

ESTTA Tracking number: **ESTTA615540**

Filing date: **07/14/2014**

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

Proceeding	91217006
Party	Plaintiff Kind LLC
Correspondence Address	Margarita Wallach McCarter & English, LLP 245 Park Avenue, 27th Floor New York, NY 10167 UNITED STATES mwallach@mccarter.com, apang@mccarter.com, dlynch@mccarter.com
Submission	Other Motions/Papers
Filer's Name	Margarita Wallach
Filer's e-mail	mwallach@mccarter.com, apang@mccarter.com, dlynch@mccarter.com
Signature	/mw/
Date	07/14/2014
Attachments	Opposition No. 91217006 - Restated Motion to Amend Registrations.pdf(61034 bytes ) Opposition No. 91217006 - Memo of Law in Support of Restated Motion to Amend Registrations.pdf(180402 bytes ) Lubetzky Declaration (Executed).PDF(141523 bytes )

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

KIND LLC,

Opposer,

v.

HERBERT D. FLORES DBA  
ZONAFELIZ,

Applicant.

Opposition No. 91217006

**RESTATED MOTION TO AMEND REGISTRATIONS**

Opposer, Kind LLC (“Kind”), hereby moves, pursuant to Trademark Rule 2.107 and Section 7 of the U.S. Trademark Act, to amend U.S. Trademark Registration Nos. 2984772, 3882221, 3971639 and 4097493 to correct the dates of first use and first use in commerce printed on the certificates of registration from February 18, 2003 to at least as early as June 14, 2004, and to amend U.S. Trademark Registration No. 4161495 to correct the dates of first use and first use in commerce for the Class 29 goods printed on the certificate of registration from February 18, 2003 to at least as early as June 14, 2004. As set forth in the brief and the Declaration of Daniel Lubetzky submitted herewith, it is respectfully requested that the Trademark Trial and Appeal Board grant Kind’s Restated Motion to Amend Registrations.

For the information of the Board, Kind is also filing motions seeking the identical relief in Opposition Nos. 91211463, 91213362, 91214163, 91216941 and 91212055.

Dated: July 14, 2014

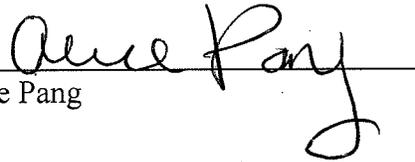
Respectfully submitted,

/s/ Margarita Wallach  
Margarita Wallach  
Attorney for Kind LLC  
McCarter & English LLP  
245 Park Ave., 27<sup>th</sup> Floor  
New York, NY 10167  
Tel: (212) 609-6819  
Fax: (212) 935-5214

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Restated Motion to Amend Registrations was served on this 14<sup>th</sup> day of July, 2014 via first class mail, postage prepaid on Applicant at:

Herbert D. Flores  
PO Box 818  
Moss Beach, CA 94038-0818

  
\_\_\_\_\_  
Alice Pang

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

KIND LLC,

Opposer,

v.

HERBERT D. FLORES DBA  
ZONAFELIZ,

Applicant.

Opposition No. 91217006

**MEMORANDUM OF LAW IN SUPPORT OF  
RESTATED MOTION TO AMEND REGISTRATIONS**

Pursuant to Trademark Rule 2.107 and Section 7 of the U.S. Trademark Act, Opposer Kind LLC (“Kind”) seeks to amend U.S. Trademark Registration Nos. 2984772, 3882221, 3971639, 4097493, and 4161495 to correct the dates of first use printed on the certificates of registration. Pursuant to 37 C.F.R. § 2.133(a), Kind is also filing motions seeking the identical relief in Opposition Nos. 91211463, 91213362, 91214163, 91216941 and 91212055.

