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

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|---|---|
| Proceeding | 91218523 |
| Party | Defendant<br>13th Ave Fish Market Inc. DBA Freund's Fish |
| Correspondence Address | ROBERT B.G. HOROWITZ<br>BAKER & HOSTETLER LLP<br>45 ROCKEFELLER PLZ FL 14<br>NEW YORK, NY 10111-0100<br>UNITED STATES<br>rhorowitz@bakerlaw.com |
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| Signature | /Robert B.G. Horowitz/ |
| Date | 12/29/2014 |
| Attachments | MEMORANDUM IN OPPOSITION TO MOTION TO STRIKE WITH AMENDED ANSWER.pdf(1966634 bytes ) |

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

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Oakhurst Industries, Inc. DBA Freund Baking Co.,

Opposer,

v.

Opposition No. 91218523

13th Ave Fish Market Inc. DBA Freund's Fish,

Applicant.

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**MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE AND IN SUPPORT OF APPLICANT'S MOTION TO AMEND ANSWER TO NOTICE OF OPPOSITION**

Pursuant to Trademark Rules 37 C.F.R. §§ 2.107 & 2.133, Federal Rule of Civil Procedure 15(a) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 507.02 & 514.02, Applicant 13th Ave Fish Market Inc. DBA Freund's Fish ("Applicant") submits this Memorandum of Law in Opposition to Opposer's Motion to Strike and in Support of Applicant's Motion to Amend Answer to Notice of Opposition.[1] By this Motion, Applicant seeks to amend its Answer to Notice of Opposition to remove certain affirmative defenses and develop others. Applicant also seeks the scheduling of a discovery/settlement conference with the participation of the presiding Interlocutory Attorney.

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[1] A copy of Applicant's Amended Answer to Notice of Opposition is attached to this Memorandum.

## A. PROCEDURAL BACKGROUND

On September 24, 2014, Oakhurst Industries, Inc. DBA Freund Baking Co. ("Opposer") filed its Notice of Opposition against Applicant's application for registration of FREUND'S FAMOUS word mark and its FREUND'S FAMOUS design mark, application Serial Nos. 86/139,432 & 86/139,577, respectively. Applicant filed its Answer to Notice of Opposition on November 5, 2014, in which Applicant raised eight affirmative defenses, all of which Opposer moved to strike on December 1, 2014.

By this Opposition to Opposer's Motion to Strike, Applicant opposes Opposer's attempt to strike Affirmative Defenses 2-6 and 8. Simultaneously, Applicant seeks leave to Amend its Answer to Notice of Opposition, in which Applicant seeks to amend certain of its remaining Affirmative Defenses and to delete its First Affirmative Defense (failure to state a claim) and its Seventh Affirmative Defense (laches and acquiescence).

## B. ARGUMENT

### 1. Leave to Amend Should be Granted.

#### a. The Proposed Amendment to Answer to Notice of Opposition.

Applicant seeks leave to amend its Answer to Notice of Opposition to remove The First and Seventh Affirmative Defenses (failure to state a claim; laches and acquiescence). In addition, Applicant seeks to amend Affirmative Defense 8 to add the assertion that "Opposer thus has no rights to assert in such mark, it never having been used or, if it was used, Opposer has abandoned its rights in the mark" and, further, to fix a typographical error in its citation to the Trademark Manual of Examining Procedure.

#### b. The Proposed Amendment will Cause No Prejudice Whatsoever and is Consistent with Settled Law.

TBMP Section 507.02 directs that "leave [to amend a pleading] must be freely

given when justice so requires," and continues: "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." *See also Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

At this early stage, granting Applicant's Motion to Amend will not cause any prejudice to Opposer. *Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007) ("We note that opposer's motion for leave to file an amended notice of opposition was filed prior to the start of trial ...."); *Glad Prod's Co. v. Ill. Tool Works Inc.*, 62 USPQ2d 1538 (TTAB 2002) ("With regard to any potential prejudice to respondent, the timing of a motion for leave to amend under Fed.R.Cir.P. 15(a) is a major factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment."). What is more, the amendments clarify certain affirmative defenses while eliminating others, and will thus serve to streamline and focus this proceeding, which is in the interests of both Parties. Accordingly, Applicant respectfully requests that this Motion to Amend Answer to Notice of Opposition be granted.

