

ESTTA Tracking number: **ESTTA703235**

Filing date: **10/20/2015**

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
Correspondence Address	ROBERT B.G. HOROWITZ BAKER & HOSTETLER LLP 45 ROCKEFELLER PLZ FL 14 NEW YORK, NY 10111-0100 UNITED STATES rhorowitz@bakerlaw.com, adossantos@bakerlaw.com, nydocketing@bakerlaw.com, lgrossberg@bakerlaw.com
Submission	Reply in Support of Motion
Filer's Name	Lesley McCall Grossberg
Filer's e-mail	lgrossberg@bakerlaw.com, rhorowitz@bakerlaw.com, bhipdocket@bakerlaw.com
Signature	/Lesley M. Grossberg/
Date	10/20/2015
Attachments	2015.10.20-Applicant's Reply Brief in Support of Motion to Amend.pdf(107407 bytes)

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

-----><
Oakhurst Industries, Inc. DBA Freund Baking Co.,

Opposer,

v.

Opposition No. 91218523

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

Applicant.
-----><

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

Pursuant to Trademark Rule 37 C.F.R. §§ 2.127(a), Applicant 13th Ave Fish Market Inc. DBA Freund's Fish ("Applicant"), by and through its undersigned counsel, hereby submits its reply brief in support of its Motion for Leave to File a Second Amended Answer to the Notice of Opposition (the "Motion") in this proceeding.

Opposer's opposition disregards the liberal standard for amendment of pleadings, Fed. R. Civ. P. 15(a)(2), and offers erroneous and misdirected interpretations of Applicant's proposed amendments. Applicant addresses each of these in turn. Because Opposer's own "confusion" regarding the proposed amended pleading is not a basis for denying a well-founded motion for leave to amend, and there is no prejudice to Opposer, Applicant respectfully requests that the motion to amend be granted.

I. There is No Prejudice to Opposer.

Opposer makes much of the fact that the Motion was filed “almost exactly a year after the Notice of Opposition was filed.” (Opp’n at 8.) Any delay in these proceedings lay solely at the feet of Opposer. Specifically, the “substantial motion practice” (Opp’n at 7) complained of by Opposer includes Opposer’s own Motion to Strike (docket no. 7). Moreover, a three-month delay in these proceedings can be attributed to Opposer. On the same day as the discovery conference before the Interlocutory Attorney (at which the Interlocutory Attorney expressed that the parties operate in disparate industries), Applicant communicated a settlement offer to Opposer. Opposer did not respond to that settlement offer for *three months*. (See docket nos. 15 & 17, Motions for Extension of Discovery.) Due to Opposer’s undue delay in responding to the settlement offer, the discovery period is still open, and is currently scheduled to close on January 5, 2015.

Moreover, the parties are still in the early stages of discovery. Both sides have served one set of Interrogatories and one set of Requests for Production. Applicant responded to Opposer’s discovery requests on September 10, 2015, and produced 1275 pages of responsive documents that same day, by CD-ROM sent to Opposer’s counsel. Opposer’s responses to Applicant’s discovery responses were also due on September 10, 2015. Opposer provided arguably substantive responses to, at most, four out of fifty-seven Requests for Production and to six out of seventeen Interrogatories, and interposed meaningless general objections or obstinate claims of vagueness or overbreadth to the rest. Opposer’s first production of documents was received by Applicant’s counsel more than one month later, on October 13, 2015. That production contains 149 pages of documents, of which 132 pages comprise the file wrappers for Opposer’s asserted registrations. Opposer’s counsel also informed Applicant’s counsel that Opposer would submit supplemental responses to Applicant’s discovery requests on

October 19, but has not met its own deadline. Opposer cannot claim undue prejudice and delay from Applicant's motion for leave to amend, when Opposer's own conduct in discovery evinces a lack of cooperation and candor that appears likely to necessitate intervention from the Board in the form of a motion to compel.¹

Opposer asserts that it would be prejudiced by the proposed amendment because "Opposer has already used up a substantial number of its allotted interrogatories" and have to "amend[] and re-serve[]" discovery. (Opp'n at 9.) This complaint of prejudice disregards the narrow scope of the proposed amendment. Moreover, Applicant has produced discovery responses for all of the marks identified in its proposed amendments.