**BACKGROUND**

Kind is the registered owner of numerous United States trademark registrations for the mark KIND, as well as trade dress registrations for Kind’s product packaging. Kind’s registrations include U.S. Registration Nos. 2984772, 3882221, 3971639, 4097493 and 4161495 (collectively, the “Kind Registrations”). The Kind Registrations cover goods in Class 29 and/or Class 30, among others. All of the Kind Registrations are valid and subsisting. U.S.

Registration No. 2984772 is incontestable. *See* Declaration of Daniel Lubetzky dated July 2, 2014 (“Lubetzky Dec.”) at ¶¶ 2–3 filed herewith.

At the time that each of the applications for the Kind Registrations was filed, Kind had a good faith belief that February 18, 2003 was the date that Kind first used the marks that were the subject of these applications in connection with all of the goods identified in Class 29 (U.S. Registration Nos. 3882221, 3971639, 4097493 and 4161495) and Class 30 (U.S. Registration No. 2984772) anywhere and in U.S. commerce. *Id.* at ¶ 4.

However, through Kind’s recent review of its corporate records and CEO Daniel Lubetzky’s recent communications with Kind personnel, Kind has reached the conclusion that the first use dates should not have been identified as February 18, 2003. *Id.* at ¶ 5. Instead, Kind has used the marks that are the subject of U.S. Registration Nos. 2984772, 3882221, 3971639 and 4097493 in connection with the goods identified therein, anywhere and in U.S. commerce, since at least as early as June 14, 2004. *Id.* Likewise, Kind has used the mark that is the subject of U.S. Registration No. 4161495 in connection with the Class 29 goods identified therein, anywhere and in U.S. commerce, since at least as early as June 14, 2004. *Id.*

## ARGUMENT

Pursuant to section 7(h) of the Trademark Act, if a mistake in a trademark registration is made in good faith, the owner may apply for an amendment of its registration, so long as the amendment does not result in republication or a material alteration of the marks at issue. *See* 15 U.S.C. § 1057(h); *see also* TMEP § 1609.10(b). Kind seeks merely to correct the first use dates printed on the certificates of registration for the Kind Registrations. Accordingly, the relief Kind seeks does not require republication of the marks and trade dress at issue. *See* 15 U.S.C. §

1057(h); see *also* TMEP § 1609.10(b). Nor does it cause a material alteration of the marks. See TMEP § 1609.10(b).

Furthermore, Kind's request to change the dates of use should be accepted by the Board even though the corrected dates are later than the dates originally set forth in the Kind Registrations because the modified dates would have been accepted during examination of the application. See TMEP § 1609.07; see *also In re Pamex Foods, Inc.*, 209 USPQ 275 (Comm'r Pats. 1980); *Grand Bag & Paper Co. v. Tidy-House Paper Prods., Inc.*, 109 USPQ 395 (Comm'r Pats. 1956). For applications based on use in commerce under 15 U.S.C. § 1051(a), like the applications that issued as the Kind Registrations, the registration cannot be corrected to specify a date of use that is later than the application filing date. 37 C.F.R. § 2.71(c)(1)). Here, Kind seeks to amend its dates of use for the Kind Registrations to at least as early as June 14, 2004, which is a date that is earlier than the filing dates of the applications that were the basis for Registration Nos. 4161495, 3882221, 3971639, and 4097493 that is at least as early as the filing date for the application that was the basis for Registration No. 2984772.

At the time Kind filed the applications for the Kind Registrations, it had a good faith belief that it began using its KIND-formative marks and trade dress in connection with the goods identified in Registration Nos. 2984772, 3882221, 3971639 and 4097493 and the Class 29 goods identified in Registration No. 4161495 since at least as early as February 18, 2003. Lubetzky Dec. at ¶ 4. However, Kind recently discovered through a review of its corporate records and communications between CEO Daniel Lubetzky and Kind personnel that Kind's first use dates for the Kind Registrations were inaccurately recorded. *Id.* at ¶ 5. Kind has used its KIND-formative marks and trade dress in Class 29 (U.S. Registration Nos. 3882221, 3971639, 4097493 and 4161495) and Class 30 (U.S. Registration No. 2984772) since at least as early as June 14,

2004. *Id.* Accordingly, Kind requests that the Board grant its request to correct the first use dates printed on the certificates of registration for the Kind Registrations to reflect this change.

