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

Proceeding	91213597
Party	Defendant Tigercat International Inc.
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Attachments	APPLICANT'S MEMO IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION (M1346812).pdf(824743 bytes )



were, the facts that are not subject to dispute and the governing law render the premise immaterial and the proposed amendment futile.

Opposer asks the Board for leave to amend its Notice of Opposition so that it may seek to have Tigercat's identification of goods restricted to: "Off road industrial vehicles, namely, skidders and purpose-built prime movers, carrying aerial devices, mulchers and sprayers, all of the foregoing *used exclusively* in the forestry and vegetation management fields," [emphasis added]. (See Opposer's Mot. for Leave to File Am. Notice of Opp., p. 3).

This specific restriction, that the goods are "used exclusively in the forestry and vegetation management fields" proposed by Opposer could be appropriate only if the restriction would preclude a likelihood of confusion, and only if Opposer could demonstrate that the proposed restriction would establish a clear-cut and commercially significant distinction between the goods of the parties and/or trade channels of the parties. *The Bd. of Regents, Univ. of Texas System v. Southern Illinois*, 110 U.S.P.Q.2d 1182, 1197 (TTAB 2014). Opposer can do neither and has improperly delayed filing its motion.

"Under Fed. R. Civ. P. 15(a), a leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, 1286 (TTAB 2008).

**A. Opposer's Proposed Amendment is Futile and Legally Insufficient.**

One factor in determining whether an amendment should be allowed is the sufficiency of the proposed amendment. Where the moving party seeks to add a new claim or defense, and the

proposed pleading thereof is legally insufficient, the Board will generally deny the motion for leave to amend. *Trek Bicycle Corp. v. Style Trek, Ltd.*, 64 U.S.P.Q.2d 1540, 1541 (TTAB 2001). Opposer's proposed amendment is futile, as it is based on misstatements of fact and misapplication of the law.

Opposer seeks to amend its Notice to add a restriction to Applicant's goods pursuant to Section 18 of the Lanham Act which allows for the limitation of goods and services in an opposition proceeding. 15 U.S.C § 1068. A party attempting to avoid a finding of likelihood of confusion by restricting the goods in the adverse party's registration or application must plead and *prove* that "(1) the adverse party is not using its mark on the goods or services sought to be excluded by the proposed restriction, and (2) a finding of likelihood of confusion will be avoided by entry of the restriction of goods or services - that is, the restriction must be 'commercially significant.'" [emphasis added]. *The Bd. of Regents, U. of Texas System v. Southern Illinois*, 110 U.S.P.Q.2d 1182, 1197 (TTAB 2014). See also *Eurostar Inc. v. Euro-star Reitmoden GmbH & Co., KG*, 34 U.S.P.Q.2d 1266, 1270 (TTAB, 1995): "A restriction is 'commercially significant' if its entry would avoid a finding of likelihood of confusion or if the registrant has set forth its goods in terms that overstate the range of goods or the trade channels in which those goods move, so that fairness demands that an appropriate restriction to the registration be entered."

**1. Opposer Has Misstated The Material Facts With Respect to Tigercat's Goods and Proposed Channel of Trade Restriction.**

The facts preclude Opposer's proposed restriction both because it cannot establish Tigercat's non-use of its mark on goods used outside the forestry field and because it cannot establish that the proposed restriction would be commercially significant. The facts, which Opposer either misstates or entirely and improperly ignores, include:

1. Opposer has pleaded U.S. Reg. No. 4,139,027 in its Notice of Opposition and relies on this registration which includes equipment for use in the forestry. (See Notice of Opposition Paragraph 14 directed to Opposer's U.S. Reg. No. 4,139,027, directed to goods which include: *pumps for machines for use in..., forestry, machines and machine tools for use in forestry*) (emphasis added).

2. Opposer promotes that its goods can be used in different industries based on the required use. On its website, Opposer lists numerous goods for use in forestry as well as other industries such as construction. For example, "small dozers", "medium dozers", "large dozers", "medium excavators", "large excavators" and "wheel loaders" are both listed on Opposer's forestry industry page ([http://www.cat.com/en\\_US/products/new/by-industry/forestry.html](http://www.cat.com/en_US/products/new/by-industry/forestry.html)) as well as its construction industry page ([http://www.cat.com/en\\_US/products/new/by-industry/construction.html](http://www.cat.com/en_US/products/new/by-industry/construction.html)). (See Declaration of John Metzger Ex. A, hereafter Metzger Dec. Ex. \_\_). Further, in a video uploaded by Opposer located at <https://www.youtube.com/watch?v=PwRG2zM5w1Q>, representatives of Opposer talk about how its machine (the 586C) can be used "all over the place." The description of the video reads: "The new Cat® 586C Site Prep Tractor is a multi-purpose, heavy-duty machine with the muscle to run power-hungry mulchers and brushcutters. Applications include residential/commercial development, land management, right-of-way construction and maintenance, wetlands and wildlife habitat management, plantation reclamation and management, and clearing for flood control and firebreaks." (Metzger Dec. Ex. B).

