

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

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Mailed: March 22, 2016

Opposition No. 91218523

Oakhurst Industries, Inc. DBA Freund  
Baking Co.

v.

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

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of the following fully briefed motions:

- 1) Applicant's September 22, 2015 motion to amend its answer;
- 2) Applicant's November 3, 2015 motion to compel discovery; and
- 3) Opposer's November 28, 2015 motion for leave to amend its notice of opposition.

The Board has considered the parties' briefs on the contested motions, but does not restate, discuss or address irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

**Applicant's motion to amend its answer<sup>1</sup>**

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<sup>1</sup> The Board notes Applicant's amended certificate of service indicating that it served its motion on September 22, 2015.

Amendments to pleadings in *inter partes* proceedings are governed by Fed. R. Civ. P. 15, which is applicable to Board proceedings by Trademark Rule 2.116(a). TBMP § 507.01 (2015). Fed. R. Civ. P. 15(a) governs amendments before trial. Pursuant to Fed. R. Civ. P. 15(a)(2), where, as here, a party may not amend its pleading as a matter of course under Fed. R. Civ. P. 15(a)(1),

...a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

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. TBMP § 507.02 (2015). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion to amend. *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 (TTAB 2007); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

The timing the motion is a main factor in determining whether the non-movant would be prejudiced by allowance of the proposed amendment. TBMP § 507.02 (2015). The motion should be filed as soon as any ground for the amendment, *e.g.*, newly discovered evidence, becomes apparent. A long delay in moving for leave to amend may render the amendment untimely. *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002).

Applicant appropriately included with its filing a redlined copy of its second amended answer.<sup>2</sup> TBMP 507.01 (2015). Applicant seeks leave to delete its sixth affirmative defense, and to amend the second affirmative defense to assert prior use of various marks - including both the opposed marks and marks other than the opposed marks - which contain the element FREUND'S for specified goods. Applicant argues that the amendment is made "to conform to the facts that have emerged in discovery,"<sup>3</sup> and that it is relevant to the issue of the length of time under which there has been concurrent use without evidence of actual confusion.

It is noted that the matters that Applicant seeks to add have been exclusively within its own knowledge. Applicant could have sought leave to amend earlier, and its explanation that evidence underlying the added assertions was brought to light through the process of responding to discovery requests is questionable. Notwithstanding, Applicant filed its motion when 3 ½ months of discovery remained, and record does not reflect that Applicant has sought to ambush Opposer late in the proceeding. Opposer has ample opportunity to conduct discovery regarding the added assertions, and may seek to extend discovery as it deems necessary. Thus, prejudice to Opposer is not substantial, and is not of a nature that would preclude leave to amend. Opposer does not point to, for example, an inability to take discovery on or address at trial the applicability, relevance or veracity of Applicant's added assertions.

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<sup>2</sup> 19 TTABVUE 10.

<sup>3</sup> 19 TTABVUE 4.

Applicant's added assertions do not comprise a true affirmative defense. Rather, they operate to put Opposer on notice of the alleged basis for Applicant's position regarding lack of actual confusion, one of the relevant factors in the likelihood of confusion analysis as set forth in *In re E. I. du Pont De Nemours Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer objects on the basis that Applicant is asserting "newly specified marks"<sup>4</sup> or "seeking to add"<sup>5</sup> marks. Relevant to this point, Applicant cannot "add" marks. Notwithstanding Applicant's posturing as to its alleged use of marks that are not at issue in this proceeding, Applicant shall note that the Board analyzes the two weightiest *du Pont* factors - the similarity of the parties' marks, and similarity of the parties' respective goods and services - on the basis of *the marks, and the identified goods and services, as they are set forth in the two opposed applications. In re E. I. du Pont De Nemours Co., supra. Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 16 USPQ2d at 1787.

