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

Proceeding	91214508
Party	Plaintiff Tekni-Plex, Inc.
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____)	
Tekni-Plex, Inc.,)	
)	
Opposer,)	Opposition No. 91214508
)	Application Serial No. 86/001,725
v.)	Mark: EDGEPULL
)	Class 17
Selig Sealing Products, Inc.)	
)	
Applicant.)	
_____)	

OPPOSER’S REPLY IN FURTHER SUPPORT OF ITS MOTION TO AMEND NOTICE OF OPPOSITION

The Opposer, Tekni-Plex, Inc. (hereinafter, “Tekni-Plex” or “Opposer”), submits this reply in further support of its Motion to Amend its Notice of Opposition, pursuant to Rule 15(a) of the Federal Rules of Civil Procedure, Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 507.02, and Rules 2.107(a), 2.127(a), and 2.119(c) of the Trademark Rules of Practice.

In its Motion to Amend the Notice of Opposition, Tekni-Plex sought to amend its Notice of Opposition to allege, as an additional ground for opposition, that the Applicant, Selig Sealing Products, Inc. (hereinafter “Selig” or “Applicant”), lacked a *bona fide* intent to use the mark that is subject to this Opposition at the time that application was filed. Tekni-Plex concurrently filed a Motion for Summary Judgment on the basis that Selig lacked the requisite *bona fide* intent necessary to file its application under 15 U.S.C. §1051(b). On February 17, 2015, Selig filed its Opposition to Tekni-Plex’s Motion to Amend its Notice of Opposition.

During the discovery period, Tekni-Plex sought interrogatories, requests for documents, and notices of depositions to obtain documentary evidence regarding Selig’s alleged *bona fide*

intent to use the EDGEPULL mark (the “Mark”) in U.S. commerce in connection with Applicant’s goods. In response, Selig failed to provide any discovery other than the vaguest of interrogatory responses, demonstrating that it does not—and did not at the time of filing the Selig Application—have a bona fide intent to use the Mark in commerce in connection with the goods identified in the Selig Application. In response to Opposer’s First Request for Production of Documents, Selig provided no documentary evidence of:

- Selig’s development, creation, and decision to adopt the Mark;
- Selig’s business plans, promotional activities, marketing, advertising, or communications regarding the Mark;
- Selig’s decision to apply to register the Mark; or
- Selig’s bona fide intent to use the Mark.

Selig’s opposition to the Motion to Amend does not make a single mention of that basis – which was only discovered by Tekni-Plex in the recently concluded discovery phase. Selig ignores the basis for Tekni-Plex’s Motion to Amend, and glosses over its failure to produce a single piece of documentary evidence during discovery supporting its *bona fide* intent to use the Mark. The reason is clear – Selig has no such evidence, and seeks to evade well-settled precedent that without such intent, summary judgment is proper on lack of *bona fide* intent.

Instead, Selig focuses on the timing of the Motion, and attempts to distort the facts and the timing of the current proceeding. Selig asserts that the timing of Opposer’s Motion would be “clearly prejudicial to Selig.” In support, Selig cites to a case where the Board denied a Motion to Amend the pleadings which was filed four days after the close of the trial period. *Black & Decker Corp. v. Emerson Elec. Co.*, 84 U.S.P.Q. 2D 1482 (T.T.A.B. Mar. 23, 2007). The facts in that case are entirely distinct from the present proceeding, where Opposer’s Motion to Amend was filed before the start of the trial period, and as soon as Tekni-Plex was reasonably able to do so after the relevant grounds for the amendment became apparent. In *Black & Decker*, the

Board even acknowledged that the Opposer “did not request that proceedings be suspended pending a decision on its motion,” whereas here, Tekni-Plex simultaneously moved for Summary Judgment based on Applicant’s lack of *bona fide* intent, and requested that the Board “stay all deadlines in this Opposition proceeding pending a decision on summary judgment.” The facts and outcome of the *Black & Decker* case have no relation to the present opposition proceeding, and the Board generally grants motions to amend where, as here, the proceedings are still in the pre-trial stage. *United States Olympic Comm. v. O-M Bread Inc.*, 26 U.S.P.Q. 2d 1221, 1222 (T.T.A.B. 1993). The Board has also held that there is generally no prejudice to an Applicant where a motion to amend is filed prior to the start of the trial period. *Hurley International L.L.C. v. Volta*, 82 U.S.P.Q. 2d 1339, 1341 (T.T.A.B. 2007 (granting motion to amend before the start of trial); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 U.S.P.Q. 618, 621 (T.T.A.B. 1974) (finding no prejudice where trial period had not yet commenced).