3. Opposer directly advertises and promotes its goods to customers who operate in the forestry field. (Metzger Dec. Exs. A, C and L).

4. Tigercat and Caterpillar have each for many years offered for sale equipment used in the forestry field. (Metzger Dec. Exs. C and D).

5. Opposer's contention that all of the products referenced on Tigercat's website and in the "1,100 pages of production material" offered by Tigercat shows products that "appear to be related to the forestry industry" (Opposer's Mot. for Leave to File Am. Notice p. 3) is simply inaccurate. By way of example:

a. Tigercat produced to Opposer "The Tigercat Story" (Metzger Dec. Ex. E.) which reads: "Tigercat has extended its product applications to other industries. Knuckleboom loaders have found application in scrap yards and rock quarries. The M726D and M760 mulchers are used in the construction, utility and public work sectors."

b. Tigercat published on its website an article dated August 12, 2010 entitled, "Tigercat Adds Off-Road Industrial Product: S610C". (Metzger Dec. Ex. F) The first sentence reads "Tigercat recently opened a new division that specializes in the engineering and development of specialty machines for off road industrial applications. Tigercat produced its website including a page entitled "Off Road Industrial Equipment" which stated: " Tigercat's off-road industrial engineering division seeks to develop machines required for highly specialized off-road industrial applications. Tigercat off-road industrial products currently focus on two key areas, vegetation management equipment and off-road carriers. Industries served include the utilities sector and oil and gas producers and exploration companies." (Metzger Dec. Ex. G).

c. Tigercat produced advertising for the Tigercat M726E, which stated: "The Tigercat M726E is an asset in pipeline clearing and maintenance applications. . . . In ROW [right of way] maintenance, Tigercat's WIDERANGE™ permits quicker travel speeds. . . ." (Metzger Dec.

Ex. H). In July 2011, Tigercat also uploaded to YOUTUBE videos showing the Tigercat M726E Mulcher used in non-forestry application. (Metzger Dec. Ex. I).

6. Opposer's statement that Applicant admitted that it does not "sell goods under the TIGERCAT mark in the 'landscaping industry,' 'mining industry,' or 'agriculture industry.'" (Opposer's Mot. for Leave to File Am. Notice p. 3) is misleading at best. Tigercat, (and other manufacturers) do not sell only to specific industries. It sells to dealers, who in turn, sell to end users. (See Declaration of Paul Iarocci ¶8 and Ex. B thereto, hereafter "Iarocci Dec. ¶ \_\_\_").

7. Specific industry designations that suggest a limitation on use of equipment to specific industries, such as "used exclusively in the forestry and vegetation and [sic] management fields" are not commercially meaningful based on the way off road industrial equipment is manufactured and distributed and used. End-users use the equipment to meet their particular needs for a project. . . . (Iarocci Dec. ¶¶9 – 12). Hydraulic excavators can be used anywhere and by any industry which needs digging to be done, including but not limited to forestry. Zeigler CAT, a dealer for Opposer, lists Opposer's hydraulic excavators on its website for use in forestry, construction, landscaping, farming and agriculture, demolition and scrap, mining, and quarry and aggregate. (Metzger Dec. Ex. J).

8. On its website, Tigercat lists various products which can be used in multiple fields. For example, Tigercat lists the M760 mulcher and the text states, "The M760 mulcher effectively clears trees, stumps and brush, leaving behind a coarse wood mulch. The M760 is ideal for *commercial land-clearing and right-of-way applications as well as site-preparation work.*" (emphasis added) (Metzger Dec. Ex. K).

Opposer's reliance on its '027 Registration, its own representations to the relevant public, the fact that off-road equipment of the types sold by the parties is not restricted to any one field of use, and the other facts above noted, establish:

1. that there is no commercially meaningful distinction between the goods of the parties sold under their respective different marks based on industry designations or fields of use.

Machinery of the sort identified in the opposed application, such as mulchers, can be used in the forestry industry, in the construction industry, and other off-road contexts. Hydraulic excavators can be used in the forestry industry, as well as the demolition and scrap, mining, and quarry and aggregate industries. Dozers can be used in the forestry industry as well as the mining, waste, and quarry and aggregate industries.

2. that Opposer, like Tigercat, is selling goods promoted for and used in the forestry and vegetation management industries as well as other industries where off road equipment is employed, depending on the need of the end user, and so;

3. that the proposed amendment is not supported by the facts and is accordingly futile and legally insufficient under Section 18.