The Board notes Opposer's position that the proposed answer renders confusing or inconsistent certain matters concerning Applicant's first use dates and/or Applicant's goods. These are matters for discovery, and as noted, Opposer has ample opportunity to probe further. Notwithstanding, Applicant shall note that, in adjudicating cases on summary judgment or at final hearing, the Board takes into

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<sup>4</sup> 21 TTABVUE 6.

<sup>5</sup> 21 TTABVUE 7.

account the consistency and clarity - or lack thereof - in a party's arguments and evidence. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2010 (TTAB 2015).

In view of the Board's findings, Applicant's motion for leave to amend is granted. The second amended answer to the notice of opposition is Applicant's operative pleading in this proceeding.

**Opposer's motion for leave to amend notice of opposition**

Initially, the Board notes Applicant's arguments that Opposer's motion to amend is in contravention of the suspension order and is not germane to the motion to compel, and is therefore untimely. Applicant made these arguments in its response filed on December 14, 2015,<sup>6</sup> but also in its reply brief on its motion to compel discovery, wherein it sets forth its position on Opposer's intent in moving for leave to amend.<sup>7</sup> Applicant's addressing this issue in its reply brief indicates, in itself, that Applicant deems Opposer's motion to be relevant to the motion to compel. In this regard, Applicant's position is inconsistent. In any event, having considered the circumstances presented in this proceeding, the Board exercises its discretion to consider Opposer's motion for leave to amend.

Opposer seeks leave to delete its dilution claim with prejudice. In particular, it seeks leave to delete allegations asserted against each of the involved applications as set forth in ¶ 32-38 of the notice of opposition,<sup>8</sup> and the allegation that its marks

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<sup>6</sup> 28 TTABVUE.

<sup>7</sup> 27 TTABVUE 11.

<sup>8</sup> 26 TTABVUE 3.

have become famous within the meaning of § 43(c) as set forth in ¶ 10 of the notice of opposition.<sup>9</sup> Opposer appropriately included with its filing a redlined copy of its first amended notice of opposition. TBMP 507.01 (2015).

Applicant states that it does not in principle oppose Opposer's motion to withdraw the dilution claim with prejudice.<sup>10</sup>

Opposer only deletes matter and does not seek to add any allegations. Its amendments do not violate settled law, and pose no prejudice to Applicant. Inasmuch as Opposer only seeks to delete, Applicant need not file an answer to the amended notice of opposition. There is no burden or prejudice to Applicant. Applicant's operative answer will remain its operative pleading.

Based on this record, Opposer's motion for leave to amend the notice of opposition is granted. The first amended notice of opposition is Opposer's operative pleading in this proceeding.

### **Applicant's motion to compel discovery**

Initially the Board notes that Opposer's motion for leave to amend the notice of opposition does not render Applicant's motion to compel moot. The motion remains viable for consideration with respect to the discovery requests it identifies in its reply brief. More to the point, Opposer has deleted its dilution claim, but maintains its

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<sup>9</sup> 26 TTABVUE 6. The Board notes that the draft also deletes the previously stricken fraud claim.

<sup>10</sup> 28 TTABVUE 2. Applicant's request for "the opportunity to respond substantively" to Opposer's motion to amend is inconsistent with its discussion, in two filings, of Opposer's motion, and is inconsistent with its statement that it does not in principle oppose Opposer's motion. The Board has adjudicated Opposer's motion on its merits.

claim of priority and likelihood of confusion; thus, under the likelihood of confusion analysis the fame of Opposer's pleaded marks remains a relevant issue for discovery. This is because the fame of an opposer's mark, when present, plays a "dominant role in the process of balancing the *Du Pont* factors." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).<sup>11</sup> Finally, the Board finds unpersuasive Opposer's arguments suggesting that withdrawal of the dilution claim, in itself, renders moot Applicant's requests for information about pricing of Opposer's goods or services, purchase orders and invoices, and sales figures.<sup>12</sup>

Turning to Applicant's motion, the Board finds that by way of the substance of the pre-motion email communications and letters that Applicant made of record with its motion, Applicant satisfied the good faith effort requirement of Trademark Rule 2.120(e)(1). Opposer's arguments to the contrary are unpersuasive and unsupported by the record.