In a similar vein, Opposer's reliance on *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285 (TTAB 2008) and *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540 (TTAB 2001) is unavailing. In both of those proceedings, the proposed amendments were sought by the plaintiff to add entirely new claims. In contrast, Applicant's proposed amendment merely clarifies an affirmative defense to conform to the evidence that has been brought to light through the process of responding to discovery requests.

Finally, Opposer's argument that the Motion should be denied "even if filed with time left in the discovery period" if the amendments are based on information "within the movant's knowledge for a long period of time" is inapplicable, and moreover, overstates the gravity of the proposed amendment. Applicant has used a substantial number of trademarks during its lengthy existence that incorporate the element FREUND'S. It was not until Applicant was responding to Opposer's discovery requests and gathering

¹ As mentioned above, Opposer represented to Applicant, through counsel, that it would be supplementing its inadequate discovery responses on October 19, 2015. Opposer notified the undersigned yesterday that its supplemental responses were "not ready" but would "be ready shortly," leaving Applicant currently unable to evaluate whether Board intervention is necessary to compel cooperation in the discovery process.

responsive documents that it had cause to closely inspect specimens of use of each of those marks and determine exactly which products had been sold under which marks, and when. That much is evident from the proposed amendment itself. So while Applicant was able to accurately and in good faith plead in its initial Answer that it had used the FREUND'S FAMOUS mark for "at least 40 years for its fish products," the proposed amendment would set forth with greater specificity which "fish products" it is referring to. No prejudice will inure to Opposer due to the substance of the amendment when the amendment merely reflects the facts and documents that were produced to Opposer in discovery.

II. "At Least As Early As" is Acceptable First Use Date Terminology

Much of Opposer's opposition to the Motion is based on a fundamental misunderstanding or disagreement over the term "*at least as early as* early as October 1, 2013" (emphasis added). This is how Applicant's first use of the applied-for marks was described in U.S. Serial Nos. 86/139,577 and 86/139,432. Yet Opposer repeatedly asserts in its opposition that Applicant has claimed October 1, 2013, without the "at least as early as" qualification, to be the claimed date of first use by Applicant. (See, e.g., Opp'n at 2 ["On December 10, 2013, Applicant filed its Applications Serial Nos. 86/139,432 and 86/139,577, stating that the first use and first use in commerce dates for both marks in these applications as **October 1, 2013.**" (emphasis in Opp'n)]; *id.* at 3 ["Applicant contradicted itself by stating conflicting first use dates: First, October 1, 2013 for both of its marks..."]; *id.* at 4 ["Applicant ... 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"; *id.* at 7 ["Applicant declared there was no inconsistency with its stated use date of **October 1, 2013**" (emphasis added)].)

Opposer's insistence on repeatedly rejecting the plain meaning of the phrase "at least as early as" as used in Applicant's trademark applications is unfounded. It is well settled that "[c]laiming a date for first use 'at least as early as' **is permitted** and does give notice that the applicant might someday try to prove an earlier date." 3 McCarthy on Trademarks and Unfair Competition § 19:52 (4th ed.); see *also* TMEP § 903.06 ("[T]he applicant may use indefinite terms in describing dates if the applicant considers it necessary....[T]erms such as 'at least as early as,' 'prior to,' 'before,' 'on or about,' and 'in' are acceptable for the record....In an inter partes proceeding, a date of use must be established by appropriate evidence. A date of use set forth in an application or registration owned by applicant or registrant is not evidence on behalf of that applicant or registrant.").

"At least as early as October 1, 2013" by its plain meaning means any date in history up to and including October 1, 2013, but not thereafter. It does not, as Opposer intimates, mean October 1 and October 1 only. All of the first use dates mentioned in Applicant's pleadings, including the proposed Second Amended Answer, predate October 1, 2013. Specifically as to the two marks directly at issue in this proceeding – FREUND'S FAMOUS word mark, and the design mark  (literal element FREUND'S FAMOUS) – Applicant's proposed Second Amended Answer alleges that the marks were first used in 2009 and 2010 for specific goods, as follows:

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.