**2. The Remaining Affirmative Defenses Are Relevant, They Do Not Prejudice Opposer, And They Should Not be Struck.**

TBMP Section 506.01 provides that "motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. A

defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits".

In moving to strike, Opposer argues that *all* of Applicant's Affirmative Defenses "are improperly pled and lack sufficient specificity to put Opposer on notice of their legal and factual bases," and that they "are simply inapplicable to TTAB opposition proceedings or are comprised of redundant, impermissible or immaterial matter." Mot. To Strike at 3.

a. Applicant's Second Affirmative Defense.

Applicant's Second Affirmative Defense (no likelihood of confusion) goes directly to the issues in the case and will not cause any additional burden upon Opposer. Indeed, lack of likelihood of confusion is specifically identified as an available affirmative defense in the TBMP, *see* TBMP § 311.02(b) (noting that an applicant "might deny that there is any likelihood of confusion with respect to its mark and goods as set forth in the application"), rendering Opposer's attempt to strike that affirmative defense puzzling.

b. Applicant's Third and Fourth Affirmative Defenses.

The third and fourth affirmative defenses go to the length of Applicant's use of the marks in question. Opposer asserts the periods of use (40 years for one mark, 5 years for another) are "wholly inconsistent" with the dates of first use set forth in the respective applications. To the contrary, the dates of first use—identified as "at least as early as October 1, 2013" in both applications—are in fact entirely *consistent* with having used the marks for 40 years and 5 years, respectively. It is simply a canard to suggest that there is any inconsistency between first use of a mark "40 years" ago and first use of a mark "at least as early as October 1, 2013."

Moreover, and contrary to Opposer's assertion, Applicant's Third and Fourth

Affirmative Defenses do not "merely restate" what is in the Answer's denials. These affirmative defenses showing the duration of Applicant's use are clearly relevant and material. Opposer suggests that because lack of actual confusion is not a *prerequisite* to a showing of likelihood of confusion, lack of confusion is simply *irrelevant* to whether there is a likelihood of confusion. Opposer is incorrect. While a showing of actual confusion is not necessary to establish likelihood of confusion, a lack of actual confusion is indisputably *relevant* to the likelihood of confusion analysis, as DuPont factor no. 8 is "[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion". See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

c. Applicant's Fifth Affirmative Defense.

Applicant's Fifth Affirmative Defense asserts that Applicant's use of a registration symbol was inadvertent and without intent to mislead or deceive, and that such use has been discontinued. The inclusion as an affirmative defense will not burden Opposer and is clearly material.

d. Applicant's Sixth Affirmative Defense.

Applicant's Sixth affirmative defense asserts that the fame that Opposer's marks may possess is insufficient for dilution protection under Section 43(c) of the Lanham Act. While this is stated in the denial to paragraph 35 of the Notice of Opposition, the inclusion as an affirmative defense also will not burden Opposer and is clearly material.

e. Applicant's Eighth Affirmative Defense.

Applicant's Eighth affirmative defense asserts that Opposer has not used its mark in connection with "private label baking services," as the specimen of use in Registration No. 4500792 does not refer to such services. Applicant's original Answer incorrectly

cited to Section 1304.04 of the Trademark Manual of Examining Procedure. Opposer correctly asserts that Section 1304.04 (cited due to a typographical error) is inapplicable. Section 1301.04, however, *is* applicable—and that Section makes clear that a failure to submit a specimen referring to the claimed services renders the registration defective. Applicant's Eighth Affirmative Defense is therefore clearly relevant and should not be struck.

Opposer's other argument against Applicant's Eighth Affirmative Defense—that it fails to allege fraud with the requisite specificity—is a straw man, as the Eighth Affirmative Defense does not allege fraud at all. Rather, Applicant charges nonuse of the mark, or alternatively, abandonment of use of the mark, so that there are no rights in it.

