyzing likely confusion under the *du Pont* factors.⁸

The Board construes Applicant’s objection to Opposer’s DON Q common law rights evidence as a motion to strike such evidence and Opposer’s rebuttal response as a motion for leave to amend its pleadings to assert such common law rights. These two construed motions are addressed below.

Madrid applications are treated differently in many key respects from other applications. To fulfill its reporting and other obligations under the Madrid Protocol,

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

⁷ *Id.* at pp. 4-5; 92 TTABVUE 10-11.

⁸ *Id.* at p. 7; 92 TTABVUE 13.

the USPTO has promulgated regulations to accommodate the particular attributes of these applications and of the Madrid system for extending international registrations into member countries. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 55748 (Sept. 26, 2003); *see also In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005), for additional discussion.

In particular, the ESTTA cover sheet performs an integral function in cataloguing and reporting to the IB information on oppositions filed against Madrid applications. As the Board explained in *CSC Holdings, LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011):

In the case of oppositions against § 66(a) applications, the ESTTA electronic form plays an additional, vital role. As discussed below, when an opposition is instituted, the USPTO must so notify the International Bureau (“IB”) of the World Intellectual Property Organization, informing it of certain information required under U.S. law implementing the Madrid Protocol. This notice must be sent within strict time limits, and any USPTO failure to fully and timely notify the IB may result in the opposition being limited by the information sent or dismissed in its entirety. In order to avoid any deficiency in the IB notification and to ensure that it is timely sent, the ESTTA electronic form collects all necessary information and automatically sends the required notice to the IB. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020 n.3 (TTAB 2005). In doing so, the ESTTA system sends only the information provided by the filer on the electronic form - the automated system does not send a copy of the filer’s attached explanatory pleading to the IB. Moreover, the system is fully automated, and Board personnel do not review or edit the information provided on the electronic form in order to ensure that it is complete. As a result, any required information that appears in the attached pleading but was not entered on the ESTTA electronic form will not be included in the USPTO’s notification to the IB.

When a notice of opposition is uploaded for filing against a Section 66(a) application, and after confirming that the application is ripe for opposition, ESTTA allows the opposer to identify the grounds for opposition, as well as the registrations and/or pending applications of which it claims ownership, and on which it relies as a basis for its opposition. ESTTA also permits an opposer to identify common law rights in a mark or marks, and the goods and/or services associated therewith as a basis for its asserted claims, as illustrated below.⁹

STEP #1

Grounds for Opposition

Please check as many grounds for opposition as are applicable. If a particular ground is not listed, check the "Other" box and fill in the ground in the text box provided.

The grounds for opposition are as follows:

<input type="checkbox"/> Priority and likelihood of confusion	Trademark Act Section 2(d)
<input type="checkbox"/> The mark is merely descriptive	Trademark Act Section 2(e)(1)
<input type="checkbox"/> The mark is generic	Trademark Act Sections 1, 2 and 45
<input type="checkbox"/> The mark is deceptively misdescriptive	Trademark Act Section 2(e)(1)
<input type="checkbox"/> The mark is primarily geographically descriptive	Trademark Act Section 2(e)(2)
<input type="checkbox"/> The mark is primarily geographically deceptively misdescriptive	Trademark Act Section 2(e)(3)
<input type="checkbox"/> The mark is primarily merely a surname	Trademark Act Section 2(e)(4)
<input type="checkbox"/> The mark comprises matter that, as a whole, is functional	Trademark Act Section 2(e)(5)
<input type="checkbox"/> No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
<input type="checkbox"/> No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
<input type="checkbox"/> Failure to function as a mark	Trademark Act Sections 1, 2 and 45
<input type="checkbox"/> The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45, and Section 2(f)
<input type="checkbox"/> Dilution by blurring	Trademark Act Sections 2 and 43(c)
<input type="checkbox"/> Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
<input type="checkbox"/> Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
<input type="checkbox"/> False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
<input type="checkbox"/> Deceptiveness	Trademark Act Section 2(a)
<input type="checkbox"/> Immoral or scandalous matter	Trademark Act Section 2(a)
<input type="checkbox"/> Disparaging	Trademark Act Section 2(a)
<input type="checkbox"/> Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods	Trademark Act Section 2(a)
<input type="checkbox"/> Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof	Trademark Act Section 2(b)
<input type="checkbox"/> Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act Section 2(c)
<input type="checkbox"/> Registration barred by claim or issue preclusion	Mayer/Berkshire Corp. v. Berkshire Fashions Inc., 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005)
<input type="checkbox"/> Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

⁹ The first chart displays a checklist of available grounds for opposition. The second chart includes a box where a party may identify marks and the goods and/or services associated therewith it intends to rely upon as a basis for its asserted claim(s) that are not subject to a U.S. Registration or pending application.

