

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

Mailed: August 9, 2016

Opposition Nos. 91212519 (parent)
91212521
91212522
91215672
91215674
91215677

Hint Incorporated

v.

Sunrise Apparel Group, LLC

**Robert H. Coggins,
Interlocutory Attorney:**

These cases are now before the Board for consideration of the following filings:

1. Applicant's renewed motions (filed February 3, 2014, in Opposition Nos. 91212519 (parent), 91212521, and 91212522) to amend the subject applications and answers in the respective oppositions;
2. Opposer's consented motions (filed February 13 and April 11, 2014, in Opposition No. 91212519 (parent)) to suspend proceedings for settlement;
3. Applicant's motion (filed June 27, 2014, in Opposition Nos. 91212519 (parent), 91215672, 91215674, and 91215677) to further consolidate proceedings;
4. Opposer's consented motion (filed August 21, 2014, in Opposition No. 91212519 (parent)) for an extension of time;

5. A second copy of the parties' stipulated protective agreement (filed November 10, 2014, in Opposition No. 91212521; and December 1, 2014, in Opposition No. 91212519 (parent));

6. Opposer's motions (filed December 29, 2014, in Opposition Nos. 91212519 (parent), 91215672, 91215674, and 91215677) for default judgment in Opposition Nos. 91215672, 91215674, and 91215677; and

7. Opposer's change of correspondence address (filed September 21, 2015, in Opposition Nos. 91212519 (parent), 91212521, 91212522, 91215672, 91215674, and 91215677).

Background

In a February 3, 2014 order, the Board granted Applicant's earlier-filed motions to consolidate Opposition Nos. 91212519, 91212521, and 91212522; denied without prejudice Applicant's earlier-filed motions to amend the respective subject applications to and answers in Opposition Nos. 91212519, 91212521, and 91212522; noted the parties' earlier-filed stipulated protective agreement; and reset the schedule for consolidated Opposition Nos. 91212519, 91212521, and 91212522. *See* 11 TTABVUE (in Opposition No. 91212519 (parent)). After the Board's order issued on February 3rd, Applicant filed, later that same day, a second motion to amend the applications and answers in Opposition Nos. 91212519, 91212521, and 91212522. Shortly after Applicant filed the renewed motions to amend, Opposer filed (on February 13, 2014) a consented motion for a sixty-day suspension of the consolidated proceedings to allow the parties to engage in settlement, and this was followed by Opposer's April 11, 2014, consented motion for a further ninety-day suspension for settlement. On August 21, 2014, Opposer filed a consented motion for a thirty-day extension of time to allow the parties to continue their settlement discussions.

Separately, and unknown to the Board at that time within the context of the three previously consolidated cases, Opposer instituted Opposition Nos. 91215672, 91215674, and 91215677, on March 31, 2014, against three additional applications (i.e., one application subject to each opposition proceeding) owned by Applicant. Prior to the time set for Applicant to answer each new opposition, Opposer filed consented motions for a sixty-day suspension of time to allow the parties to engage in settlement. The motions to extend were granted by the Board, and Applicant's time to answer the new oppositions was reset to July 10, 2014, for Opposition Nos. 91215674 and 91215677, and to August 10, 2014, for Opposition No. 91215672.

Within the ninety-day period of further suspension sought in the consolidated proceedings, and within the time allowed to file answers to the three new oppositions, Applicant filed (on June 27, 2014), in the consolidated "parent" and all three of the new oppositions, a motion to further consolidate Opposition Nos. 91212519 (parent), 91212521, and 91212522 with Opposition Nos. 91215672, 91215674, and 91215677. Before the Board took up any of the then-outstanding motions to suspend or extend the previously consolidated proceedings, or the motion to further consolidate, Opposer filed motions seeking default judgments in the three new oppositions, arguing, *inter alia*, that Applicant's motion for further consolidation did not substitute for Applicant's responsibility to file answers in the new proceedings.

Further Consolidation

Applicant's motion to further consolidate is **granted** as conceded and as well-taken. Fed. R. Civ. P. 42(a); Trademark Rule 2.127(a). Accordingly, Opposition Nos.

Opposition Nos. 91212519, 91212521, 91212522, 91215672, 91215674 & 91215677

91215672, 91215674, and 91215677 are consolidated into previously consolidated Opposition No. 91212519 (as the parent) and may be presented on the same record and brief. The Board file will be maintained in Opposition No. 91212519 as the “parent” case. The parties should no longer file separate papers in connection with each proceeding; only a single copy of each paper should be filed by the parties in the parent case, and each paper should bear all proceeding numbers in the caption.

Change of Address

Opposer’s changes of correspondence address are **noted** and entered. Although Opposer did not amend its courtesy correspondence email addresses in the parent case, the Board presumes that this was a clerical oversight, and, in view thereof, the email addresses in the parent case have been updated as indicated in the changes of correspondence filed in the non-parent cases.

