TTAB

Docket No. 30GL-192270

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

*In re Matter of Application Serial No. 85/587,640 for the trademark **HINT** in Class 18* Hint, Incorporated, Opposer, v. Sunrise Apparel Group, LLC, Applicant.	Opposition No. 91-212519 **REPLY TO OPPOSITION TO MOTION TO AMEND APPLICATION AND ANSWER TO NOTICE OF OPPOSITION**

Commissioner of Trademarks
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Applicant Sunrise Apparel Group, LLC ("Applicant") submits this reply brief in support of its Motion to Amend Application and Answer to Notice of Opposition, to address certain statements presented by Opposer Hint, Incorporated's ("Opposer") opposition to the motion to amend and to further revise the proposed amendment of Applicant's identification of goods.

I. THE MOTION TO AMEND SHOULD BE GRANTED

A. The Proposed Amendment is Not Vague

The proposed amendment of Applicant's identification of goods is not vague and ambiguous. Applicant further proposes amendment of its identification of goods to the following, as indicated in bold underline:

> Hair accessories, namely, hair ties, hair scrunchies, hair combs, decorative bobby pins, hair barrettes, hair clips, ornaments for the hair, ponytail holders, and hair ribbon, **<u>sold only through one</u>**

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national retail store owned by Vanity Shop of Grand Forks, Inc. or its assigns, which has brick and mortar stores and an ecommerce website,

Applicant notes that TMEP §1402.09 generally requires the use of generic wording in an identification of goods or services rather than use of a trademark that is registered to an entity other than the applicant. TMEP §1402.09; *Camloc Fastener Corp. v. Grant*, 119 USPQ 264, 265 n.1 (TTAB 1958). Applicant's proposed identification, however, is not the situation in which Applicant is proposing use of a registered trademark as a noun, such as iPods™ instead of "portable music players", HDMI™ instead of video audio cables or YO-YO's™ instead of "spinning toys". In those situations, certainly, use of generic wording is necessary in order for the public to know what the particular good or service is. In contrast, Applicant's reference to the national retail store Vanity, Inc. is not as a replacement for a good or service, but merely clarifies the channel of trade through which they are sold. Applicant's proposed amendment should therefore be accepted because it is not vague or ambiguous.

B. The Proposed Amendment Would Alleviate Any Alleged Likelihood of Confusion

Opposer asserts that Applicant's proposed amendment would not alleviate any alleged likelihood of confusion because Opposer's own identifications in its registrations do not contain any restrictions on the channels of trade. That is not the end of the inquiry, however. Opposer's and Applicant's channels of trade contain hardly any overlap, such that any likelihood of confusion is alleviated. *Coach Services, Inc. v. Triumph Learning, LLC*, 668 F.3d 1356 (Fed. Cir. 2012). In *Coach*, the applicant applied to register a variety of COACH marks for the following goods and services, directed to teachers and students:

> Computer software for use in child and adult education, namely, software to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams; prerecorded audio and video tapes in the field of child and adult education, featuring materials to assist

> teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 9; and
>
> Printed materials in the field of child and adult education, namely, textbooks, workbooks, teacher guides and manuals, posters and flashcards, all featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 16.

Coach Services, 668 F.3d at 1360-61. The opposer asserted a variety of COACH marks for luxury products, including "handbags, luggage, clothing, watches, eye glasses, and wallets." *Id.* at 1361. The opposer's registrations did not contain any restrictions on the channels of trade. The Court of Appeals for the Federal Circuit affirmed the Board's finding that the channels of trade were distinct. The Board found that the opposer sold its products through its 400 retail stores and through third-party retailers and advertised in newspapers, fashion magazines, and catalogs that target female consumers between the ages of 25-65 in all income brackets. *Id.* at 1370. The Board further found that the applicant targeted educational professionals and marketed its products through catalogs, direct mail, and personal sales representatives. *Id.* Despite the fact that the opposer's registrations contained no restrictions on the channels of the trade, the Federal Circuit still concluded, "[un]der these circumstances, the Board did not err in concluding that the goods are not related and the channels of trade are distinct." *Id.* at 1371.