STEP #2

Opposer's Pleaded Mark(s)

You have indicated a ground for opposition based on your ownership of a trademark. Enter the trademark or trade name upon which you intend to rely in this proceeding. Enter no more than 49.

If you are alleging prior use of a mark which is the subject of a U.S. registration or application, you may indicate the number and the necessary information will be retrieved from the USPTO database.

Enter the appropriate application Serial or Registration No.

If the asserted mark is not the subject of a U.S. Registration or pending application, enter the mark below. If the mark consists of words or letters only, type the mark in uppercase letters in the space below. If the mark features a design or special characters, attach a JPEG image showing your mark. If the mark is not capable of representation in either words or an image, (i.e., sound marks), enter a concise description of the mark.

☐ Type the mark (or a concise description) below

☐ Upload Mark image

Click Browse button and select a JPEG file with a mark.

No file chosen

List the goods and services concerned below: *

Because the ESTTA filing system permits an opposer opposing an application under Section 66(a) to identify all marks it intends to rely upon at trial as a basis for its asserted claim(s), including unregistered marks used for particular goods or services and in which the opposer believes it has acquired “common law” rights, and since the information provided to the IB is limited to that which the opposer specifically selects or sets forth on the ESTTA cover sheet, *see* Trademark Rule 2.104(c), 37 C.F.R. § 2.104(c), (“Oppositions to applications filed under Section 66(a)

of the Act are limited to the goods, services and grounds set forth in the ESTTA cover sheet.”),¹⁰ the instant Opposer’s failure to identify its common law rights in “the other goods and services” including “rum cakes, chocolates and bar services” on the ESTTA cover sheet precludes Opposer from now relying on such common law rights in the marks as a basis for its asserted claims. Indeed, if an opposer is precluded from amending its pleading to add an additional claimed registration to support a previously asserted likelihood of confusion claim under Section 2(d) of the Trademark Act,¹¹ it would follow that an opposer also could not add common law trademark

¹⁰ Although Trademark Rule 2.104(c) took effect on January 14, 2017, a date subsequent to the close of the parties’ testimony period in this case, it is nonetheless applicable to this pending proceeding since it codifies existing Board practice and case law. *See* Notice of Final Rulemaking, 81 Fed. Reg. 69950, 69954, 69957 (Oct. 7, 2016).

¹¹ With regard to amending a pleading against a Madrid application during the pendency of a Board proceeding, the Board promulgated Trademark Rule 2.107(b), 37 C.F.R. § 2.107(b), which provides as follows (emphasis added):

Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add **grounds for opposition** or goods or services beyond those identified in the notice of opposition, or to add a joint opposer. The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.

In its Notice of Rulemaking, the Board provided the following guidance regarding the application of Trademark Rule 2.107(b):

[P]leadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court; except that, once filed, such opposition may not be amended to add to the goods or services opposed, or to add to the grounds for opposition. Thus, opposer may not add an entirely new ground for opposition or **add an additional claimed registration to a previously stated section 2(d) ground**. An opposer may make amendments to grounds asserted in the notice of opposition, for example, for clarification.

rights not previously identified on the ESTTA cover sheet. By doing so, an opposer would be impermissibly expanding, not clarifying, the scope and/or basis of its Section 2(d) claim.

Accordingly, Applicant's construed motion to strike is granted to the extent that the Board will give no consideration to Opposer's common law rights in its DON Q marks used in association with "the other goods and services" including "rum cakes, chocolates and bar services" as a basis for its asserted claims. Opposer's construed motion for leave to amend its pleading is therefore denied.¹²

A final decision on the merits of this case will issue in due course.

Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 55748, 55757 (Sept. 26, 2003) (emphasis added); *see also Prosper Bus. Dev. Corp. v. Int'l Bus. Machs., Corp.*, 113 USPQ2d 1148, 1151 n.7 (TTAB 2014) (opposition against a Section 66(a) application may not be amended to add an additional claimed registration to a previously asserted likelihood of confusion claim).

¹² Even if Opposer were allowed to amend its pleading to assert its common law rights in its DON Q marks for "other goods and services" including "rum cakes, chocolates and bar services" as a basis for its asserted claims, attempting to do so at trial without providing any justifiable reason for its delay when Opposer was clearly aware of its common law rights at the time it filed its notice of opposition, would constitute an undue delay and would be prejudicial to Applicant. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008) (motion for leave to amend to add claims of descriptiveness and fraud denied; petitioner unduly delayed in adding claims which were based on facts within petitioner's knowledge at time petition to cancel was filed); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) (opposer unduly delayed in filing motion for leave to amend during testimony period).