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<sup>11</sup> Fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005), citing *The Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). While the fame element of a dilution claim is an either/or proposition - that is, fame either does or does not exist - the fame element of a likelihood of confusion claim "varies along a spectrum from very strong to very weak." *Palm Bay Imports Inc.*, *supra*, citing *In re Coors Brewing Co.*, 343 F.3d 1340, 1344, 68 USPQ2d 1059 (Fed. Cir. 2003). Fame for likelihood of confusion purposes may be measured indirectly by, among other things, the volume of sales, substantiality of advertising expenditures of the goods and services sold under the mark, market share, the length of time of use of the mark, widespread critical assessments, notice by independent sources of the products identified by the marks, and the general reputation of the marked products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d 1303, 1308-09 (Fed. Cir. 2002).

<sup>12</sup> 25 TTABVue 6.

Trademark Rule 2.120(e)(1) also requires that the movant include with its motion a copy of the discovery requests at issue. Applicant's motion is deficient in that Applicant failed to include a copy of its first set of document requests and first set of interrogatories. This is puzzling because Applicant argues, in part, that Opposer's objections relating to Applicant's definitions of terms (*e.g.* "Objection to definition of 'Opposer's marks'") were improper objections. The Board is able to resolve the issues relative to Applicant's definitions only because Opposer provided with its brief partial copies of Applicant's discovery requests, and said submission includes Applicant's "definitions and instructions."<sup>13</sup>

Applicant served its discovery, and Opposer served its responses and supplemental responses prior to the date (*i.e.* December 1, 2015) on which amendments to the Federal Rules of Civil Procedure (*e.g.* amendments to Fed. R. Civ. P. 26(b)) became effective. Nonetheless, the Board finds that the discovery requests at issue in Applicant's motion to compel are proportional to the claims and defenses in this proceeding, to the issues being litigated (*e.g.* priority and likelihood of confusion), and to the stature and nature of the parties.

Applicant's reply brief is not entirely clear with respect to the discovery that remains at issue after Opposer served supplemental responses to some of the requests on November 9, 2015 (nearly a week after Applicant filed its motion to compel). Nonetheless, Applicant affirmatively states that the following discovery requests

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<sup>13</sup> 25 TTABVUE 24, 33.

remain deficient<sup>14</sup> in spite of Opposer's supplemental responses: Document Request Nos. 11, 14, 25, 32, 42, 47, 49, 52 and 53; Interrogatory Nos. 4, 14 and 15, 17. Accordingly, the Board has reviewed Opposer's responses, and supplemental responses (where served), and has adjudicated Applicant's motion to compel with respect to these discovery requests.

In all instances in which Opposer objects on the basis of the definition of "Marked Goods and Services," the objection is overruled. From a fair reading of Applicant's definition of "Marked Goods or Services," it is plainly obvious in the context of this proceeding that this wording refers in all goods or services on or in connection with which Opposer uses one or both of Opposer's pleaded marks. This is a standard, common and appropriate definition in the context of an *inter partes* case involving a § 2(d) claim. Opposer's initial objections to the definition were unsubstantiated and unsupported, and merely argumentative. Moreover, the objections reflect a lack of cooperation in the discovery process.<sup>15</sup>

Document Request No. 11: Opposer's objections are overruled. The record does not reflect any manner in which Opposer's price lists for baked goods are trade secret or highly confidential, and Opposer fails to demonstrate how and why they are

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<sup>14</sup> 27 TTABVUE 4, 7.

