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Filing date: **09/22/2015**

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

Proceeding	91218523
Party	Defendant 13th Ave Fish Market Inc. DBA Freund's Fish
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	09/22/2015
Attachments	2015-09-22-Applicant Motion for Leave to File Second Amended Answer and Proposed Second Amended Answer.pdf(185449 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.
-----><

**APPLICANT 13th AVE FISH MARKET INC. DBA FREUND'S
FISH'S MOTION FOR LEAVE TO FILE A SECOND AMENDED
ANSWER TO NOTICE OF OPPOSITION**

Pursuant to Trademark Rule 37 C.F.R. §§ 2.107, Federal Rule of Civil Procedure 15(a) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 507.02, Applicant 13th Ave Fish Market Inc. DBA Freund's Fish ("Applicant"), by and through its undersigned counsel, hereby moves the Board for an order permitting Applicant to amend its Amended Answer to Notice of Opposition and to submit its proposed Second Amended Answer to Notice of Opposition, for the purposes of streamlining the pleadings and discovery in this proceeding, and further to accurately reflect information that has become known to Applicant in the course of responding to discovery requests. The grounds for this motion are more fully set forth in the accompanying Memorandum of Law, as required by 37 C.F.R. § 2.127(a).

MEMORANDUM OF LAW

By this Motion, Applicant seeks to amend its Amended Answer to Notice of Opposition to remove one affirmative defense that has been stricken by the Board, and to further develop its defense regarding Applicant's length of use of its marks.

I. PROCEDURAL BACKGROUND

Opposer, Oakhurst Industries Inc. DBA Freund Baking Co. ("Opposer") brought this opposition proceeding on September 24, 2014, against Applicant's application for registration of its FREUND'S FAMOUS word mark (Serial No. 86/139,432) and its FREUND'S FAMOUS design mark (Serial No. 86/139/577). Applicant filed its Answer to Notice of Opposition on November 5, 2014, raising eight affirmative defenses. Opposer moved to strike all eight of Applicant's affirmative defenses on December 1, 2014.

Applicant opposed the motion to strike, and simultaneously moved for leave to amend its responsive pleading by removing two affirmative defenses (failure to state a claim, and laches and acquiescence). Applicant also sought to amend its eighth Affirmative Defense (which became the Sixth Affirmative Defense in the amended pleading) 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" to its allegation that Opposer does not actually use its marks in connection with private label baking services. [Dkt. entry no. 10.]

The Board granted Applicant's motion to amend, holding that Applicant's proposed Amended Answer to Notice of Opposition was now its operative pleading, but struck the Sixth Affirmative Defense, as amended, as an impermissible collateral attack on a pleaded registration. [Dkt. entry no. 12, 3-6-15 Order, at 3-4.] Opposer's motion to strike Applicant's affirmative defenses was otherwise denied. [*Id.*]

II. ARGUMENT

A. Leave to Amend Should be Granted.

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 Fed. R. Civ. P. 15(a)(2); *Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

The Board has a long history of granting leave to amend pleadings. Under the liberal standard for amendment, such motions should be granted unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1383 (TTAB 1991) (permitting applicant to amend its answer in opposition proceeding). As set forth below, the proposed amendment neither violates settled law nor would be prejudicial to the rights of Opposer.

B. The Proposed Amendment to Answer to Notice of Opposition.

Applicant moves to file a second amended pleading that would remove the now-stricken Sixth Affirmative Defense. The proposed amendment would further amend the Second Affirmative Defense with respect to the allegations regarding Applicant's history of use of its marks for various goods and services, in order for the pleading to conform to the facts that have emerged in discovery.

Both a redlined version showing the proposed amendments to Applicant's current operative pleading and a clean version of the Proposed Second Amended Answer are attached hereto, pursuant to TBMP § 507.01. The Second Affirmative

Defense as stated in the Amended Answer is as follows:

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.

Applicant now moves to amend that affirmative defense to state as follows:

Second affirmative defense.