Similarly, it is irrelevant whether Opposer's registrations contain any kind of restriction. Opposer does not own any registrations for the standalone mark HINT in Class 26. The only registration Opposer owns that is not for water products is in Class 25, U.S. Reg. No. 4,357,028 for the mark HINT DRINK WATER NOT SUGAR. Opposer's other registrations demonstrate that Opposer is primarily in the beverage industry, which is not Applicant's industry. Applicant's authorized retailer Vanity Shop of Grand Forks, Inc. does not, to the best of

Applicant's knowledge, sell any beverages. Applicant's and Opposer's targeted customers are distinct and the channels of trade are distinct, alleviating any alleged likelihood of confusion.

C. Applicant Consents to Judgment on the Original Description

Finally, Applicant refutes Opposer's contention that Applicant does not unconditionally accept entry of judgment on Applicant's original identification of goods.

Section 514.01 of the TBMP states, "However, if the proposed amendment limits the identification of goods or services and the applicant consents to the entry of judgment on the question of, for example, a likelihood of confusion with the goods or services to be deleted, it may be approved, even where an opposer objects." TBMP §514.01. The TBMP cites *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ.2d 1433 (TTAB 2007). In *Drive Trademark Holdings*, the Board denied the applicant's motion to amend because "applicant [did] not consent[] to entry of judgment with respect to opposer's claim of likelihood of confusion between opposer's marks and applicant's mark as to the broader recitation of services." *Id.* at 1435-36.

Drive Trademark Holdings is a 2007 case. In a case from this year, *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ.2d 1825 (TTAB 2013), the Board allowed a motion to amend, even though the applicant did not expressly consent to judgment on the original broad description:

> In its answer, applicant does not assert the Section 18 affirmative defense or otherwise raise the issue of a restriction to its descriptions of goods and services. Nevertheless, we find applicant's alternative request to restrict its descriptions of goods and services timely inasmuch as its motion was filed before the close of discovery. Moreover, the issue of the proposed restriction was clearly tried by the parties and argued in their respective trial briefs. Accordingly, we deem the answer in this proceeding to be amended to include the Section 18 affirmative defense. Fed. R. Civ. P. 15(b). We further note that the Section 18 affirmative defense is raised in the alternative; **applicant did not explicitly consent to judgment being entered against it with respect to the**

> **original, broader descriptions of goods and services.** In its trial brief, applicant focuses the bulk of its arguments against finding a likelihood of confusion based on the restricted, narrower scope of applicant's goods and services.
>
> Nevertheless, applicant also suggests the amendments may not be "necessary" and requests that the Board offer applicant the option to reconsider entry of the amendments " in the event that the Board determines that applicant is entitled to registration of its mark even without the proposed amendments." Brief, p. 31. With the above in mind, **we address applicant's Section 18 affirmative defense in this decision, as requested, in the alternative. That is, we have considered the original, unamended descriptions of goods in our likelihood of confusion analysis, and upon finding a likelihood of confusion therewith, we have also considered whether applicant has established its Section 18 affirmative defense, i.e., whether the proposed restrictions negate the likelihood of confusion.**

Embarcadero Technologies, 105 USPQ.2d at 1828-29 (emphasis added.) The Board went on to find that "Applicant has established its Section 18 defense" and there was no likelihood of confusion based on the amended (restricted) identification of goods and services. *Id.* at 1840.

Applicant respectfully submits that under the recent Board decision, it is vague as to whether Applicant must expressly consent to an entry of judgment on the broad description. In any event, Applicant hereby expressly consents to an entry of judgment on the original description.

Applicant respectfully submits that the Board has the discretion under Section 18 of the Trademark Act to consider both the amended and unamended descriptions of goods.

II. CONCLUSION

For the reasons stated above and in Applicant's motion to amend, Applicant respectfully requests that the Board enter an order granting Applicant leave to amend its

application to amend the identification of goods and for Applicant leave to file its proposed amended Answer. Applicant further requests that the Board deem that Applicant's Amended Answer filed and served.

Respectfully submitted,

Dated: December 30, 2013

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Attn: Trademark Trial and Appeals Board P.O. Box 1451, Alexandria, VA 22313-1451, on this 30th day of December, 2013.

LaTrina A. Martin

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **REPLY TO OPPOSITION TO MOTION TO AMEND APPLICATION AND ANSWER TO NOTICE OF OPPOSITION** is being deposited as first class mail, postage prepaid, in an envelope addressed to:

Lori S. Kozak
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on this 30th day of December, 2013.

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