

ESTTA Tracking number: **ESTTA703362**

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

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

Proceeding	91218800
Party	Plaintiff Kimberly-Clark Worldwide, Inc.
Correspondence Address	JENNIFER E HOEKEL ARMSTRONG TEASDALE LLP 7700 FORSYTH BOULEVARD, SUITE 1800 SAINT LOUIS, MO 63105 UNITED STATES jhoekel@armstrongteasdale.com, dschmitt@armstrongteasdale.com, iptm@armstrongteasdale.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Jennifer E. Hoekel
Filer's e-mail	iptm@armstrongteasdale.com, jhoekel@armstrongteasdale.com
Signature	/Jennifer E. Hoekel/
Date	10/20/2015
Attachments	Motion for Leave to Amend Notice of Opposition-21595652.pdf(2964714 bytes ) Exhibit 1-21595665.pdf(152736 bytes ) Exhibit 2-21595676.pdf(54226 bytes )

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

KIMBERLY-CLARK WORLDWIDE, INC.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91218800
	)	
MATOSANTOS COMMERCIAL CORP.	)	
	)	
Applicant.	)	

**MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

Pursuant to 37 C.F.R. §§ 2.107 and 2.116(a) and Rule 15(a), Fed.R.Civ.P., Opposer Kimberly-Clark Worldwide, Inc. (hereinafter “Opposer” or “Kimberly-Clark”) requests that the TTAB enter the attached proposed First Amended Notices of Opposition relating to Opposition No. 91218800.

**MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF  
OPPOSER’S MOTION TO AMEND NOTICE OF OPPOSITION**

1. The Requested Amendment

Kimberly-Clark has attached as Exhibit 1 its fully executed, proposed Amended Notice of Opposition relating to the opposed application to register the mark TENDER PUFF BATHROOM TISSUE and Puppy Design (hereinafter ‘TENDER PUFF Mark”).

Kimberly-Clark has added (i) a new paragraph 3 that identifies details of Opposer’s Registration No 4,656,343, (ii) a new paragraph 4 which identifies the updated status of Opposer’s Registration Nos. 2,918,976 and 2,918,077 as expired, and (iii) the following language to paragraph 11: “By virtue of its prior use, long-standing common law rights, and

evidence of consistent and continual use and registrations, Opposer has rights in Opposer's Puppy Design Mark prior and superior to any rights of Applicant in Applicant's Alleged Mark..”

## 2. The Legal Standards

As provided by 37 C.F.R. §§ 2.107 and 2.116(a) and (b), Kimberly-Clark's Motion to Amend shall be governed by Rule 15(a), *Federal Rules of Civil Procedure* which provides that “...a party may amend the party's pleading only by leave of Court or by written consent of the adverse party, and leave shall be freely given when justice so requires.” In *Foman v. Davis*, 331 U.S. 178, 182 (1962), the Court explained the circumstances under which amended pleadings should be permitted:

If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits. In the absence of any apparent or declared reason – such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. – the leave sought should, as the rules require, be “freely given.”

In *Commodore Electronics Limited v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993), The Board, consistently with *Foman v. Davis*, recognized that “amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposition parties.” See also, *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971). Thus, in deciding Opposer's motion for leave to amend, the Board must consider whether there is any undue prejudice to applicant and whether the amendment is legally sufficient. See e.g., *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974).

The TTAB Manual of Procedure at Sections 507.01 and 507.02 recite similar considerations justifying entry of an amended pleading.

3. Change in Status of Cited Registrations

The Notice of Opposition was originally filed using Opposer's Registration Nos. 2,918,076 and 2,918,077 as the marks cited by Opposer as basis for opposition. As of August 14, 2015, these registrations expired. However, Opposer has continually used the Puppy Design Mark in various positions since at least as early as August 11, 2003. An additional application has also been filed. The Notice of Opposition sets forth a cause of action based on Section 2(a) of the Lanham Act based on Opposer's registrations and common law rights. The Amended Opposition does not change the claim, but updates only the changed status in the cited registrations.