60. Applicant has used a number of marks containing the element FREUND'S, including FREUND'S FISH MARKET, FREUND'S FAMOUS GEFILTE FISH, FREUND'S FAMOUS, FREUND'S, and FREUND'S FISH, in the past without any instances of actual confusion with any marks Opposer may apply to its goods.

61. FREUND'S FISH MARKET and FREUND'S have been in use for at least 55 years as a trademark in connection with fresh and frozen fish, and gefilte fish, and the wholesale and retail sale of such goods.

62. FREUND'S FISH MARKET, FREUND'S and FREUND'S FISH have been used for breaded fish fillets during the past 10-15 years.

63. The FREUND'S FAMOUS word mark has been used as a trademark in connection with gefilte fish for approximately 15-20 years.

64. FREUND'S FISH has been used as a trademark for smoked fish at least as early as 2004.

65. The FREUND'S word mark has been used as a mark for

prepared foods sold on a takeout basis, namely, sushi, grilled fish, kugel, salads, sandwiches and wraps and as a brand for such goods since 2005, and as a trademark for herring and dips at least as early as 2006.

66. The FREUND'S FAMOUS word mark has been used in connection with fresh fish, frozen fish, breaded fish filets, sauces, and marinades since 2009, except for the canned fish, herrings and dips for which use commenced during 2010.

67. The FREUND'S FAMOUS design mark has been in use for the above goods and services since 2009, except for the canned fish, herrings and dips for which use commenced during 2010.

Thus, the proposed amendment to the Second Affirmative Defense simply clarifies the length of time in which Applicant has continuously used its marks containing the element FREUND'S without any instances of actual confusion with Opposer's alleged marks, all of which Opposer alleges "feature the term FREUND" (Notice of Opposition, Par. 3) and "FREUND" is asserted to be the dominant feature of Opposer's Marks (Notice of Opposition, Pars. 20-21).

Opposer may argue against this motion that Applicant's marks that are not the subject of this proceeding are not relevant should not be included in its second affirmative defense. Such use by Applicant is quite relevant, however, because Applicant's use of marks over the years comprising FREUND'S *per se* and FREUND'S with other literal elements, bears on the lack of a likelihood of confusion under factor No. 8 in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) ("The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion").

Further, Opposer alleges its marks are famous (Notice of Opposition, ¶ 10). Fame is the fifth factor in a *DuPont* likelihood of confusion analysis (“The fame of the prior mark [sales, advertising, length of use]”). Applicant’s use over the years of the marks it wishes to now add in clarification of the second affirmative defense becomes more relevant because, if the facts as alleged in the proposed amended second affirmative defense are proven, the lack of instances of actual confusion undercuts the notion that Opposer’s alleged marks are famous.

C. No Prejudice Insures to Opposer by Applicant’s Proposed Amendment.

There would be no prejudice to Opposer if Applicant is granted leave to amend its responsive pleading. The proceedings are still in the early stages of discovery, with over three months until discovery closes. *See Zanella Ltd. v. Nordstrom Inc.*, 90 U.S.P.Q.2d 1758, 1759 (TTAB 2009) (finding no prejudice in allowing an amendment to the pleadings with approximately three months remaining in the discovery period). Indeed, the Board has found no prejudice in other proceedings, even at later stages of discovery. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (no undue prejudice to respondent when motion to amend was filed prior to opening of petitioner’s testimony period); *see also Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989) (respondent not prejudiced when Board permits amended pleadings during discovery stage).

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. Finally, there is no surprise to Opposer in the proposed amendment, insofar as the proposed amendment conforms to an interrogatory response that Applicant recently provided to Opposer.

III. CONCLUSION

Applicant has undertaken in its proposed Second Amended Answer to remove one stricken defense, and to further clarify the allegations set forth in its Second Affirmative Defense. It respectfully submits the other affirmative defenses should remain as set forth in its amended answer, and that its Second Amended Answer be accepted at this early stage in the proceeding. Accordingly, Applicant respectfully requests that this Motion to Amend Answer to Notice of Opposition be granted.

