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

Proceeding	91218523
Party	Plaintiff Oakhurst Industries, Inc. DBA Freund Baking Co.
Correspondence Address	STEVEN A. FREUND Law Office of Steven A. Freund P.O. BOX 911457 LOS ANGELES, CA 90091 UNITED STATES sfreund@freundlawfirm.com
Submission	Opposition/Response to Motion
Filer's Name	Steven Freund
Filer's e-mail	sfreund@freundlawfirm.com
Signature	/Steven Freund/
Date	10/13/2015
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO., Opposer,	)	Opposition No. 91218523
	)	Application Serial No. 86/139,432 Mark: FREUND'S FAMOUS Filing Date: December 10, 2013
v.	)	Application Serial No. 86/139,577 Mark: Freund's Filing Date: December 10, 2013
13TH AVE FISH MARKET INC. DBA FREUND'S FISH, Applicant	)	

OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO FILE A SECOND AMENDED ANSWER TO NOTICE OF OPPOSITION

Opposer, Oakhurst Industries, Inc. DBA Freund Baking Co. ("**Opposer**"), hereby opposes Applicant 13th Ave Fish Market Inc. DBA Freund's Fish's ("**Applicant**") Motion for Leave to File a Second Amended Answer to Notice of Opposition ("**Motion**"). The Motion should be denied because Applicant has unduly delayed in filing the Motion, which would cause prejudice to Opposer. Additionally, what the Motion is seeking to add contradicts and confuses matters within the Answer. The Motion is further unnecessary because Applicant is seeking to delete matter from its First Amended Answer which has already been stricken. Finally, leave to amend would be futile due to the impermissibility of the matter that Applicant is seeking to add to its Answer. As such, the Motion should be denied.

I. THE MOTION SHOULD BE DENIED BECAUSE APPLICANT IS SEEKING TO ADD CONFUSING MATTER TO ITS ANSWER AND HAS UNDULY DELAYED IN FILING THE MOTION

A. Applicant's Intentional Inconsistency Regarding Its First Use Dates Is Well-Documented

Applicant has unduly delayed in filing the Motion, seeking to add information that was already in its possession for quite some time -- rendering the Motion untimely. *See* Trademark Trial and Appeal Board Manual of Procedure ("**TBMP**") §507.02(a). Applicant seeks to change (yet again) the first use dates for its two marks that are the subject of this proceeding and are being opposed by Opposer: Application Serial No. 86/139,432 for the word mark "FREUND'S FAMOUS" and Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS). Also, Applicant is seeking to add information regarding marks that are not the subject of this proceeding, along with their supposed first use dates. Motion at pgs. 4-5. Applicant's history of gamesmanship regarding its dates of use started from the time of filing its Application Serial Nos. 86/139,432 and 86/139,577 and has continued throughout this proceeding. As discussed more fully below, Applicant has unduly delayed in seeking its current proposed amendment.

On December 10, 2013, Applicant filed its Applications Serial Nos. 86/139,432 and 86/139,577, stating the first use and first use in commerce dates for both marks in these applications as **October 1, 2013**. Application Serial Nos. 86/139,432 and 86/139,577, December 10, 2013. [Emphasis added.]

On November 5, 2014, Applicant filed its initial Answer, where, in Paragraph 57, it "..aver[red] that its dates of first use [as stated to be October 1, 2013 in its Application Serial Nos. 86/139,432 and 86/139,577] are correct." Dkt. entry no. 4 at pg. 7, ¶ 57. In Paragraph 61 of that same Answer, for its Third Affirmative Defense, Applicant stated: "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." Id. at pg. 8, ¶ 61. In Paragraph 62 of the Answer, for its Fourth Affirmative Defense, Applicant stated: "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." Id. at pg. 8, ¶ 62. In Applicant's initial Answer, as can be clearly seen above, Applicant contradicted itself by stating conflicting first use dates: First, October 1, 2013 for both of its marks (Application Serial Nos. 86/139,432 and 86/139,577). Then, forty years prior for the word mark FREUND'S FAMOUS (Application Serial No. 86/139,432) and five years prior for the design mark it calls the FREUND'S FAMOUS design mark (Application Serial No. 86/139,577).

