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

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85/836,544
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

OPPOSER INTS IT IS NOT THE SAME, GMBH'S RESPONSE TO APPLICANT DISIDUAL CLOTHING, LLC'S MOTION FOR LEAVE TO AMEND ITS APPLICATION

Pursuant to T.B.M.P. § 514.03, Disidual Clothing, LLC ("Applicant") has moved to amend its application to delete "belts, gloves, dresses, and knit face masks" in Class 25 from the identification of goods of its trademark application. INTS It Is Not The Same, GmbH ("Opposer") respectfully requests that the Board deny the Applicant's motion, because Applicant's proposed amendment would unfairly limit the relief that Opposer is entitled to seek in this proceeding.

BACKGROUND

On May 31, 2016, the Board granted Opposer's Motion for Leave to Amend its Notice of Opposition in order to add the following three additional claims, including (1) that Applicant's mark is void *ab initio* for failure to use the mark at the time its use-based application was filed, (2) that Applicant abandoned its mark though nonuse, and (3) that Applicant committed fraud on the USPTO by failing to use its "DISIDUAL" mark in commerce on all of the goods identified in the use-based application.

ARGUMENT

The amendment of any application which is the subject of an *inter partes* proceeding before the Board is governed by Trademark Rule 2.133. Thus, an application which is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party and the approval of the Board, or except upon motion granted by the Board. The Board generally will defer determination of an unconsented motion to amend the identification of goods in a subject application until final decision, or until the case is decided upon motion for summary judgment. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007). Under certain circumstances the Board may accept a proposed amendment immediately, notwithstanding an opposer's objection. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 963 (TTAB 1986).

In determining whether to accept a proposed amendment to an identification that, while contested or unconsented, is otherwise acceptable, the Board looks to see whether the following circumstances are present:

1. The proposed amendment must serve to limit the broader identification of goods or services;

2. The applicant must consent to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;

3. If the applicant wishes to avoid the possibility of a *res judicata* effect by the entry of judgment on the original identification, the applicant must make 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; and

4. Where required to support the basis of the subject application, any specimens of record must support the goods or services as amended; and applicant must then introduce evidence during its testimony period to prove use of its mark with the remaining goods or services prior to the relevant date as determined by the application's filing basis.

Johnson & Johnson v. Stryker Corp., 109 USPQ2d 1077, 1078 (TTAB 2013).

The Applicant postulates that the deletion of "belts, gloves, dresses, and knit face masks" from its identification of goods "is the same relief that Opposer could have obtained if it prevailed on its new claims." *See* [Applicant's Motion for Leave to Amends its Application, pg. 3]. Applicant's contention is unequivocally false. The Applicant may be correct that consenting to judgment on Opposer's first two newly added claims would result in the same relief that Opposer could obtain if it prevailed on those two claims at trial. More specifically, if Opposer prevailed on its claim that Applicant's mark is void *ab initio* and/or its claim of abandonment, then the implicated goods would be deleted from the application.

However, Applicant fails to acknowledge that Opposer's third claim of fraud can result in voiding Applicant's entire application. It is well-settled law that "fraud cannot be cured merely by deleting from the registration those goods or services on which the mark was not used at the time of the signing of a use-based application or a Section 8 affidavit. *G&W Laboratories, Inc. v. G W Pharma Limited*, 89 USPQ2d 1571 (TTAB 2009) [precedential] ((citing *Turbo Sportswear v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1155 (TTAB 2005)) (also citing *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1208 (TTAB 2003) (espousing that deleting "the goods upon which the mark has not yet been used does not remedy an alleged fraud upon the Office. If fraud can be shown in the procurement of a registration, the entire resulting registration is void."))). The Applicant's fraud occurred at the time it filed its use-based application, because Applicant knew at that time that its mark was not being used in connection with all of the goods identified in the application. Applicant's attempt to now delete "belts, gloves, dresses, and knit face masks" from its application does not eliminate the fraud that already occurred, and Applicant's trademark application should be denied accordingly.

CONCLUSION

Applicant's Motion for Leave to Amend its Application should be denied. Applicant seeks to amend the Identification of Goods for its trademark application in order to prevent Opposer from seeking to cancel Applicant's mark on the basis of fraud. If Applicant's motion was granted, it would unfairly limit the relief that Opposer is entitled to seek in this opposition.

Respectfully submitted,

July 20, 2016
Date

/1433-55/

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CERTIFICATE OF SERVICE

This is to certify that on July 20, 2016, a true and correct copy of the foregoing document is being sent by regular mail to the following attorney of record for the Applicant

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