### 3. Applicant Requests a Discovery and Settlement Conference With the Presiding Interlocutory Attorney.

Last, opposing counsel did not reach out to counsel for Applicant about scheduling a discovery and settlement conference within the December 4, 2014 deadline, choosing instead to simply make a motion to strike that concludes with a request that the Board suspend this opposition proceeding pending the motion to strike. That request was granted by order of the presiding Interlocutory Attorney on December 23, 2014.[2] While Applicant has no objection to action in this proceeding being

[2] In that order, the Interlocutory Attorney also granted Applicant's motion for an extension of time to oppose Opposer's motion to strike, due to Applicant's untimely receipt of Opposer's moving papers. As is correctly noted in that order, counsel for Applicant is located in a large building in New York City, and that building has no difficulty receiving service. Counsel for Applicant is unaware of any possible reason for the delay other than that the papers were in the custody of the United States Postal Service from the date of mailing, identified as December 1, until the date of receipt, December 16. Counsel for Opposer has previously declined counsel for Applicant's request for service via email, but in light of the presiding Interlocutory Attorney's suggestion that the parties

suspended pending the motion to strike, as well as to it being suspended pending the disposition of Applicant's motion to amend its pleading, Applicant requests that a discovery/settlement conference be held with the presiding Interlocutory Attorney and counsel for the parties, so that the merits, discovery and possible settlement may be discussed (including the lack of merit of Opposer's descriptiveness claim against Applicant's FREUND'S FAMOUS and fish design mark application, SN 86139577, which Applicant submits is baseless).

## C. CONCLUSION

Applicant has undertaken in its amended answer to remove two affirmative defenses. It respectfully submits the other affirmative defenses should remain as set forth in its amended answer, and that its amended answer be accepted at this very early stage in the proceeding. Applicant also requests that a discovery/settlement conference be held with the participation of the presiding Interlocutory Attorney.

Dated: New York, N.Y.
December 29, 2014

Respectfully submitted,
BAKER & HOSTETLER LLP

Counsel for Applicant

By: _____

Robert B.G. Horowitz
Nicholas M. Rose
45 Rockefeller Plaza, 14th Floor
New York, N.Y. 10111
212 589-4200

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stipulate to service via email, counsel for Applicant will renew that request and will advise the Presiding Interlocutory Attorney accordingly.

CERTIFICATE OF SERVICE

I hereby certify that the foregoing MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE AND IN SUPPORT OF APPLICANT'S MOTION TO AMEND ANSWER TO NOTICE OF OPPOSITION and AMENDED ANSWER TO NOTICE OF OPPOSITION and Exhibits were served by first class mail, postage prepaid, on Opposer's counsel, this 29th day of December, 2014 by first class mail, postage prepaid, in an envelope addressed as follows:

Steven A. Freund, Esq.
Law Offices of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091

Ana Dos Santos

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

| | | |
|---|---|---|
| OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO., | ) | |
| Opposer, | ) | Opposition No.: 91218523 |
| v. | ) | |
| 13TH AVE FISH MARKETING INC., DBA FREUND'S FISH, | ) | |
| Applicant. | ) | |

**AMENDED ANSWER TO NOTICE OF OPPOSITION**

Applicant, 13TH AVE FISH MARKETING INC. DBA FREUND'S FISH (hereinafter referred to as "Applicant"), through its counsel below, responds to the allegations in the Notice of Opposition as follows:

1. Lacks sufficient knowledge or information to respond to the allegations of paragraph 1 of the Notice of Opposition and, therefore, denies same.

2. Admits that "SINCE 1856" AND "BAKING CO." have been disclaimed from Registration No. 4,500,792 but otherwise lacks sufficient knowledge or information to respond to the remaining allegation in paragraph 2 of the Notice of Opposition and, therefore, denies same.

3. Lacks sufficient knowledge or information to respond to the allegations of paragraph 3 of the Notice of Opposition and, therefore, denies same. Applicant also avers that the appearance of Opposer's alleged common law mark is so small in the Notice of Opposition that it is incapable of being scrutinized.

4. Lacks sufficient knowledge or information to respond to the

allegations of paragraph 4 of the Notice of Opposition and, therefore, denies same.

5. Lacks sufficient knowledge or information to respond to the allegations in paragraph 5 of the Notice of Opposition and, therefore, denies same.

6. Lacks sufficient knowledge or information to respond to the allegations in paragraph 6 of the Notice of Opposition and, therefore, denies same.

7. Lacks sufficient knowledge or information to respond to the allegations in paragraph 7 of the Notice of Opposition and, therefore, denies same.

8. Lacks sufficient knowledge or information about the allegations in paragraph 8 of the Notice of Opposition and, therefore, denies same.

9. Avers that the allegation in paragraph 9 of the Notice of Opposition calls for a legal conclusion to which no response is required but, in any event, denies same.