4. Timeliness of Kimberly-Clark's Motion to Amend

Opposer's Registrations Nos. 2,918,076 and 2,918,077 expired as of August 14, 2015, less than 3 months from the filing of Kimberly-Clark's Opposition. Additionally, Opposer provided Applicant with a copy of the proposed Amended Opposition and requested consent to filing on September 21, 2015 (see attached Exhibit 2). At that time, Applicant was already late on serving its Initial Disclosures (due September 18, 2015). Even after being noticed of its tardiness, Applicant did not serve its Initial Disclosures until October 13, 2015. Applicant was on full notice of Opposer's claims and basis for Opposition prior to preparing and serving its initial disclosures and before any other deadlines in this case.

5. No Prejudice to Matosantos

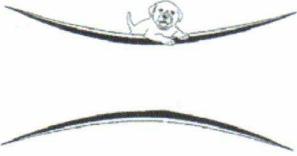
In light of the change in status of the Registrations after the filing of the Opposition, Opposer Moves to Amend its Opposition to accurately identify the status of these marks. There

is no prejudice to Applicant by updating the status of these registrations especially because the status is of public record.

The Opposition clearly set out that Opposer has used the Puppy Design Mark continually, and in numerous positions over time. Registration No. 4,656,343 covering the Puppy Design Mark that is now identified in Paragraph 3 of the Amended Opposition was in existence at the time of filing of the Opposition, and is covered by Opposer's statement in the original Opposition Paragraph 3 as follows:

“Opposer is the owner of numerous registrations for Opposer's Puppy Design mark for various goods in Classes 3 and 16 including the following U. S. federal trademark registrations which are in full force and effect:

<b>Registration Details</b>	<b>Dates</b>	<b>Goods</b>
	Registered December 16, 2014  First Use May 9, 2013	(Int'l Class: 16) Bathroom tissue

Registration Details	Dates	Goods
 <p data-bbox="305 431 521 499">SN: 78-215104 RN: 2,918,076</p>	<p data-bbox="602 258 850 326">Registered January 11, 2005</p> <p data-bbox="607 364 846 433">First Use August 11, 2003</p> <p data-bbox="672 465 781 499">Expired</p>	<p data-bbox="932 258 1370 399">(Int'l Class: 3) Disposable wipes impregnated with a cleaning compound for personal hygiene</p> <p data-bbox="1036 435 1268 499">(Int'l Class: 16) Bathroom tissue</p>
 <p data-bbox="272 768 483 836">SN: 78-215131 RN: 2,918,077</p>	<p data-bbox="602 580 850 649">Registered January 11, 2005</p> <p data-bbox="607 687 846 756">First Use August 11, 2003</p> <p data-bbox="672 788 781 822">Expired</p>	<p data-bbox="932 580 1370 721">(Int'l Class: 3) Disposable wipes impregnated with a cleaning compound for personal hygiene</p> <p data-bbox="1036 758 1268 822">(Int'l Class: 16) Bathroom tissue</p>

Thus, there is no prejudice to Applicant by adding the specific details of this registration to the Opposition as it is included in the original Opposition by general reference. Additionally, the Amended Opposition now corrects the original Opposition that noted registrations 2,918,076 and 2,918,077 were “in full force and effect” as they have since expired.

Additionally, Paragraph 6 of the original Opposition shows numerous images of the Puppy Design Mark that Opposer has used and promoted over time. The specific image covered by Registration 4,656,343 appears in these examples on three packages: in the first row, image 2 and the third row, images 1 and 3. There is no surprise as to the use of this Registration as a basis for Opposer’s Opposition, and thus no prejudice to Applicant.

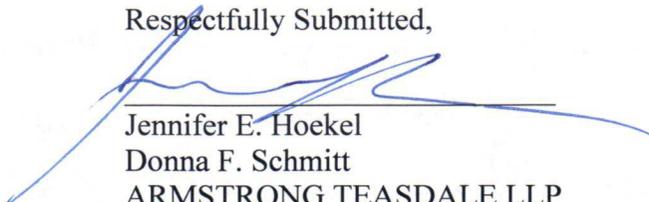
The addition of the words “long-standing common law rights and evidence of consistent and continual use and registrations” in paragraph 11 do not change or add any additional basis for Opposer’s Opposition, but clarify that Opposer has used the Puppy Design Mark in various positions under its common law rights the Puppy Design Mark. The original Opposition set out

a claim that Applicant's Alleged mark, when used in Connection with Applicant's Goods, violates Section 2(d) of the Lanham Act. Common Law rights are an appropriate basis for an Opposition under Section 2(d).