Opposer cannot credibly contend that 2009 and 2010 are not “at least as early as” 2013, but repeatedly attempts to do just that. Likewise, the portion of Opposer’s opposition to the Motion contending that there is “confusion” between paragraphs 66 and 67 of the proposed Second Amended Answer (Opp’n at 4) does not present grounds for denying the Motion. In context, “the above goods” as used in paragraph 67 refers to the goods described in the preceding paragraph. (*Cf. id.* at 5.)

Simply put, there is no inconsistency or conflict. Insofar as motions to amend should be denied (in the absence of prejudice to the nonmoving party, which is addressed above) only when an amendment would be contrary to law, Opposer has failed to establish that the proposed amendment would be contrary to law over Opposer’s manufactured confusion over Applicant’s allegations regarding its first use dates. The basis for the filing of the Motion, as explained in Applicant’s opening memorandum, is simply to clarify Applicant’s former affirmative defense that it had “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,” to conform to the specific delineation of which marks including the element FREUND’S were used by Applicant in connection with particular goods.

III. Opposer Misinterprets the Proposed Amendments

Opposer’s opposition incorrectly asserts that the proposed amendment is seeking to add “the family of marks doctrine and tacking” as affirmative defenses. (Opp’n at 9.) To the contrary, the proposed amendments are not directed to an assertion of intervening or prior rights, and neither doctrine is so much as hinted at by the proposed

amendments. Applicant's proposed Second Affirmative Defense merely goes to the absence of a likelihood of confusion between Applicant's marks and Opposer's marks by alleging the lengthy coexistence of Applicant's marks and Opposer's marks without the occurrence of any instances of actual confusion. See ¶ 60 of the Proposed Second Amended Answer ("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 without any instances of actual confusion with any marks Opposer may apply to its goods."). And the proposed amendment should not be considered a claim of "tacking," nor is it styled as such. (See *id.*) Rather, the expanded explanation of the marks incorporating the term "FREUND'S" as used for specific products by Applicant demonstrates that Applicant is able to use those marks without confusion among the consuming public, so neither would there be confusion with Opposer's mark.

In this proceeding, Opposer has alleged its marks are famous for its likelihood of confusion and dilution claims. The fame of Opposer's marks, the nature and extent of any actual confusion, and the variety of goods on which a mark is or is not used are relevant areas of inquiry under the *DuPont* likelihood of confusion factors, *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Applicant contends the marks in its revised affirmative defenses directly bear on the alleged fame of Opposer's marks; a lack of instances of actual confusion with Applicant's FREUND'S per se and FREUND'S -formative marks for the goods and services to which they have been applied supports the conclusion that Opposer's marks are not famous and that a likelihood of confusion is not present in this case.

IV. CONCLUSION

Opposer's opposition to the Motion to Amend relies on deliberate misinterpretation of plain language to raise red herrings as claims of "prejudice." Neither the timing nor the content of the proposed amendment prejudices Opposer. And the proposed amendments are not "impermissible," despite Opposer's attempts to impute two legal doctrines to the proposed amendment that Applicant has neither expressly nor implicitly invoked. The Board should apply the liberal amendment standard and grant Applicant's Motion to Amend Answer to Notice of Opposition.

Dated: October 20, 2015

/s/ Lesley M. Grossberg
Robert B.G. Horowitz
BAKER & HOSTETLER LLP
45 Rockefeller Plaza
14th Floor
New York, New York 10111-0100
rhorowitz@bakerlaw.com
(212)589-4200

Lesley McCall Grossberg
BAKER & HOSTETLER LLP
2929 Arch Street
Cira Centre, 12th Floor
Philadelphia, PA 19104-2891
lgrossberg@bakerlaw.com
(215) 568-3100

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

CERTIFICATE OF SERVICE

I hereby certify that the foregoing REPLY BRIEF OF APPLICANT IN FURTHER SUPPORT OF MOTION FOR LEAVE TO FILE A SECOND AMENDED ANSWER TO NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on Opposer's counsel, this 20th day of October, 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