Nor can Selig show prejudice when the facts on which the motion is based are exclusively within its own knowledge. There is no prejudice to an Applicant when the facts are uniquely within its knowledge and where the factual basis for the motion was obtained by the moving party through discovery taken from the non-moving party. This is precisely the situation here and, accordingly, the amendment should be allowed. *See* TBMP § 507.02(a) (“A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely”); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703-04 (TTAB 2000) (no undue delay despite filing of motion to add claim more than two years after proceeding was brought, where motion was filed promptly after the claim became available). Here, the facts relevant to this Motion are clearly known to Selig, and no new discovery would be required, nor has additional discovery been requested. *See*

Metromedia Steakhouses, Inc. v. Pondco II, 28 U.S.P.Q. 2D 1205, 1207 (T.T.A.B. July 6, 1993) (granting a motion to amend the Notice of Opposition after the close of discovery where “additional discovery as to the ground sought to be added to the plaintiff’s claim should not be necessary, and neither party has requested additional discovery [because t]he facts as to that application and that opposition would appear to be readily established by the record, and in any event they would surely be known to applicant”).

In its response, Selig also asserts that Tekni-Plex’s Motion to Amend is not timely because the facts relevant to the Motion “existed as long ago as July 3, 2013,” when its applications were filed. In support of this proposition, Selig cites to a decision denying a Motion to Amend based on undue delay in its filing, *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q. 2D 1285 (T.T.A.B. Sept. 29, 2008). However, once again, the facts in *Media Online* are readily distinguishable. In *Media Online*, the Motion to Amend was based on claims of descriptiveness and fraud. In denying the motion, the Board held that the “petitioner appears to have consulted dictionary definitions and accessed respondent’s web site, actions which could quite easily have been undertaken prior to filing of the petition to cancel, or by any prompt investigation conducted immediately thereafter. Petitioner waited over seven months, however, and until after respondent’s motion for judgment before filing the motion for leave to amend its pleading to add the two additional claims.” *Id.* at 1286. The Board went on to find that respondent would have been prejudiced, noting that “petitioner did not claim that it learned of these newly asserted claims through discovery or was otherwise unable to learn about these new claims prior to or shortly after filing its first complaint. Petitioner therefore had ample time to file a motion for leave to amend its pleading at an earlier stage in the proceeding.” *Id.* at 1287. In contrast, here the facts which gave rise to Tekni-Plex’s Motion to Amend are based on Selig’s

failure to produce any documentary or other evidence in discovery that could support its *bona fide* intent to use the Mark.

In an attempt to evade the consequences of its failure to produce any evidence of *bona fide* intent, Selig again distorts the issues by trying to cast blame on Tekni-Plex for not asserting this claim sooner. Selig asserts that the facts relevant to the claim for lack of *bona fide* intent were known to Tekni-Plex when it filed its Notice of Opposition because “[i]n the original claim, Tekni-Plex alleges on information and belief that Selig learned of Tekni-Plex’s interest in the EDGEPULL mark and filed the subject application to usurp any rights of Tekni-Plex.” (Selig Opp. at 4.) However, it is not Selig’s interest in the EDGEPULL mark which forms the basis of Opposer’s Motion to Amend the Notice of Opposition to add a claim for lack of *bona fide* intent to use the Mark, but rather Selig’s failure to provide any evidence in discovery of such *bona fide* intent.

Tekni-Plex did not delay in moving to amend, but instead filed this motion as soon as reasonably possible after it became clear that Selig was not going to produce any evidence to support a *bona fide* intent to use the Mark. The Board has frequently held that an absence of documentary evidence from the applicant regarding its intent to use the mark constitutes objective proof sufficient to show that the applicant lacks a *bona fide* intent to use the mark in commerce. *Honda Motor Co., Ltd. v. Friedrich Winkelman*, 90 U.S.P.Q. 2D 1660 (T.T.A.B. April 8, 2009) (granting opposer’s motion for summary judgment because, even when viewing the evidence in favor of the applicant, there was no evidence of the applicant’s *bona fide* intent); *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 1587 (T.T.A.B. 2008) (sustaining opposition based on applicant’s lack of *bona fide* intent to use the mark in commerce). This lack of documentary evidence could not have been known to Tekni-Plex prior

to the close of the discovery period, and certainly not before the beginning of the discovery period, as alleged by Selig.