6. Summary and Conclusion

All legal and factual issues relevant to Kimberly-Clark's claim were presented to Matosantos in the original Opposition and by email of September 21, 2015, requesting consent to file the Amended Opposition. Discovery has not yet closed and the testimony periods have not yet commenced. Matosantos provided its Initial Disclosures on October 13, 2015, over 30 days late. To allow disposition of this case on the merits and in the interests of justice, Kimberly-Clark requests that its proposed Amended Notice of Opposition be entered since the requirements imposed by Rule 15(a), Fed.R.Civ.P. have been met.

Respectfully Submitted,



Jennifer E. Hoekel  
Donna F. Schmitt  
ARMSTRONG TEASDALE LLP  
7700 Forsyth Boulevard, Suite 1800  
Saint Louis, MO 63105  
Phone: 314-621-5070  
Fax: 314-621-5065  
[jhoekel@armstrongteasdale.com](mailto:jhoekel@armstrongteasdale.com)  
[dschmitt@armstrongteasdale.com](mailto:dschmitt@armstrongteasdale.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION has been forwarded by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this 20<sup>th</sup> day of October, 2015, to the following:

Samuel F. Pamas  
Hoglund & Pamas, P.S.C.  
256 Eleanor Roosevelt  
San Juan, Puerto Rico 00918  
United States

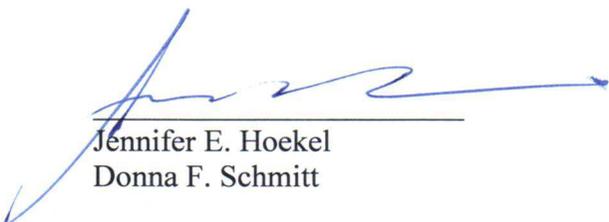
  
\_\_\_\_\_  
Jennifer E. Hoekel  
Donna F. Schmitt

EXHIBIT 1

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

KIMBERLY-CLARK WORLDWIDE, INC. )  
 )  
Opposer, )  
 )  
v. ) Opposition No. 91218800  
 )  
MATOSANTOS COMMERCIAL CORP. )  
 )  
Applicant. )

**AMENDED NOTICE**  
**OF OPPOSITION**

Opposer, Kimberly-Clark Worldwide, Inc. (hereinafter "Opposer" or "Kimberly-Clark"), is a Delaware corporation with its principal place of business at 2300 Winchester Road, Neenah, Wisconsin, 54956. Opposer believes it will be damaged by registration of the mark TENDER PUFF BATHROOM TISSUE and Puppy Design as shown below:



("Applicant's Alleged Mark") for "toilet paper" in Class 16 ("Applicant's Goods"), which mark is the subject of application Serial No. 85/901,644, filed on April 11, 2013 by Matosantos Commercial Corp. ("Applicant") and published for opposition

in the Official Gazette on April 15, 2014, and, by and through its undersigned attorneys, hereby opposes the same.

The grounds for this Opposition are as follows:

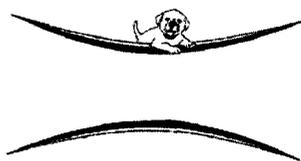
1. Opposer has adopted and used for many years in interstate commerce a Puppy shown in various poses and live in various television commercials and videos as a trademark and brand ambassador (“Opposer’s Puppy Design Mark”) for and in connection with Opposer’s marketing and promotion of, and on the packaging for, various goods in the fields of disposable paper products and personal hygiene products, including but not limited to, bathroom tissue and disposable wipes (“Opposer’s Goods”).

2. Opposer is and has been at all times pertinent hereto (including since long prior to the filing date of the Application), the owner of all right, title and interest in and to Opposer’s Puppy Design Mark.

3. Opposer is the owner of U.S. Trademark Registration No. 4,656,343 for Opposer’s Puppy Design Mark for bathroom tissue in Class 16.

