

ESTTA Tracking number: **ESTTA709734**

Filing date: **11/19/2015**

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

Proceeding	91218800
Party	Defendant Matosantos Commercial Corp.
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Date	11/19/2015
Attachments	OPPOSITION TO MOTION TO AMEND NOTICE OF OPPOSITION TP-final.pdf(274748 bytes) 2014_06_09_15_01_20.pdf(610164 bytes)

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

KIMBERLY-CLARK WORLDWIDE, INC.

Opposer

v.

MATOSANTOS COMMERCIAL CORP.

Applicant

Opposition No. 91218800

Serial No. 85/901,644

Mark: TENDER PUFF BATHROOM TISSUE
and Design

Filing Date: April 11, 2013

Publication Date: April 15, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

**MOTION IN OPPOSITION TO OPPOSER'S MOTION TO AMEND NOTICE OF
OPPOSITION**

COMES NOW applicant Matosantos Commercial Corp. (hereinafter referred to as "Applicant"), through its undersigned counsel, and respectfully states, alleges and prays:

INTRODUCTION

On September 10, 2015, Opposer Kimberly-Clark Worldwide, Inc. ("Opposer" or "Kimberly-Clark") filed a "Motion for Leave to Amend Notice of Opposition" ("Motion to Amend"). In such Motion to Amend, Opposer moved to amend its notice of opposition to add the details of Opposer's Registration No. 4,656,343, identify the updated status of Opposer's Registration Nos. 2,918,076 and 2,918,077 and include the following statement: "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."

However, Applicant respectfully requests that Opposer's Motion to Amend be denied since (1) the Motion to Amend is untimely and; (2) granting such Motion will cause prejudice to Applicant. This, since Opposer was allegedly using its purported new puppy design and claimed rights over the same, since before filing the Notice of Opposition. Accordingly, to include a new trademark registration, with a new design, more than one year after filing its Opposition, although knowing of its existence and alleged use for over a year before filing the Opposition would prejudice Applicant, and would render the past year and a half of proceedings worthless.

DISCUSSION

Section 507.02 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") states that a party may amend its pleading only by written consent of every adverse party or by leave of the Board. See Fed. R. Civ. P. 15(a). In these cases, the Board usually grants leave to amend pleadings, unless the amendment would violate settled law **or is prejudicial to the rights of the adverse party**. One of the factors used by the Board to determine whether it should grant the motion to amend is timing. As stated in American University v. Nico Van Niekerk, the timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a major factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). See also, *Am. Univ.*, CANCELLATION 9204093, 2003 WL 22970623, at *2 (Dec. 15, 2003).

According to Section 507.02(a) of the TBMP, the timing of the motion plays a large role in the Board's determination of whether a party would be prejudiced by the allowance of the proposed amendment. Therefore, a long a unexplained delay in filing

the motion, **specifically when there is no question of newly discovered evidence**, may render the amendment untimely. See Section 507.02(a) of the TBMP. In this case, Applicant did not consent to Opposer's amendment, primarily for the reasons set forth below.

Applicant filed its TENDER PUFF BATHROOM TISSUE and design ("Tender Puff"), serial number 85,901,644 on April 11, 2013, in which it **identified the date of first use as February 7, 2013**. Later, Applicant's trademark was published on April 15, 2014 and with only 9 days left in the Opposition period, Opposer filed its Extension of Time to Oppose to Applicant's TENDER PUFF, serial number 85,901,644 on May 6, 2014. A mere 9 days later, Opposer filed the new puppy trademark application, Registration No. 4656343, which differed greatly to Opposer's previous registrations, numbers 2,918,076 and 2,918,077 and **in which it identified the date of first use of such design as May 9, 2013**.

One month later, after Opposer had already filed its application serial number 86281791, Opposer notified Applicant through letter dated June 6, 2014, of its intentions to oppose to Applicant's Tender Puff application. **Exhibit 1**. Clearly, by then, (**almost one and a half year ago**) Opposer had already claimed rights over its new puppy design –one for which it claimed a date of first use that did not precede that of Applicant.