On December 1, 2014, Opposer filed a Motion to Strike Applicant's Affirmative Defenses. Dkt. entry no. 7. In its Motion to Strike, Opposer pointed out the above-mentioned inconsistency regarding Applicant's first use dates in Paragraphs 57, 61 (Applicant's Third Affirmative Defense) and 62 (Applicant's Fourth Affirmative Defense) in Applicant's Answer. Id. at pg. 5.

On December 29, 2014, Applicant filed a combined Opposition to the Motion to Strike and a Motion to Amend its Answer, along with its Amended Answer (the "**First Amended Answer**"). Dkt. entry no. 10. In its Opposition to the Motion to Strike, Applicant denied that there was any inconsistency regarding its first use dates as stated in its Application Serial Nos. 86/139,432 and 86/139,577 with what they were later stated to be in Applicant's Third and Fourth Affirmative Defenses in its Answer. Id. at pg. 4. Applicant ridiculously claimed the first use date of at least as early as October 1, 2013 as stated in both its Application Serial Nos. 86/139,432 and 86/139,577, is "entirely *consistent* with having used the marks for 40 years and 5 years, respectively." Id. Applicant proclaimed that "[i]t is simply a canard to suggest any inconsistency between [the first use dates as stated in the applications with the first use dates as stated in the Answer]." Id. Notably, Applicant firmly stood by the above inconsistent dates as its first use dates for its Application Serial Nos. 86/139,432 and 86/139,577 and, in the First Amended Answer, did not change its above-mentioned response in Paragraph 57 (Id. at pg. 15), nor did it change anything about its above-mentioned Third and Fourth Affirmative Defenses (other than retitling them the Second and Third Affirmative Defenses) (Id. at pg. 16). Applicant could have taken the opportunity in the

First Amended Answer to state new first use dates for the marks at issue especially in light of Opposer asserting the inconsistency, but deliberately chose not do so.

Applicant's adherence to the above-mentioned first use dates did not end up being so steadfast when, on September 22, 2015 (almost a year to the day of the filing of the Notice of Opposition) Applicant filed its Motion for Leave to File a Second Amended Answer to Notice of Opposition, along with its proposed Second Amended Answer (the "**Second Amended Answer**"). Applicant is seeking to delete, in its entirety, the wording of the Second Affirmative Defense of the First Amended Answer (which was the same exact wording of the Third Affirmative Defense in its initial Answer), which had stated that Applicant had used its FREUND'S FAMOUS word mark (Application Serial No. 86/139,432) for forty years. Motion at pgs. 4-5. Applicant now wants to amend the Second Affirmative Defense to state that instead of the FREUND'S FAMOUS word mark being used by Applicant for forty years with its fish products, it has been used "...in connection with gefilte fish for approximately 15-20 years," (Mot. at pg. 4, ¶ 63), and 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." Mot. at pg. 5, ¶ 66. Applicant is pleading these above *three* entirely new first use dates for the FREUND'S FAMOUS mark, and has not amended its averment that the first use date of October 1, 2013 is correct in Paragraph 57 of the proposed Second Amended Answer (Mot. at pg. 15, ¶ 57), which leaves four different first use dates for FREUND'S FAMOUS, confusingly enough. Also, it should be noted that Applicant is trying to add goods that are not a part of either of the applications that are the subject of this proceeding (sauces, marinades and dips), which further confuses matters in its proposed Second Amended Answer.

The confusion continues in Applicant's Motion, because, with regard to the FREUND'S FAMOUS design mark that is the subject of Application Serial No. 86/139,577, Applicant is seeking to add to the Second Affirmative Defense (though this affirmative defense only dealt with the FREUND'S FAMOUS word mark originally) to state: "[t]he 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." Mot. at pg. 5, ¶67. It is unclear exactly which "above goods" Applicant is deeming to apply to the design mark. There are many goods and also services in the proposed Second Amended Answer, including goods and services that are not a part of either of the applications that are the subject of this proceeding (sauces, marinades, dips, wholesale and retail sales of fish, prepared foods sold on a takeout basis, sushi, kugel, salads, sandwiches, and wraps). Interestingly enough, Applicant did not change the Third Affirmative Defense in the proposed Second Amended Answer which stated that "Applicant has used the FREUND'S FAMOUS design mark for at least five years for its fish products..." Mot. at pg. 17, ¶ 68. As such, there now appears to be three conflicting dates of use for the FREUND'S FAMOUS design mark, emblematic of the confusion within the proposed Second Amended Answer.