<b>Registration Details</b>	<b>Dates</b>	<b>Goods</b>
	Registered December 16, 2014  First Use May 9, 2013	(Int’l Class: 16) Bathroom tissue

4. Opposer has a long history of use of Opposer’s Puppy Design Mark, continually in various poses and positions, as evidenced by the multiple prior registrations, including the following:

Registration Details	Dates	Goods
 <p data-bbox="332 453 552 524">SN: 78-215104 RN: 2,918,076</p>	<p data-bbox="633 282 885 352">Registered January 11, 2005</p> <p data-bbox="641 383 876 453">First Use August 11, 2003</p> <p data-bbox="706 483 812 524">Expired</p>	<p data-bbox="966 282 1404 423">(Int'l Class: 3) Disposable wipes impregnated with a cleaning compound for personal hygiene</p> <p data-bbox="1063 453 1307 524">(Int'l Class: 16) Bathroom tissue</p>
 <p data-bbox="300 786 519 856">SN: 78-215131 RN: 2,918,077</p>	<p data-bbox="633 604 885 675">Registered January 11, 2005</p> <p data-bbox="641 705 876 776">First Use August 11, 2003</p> <p data-bbox="706 806 812 846">Expired</p>	<p data-bbox="966 604 1404 745">(Int'l Class: 3) Disposable wipes impregnated with a cleaning compound for personal hygiene</p> <p data-bbox="1063 776 1307 846">(Int'l Class: 16) Bathroom tissue</p>

5. Opposer's Puppy Design Mark has been continuously used and extensively advertised and promoted in interstate commerce for over a decade for and in connection with one or more of Opposer's Goods.

6. Opposer has used and promoted Opposer's Puppy Design Mark in numerous ways including in various advertisements and television commercials and on its packaging as shown in the images below:



7. As a result of the long, widespread and extensive use, advertising and promotion by Opposer of Opposer's Puppy Design Mark on and in connection with Opposer's Goods, Opposer's Puppy Design Mark serves to identify and distinguish Opposer's Goods from the goods, services and businesses of others; symbolizes the goodwill of Opposer's business; is well- known; and is of great value to Opposer in connection with the offering of Opposer's Goods.

8. By the Application, Applicant seeks to register the mark TENDER PUFF BATHROOM TISSUE and Puppy Design in connection with "toilet paper" in Class 16. The design element of Applicant's mark consists of a puppy holding a heart shaped pillow as shown below:



9. The puppy shown in Applicant's Alleged Mark is the same or similar dog breed as the puppy in Opposer's Puppy Design Mark and/or is otherwise confusingly similar to Opposer's Puppy Design Mark.

10. Applicant's Application claims February 7, 2013 as the date of first use of Applicant's Alleged Mark. Accordingly, even assuming that date is accurate, Applicant is unable to establish, with respect to Opposer's use of Opposer's Puppy Design Mark, priority of use or priority of rights in the United States in connection with Applicant's Alleged Mark.

11. By virtue of its prior use, long-standing common law rights, and evidence of consistent and continual use and registrations, Opposer has rights in Opposer's Puppy Design Mark prior and superior to any rights of Applicant in Applicant's Alleged Mark.

12. Applicant's Goods and Opposer's Goods both include bathroom tissue and/or toilet paper in Class 16. In addition, on information and belief, Applicant's Goods and Opposer's Goods are of identical types; are offered or may be offered through the same or substantially the same, and/or related channels of trade, to the same, substantially the same, and/or related classes of purchasers; and are advertised, marketed and promoted through the same media channels.

13. Applicant's Alleged Mark, when used in connection with Applicant's Goods, so resembles Opposer's Puppy Design Mark as to be likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin of Applicant's Goods; with respect to Opposer's sponsorship thereof or connection or affiliation therewith; and/or in other ways, in violation of Section 2(d) of the Lanham Act.

14. Opposer would be damaged by registration of Applicant's Alleged Mark because such registration would constitute prima facie evidence of Applicant's exclusive right to use Applicant's Alleged Mark for and in connection with Applicant's Goods, which would be inconsistent with and detrimental to Opposer's prior, established and superior rights in and to Opposer's Puppy Design Mark.

15. Applicant's Alleged Mark falsely suggests a connection or affiliation with Opposer in violation of Section 2(a) of the Lanham Act and Applicant is therefore not entitled to registration of Applicant's Alleged Mark.

16. By reason of the foregoing facts, Opposer believes it will be irreparably damaged by the registration of Applicant's Alleged Mark.