<sup>15</sup> To the extent that Opposer interposed general objections based on the wording in Applicant's definition of "Opposer's Marks," Opposer's objections are overruled. The objection goes to an obvious typographical error on Applicant's part. *Cadbury UK Limited v Meenaxi Enter., Inc.*, 115 USPQ2d 1404, 1407 (TTAB 2015) (party may not avoid its discovery obligations due to "an obvious typographical error;" such error does not justify failure to respond to discovery requests). Moreover, Applicant acknowledged this inadvertence in its September 22, 2015 communication to Opposer's counsel.

appropriate for such designation; even assuming Opposer had a good faith belief that the information is entitled to this designation, it failed to provide this information under the applicable standard protective order. The information is relevant to, at a minimum, the similarity or dissimilarity of established trade channels. Applicant's motion is granted, and Opposer is directed to serve a second supplemental response.

Document Request No. 14: Opposer's objections are overruled. It is plainly obvious that Applicant seeks documents showing Opposer's expenditures for its goods and services bearing its pleaded marks from the claimed dates of first use. It is also evident that such information is relevant to, at a minimum, Opposer's allegations of priority and likelihood of confusion. Opposer bears the burden of proving priority as alleged; at a minimum, Applicant is entitled to know the information upon which Opposer will rely. The information sought is not irrelevant and the request is not overbroad or unduly burdensome. Furthermore, sales, advertising and length of use all bear on the issue of the fame of an asserted prior mark. *In re E. I. du Pont De Nemours Co.*, 177 USPQ at 567. Applicant's motion is granted, and Opposer is directed to serve a second supplemental response.

Document Request No. 25: Opposer's objections are sustained in part. Instances and details of press coverage of or relating to Opposer's goods and services bearing Opposer's marks are or may be equally as available to Applicant as they are to Opposer. Moreover, the request is worded in an overly broad manner. If Applicant seeks specific instances of where the identified matters are "mentioned in the press," it may serve a new request that is narrowed and tailored to seek relevant information

and documents. However, Applicant's motion is granted with respect to documents that are actually within Opposer's possession.<sup>16</sup> Accordingly, Applicant's motion is granted in part, and Opposer is directed to produce any and all responsive information and documents that are actually within Opposer's possession; if Opposer is not in possession of responsive documents, it must affirmatively state this in the response.

Document Request No. 32: Opposer's objections are overruled. Opposer's knowledge of recognition by others of Opposer's pleaded marks is related to this proceeding because, at a minimum, it bears on *du Pont* factors relevant to likelihood of confusion such as the strength or fame of Opposer's pleaded marks. Applicant's motion is granted, and Opposer is directed to serve a second supplemental response wherein it produces responsive documents that are actually within Opposer's possession.

Document Request No. 42: Opposer's objections based on burden and relevance are sustained. Applicant's request is not sufficiently narrowed so as to specifically seek information and documents pertaining to the goods on which Opposer uses its pleaded marks. A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding. TBMP § 414 (2015). Notwithstanding, the Board also notes that Opposer's objections based on violation of "right of financial privacy," and assertions that the information sought is sensitive,

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<sup>16</sup> With respect to Requests Nos. 25 and 32, the Board accepts Applicant's specific narrowing of its requests as set forth in its reply brief at 27 TTABVUE 5.

trade secret and highly confidential, are overruled. On balance, and based on these findings, Applicant's motion is denied.

Document Request No. 47: Opposer's objections are overruled to the extent that Applicant seeks the names and addresses of Opposer's officers and members; such information is discoverable. TBMP § 414 (2015). However, the names and addresses of shareholders are not discoverable inasmuch as this proceeding does not involve the issue of related companies. *Id.* Applicant's motion is granted as to documents sufficient to identify all members and officers of Opposer since 2005; Opposer is directed to serve a second supplemental response.

Document Request No. 49: Opposer's objections are overruled. Applicant's request is not unduly burdensome, or irrelevant, and does not seek documents not relevant to this proceeding. The objection based on privilege is overruled. Applicant's motion is granted; Opposer is directed to serve a supplemental response, including, as appropriate, a privilege log.

