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

Proceeding	91212680
Party	Plaintiff Frito-Lay North America, Inc.
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Attachments	Opposer's Response to Applicant's Motion to Amend Applications (FRIT030).pdf(18973 bytes)

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

In the Matter of Trademark Application
Serial No. 79111074 for CORN THINS and
Serial No. 85820051 for RICE THINS

FRITO-LAY NORTH AMERICA, INC.,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212680 (Parent)
	§	Opposition No. 91213587
REAL FOODS PTY LTD,	§	
	§	
Applicant.	§	

OPPOSER’S RESPONSE TO APPLICANT’S MOTION TO AMEND APPLICATIONS

Applicant has moved for the entry of amendments to the goods and services identifications in the two applications in this proceeding. However, Applicant has not shown that its motion can be granted before trial, and due to the nature of the issues presented in these oppositions and the kind of amendments proffered, the motion is also not appropriate for consideration at final hearing. The Board should deny the motion to amend without deferring the motion to trial.

Standards governing *inter partes* motions to amend

The Board considers a contested motion to amend made during a pending *inter partes* proceeding as part of the Board’s authority, pursuant to Section 18 of the Lanham Act, to “restrict the goods or services identified in an application or registration.” *Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (citing 15 U.S.C. § 1068). Presuming that an amendment is raised in a timely manner to put the plaintiff on notice, *see id.*, the Board examines the following circumstances when deciding whether a proposed amendment is acceptable. First, the amendment “must serve to limit the broader identification of goods or

services.” *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1078 (TTAB 2013) (citing *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 (TTAB 2007)); accord 37 C.F.R. § 2.71(a). Second, the Board considers whether the applicant has consented to allow judgment against it on the broader identification of goods in the application as published. *Id.* Consent to judgment on the broader goods is required to allow for entry of the amendment immediately; otherwise, the Board defers the proposed amendment to final hearing provided that the other considerations have been met. *See Drive Trademark Holdings*, 83 USPQ2d at 1436.

Third, the Board considers whether the applicant has made “a *prima facie* showing that the proposed amendment serves to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial.” *Johnson & Johnson*, 109 USPQ2d at 1078. This consideration serves two purposes. First, should the applicant have consented to judgment on the broader goods, this consideration prevents the entry of judgment on the broader goods inadvertently causing the narrower goods to be barred due to *res judicata*. *Drive Trademark Holdings*, 83 USPQ2d at 1435. Second, the consideration serves to ensure that the amendment has the capability of defending against the grounds for opposition, thus allowing the application to go forward to registration. *See Embarcadero Techs.*, 105 USPQ2d at 1828 (noting that an applicant must provide an explanation or allegation of how the proposed amendment functions to mitigate the grounds for opposition); 2 Jeffrey A. Handelman, *Guide to TTAB Practice* § 15.03[D] (noting that amendments must be material such that the grounds for opposition or cancellation, such as likelihood of confusion, are avoided). An amendment that could not defend against the grounds for opposition is not favored. *See, e.g., Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783,

1788 (Fed. Cir. 1990) (criticizing as “pointless maneuvering” a goods and services amendment that plainly did not affect the opposition).

Finally, when necessary to support the basis of the application, “any specimens of record must support the goods or services remaining after the amendment is entered, and the applicant must introduce evidence during its testimony period to prove use of its mark on those remaining goods or services prior to the relevant date as determined by the basis of the application.” *Drive Trademark Holdings*, 83 USPQ2d at 1435.

The Board will grant the motion before trial only if all of the enumerated circumstances are present. *See Johnson & Johnson*, 109 USPQ2d at 1080 (granting motion after noting all circumstances present); *Drive Trademark Holdings*, 83 USPQ2d at 1436 (refusing to grant motion due to lack of consent to judgment as to broader goods, due to unsupported specimens, and due to lack of prima facie showing of substantially different issue). In addition, the lack of some circumstances will cause the Board not to defer the motion to trial either and instead outright deny the motion. *See Drive Trademark Holdings*, 83 USPQ2d at 1435-36.

The motion to amend cannot be granted pre-trial

Applicant’s motion is deficient on at least two of the four factors. First, Applicant has not consented to judgment against it on the broader good and services descriptions. Without consent to judgment, the best that could be done with respect to Applicant’s motion (provided that all other circumstances are present) would be to defer it to trial on the merits. Second, Applicant has not advanced any argument that adding “namely, popped corn cakes” to the goods and services description for CORN THINS and adding “namely, rice cakes” to the goods and services

description for RICE THINS changes the issues in the case in any way.¹ Lacking such a prima facie showing, the amendment cannot be entered at this stage.

The motion cannot be deferred to trial

However, a trial on the merits for these amendments would be needless as they are not material amendments. The Board should not defer the amendments to trial but should instead deny the motion outright.

The amendments proffered by Applicant both take the form “namely,” followed by either “popped corn cakes” or “rice cakes.” The word “namely” has one of two meanings in this context. One possible meaning is “specifically.” *Webster’s II New College Dictionary* 726 (1995). In other words, it could mean that Applicant is narrowing its goods and services description from listing broader genera of goods “crispbread slices primarily made from” corn/rice to narrower subgenera “popped corn cakes”/“rice cakes.” The other meaning is “[t]hat is to say.” *Id.* In other words, it could mean that Applicant is providing “popped corn cakes” and “rice cakes” as perhaps clearer understood synonyms of the genera “crispbread slices primarily made from” corn/rice.

Given that Applicant’s amendments constitute either synonyms of the applied-for class of goods or sub-classes of the applied-for goods, the amendments are not material. The grounds for opposition in this proceeding are (1) that Applicant’s marks are generic for the applied-for goods, (2) that Applicant’s marks are so highly descriptive of the applied-for goods (pursuant to *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999)) that they are not capable of acquiring distinctiveness, and (3) that Applicant’s marks are merely descriptive of the applied-for goods and have not acquired distinctiveness. Each of those grounds for opposition

¹ As explained below, such a showing could not have been made due to the nature of the proposed amendments and the grounds of opposition.

depends on the nature of the goods or services sought in the application. *See Magic Wand Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (noting that a proper genericness inquiry focuses on the description of goods and services); *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (noting that descriptiveness is considered in relation to the goods and services for which registration is sought). If the amendments merely designate synonyms of the already present goods descriptions, then the goods description has simply been renamed without being changed. Thus, a substantially different issue has not been presented for trial. In the alternative, if the amendments specify subgenera, the amendments are still not material because subgenera are necessarily members of the broader genus of goods. *See, e.g., In re Int'l Bus. Machs. Corp.*, 81 USPQ2d 1677, 1684 (TTAB 2006) (refusing registration as the mark ESERVER identified a subgenus of the applied-for goods); *In re Bongrain Int'l (Am.) Corp.*, 17 USPQ2d 1490, 1491-92 (TTAB 1990) (refusing registration because the mark BABY BRIE served to identify a subgenus of the applied-for goods). Thus, if here the applied for marks are generic for the broader goods, then they are also generic for the goods as narrowed here, meaning that the subgenera proffered do not present a substantially different issue for trial.

Given that the amendments do not present new issues for trial on the claims in this opposition, the amendments cannot be deferred to trial. They must instead be denied.

Conclusion

The motion to amend the applications can neither be granted now nor deferred to trial. Accordingly, the Board should deny the motion outright.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO AMEND APPLICATIONS has been served via First Class Mail, postage prepaid, at the address below on September 22, 2014:

Bruce S. Londa
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/Paul Madrid/
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