B. <u>Applicant Seeks To Add To The Proceeding Marks As Well As Goods and Services That Are Not Being Opposed</u>

In its Motion, Applicant seeks to add to the proceeding FREUND'S FISH MARKET, FREUND'S FAMOUS GEFILTE FISH, FREUND'S, and FREUND'S FISH (Mot. at pgs. 4-5) along with goods and services that are not covered by its two applications being opposed, namely "wholesale and retail sale" of fresh and frozen fish (Id.), "prepared foods sold on a takeout basis, namely sushi,...kugel, salads, sandwiches and wraps, dips....sauces, and marinades..." (Id. at pg. 5). These newly specified marks and goods and services are patently not relevant to the proceeding because they are not the two subject marks in Applicant's applications nor are any of these enumerated goods and services listed in those two applications. Applicant's argument that the new marks are relevant is based on a overbroad reading of *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) ("***DuPont***"). *DuPont* dealt with the appeal from a decision of the Trademark Trial and Appeal Board involving a mark that the applicant *was seeking to register*, and mentioned nothing about any other marks the applicant was using that it was not seeking to register. *Id.* *DuPont* does not, nor does it purport to stand for the proposition that its holding should cover other marks and goods and

services of Applicant's that are not the subject of the proceeding. As such, Applicant is attempting to extrapolate from *DuPont* that it can use the *DuPont* factors to make relevant the marks that Applicant is seeking to add to this proceeding, when in fact *DuPont's* factors are solely used to apply to a comparison of whatever marks Applicant is trying to register with the marks being cited against the Applicant. *Id.*

C. <u>Opposer Will Suffer Prejudice If The Motion Is Granted</u>

Undue delay in filing a motion for leave to amend will be found if the new matter sought to be added is based on facts within the movant's knowledge prior to the institution of the proceeding. *See Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285 (TTAB 2008) and *Trek Bicycle Corporation v. StyleTrek Limited,* 64 U.S.P.Q.2d 1540 (TTAB 2001). In this case, Applicant's undue delay is apparent because all the matter it is seeking to add in its Motion was in its possession *significantly prior* to Opposer's filing of the Notice of Opposition. As stated earlier, the Notice of Opposition was filed on September 24, 2014. It strains even the remotest sense of credibility for Applicant to claim that it did not know what marks it was using, nor the goods it was using with such marks (facts which are a fundamental concept to this proceeding) for nearly a year after the Notice of Opposition, or nine months ago when it filed its First Amended Answer. Moreover, to accept what Applicant is stating as true, would mean that (among other things that strain credulity) Applicant did not realize it was using some of these marks for goods for the *past fifty-five years*! Mot. at pg. 4. If for the sake of argument this statement is true, it should be considered willful ignorance, which should not be rewarded by the Board. For the reasons above, it is completely misleading and disingenuous for Applicant to state that the information that Applicant is seeking to add in the proposed Second Amended Answer only "...has become known to Applicant in the course of responding to discovery requests." Mot. at pg. 1.

Applicant is engaging in its characteristic "hide the ball" tactics in filing this Motion, especially because Opposer had raised the issue of Applicant's dubious and inconsistent statements regarding its first use dates long ago in this proceeding (on December 1, 2014) when Opposer filed its initial Motion to Strike Applicant's Affirmative

Defenses. Dkt. entry no. 7 at pg. 5. In responding to Opposer's Motion to Strike, Applicant did not mention any of the marks and goods and services it is seeking to add in the proposed Second Amended Answer. Instead, Applicant doubled down on its earlier stated inconsistent first use dates in the Answer and did nothing to change them in its Opposition to the Motion to Strike and First Amended Answer. Dkt. entry no. 10 at pgs. 4, 15-16. Furthermore, Applicant declared there was no inconsistency with its stated first use date of October 1, 2013 in its Applications and stated first use date of forty years prior in its Answer. Dkt. entry no. 10 at pg. 4. It defies credibility that Applicant, at the time of responding to the Motion to Strike, did not know about the matters it is now seeking to add. Or, if it did not, it insolently chose to hide its head in the sand about this information. Now, a year into the proceeding, and after substantial motion practice, and Applicant's filing of two Answers, Applicant is changing its tune. The Board should not provide Applicant the sought relief when undeniably Applicant had knowledge of the subject of its proposed amendment for a long period of time and did not act upon it or perhaps hid it.