### CONCLUSION

For the foregoing reasons, KIND respectfully requests that the Trademark Trial and Appeal Board grant this Restated Motion to Amend Registrations and correct the dates of first use printed on the certificates of registration for Registration Nos. 2984772, 3882221, 3971639 and 4097493 from February 18, 2003 to at least as early as June 14, 2004 and correct the dates of first use printed on the certificate of registration for Registration No. 4161495 for the Class 29 goods from February 18, 2003 to at least as early as June 14, 2004.

Dated: July 14, 2014

Respectfully submitted,

/s/ Margarita Wallach  
Margarita Wallach  
Attorney for Kind LLC  
McCarter & English LLP  
245 Park Ave., 27<sup>th</sup> Floor  
New York, NY 10167  
Tel: (212) 609-6819  
Fax: (212) 935-5214

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Memorandum of Law in Support of the Restated Motion to Amend Registrations was served on this 14<sup>th</sup> day of July, 2014 via first class mail, postage prepaid on Applicant at:

Herbert D. Flores  
PO Box 818  
Moss Beach, CA 94038-0818

  
\_\_\_\_\_  
Alice Pang

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of the Application of KIND LLC :  
to Correct the Dates of First Use of :  
U.S. Registration Nos.: :  
: :  
2984772 :  
3882221 :  
3971639 :  
4097493 :  
4161495 :

-----X

**DECLARATION OF DANIEL LUBETZKY**

I, Daniel Lubetzky, hereby declare as follows:

1. I am the Founder and Chief Executive Officer of Kind LLC, formerly known as PeaceWorks Holdings, LLC (“Kind”), and have personal knowledge of the facts contained herein.

2. Kind is the registered owner of numerous United States trademark registrations for the mark KIND, as well as trade dress registrations for Kind’s product packaging. Kind’s registrations include U.S. Registration Nos. 2984772, 3882221, 3971639, 4097493 and 4161495 (collectively, the “Kind Registrations”). The Kind Registrations cover goods in Class 29 and/or Class 30, among others.

3. All of the Kind Registrations are valid and subsisting. U.S. Registration No. 2984772 is incontestable.

4. At the time that each of the applications for the Kind Registrations was filed, Kind had a good faith belief that the date that Kind first used the marks that were the subject of these applications in connection with all of the goods identified in Class 29 (U.S. Registration Nos. 3882221, 3971639, 4097493 and 4161495) and Class 30 (U.S. Registration No. 2984772) anywhere and in commerce was on February 18, 2003.

5. As a result of a recent review of Kind's corporate records and my recent communications with Kind personnel, Kind has reached the conclusion that the first use dates should not have been identified as February 18, 2003. Instead, Kind has used the marks that are the subject of U.S. Registration Nos. 2984772, 3882221, 3971639 and 4097493 in connection with the goods identified therein, anywhere and in U.S. commerce, since at least as early as June 14, 2004. Likewise, Kind has used the mark that is the subject of U.S. Registration No. 4161495 in connection with the Class 29 goods identified therein anywhere and in U.S. commerce, since at least as early as June 14, 2004.

6. Pursuant to Section 7 of the U.S. Trademark Act, Kind therefore requests to correct the dates of first use printed on the registration certificates for U.S. Registration Nos. 2984772, 3882221, 3971639 and 4097493 from February 18, 2003 to June 14, 2004. Kind also requests to correct the dates of first use printed on the registration certificate for U.S. Registration No. 4161495 for the Class 29 goods from February 18, 2003 to June 14, 2004.

I declare under penalty of perjury that all statements made herein are of my own knowledge and are true and those made on information and belief are believed to be true.

Executed this 2nd day of July, 2014.



---

Daniel Lubetzky