As important as the facts that Opposer knows and ignores, is the fact that neither party controls the use of the equipment that it makes and sells. Dealers sell the equipment and the end user determines where and how it will be used, not the parties. (Iarocci Dec. ¶12; Metzger Dec. Ex. L).

Opposer's misstatements of fact not only illustrate the futility of its proposed amendment, but also lead to a misrepresentation of the applicable law in determining whether or not the proposed amendment would obviate any likelihood of confusion or dilution.

Opposer's attempt to delineate and differentiate fields of use and thereby restrict Applicant's goods must fail based on the applicable law and the facts, including the representations made by Opposer and its dealers to the relevant public.

## **2. Opposer's Motion is Not Supportable Under Section 18 of the Lanham Act.**

As noted above, Section 18 of the Lanham Act, 15 U.S.C § 1068, allows for the limitation of goods and services in an opposition proceeding only when a party can plead and *prove* that “(1) the adverse party is not using its mark on the goods or services sought to be excluded by the proposed restriction, and (2) a finding of likelihood of confusion will be avoided by entry of the restriction of goods or services - that is, the restriction must be ‘commercially significant.’” [emphasis added]. *The Bd. of Regents, U. of Texas System v. Southern Illinois*, 110 U.S.P.Q.2d 1182, 1197 (TTAB 2014). Section 18 is generally applied where an applicant seeks to avoid a finding of likelihood of confusion by restricting the Opposer's identification of goods, based on the actual use of the mark of the registration relied on by the Opposer. Opposer cannot establish that Tigercat is not using its TIGERCAT mark on its goods in the trade channels sought to be excluded by the proposed restriction. (Iarocci Dec. ¶¶ 9, 10 and 11; See Declaration of Jared Swenson ¶¶ 6, 7 and 8, hereafter “Swenson Dec. ¶ \_\_\_”; Metzger Dec. Exs. G – I and M – S).

Tigercat is using its mark on such off road industrial equipment as is identified in its application and such equipment is and has been used outside the forestry and vegetation management fields. (Metzger Dec. Exs. M – S).

Tigercat does not and cannot control where and in what fields the equipment it makes and sells will be used once it is in the hands of the end-user. (Iarocci Dec. ¶12). Tigercat employees

and Tigercat dealer employees have seen Tigercat off road industrial equipment used in non-forestry application by ends-users. (Iarocci Dec. ¶¶ 9, 10, and 11; Swenson Dec. ¶¶ 6, 7 and 8).

Based on the facts of record, Opposer's contention that the restriction it seeks will alleviate its concerns of dilution and likelihood of confusion demonstrates only the absurdity of its dilution claim and the inherent weakness of its Section 2(d) claim.

Opposer attempts to argue that no dilution or likelihood of confusion may exist when Applicant's use of the TIGERCAT mark is restricted to the forestry and vegetation management fields, but Opposer is relying in this proceeding on its '027 registration for goods in those exact fields; and Opposer markets goods to those fields. (Opposer's Mot. for Leave to File Am. Notice p. 3). The argument is manifestly without merit.<sup>1</sup>

A claim of dilution is not predicated on a finding as to the related nature of the parties' goods or overlapping trade channels. In fact, the relatedness of the goods is not even a factor under 15 U.S.C. § 1125(c) of the Lanham Act. Rather, to prevail on a claim of dilution, opposer "must provide evidence that when the public encounters opposer's mark *in almost any context*, it associates the term, at least initially with the mark's owner." [emphasis added]. *The B.V.D. Licensing Corp. v. Bosideng Co., Ltd.*, 2012 WL 423820 at \*9 (TTAB Jan. 12, 2012).

Applicant's proposed amendment is simply immaterial to its claim of dilution.

Opposer does not meet either prong of the test for acceptance of an amendment under Section 18. Its attempt to amend its Notice of Opposition to seek a restriction of Tigercat's trade channels and goods is futile, and so should be denied.

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<sup>1</sup> The proposed amendment does appear to recognize the significance of Tigercat's incontestable trademark registration which is directed to some of the same goods as are identified in the application herein opposed.

**B. Opposer's Proposed Amendment Has Been Improperly Delayed and Would Be Prejudicial to Applicant.**

Under Fed. R. Civ. P. 15(a), leave to amend pleadings is not granted if such amendment would be prejudicial to the rights of the adverse party or parties. *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285 (TTAB 2008). In determining whether a party would be prejudiced by the proposed amendment, the Board looks not only to the futility of the proposed amendment but also to the timing of the request for leave to amend. TBMP § 507.