The matter that Applicant is seeking to add in the proposed Second Amended Answer does not, unlike what Applicant says, "clarif[y] the length of time in which Applicant has continuously used its marks..." Mot. at pg. 5. As discussed earlier, the matter that Applicant is seeking to add involves more inconsistent first use dates for the two marks that are being opposed and adds marks, goods and services that are not involved in the proceeding, rendering the proposed Second Amended Answer a muddled mess. Applicant's weak statement that "...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" (Mot. at pg. 7) is entirely misleading and disingenuous. The interrogatory that Applicant is referring to was specifically directed at ***solely*** the two marks that are being opposed in this proceeding: Application Serial No. 86/139,432 for the word mark "FREUND'S FAMOUS" and Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS). Opposer had expressly defined in its discovery to

Applicant that such discovery was directly solely at the two foregoing marks – the sole two marks contained in both of Applicant's applications. Applicant would have the Board believe that any response to a discovery request would make for valid matter to add to a pleading via a motion to amend, even if it involves matters that are non-responsive to the request.

As support for the Motion, Applicant unconvincingly suggests that the removal of the already stricken Sixth Affirmative Defense in its proposed Second Amended Answer "...will thus serve to streamline and focus this proceeding..." Mot. at pg. 7. This is nonsense, considering that this defense was already stricken and thus given no consideration whatsoever in the Board Order on March 6, 2015. Dkt. entry no. 12 at pgs. 3-4. Opposer and the Board are perfectly capable of ignoring a stricken defense. A motion to amend that feebly seeks to justify itself, in part, by removing a long ago stricken defense should be scrutinized as being unnecessary and merely adding paperwork to a proceeding.

A motion to amend will be denied, even if filed with time left in the discovery period, when it is based on information within the movant's knowledge for a long period of time. *See Media Online Inc. v. El Clasificado, Inc.* 88 U.S.P.Q.2d 1285 (TTAB 2008), *citing Trek Bicycle Corporation v. StyleTrek Limited,* 64 U.S.P.Q.2d 1540 (TTAB 2001). This Motion comes almost exactly a year after the Notice of Opposition was filed and nine months after Applicant filed its First Amended Answer. In *Media Online Inc. v. El Clasificado, Inc.*, the motion to amend was filed seven months after the proceeding was instituted and in *Trek Bicycle Corporation v. StyleTrek Limited*, the motion to amend was filed eight months after the proceeding was instituted; both motions were denied as unduly delayed due to their being based on information within the movants' knowledge since the beginning of their respective proceedings. *See Media Online Inc. v. El Clasificado, Inc.* 88 U.S.P.Q.2d 1285 (TTAB 2008) and *Trek Bicycle Corporation v. StyleTrek Limited,* 64 U.S.P.Q.2d 1540 (TTAB 2001).

Both parties are well into their examination of this case and assessment of their respective claims and defenses, including being well into discovery. Granting the

Motion, which is based on two impermissible additional affirmative defenses (as explained below), would essentially force the parties to start the entire process over again. This would especially unreasonably burden and prejudice Opposer, because now Opposer would have to amend and re-serve discovery on Applicant, to make sure it addresses all the marks and goods and services that would be added in the proposed Second Amended Answer. As stated earlier, the discovery Opposer has served on Applicant was specifically restricted to *solely* to Application Serial No. 86/139,432 for the word mark "FREUND'S FAMOUS" and Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS). Opposer has already used up a substantial number of its allotted interrogatories. Furthermore, allowing applicant to defend its case in a "piecemeal" fashion (especially when Opposer has called Applicant out on this behavior before on this very same issue and Applicant has previously amended its Answer) would unfairly prejudice Opposer by significantly expanding the scope of this proceeding thereby increasing the time, effort, and money Opposer would have to spend in amending and re-serving such discovery along with having to change its strategy (yet again, because Applicant has amended its Answer before) in handling its case to conform to a third Answer of Applicant's. *See Media Online Inc. v. El Clasificado, Inc.* 88 U.S.P.Q.2d 1285 (TTAB 2008).

Rewarding Applicant's obvious withholding of facts within its knowledge for a long period of time to continually change its affirmative defenses (thereby prejudicing Opposer), would empower other parties in Board proceedings to do the same.