Dated: September 22, 2015

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

CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S MOTION FOR LEAVE TO FILE A SECOND AMENDED ANSWER TO NOTICE OF OPPOSITION and PROPOSED SECOND AMENDED ANSWER TO NOTICE OF OPPOSITION were served by first class mail, postage prepaid, on Opposer's counsel, this 19th day of September, 2015, 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

/s/ Lesley M. Grossberg
Lesley M. Grossberg

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

OAKHURST INDUSTRIES, INC. DBA)
FREUND BAKING CO.,)

Opposer,)

v.)

13TH AVE FISH MARKET~~ING~~ INC.,)
DBA FREUND'S FISH,)

Applicant.)

Opposition No.: 91218523

SECOND AMENDED ANSWER TO NOTICE OF OPPOSITION

Applicant, 13TH AVE FISH MARKET~~ING~~ 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 a number of marks containing the element FREUND'S, including FREUND'S FISH MARKET, FREUND'S FAMOUS GEFILTE FISH, FREUND'S FAMOUS, FREUND'S, and FREUND'S FISH, in the past without any instances of actual confusion with any marks Opposer may apply to its goods.

61. FREUND'S FISH MARKET and FREUND'S have been in use for at least 55 years as a trademark in connection with fresh and frozen fish, and gefilte fish, and the wholesale and retail sale of such goods.

62. FREUND'S FISH MARKET, FREUND'S and FREUND'S FISH have been used for breaded fish fillets during the past 10-15 years.

63. The FREUND'S FAMOUS word mark has been used as a trademark in connection with gefilte fish for approximately 15-20 years.

64. FREUND'S FISH has been used as a trademark for smoked fish at least as early as 2004.

65. The FREUND'S word mark has been used as a mark for prepared foods sold on a takeout basis, namely, sushi, grilled fish, kugel, salads, sandwiches and wraps and as a brand for such goods since 2005, and as a trademark for herring and dips at least as early as 2006.

66. The FREUND'S FAMOUS word mark has been used in connection with fresh fish, frozen fish, breaded fish filets, sauces, and marinades since 2009, except for the canned fish, herrings and dips for which use commenced during 2010.

67. The FREUND'S FAMOUS design mark has been in use for the above goods and services since 2009, except for the canned fish, herrings and dips for which use commenced during 2010.

~~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.

~~6168.~~ 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.

~~6269.~~ 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.

~~6370.~~ 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.

Dated: September 19, 2015

/s/ Lesley McCall Grossberg
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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 a number of marks containing the element FREUND'S, including FREUND'S FISH MARKET, FREUND'S FAMOUS GEFILTE FISH, FREUND'S FAMOUS, FREUND'S, and FREUND'S FISH, in the past without any instances of actual confusion with any marks Opposer may apply to its goods.

61. FREUND'S FISH MARKET and FREUND'S have been in use for at least 55 years as a trademark in connection with fresh and frozen fish, and gefilte fish, and the wholesale and retail sale of such goods.

62. FREUND'S FISH MARKET, FREUND'S and FREUND'S FISH have been used for breaded fish fillets during the past 10-15 years.

63. The FREUND'S FAMOUS word mark has been used as a trademark in connection with gefilte fish for approximately 15-20 years.

64. FREUND'S FISH has been used as a trademark for smoked fish at least as early as 2004.

65. The FREUND'S word mark has been used as a mark for prepared foods sold on a takeout basis, namely, sushi, grilled fish, kugel, salads, sandwiches and wraps and as a brand for such goods since 2005, and as a trademark for herring and dips at least as early as 2006.

66. The FREUND'S FAMOUS word mark has been used in connection with fresh fish, frozen fish, breaded fish filets, sauces, and marinades since 2009, except for the canned fish, herrings and dips for which use commenced during 2010.

67. The FREUND'S FAMOUS design mark has been in use for the above goods and services since 2009, except for the canned fish, herrings and

dips for which use commenced during 2010.

Third affirmative defense.

68. 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.

69. 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.

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

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

Dated: September 19, 2015

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