

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

Mailed: August 5, 2016

Opposition No. 91212768

INTS It Is Not The Same, GmbH

v.

Disidual Clothing, LLC

George C. Pologeorgis,
Administrative Trademark Judge:

This proceeding now comes before the Board for consideration of Applicant's motion (filed June 30, 2016) to amend the identification of goods of its involved application Serial No. 85836544 for the mark DISIDUAL. Opposer filed its opposition to the motion to amend on July 20, 2016.

As background, on March 1, 2016, Opposer filed a motion for leave to amend its pleading to add three additional grounds for opposition, namely, (1) nonuse of certain goods as of the filing date of Applicant's use-based application, (2) abandonment of Applicant's mark as to certain goods, and (3) fraud based on nonuse of certain goods as of the filing date of Applicant's application.¹ By order dated May 31, 2016, the Board granted Opposer's motion but allowed Opposer until June 15, 2016 in which to file and serve a revised amended pleading which properly

¹ Opposer's originally-filed notice of opposition only asserted a claim of likelihood of confusion.

states a claim of abandonment.² By the same order, the Board allowed Applicant until 15 days from the date indicated on Opposer's revised amended pleading in which to file and serve its answer or otherwise respond to the revised amended pleading.

On June 15, 2016, Opposer filed its revised amended pleading. The revised amended notice of opposition sets forth four grounds for opposition, namely, (1) likelihood of confusion, (2) nonuse of certain goods as of the filing date of Applicant's use-based application, (3) abandonment of Applicant's mark as to certain goods identified in Applicant's application, and (4) fraud based on Applicant's nonuse of certain goods as of the filing date of Applicant's use-based application.

In lieu of filing an answer to Opposer's revised amended pleading, Applicant filed a motion to amend its involved application.

Applicant's Motion to Amend Application

The Board now turns to Applicant's motion to amend. By way of its motion, Applicant seeks to amend the identification of goods in its involved application by deleting the following goods from the identification: belts, gloves, dresses and knit face masks.

While the Board will generally defer determination of a timely filed (i.e., pre-trial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment, in practice, an acceptable amendment to the identification of goods or recitation of services often may be permitted, even

² The Board also provided clarification on how to plead properly a claim of nonuse as to some but not all the goods as of the filing date of a use-based application and the resultant judgment if such a claim is proven.

where an opposer objects, if the proposed amendment serves to limit the identification of goods or recitation of services and if the applicant consents to the entry of judgment as to all claims asserted by an opposer with respect to the broader identification of goods or recitation of services. *See, e.g., Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433 (TTAB 2007); *see also International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods). If the applicant wishes to avoid the possibility of a res judicata effect of the entry of judgment, an applicant seeking to amend its identification of goods or recitation of services must set forth adequate reasons for the amendment. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); and *International Harvester Company v. International Telephone and Telegraph Corporation*, *supra*. That is, an applicant must make a prima facie showing that the proposed amendment serves to change the nature and character of the goods and services or to restrict their channels of trade and customers in such a manner that a substantially different issue for trial has been introduced from the issue presented by the opposition against the application based on the original identification of goods and services. *Drive Trademark Holdings LLC*, 83 USPQ2d at 1435.

As noted above, Applicant seeks to amend its application by deleting “belts, gloves, dresses and knit face masks” from the identification of goods of its involved

application. While the Board acknowledges that Opposer's claims of nonuse and abandonment are based solely on the goods Applicant seeks to delete and that the deletion of such goods may cure these two claims, the Board notes that Opposer has also asserted claims of likelihood of confusion and fraud. Applicant, however, does not affirmatively state that Applicant will accept judgment on Opposer's likelihood of confusion and fraud claims as to the goods originally identified by Applicant. Moreover, Applicant fails to provide a prima facie showing that the amendment would substantially alter the issues with regard to Opposer's likelihood of confusion claim, as well as Opposer's fraud claim.³

In view thereof, consideration of Applicant's June 30, 2016, motion to amend its application is **DEFERRED** until final decision.

The Board has reviewed Opposer's revised amended notice of opposition filed on June 15, 2016 and finds that Opposer's claim of nonuse is deficiently pleaded. As the Board explained in its May 31, 2016, order, a claim of nonuse as to some but not all the goods in a use-based application as of the filing date of a use-based application, if proven, would *not* render the entire use-based application void *ab initio*. 39 TTABVUE p. 4. Instead, the only result would be that judgment would be entered against Applicant solely in connection with the goods that Applicant failed to use its mark in connection therewith at the time it filed its use-based application.

Id.; see *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696 (TTAB

³ Fraud based on nonuse of certain goods identified in a use-based application may not be cured by deleting such goods from the use-based application. See *G&W Laboratories, Inc. V. G W Pharma Limited*, 89 USPQ2d 1571 (TTAB 2009).

2006). Despite providing this guidance, Opposer's revised amended notice of opposition improperly alleges that because Applicant did not use its mark on "belts, gloves, dresses and knit face masks" as of the filing date of Applicant's use-based application, the opposition should be sustained and Applicant's application to register the DESIDUAL mark should be refused because the mark is void *ab initio* for failure to use the mark at the time the use-based application was filed.⁴ See ¶ 17 of Opposer's revised amended notice of opposition.

Although the Board is reluctant to allow Opposer to revise its pleading once again particularly since the Board provided Opposer clear guidance on how to plead properly its claim of nonuse as to some but not all of the goods identified in Applicant's use-based application, Opposer is nonetheless allowed until **August 15, 2016** in which to file and serve a further revised pleading which sets forth a proper claim of nonuse as to some but not all the goods identified in Applicant's use-based application, pursuant to the guidelines set forth herein as well as the Board's July 31, 2016, order, failing which Opposer's claim of nonuse will be dismissed and stricken from its revised amended pleading filed on June 15, 2016.

In turn, Applicant is allowed until **fifteen (15) days** from the date indicated on the certificate of service of Opposer's further revised notice of opposition in which to file and serve its answer to this further revised pleading.

⁴ The Board notes that an application may be deemed void *ab initio*, not a mark subject to an application. The Board further notes that rather than alleging that judgment should be entered against Applicant solely in regard to the goods that form the basis of its nonuse claim, Opposer instead improperly requests that Applicant's entire application be refused registration.

If Opposer fails to file and serve a further revised pleading permitted by this order by the August 15, 2016, deadline, set forth herein, Applicant is allowed until **August 30, 2016** in which to file and serve an answer to Opposer's revised amended pleading filed on June 15, 2016, as restricted by this order.

Remaining trial dates are reset as follows:

30-day testimony period for plaintiff's testimony to close	October 2, 2016
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	October 17, 2016
30-day testimony period for defendant and plaintiff in the counterclaim to close	December 1, 2016
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	December 16, 2016
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	January 30, 2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	February 14, 2017
15-day rebuttal period for plaintiff in the counterclaim to close	March 16, 2017
Brief for plaintiff due	May 15, 2017
Brief for defendant and plaintiff in the counterclaim due	June 14, 2017
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	July 14, 2017
Reply brief, if any, for plaintiff in the counterclaim due	July 29, 2017

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

As a final matter, the parties are reminded that they are ***precluded*** from filing any further motions for summary judgment in this matter. *See* 33 TTABVUE.