A motion for leave to amend should be filed as soon as the grounds for the amendment are known: “[a]ny party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion.” *Trek Bicycle Corp. v. StyleTrek, Ltd.*, 64 U.S.P.Q.2d 1540, 1541 (TTAB 2001). See also *Long John Silver's Inc. v. Lou Scharf, Inc.*, 213 U.S.P.Q. 263, 266 (TTAB 1982) (denying Opposer's motion for leave to amend to rely on eight additional marks “when Opposer knew, or should have known of the existence of these marks at the time of the filing of the notice of opposition.”).

Opposer misstates and ignores the relevant facts on the matter of delay as well as on the matter of the overlap in trade channels of the parties. Opposer's contention that it did not know whether Applicant was using its TIGERCAT mark outside of the forestry industry when it filed its Notice of Opposition is contradicted by the following facts:

1. Prior to November 20, 2013, both parties attended the same trade shows (Metzger Dec. Exs. Q and B) which were targeted to industries other than forestry.

2. Prior to November 20, 2013, both parties advertised in the same trade journals (Metzger Dec. Ex. R) which ads were targeted to industries other than forestry.

3. The parties have since long prior to 2013 operated in the same field – namely the manufacture and sale of off-road equipment which is often customized and sold through dealers to end users who may employ the same piece of equipment in any number of settings (Iarocci Dec. ¶¶ 9, 10 and 11; Swenson Dec. ¶¶ 6, 7 and 8; Metzger Dec. Exs. A – P; R – S).

Opposer knew (or should have known, unless it was willfully blind) Tigercat did not market nor sell its equipment to just the forestry industry prior to filing its Notice of Opposition.

Subsequent to the filing of the Notice of Opposition, more than ample evidence is of record to demonstrate Opposer knew or should have known Tigercat marketed and sold its equipment outside the forestry industry:

1. Opposer and Tigercat attended the same non-forestry specific trade show, CONEXPO CON in Las Vegas in March 2014, which show is advertised as the international gathering place for the construction industries. (Metzger Dec. Exs Q and B).

2. On April 29, 2014, Tigercat served its responses to Opposer's discovery requests, and produced documents establishing the fields in which Applicant's equipment has been employed since long prior to 2013. (Metzger Dec. Exs. G – J; M – P and S).

Opposer's motion comes nearly ten months after April 29, 2014. Between April 29 and September 2, 2014, when this proceeding was suspended based on Tigercat's motion to compel discovery arising from Opposer's refusal to supplement its evasive and incomplete discovery responses, Opposer took no action to amend its Notice of Opposition. During the suspension

period, Opposer did not seek Tigercat's consent to such amendment. Opposer has unreasonably delayed seeking to add the Section 18 restriction request.

Contrary to Opposer's contentions, its delay in bringing this motion is prejudicial. Opposer's reliance on *Cashflow Technologies, Inc. v. NetDecide*, 2002 TTAB LEXIS 147 (TTAB Feb. 7, 2002) is misplaced. First, the grant or denial of such motions is discretionary. Second, in that proceeding there was no previous improper delay. Here, Opposer has demonstrated its intent to delay through evasive and incomplete discovery responses<sup>2</sup> which required a motion to compel and so has already wasted time and resources.

Opposer contends that Applicant is not prejudiced because it has the ability to produce evidence and testimony later in the proceeding to demonstrate that the proposed restriction is unfounded. The record in this proceeding is going to be sufficiently voluminous on Opposer's likelihood of confusion and dilution claims. There is no need to compel the parties to enlarge the record further to demonstrate what is already known and what is not issue determinative. Opposer's approach is further evidence of Opposer's proclivity for wasting the resources of both the Board and Applicant.

In this circumstance, and particularly since the proposed amendment is unfounded and futile, as demonstrated above, Opposer does not meet even the liberal standard for amendment of the pleadings as its motion is belated and prejudicial.

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<sup>2</sup> In its ruling on Applicant's Motion to Compel, the Board found six of Opposer's responses to be insufficient, characterizing its response to Interrogatory No. 16 as "evasive".

### III. CONCLUSION

For the reasons set forth above, Caterpillar has not met the standard for an amendment of the pleadings and has predicated its proposed amendment on misstatement of facts and misapplication of the law. Applicant respectfully requests that Opposer's Motion To Leave To File Amended Notice Of Opposition be denied.

Dated: March 11, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

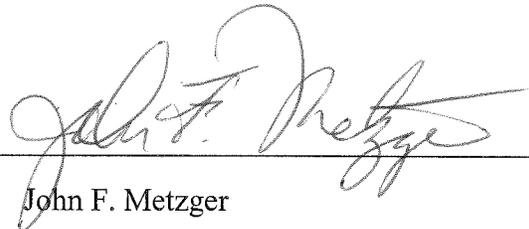
The undersigned hereby certifies that a true and correct copy of the attached APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION was served on counsel for the Opposer on the date listed below via electronic and U.S. Mail:

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