Protective Agreement

Inasmuch as the Board previously noted the parties’ stipulated protective agreement, *see* 11 TTABVUE 3 (in Opposition No. 91212519 (parent)), the additional copies of the agreement will be given **no consideration**. It is presumed that, in view of consolidation, the original protective agreement applies to each case that has been consolidated under the parent opposition.

Motions to Suspend and Extend

Opposer’s consented motions to suspend and to extend time for settlement are **granted *nunc pro tunc***. However, in view of the further consolidation ordered above, dates are reset on the schedule at the end of this order.

Motions for Default Judgment

In view of the timing of the multiple motions pending before the Board, including Applicant's motion to consolidate, which is granted, above; in view of the time it has taken the Board to address the outstanding issues raised by the multiple motions; in view of the policy of the law to decide cases on their merits; in view of the circumstances of these cases, where it does not appear that Applicant's failure to file timely answers to the three newest oppositions was willful, in bad faith, the result of gross neglect, or unduly prejudicial to Opposer; and in view of Applicant's having since filed its late answers in Opposition Nos. 91215672, 91215674, and 91215677 (at Exhibit A to Applicant's respective briefs in opposition to the motion for default (*see* 8 TTABVUE 9-14, in each Opposition No. 91215672, 91215674, and 91215677)), each of which presents a plausible response to Opposer's respective allegations; Opposer's motions for default judgment are **denied**, and Applicant's late answers are accepted. Fed. R. Civ. P. 55; TBMP § 312 and 508.

Motions to Amend

By its renewed motions, Applicant moves to amend the identification of goods in the applications subject to Opposition Nos. 91212519, 91212521, and 91212522 (*i.e.*, application Serial Nos. 85587640, 85587643, and 85587642, respectively) to add to the end of the listing of goods the wording "sold only through one national retail clothing, footwear, headwear, and accessories store owned by Vanity Shop of Grand Forks, Inc. or its assigns which has brick and mortar stores and an e-commerce website."

As Applicant acknowledges in its motions, the Board's *decision in Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077 (TTAB 2013), provides a framework for considering Applicant's motions to amend the applications subject to Opposition Nos. 91212519, 91212521, and 91212522. Although the Board generally defers determination of timely (i.e., pretrial) unconsented motions until final decision or until the case is decided upon motion for summary judgment, *see* TBMP § 514.03 and cases cited therein, in order to give the other party or parties fair notice thereof, *Stryker* held that an unconsented motion to amend may be granted prior to trial under the following circumstances:

- 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 the 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, 109 USPQ2d at 1078-79 (citing *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007)); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 964 (TTAB 1986); *Int'l Harvester Co. v. Int'l Telephone & Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980). While Applicant

argues that the first three elements are met – the fourth element not being at issue inasmuch as the subject applications are currently based on an intent-to-use – the current motion to amend will be deferred until final hearing or summary judgment.

Firstly, although Applicant states that use of the name “Vanity Shop of Grand Forks, Inc.” (“VSGF”) in the proposed amendments does not implicate the prohibition stated in TMEP § 1402.09 on use of registered marks in identifications, Applicant failed to indicate whether VSGF has consented to the use of its name in the proposed identifications of goods. It is prudent to defer consideration of the proposed amendments until Applicant affirmatively states whether VSGF consents or objects to such amendments where, under the circumstances of these cases, Applicant moves to amend after the identifications of goods have been published for opposition, and there is no procedural mechanism to VSGF to otherwise object at this stage to the inclusion of its name in an identification of goods.

Secondly, Applicant has not made a *prima facie* showing that the proposed amendments change the nature and character of the goods or restrict their channels of trade and customers so as to introduce a substantially different issue for trial. Exhibits C and D accompanying the motions to amend are not in evidence and were not otherwise supported by an affidavit or declaration. Similarly, the registrations of VSGF referenced in the motion are not in evidence and copies of those registrations were not submitted with the motion. Further, the statements as to Opposer’s channels of trade, Opposer’s retailers, and what VSGF sells and does not sell, are not

in evidence and were not otherwise supported by an affidavit or declaration from any of the interested parties.

Inasmuch as Applicant has not satisfactorily show that all of the necessary *Stryker* elements have been met, the renewed motions to amend will be **deferred** until the case is decided at final hearing or summary judgment.

Schedule

Dates are **reset** on the following schedule:

Deadline for Discovery Conference ¹	9/7/2016
Discovery Opens	9/7/2016
Initial Disclosures Due	10/7/2016
Expert Disclosures Due	2/4/2017
Discovery Closes	3/6/2017
Plaintiff's Pretrial Disclosures	4/20/2017
Plaintiff's 30-day Trial Period Ends	6/4/2017
Defendant's Pretrial Disclosures	6/19/2017
Defendant's 30-day Trial Period Ends	8/3/2017
Plaintiff's Rebuttal Disclosures	8/18/2017
Plaintiff's 15-day Rebuttal Period Ends	9/17/2017

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

¹ Although the deadline for the discovery conference in the previously consolidated cases passed, the Board recognizes and agrees with Opposer's procedural argument in the motions for default judgment that dates should be reset to allow the parties time in which to hold the discovery conference (at least for the three most recently filed oppositions).