Notwithstanding the foregoing, although since the earlier stages of the proceedings, (even before Opposer filed its "Notice of Opposition" ("Opposition") on October 13, 2014) Opposer was allegedly using its purported new puppy design and claimed rights over the same, but it failed to include it on its Notice of Opposition or even mention it as

grounds to justify its Opposition. Instead, it decided to wait until it had a registration over it in order to then abandon those registrations used as grounds for its original Opposition and practically file a new case against Applicant over a new and different puppy design, which clearly existed by the time that Opposer filed its Opposition, but not before Applicant first used its trademark.

Evidently, given Opposer's new assertions, claiming that by virtue of its prior use and long standing common law rights it had rights over its Puppy Design Mark, even if Opposer did not have a trademark registration for the Puppy design, Registration No. 4,656,343, it could have included the design as part of the Opposition, since it allegedly had common law rights over it. As discussed by Professor J. Thomas McCarthy in his treaty McCarthy on Trademarks and Unfair Competition, "all that is necessary ...is that the 'person' bringing the opposition establish conditions and circumstances from which damage to it from the opposed mark can be assumed." If opposer claims priority of use in the mark applicant seeks to register, opposer may establish priority under § 2(d) merely by proving prior use of the term in any manner "analogous to a trademark use." *See 3 McCarthy on Trademarks and Unfair Competition § 20:7 (4th ed.)*. *See also FBI v. Societe: "M. Bril & Co.,"* 172 U.S.P.Q. 310 (T.T.A.B. 1971). Therefore, if Opposer considered that its new design –*although having a date of first use subsequent to Applicant's*- somehow had priority of use, then it could have claimed so more than a year ago.

However, given the fact that Applicant has been using its TENDER PUFF BATHROOM TISSUE design since **February 07, 2013, date which precedes Opposer's use of the current puppy design**, Opposer decided not to include the

current design as part of the Opposition and instead alleged that it has been using its “puppy design trademarks” since 2003, grouping them altogether irrespective of each designs’ date of first use. Clearly, Opposer’s belated amendment is unjustified, to say the least.

What is more, Opposer, in what now, looking back, seems like a questionable attempt, showed interest in reaching a coexistence agreement with Applicant; all the while new puppy design was being registered in the United States Patent and Trademark Office (USPTO). These negotiations took well over nine months, but to no avail, since Opposer’s position remained the same from day one. This maneuvers, not only stalled the discovery proceedings for this case and misused Applicant’s and this Board’s time, but further caused Applicant to spend time, money, and resources negotiating a settlement agreement that Opposer had no interest in reaching. This were resources and time, which Applicant could have spent conducting discovery in the proceedings and in concluding this matter well before Opposer’s prior registrations had been cancelled and substituted by Opposer’s new design in order to plead a new theory and allegations before this Board, **but that were known by Opposer for more than a year before filing its Opposition and could have been included since day one.**

Undoubtedly, Opposer’s Motion to Amend does not come out of newly discovered evidence needed to supplement its claims, or out of facts not known prior to filing its Opposition; it is the complete opposite. Opposer always knew and claimed rights over its now apparent only registered puppy design, but failed to include it from the beginning.

As a result, the timing of Opposer's Motion and its allowance would unduly prejudice Applicant. First, to grant an untimely and unfounded Motion to Amend, at this stage of the proceedings, would be a way for Opposer to further delay these proceedings. Further, Opposer now wants to include a new trademark registration, with a new design, more than one year after filing its Opposition, for which Applicant will have to once again spend time, money and resources defending its trademark application from. This, on top of the time and money already spent since this proceeding began.

As it is evident, Opposer's Motion to Amend is untimely, since there is no newly discovered evidence and it was filed almost one year after the original Opposition, and granting it would cause undue prejudice to Applicant's rights. Therefore, Applicant respectfully requests this Board to deny the same.

WHEREFORE, Applicant hereby respectfully requests this Board to take notice of the foregoing for all practical purposes and that, as a result, an order be entered denying Opposer's Motion to Amend.

RESPECTFULLY SUBMITTED

This 19th of November 2015.

IT IS HEREBY CERTIFIED that on this date, a true and correct copy of Applicant's "Opposition to Motion to Amend Notice of Opposition" was served by first class mail, postage prepaid, upon the Opposer's representative: Jennifer E. Hoekel, Armstrong Teasdale LLP, 7700 Forsyth Boulevard, Suite 1800, Saint Louis, MO 63105.