Document Request No. 52: Opposer's objections based on burden and overbreadth in scope are sustained. Applicant's request is not sufficiently narrowed so as to specify the types of documents sought. If Applicant seeks advertising and promotional materials relating to Opposer's use of its pleaded marks for private label bakery services since 1981, Applicant should have tailored this request to seek that information. Applicant's motion is denied.

Document Request No. 53: Opposer's objections as to 53(a) are sustained. The names of customers constitute confidential information, and generally are not

discoverable even under the protective order. TBMP § 414 (2015). Inasmuch as the classes of customers for a party's involved goods or services are discoverable, Applicant may serve a new request seeking relevant and discoverable information. Opposer's objections as to 53(b) and (c) are overruled; the information sought is discoverable, and is relevant inasmuch as Applicant is entitled to know any other marks, registered or unregistered, on which Opposer may intend to rely that appear on packaging. Applicant's motion is granted as to 53(b) and (c); Opposer is directed to serve a second supplemental response.

Interrogatory No. 4: As noted above, information regarding Opposer's officers and members is discoverable. Opposer's objections are overruled. Applicant's motion is granted; Opposer is directed to serve a second supplemental response providing the requested information, and may limit its response with respect to "managerial employees" to managerial employees having trademark-related responsibilities.

Interrogatory No. 14: Opposer's objection is overruled. The names of expert witnesses that a party intends to call are discoverable. TBMP § 414 (2015). Applicant's motion is granted; Opposer is directed to serve a supplemental response.<sup>17</sup>

Interrogatory No. 15: Opposer's objection is sustained. During discovery, a party is not required to provide the substance of opinions to be provided by each identified intended expert witness. In discovery, a party is not required to provide

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<sup>17</sup> If either party expects to call no witnesses during its assigned testimony period, it must so state in its pretrial disclosures.

the information that it will be required to provide in its expert disclosures (e.g. a summary or list of subjects about which the expert is expected to testify; a summary or list of documents and things that may be introduced during the testimony of the expert). Applicant's motion is denied.

Interrogatory No. 17: Opposer's objections are overruled. Opposer's supplemental response is noted. Opposer is directed to serve a second supplemental response in the event that its "continuing" investigations produce any additional information regarding any instance(s) of actual confusion in connection with Applicant's marks.

Summary: Applicant's motion to compel is granted in part and denied in part, as more fully set forth above. Opposer is allowed until thirty (30) days from the mailing date of this order to serve supplemental or second supplemental responses as directed herein. To the extent that Opposer maintains any objection based on the attorney-client privilege or attorney work product doctrine, it must produce a privilege log. Fed. R. Civ. P. 26(b)(5)(A)(ii). Opposer must produce appropriately designated confidential or proprietary information pursuant to the standard protective order applicable to this proceeding. *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009). Opposer must state whether any responsive materials are being withheld on the basis of an objection. Fed. R. Civ. P. 34(b)(2)(C).<sup>18</sup>

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<sup>18</sup> Going forward, the Federal Rules are applicable to this proceeding. *Emilio Pucci Int'l BV v. Sachdev*, \_ USPQ2d \_ (TTAB 2015).

## Schedule

Proceedings are resumed. The parties are allowed until thirty days from the mailing date of this order to serve responses to any discovery that was outstanding as of the filing of the motion to compel. Expert disclosure deadline, close of discovery and trial dates are reset as follows:

Expert Disclosures Due	<b>6/11/2016</b>
Discovery Closes	<b>7/11/2016</b>
Plaintiff's Pretrial Disclosures due	<b>8/25/2016</b>
Plaintiff's 30-day Trial Period Ends	<b>10/9/2016</b>
Defendant's Pretrial Disclosures due	<b>10/24/2016</b>
Defendant's 30-day Trial Period Ends	<b>12/8/2016</b>
Plaintiff's Rebuttal Disclosures due	<b>12/23/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>1/22/2017</b>

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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Fed. R. Civ. P. 33 and 34 are applicable to this proceeding pursuant to Trademark Rule 2.116(a) which provides that “[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure.”