II. THE MOTION SHOULD BE DENIED BECAUSE LEAVE TO AMEND WOULD BE FUTILE

In its Motion, Applicant is actually seeking to add two different impermissible affirmative defenses to its pleading: the family of marks doctrine and tacking. Applicant has disguised these two defenses as merely an amendment of "...the Second Affirmative Defense with respect to the allegations regarding Applicant's history of use of its marks

for various goods and services"[1] (Mot. at pg. 3) and a clarification the Second Affirmative Defense (Mot. at 6).

What Applicant is seeking to do is establish that it possesses multiple marks with a term ("FREUND") common to Opposer's marks to establish superior rights to Opposer, namely, that it has a family of marks that it has allegedly used incorporating "FREUND" since prior to Opposer's use of its marks. *See* 4 McCarthy on Trademarks and Unfair Competition § 23:61 (4TH ed.). However, "[t]he family of marks doctrine is an argument available only to a plaintiff asserting rights, not to a defendant to prove a defense against a plaintiff's intervening rights." Id. *See also Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 U.S.P.Q.2d 1048 (TTAB 1992). Accordingly, this is a defense that is unavailable to Applicant, so the matter it is seeking to add about its other alleged "FREUND" marks should not be allowed.

In the alternative, Applicant is trying to "tack on" on its alleged use of an allegedly similar mark to the ones that are in issue in this proceeding to try to establish rights prior to Opposer's. *See* 4 McCarthy at § 3:172. However, "...in order for a party to successfully tack on such prior use, the previously used mark must be the legal equivalent of the mark in question and both marks must be considered the same by consumers." Id. Quite importantly, "[t]his test is applied strictly by the Board which will construe the test of legal equivalence as whether the marks should be regarded as one and the same." Id. In order to tack on prior use of one mark on to another, the marks must be legal equivalents. "To meet the legal equivalents test, the marks must be indistinguishable from one another..." *The Wet Seal, Inc. v. FD Management, Inc.*, 82 U.S.P.Q.2d 1629 (TTAB 2007). None of the marks that Applicant is seeking to add in its proposed Second Amended Answer are the "legal equivalent" of either its Application Serial No. 86/139,432 for the word mark "FREUND'S FAMOUS" or Application Serial No. 86/139,577 for the words and design mark (literal element FREUND'S FAMOUS); these

[1] Though, as stated earlier, this affirmative defense originally only dealt with one of the marks that was the subject of this proceeding (FREUND'S FAMOUS) and not the numerous unrelated marks Applicant is seeking to make relevant.

new marks are not "one and the same" as the two aforementioned marks (Id.), nor are they "indistinguishable" from such marks. *The Wet Seal, Inc. v. FD Management, Inc.*, 82 U.S.P.Q.2d 1629 (TTAB 2007). Consequently, tacking is a defense that is unavailable to Applicant, so the matter it is seeking to add about its other alleged marks should not be allowed.

When the movant of a motion to amend seeks a new defense, and the proposed pleading thereof is legally insufficient (as it is here), the Board will deny the motion for leave to amend. *See* TBMP § 507.02. Since the matter that Applicant is seeking to add is dealing with two affirmative defenses unavailable to it, leave to amend would be futile and the Board should deny the Motion.

III. CONCLUSION

Applicant has strategically withheld information in its possession for over a year. Presently, Applicant is seeking relief to dramatically enlarge the scope of these proceedings to include various marks, as well as, goods and services that are patently irrelevant to these proceedings and are not contained in Applicant's two applications. Applicant's Motion did not arise out of inadvertence or excusable neglect. Rather, Applicant's Motion solely arises out of Applicant's bad faith litigation tactics. For all the foregoing reasons, leave to amend would be inappropriate.

Respectfully Submitted,

Dated: October 13, 2015

By: _____

Steven A. Freund, Esq.
Attorney for Opposer
Law Office of Steven A. Freund
A Professional Corporation
P.O. Box 911457
Los Angeles, CA 90091

Phone: 310-284-7929

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO FILE A SECOND AMENDED ANSWER TO NOTICE OF OPPOSITION** has been served on Applicant's counsel via First Class U.S. Mail on October 13 2015, postage prepaid to:

Robert B.G. Horowitz
Baker & Hostetler LLP
45 Rockefeller Plaza, 14th Floor
New York, New York 10111-0100

Lesley McCall Grossberg
Baker & Hostetler LLP
2929 Arch Street
Cira Centre, 12th Floor
Philadelphia, PA 19104-2891

Steven A. Freund, Esq