#### PRAYER FOR RELIEF

WHEREFORE, Opposer respectfully prays that the Application of Matosantos Commercial Corp identified by Serial No. 85/901,644 for the alleged mark TENDER PUFF BATHROOM TISSUE and Puppy Design be refused registration in Class 16, and that no registration be issued to Applicant, and that this opposition be sustained in favor of the Opposer.

Date: September 10, 2015

Respectfully submitted,

---

Jennifer E. Hoekel  
Donna F. Schmitt  
ARMSTRONG TEASDALE LLP  
7700 Forsyth Boulevard, Suite 1800  
Saint Louis, MO 63105  
Phone: 314-621-5070  
Fax: 314-621-5065  
[jhoekel@armstrongteasdale.com](mailto:jhoekel@armstrongteasdale.com)  
[dschmitt@armstrongteasdale.com](mailto:dschmitt@armstrongteasdale.com)

Attorneys for Opposer  
Kimberly-Clark Worldwide, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Amended Notice of Opposition was served upon Applicant on the date indicated below by depositing a true and correct copy thereof with the United States Postal Service as First Class Mail, postage prepaid, addressed to the correspondent of record for the Applicant as indicated in the USPTO TARR database as follows:

Samuel F. Pamias  
Hoglund & Pamias, P.S.C.  
256 Eleanor Roosevelt  
San Juan, Puerto Rico 00918  
United States

Dated: September 10, 2015

---

Jennifer E. Hoekel  
Donna F. Schmitt  
Attorneys for Opposer

EXHIBIT 2

Shelly A. Doneff

---

**From:** Donna Schmitt <DSchmitt@ArmstrongTeasdale.com>  
**Sent:** Monday, September 21, 2015 2:41 PM  
**To:** samuel@hhoglund.com; jaime@hhoglund.com  
**Cc:** Jennifer E. Hoekel; Adriana Amadeo; Sammy Pamas; Gay Lynn Manning; Trademark  
**Subject:** Kimberly-Clark Worldwide, Inc. v. Matosantos Commercial, Corp. Opposition No. 91218800 AT Ref. 35180-2 [IWOV-iDocs.FID2611990]  
**Attachments:** K-C Amended Notice of Opposition.docx

Dear Mr. Pamas-Portalatin and Mr. Lopez,

First, I would like to introduce myself and my partner Jennifer Hoekel as we have been asked by Kimberly-Clark to enter our appearance in the above reference Opposition. Armstrong Teasdale represents Kimberly-Clark on a variety of matters including trademark enforcement matters. I spoke with Mr. Jaime Lopez a little over a week ago and appreciate his time and look forward to talking with you both about this case.

In our review of the Opposition, we plan to file an Amended Notice of Opposition, as attached hereto. Please let us know if you will Consent to our Motion to Amend and if so we will file the appropriate Notice of Consent and amended Opposition. We mailed our Initial Disclosures pursuant to the current Opposition deadlines and request that you please send us your initial disclosures by e-mail since they are now past due to speed delivery.

Please let us know if you have any questions, and we look forward to hearing from with you.

Best regards,

Donna Schmitt



Armstrong Teasdale LLP

Donna Frazier Schmitt | Partner

7700 Forsyth Blvd., Suite 1800, St. Louis, Missouri 63105-1847

DIRECT: 314.552.6681 | FAX: 314.621.5065 | MAIN OFFICE: 314.621.5070 | CELL: 314.202.1643

[dschmitt@armstrongteasdale.com](mailto:dschmitt@armstrongteasdale.com)

[www.armstrongteasdale.com](http://www.armstrongteasdale.com)

\*\*\*\*\*PRIVATE AND CONFIDENTIAL\*\*\*\*\*

**This transmission and any attached files are privileged, confidential or otherwise the exclusive property of the intended recipient or Armstrong Teasdale LLP. If you are not the intended recipient, any disclosure, copying, distribution or use of any of the information contained in or attached to this transmission is strictly prohibited. If you have received this transmission in error, please contact us immediately by e-mail ([admin@armstrongteasdale.com](mailto:admin@armstrongteasdale.com)) or telephone (314-621-5070) and promptly destroy the original transmission and its attachments. Opinions, conclusions and other information in this message that do not relate to the official business of Armstrong Teasdale LLP shall be understood as neither given nor endorsed by it.**