Further, in *ex parte* examination of a trademark application, an “applicant’s sworn statement of a bona fide intention to use the mark in commerce will be sufficient evidence of good faith. Consideration of issues related to good faith may arise in an inter partes proceeding, but the Office will not make an inquiry in an ex parte proceeding unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce.” TMEP § 1101. Tekni-Plex was entitled to rely, at least initially, on Selig’s sworn statement that it had a *bona fide* intent to use the Mark. Like the Office, Tekni-Plex could not have known of Selig’s lack of *bona fide* intent at the time it commenced this proceeding because no evidence had yet been developed regarding Selig’s lack of *bona fide* intent. This evidence – or lack thereof -- arose through Selig’s failure to produce any documents or other evidence to support its claim, at which point Tekni-Plex moved to amend.

Indeed, during discovery, Tekni-Plex pursued multiple avenues for information regarding Selig’s *bona fide* intent to use the Mark, including interrogatories, requests for documents, and deposition notices. Selig responded by stating that it would produce documents, if any existed. Ultimately, Selig did not produce any such documents (or, indeed, any documents at all), but this did not become clear until after the discovery deadline came and went with no document production from Selig. During discovery, Tekni-Plex twice noticed depositions asking for a witness who could testify as to, among other issues, Selig’s *bona fide* intent to use the Mark. Selig twice postponed the depositions scheduled by Tekni-Plex, and ultimately failed to produce any witnesses at all in response to Tekni-Plex’s notices. Within six weeks after the close of discovery on December 22, 2014, and after no documents had been produced by Selig in this

matter, on February 2, 2015, Tekni-Plex filed its Motion to Amend the Notice of Opposition to include a claim that Selig lacked a *bona fide* intent to use the Mark.

Of note, Selig does not contend that Tekni-Plex delayed in filing its Motion to Amend after the close of discovery¹, but merely that Opposer waited “more than seven months after the initial opposition was filed.” Again, Selig has ignored the facts which gave rise to Opposer’s Motion. The time which passed between the filing of the Notice of Opposition and the Motion to Amend is irrelevant when the facts relevant to Motion were not known to Opposer at the time the Notice of Opposition was filed. *Boral Ltd. v. FMC Corp.*, 59 U.S.P.Q.2D 1701, 1703-04 (T.T.A.B. Mar. 29, 2000) (granting opposer’s motion to amend because “the Board finds that applicant would not suffer substantial prejudice by permitting opposers to add a dilution claim. While it is true that opposers’ motion to amend the pleading was filed over two years after the commencement of this proceeding, opposers’ dilution claim was unavailable at the time the original notice of opposition was filed.”).

In addition to the lack of documentary evidence produced by Selig, Tekni-Plex pointed to three intent-to-use applications that Selig filed on the same day for identical goods as further evidence of its lack of *bona fide* intent. In a further attempt to divert the Board’s attention from its own lack of evidence, Selig focuses on the only one of those applications that Tekni-Plex opted not to oppose, EDGETAB, claiming that Tekni-Plex somehow seeks to circumvent the opposition rules and oppose that application at this juncture. (Selig Opp. at 5-6.) A plain reading of Tekni-Plex’s Amended Notice of Opposition makes clear that nothing could be farther from the truth, because it cites the EDGETAB application only as an additional factor suggesting

¹ Nor would any such argument be credible. This was the soonest that Tekni-Plex could reasonably prepare and file its motion, particularly given that this period spanned the Christmas and New Years holidays and busy end of year season.

that Selig lacked a *bona fide* intent to use the Mark at issue. Tekni-Plex has not opposed Selig's application for EDGETAB, and Selig is free to pursue registration of that mark.

Both Fed. R. Civ. P. 15(a) and TBMP § 507.02 make clear that leave to amend a Notice of Opposition should be freely granted "when justice so requires." Justice would not be served by depriving Opposer of the opportunity to have this claim be considered, in view of its diligent efforts to gain discovery, which yielded no evidence from Applicant, and its prompt filing of this motion. Nor would justice be served by granting registration where there is no evidence of Applicant's *bona fide* intent to use the mark, despite every opportunity to produce such evidence.

Accordingly, Opposer requests that the Board grant its motion to Amend its Notice of Opposition to include an additional ground for opposition to assert that Application Serial No. 86/001,725, for the mark EDGE PULL, should be refused based upon the Applicant's lack of *bona fide* intent to use the mark at the time of filing that application. Tekni-Plex respectfully requests that if the Board grants this motion to amend, the Board should further grant its Motion for Summary Judgment and should stay all deadlines in this Opposition proceeding pending a decision on summary judgment.

Dated: March 9, 2015

Respectfully submitted,

TEKNI-PLEX, INC.

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CERTIFICATE OF SERVICE

I hereby certify that on this date a true and correct copy of the foregoing was served upon the attorney of record for the Applicant by electronic mail, as agreed to between the parties, as follows:

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