.On this 19th of November, 2015.

A handwritten signature in cursive script, appearing to read "Sandra J. Parro".

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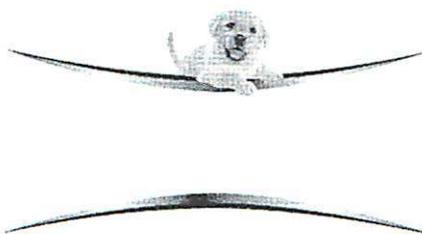
June 6, 2014

Via E-mail to: samuel@hhoglund.com and FedExSamuel F. Pamas, Esq.
Hoglund & Pamas. P.S.C.
256 Eleanor Roosevelt
San Juan, PR 00918**Re: TENDER PUFF BATHROOM TISSUE and Design Trademark Application
Serial Number 85-901644 by Matosantos Commercial Corp.**

Dear Mr. Pamas:

I am writing to you as trademark counsel for Kimberly-Clark Worldwide, Inc. ("Kimberly-Clark"), owner and registrant of several world-renowned brands of bathroom tissue and other tissue products, including but not limited to COTTONELLE®, SCOTT®, KLEENEX® and ANDREX® brands. Kimberly-Clark is aware that your client Matosantos Commercial Corp.'s ("Matosantos") TENDER PUFF BATHROOM TISSUE and Design application featuring a puppy graphic recently published for opposition, and we have filed an extension of time to oppose the same.

As you may know, Kimberly-Clark owns several U.S. Federal trademark registrations (listed below) for its Puppy Design trademark used in connection with bath tissue products sold under various brands on a worldwide basis. The Puppy Design has been used in all forms of advertising media since 1972, so extensively that the Puppy Design used in connection with tissue products has developed substantial goodwill and public recognition. On a global basis, Kimberly-Clark owns more than 250 trademark registrations for the Puppy Design. The Puppy Design as applied to bath tissue is distinctive of Kimberly-Clark and its bath tissue products.

Registration/Application Number	Goods
2918076 	Bathroom tissue and disposable wipes impregnated with a cleaning compound for personal hygiene

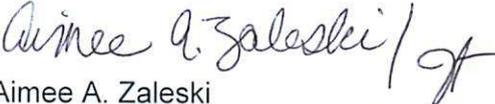
 2918077	Bathroom tissue and disposable wipes impregnated with a cleaning compound for personal hygiene
 86281791	Bathroom tissue

Your client's use of a puppy graphic that is highly similar if not nearly identical to the Kimberly-Clark Puppy Design could lead to confusion amongst consumers that the TENDER PUFF range of bath tissue is in some way connected with Kimberly-Clark or its COTTONELLE brand of bath tissue. In addition, your client's use of a puppy graphic takes unfair advantage of the substantial goodwill that Kimberly-Clark has developed in its Puppy Design and is detrimental to the distinctive character and reputation of Kimberly-Clark's Puppy Design trademark. In fact, it appears quite likely that your client selected its puppy graphic for the sole purpose of unfairly trading on the value of Kimberly-Clark's trademark.

In view of the above, we ask that Matosantos immediately withdraw its trademark application for TENDER PUFF BATHROOM TISSUE and Design and select an alternate trademark for its products that does not have the potential to be confused with the Puppy Design mark. For the avoidance of doubt, Kimberly-Clark considers that any puppy or dog character used with bath tissue is likely to be confused with its Puppy Design mark. Thus, if you client desires to associate its bath tissue with an animal, it should select some animal other than a dog or puppy. If your client has commenced use of the TENDER PUFF packaging that is the subject of the trademark application, we expect that your client will take steps to immediately withdraw such product from the market and provide written confirmation of the same to us.

We look forward to receiving your response and reaching a resolution to this matter. I would be happy to discuss this matter by telephone and can be reached at 920-721-3975. This letter is without prejudice to any rights Kimberly-Clark may have, each of which is expressly reserved.

Very truly yours,



Aimee A. Zaleski
Assistant General Counsel - Trademarks