10. Denies that Opposer's alleged marks have become famous to qualify for protection under Section 43(c) of the Lanham Act as alleged in paragraph 10 of the Notice of Opposition and lacks sufficient knowledge or information about the remaining allegations in said paragraph and, therefore, denies same.

11. Admits that Opposer filed its trademark applications on December 10, 2013 but denies the remaining allegations in paragraph 11 of the Notice of Opposition.

12. In response to Paragraph 12 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 11 above.

13. Lacks sufficient knowledge to respond to the allegations in the first sentence of paragraph 13 of the Notice of Opposition and, therefore, denies same.

Applicant also admits that Opposer's claimed filing dates in paragraph 8 of the Notice of Opposition precedes Applicant's filing dates of its applications.

14. Lacks sufficient knowledge or information to respond to the allegations in paragraph 14 of the Notice of Opposition and, therefore, denies same.

15. Admits the allegations in paragraph 15 of the Notice of Opposition and avers that endorsement or sponsorship by Opposer is unnecessary.

16. Denies the allegations in Paragraph 16 of the Notice of Opposition and avers that "FAMOUS" has been disclaimed in the applications that are the subject of this opposition proceeding.

17. Denies the allegations in paragraph 17 of the Notice of Opposition; Applicant's marks have the word "FREUND'S", not FREUND.

18. Avers that the allegation in paragraph 18 of the Notice of Opposition calls for a legal conclusion to which no response is required but, in any event, denies same.

19. Denies the allegations in Paragraph 19 of the Notice of Opposition.

20. Denies the allegations in Paragraph 20 of the Notice of Opposition and avers that the common law mark shown therein is so small as to be incapable of being scrutinized.

21. Lacks sufficient knowledge or information to respond to the allegations in paragraph 21 of the Notice of Opposition and avers that the common law mark shown in the Notice of Opposition is so small as to be incapable of being scrutinized.

22. Denies the allegations in Paragraph 22 of the Notice of Opposition.

23. Denies the allegations in Paragraph 23 of the Notice of Opposition.

24. Avers that the allegations in paragraph 24 of the Notice of Opposition call for a legal conclusion to which no response is required but, in any event, denies same.

25. Avers that the allegations in paragraph 25 of the Notice of Opposition call for a legal conclusion to which no response is required but, in any event, denies same.

26. Objects to the first sentence of Paragraph 26 of the Notice of Opposition as vague and unintelligible and lacks sufficient knowledge or information to respond to the allegations therein and allegations made in the remaining sentences about what goods Opposer has made and what services Opposer has rendered and, therefore, denies same.

27. Denies the allegations in Paragraph 27 of the Notice of Opposition.

28. Lacks sufficient knowledge or information about Opposer's alleged goods and services to respond to the allegations in paragraph 28 of the Notice of Opposition and, therefore, denies same.

29. Lacks sufficient knowledge or information about Opposer's alleged goods to respond to the allegations in paragraph 29 of the Notice of Opposition and, therefore, denies same.

30. Lacks sufficient knowledge or information about Opposer's alleged goods to respond to the allegations in paragraph 30 of the Notice of Opposition and, therefore, denies same.

31. Denies the allegations in Paragraph 31 of the Notice of Opposition.

32. In response to Paragraph 32 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 31 above.

33. Denies the allegations in paragraph 33 of the Notice of Opposition.

34. Lacks sufficient knowledge to respond to the allegations in paragraph 34 of the Notice of Opposition and, therefore, denies same.

35. Denies the allegations as to fame sufficient for a claim under Section 43(c) in paragraph 35 of the Notice of Opposition.

36. Lacks sufficient knowledge to respond to the allegations in paragraph 36 of the Notice of Opposition and, therefore, denies same.

37. Denies the allegations in Paragraph 37 of the Notice of Opposition.

38. Denies the allegations in Paragraph 38 of the Notice of Opposition.

39. In response to Paragraph 39 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 38 above.

40. Admits the allegations in paragraph 40 of the Notice of Opposition.

41. Avers that the allegation in paragraph 41 of the Notice of Opposition call for a legal conclusion to which no response is required but, in any event, denies same.

42. Denies the allegations in paragraph 42 of the Notice of Opposition and avers that the goods in its applications are "gefilte fish, fresh fish, not live, frozen fish, canned tuna fish, and breaded fish fillets".

43. Avers that the allegation in paragraph 43 of the Notice of Opposition call for a legal conclusion to which no response is required. Further Applicant

admits that its mark incorporates the design of a fish but otherwise denies the allegations in said paragraph.

44. Denies the allegations set forth in paragraph 44 of the Notice of Opposition.

45. In response to Paragraph 45 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 44 above.

46. Admits the allegation in paragraph 46 of the Notice of Opposition that at the time of filing application Serial No. 86/139,577, the drawing of the mark contained the "®", and avers that the symbol is unregistrable matter.

47. Admits the allegation in paragraph 47 of the Notice of Opposition that it relied upon the same specimen of use for each application that showed gefilte fish with the mark appearing as in the drawing of the application as originally filed but otherwise denies the allegations in this paragraph.

48. Admits the allegations in paragraph 48 of the Notice of Opposition that it received an Office Action on March 27, 2014, in which the USPTO Examiner requested Applicant to submit a new drawing with the ® symbol deleted from the mark because the symbol "is not part of the mark and is not registrable" and denies the remaining allegations in this paragraph to the extent they suggest the USPTO Examiner advised the ® symbol may not be used in connection with a mark until it is registered with the USPTO.

49. Admits the allegation in paragraph 49 of the Notice of Opposition.

50. Objects to paragraph 50 in the Notice of Opposition as being vague and unintelligible but, in any event, denies same.

51. Objects to paragraph 51 in the Notice of Opposition as being vague and unintelligible but, in any event, denies same.

52. Denies the allegations in Paragraph 52 of the Notice of Opposition.

53. Applicant responds to the allegations in Paragraph 53 of the Notice of Opposition that the specimens of use Applicant submitted for its applications speak for themselves and that Applicant complied with USPTO requirements. Applicant otherwise denies the allegations in this paragraph.

54. Objects to paragraph 54 in the Notice of Opposition as being vague and unintelligible but to the extent the paragraph is understood, admits it has used the mark for its goods with the "®".

55. Objects to paragraph 55 in the Notice of Opposition as being vague and unintelligible but admits that it has used for its goods the mark with the "®" symbol and avers such use was inadvertent and without any intent to deceive or mislead, and that Applicant is discontinuing such use.

56. Denies the allegations in paragraph 56 of the Notice of Opposition.

57. Denies the allegations in paragraph 57 of the Notice of Opposition and avers that its dates of first use are correct.

58. Denies the allegations in paragraph 58 of the Notice of Opposition and avers no willful misrepresentations of any kind occurred.

**AFFIRMATIVE DEFENSES**

First affirmative defense.

59. Applicant's use and registration of its marks as applied to its goods is not likely to cause confusion of any kind with Opposer's alleged use and registration of its mark in connection with its alleged goods and services.

Second affirmative defense.

60. Applicant has used the FREUND'S FAMOUS word mark for at least 40 years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods.

Third affirmative defense.

61. Applicant has used the FREUND'S FAMOUS design mark for at least five years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods.

Fourth affirmative defense.

62. Applicant's use of the federal registration symbol has been inadvertent and without intent to mislead or deceive, and Applicant is discontinuing such use.

Fifth affirmative defense.

63. Whatever fame Opposer's marks might possess is insufficient for dilution protection under Section 43(c) of the Lanham Act.

Sixth affirmative defense.

64. On information and belief, Opposer has not used its mark in connection with "private label baking services" as the specimens of use it submitted to cause the USPTO to issue Registration No. 4500792 do not refer to such services and thus do not meet the requirements of Section 1301.04 Trademark Manual of Examining Procedure et seq. Opposer thus has no rights to assert in such mark as applied to such services, it never having been used, or, if it was used, Opposer has abandoned its rights in its mark.

WHEREFORE, Opposer prays that the Notice of Opposition be dismissed.

Date: New York, N.Y.
December 29, 2014

Respectfully submitted,
BAKER & HOSTETLER LLP

Counsel for Applicant

By:_____

Robert B.G. Horowitz
Nicholas M. Rose
45 Rockefeller Plaza, 14th Floor
New York, N.Y. 10111
212 589-4200

CERTIFICATE OF SERVICE

I hereby certify that the foregoing AMENDED ANSWER TO NOTICE OF OPPOSITION and Exhibits was served by first class mail, postage prepaid, on Opposer's counsel, this 29th day of December, 2014 by first class mail, postage prepaid, in an envelope addressed as follows:

Steven A. Freund, Esq.
Law Offices of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091

Ana Dos Santos