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

Proceeding	92052327
Party	Plaintiff Elvis Presley Enterprises, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Reg. No. 1,909,802: KING OF ROCK ‘N’ ROLL MUSIC

ELVIS PRESLEY ENTERPRISES, INC.	)	
	)	
Petitioner,	)	
v.	)	
	)	Cancellation No. 92052327
KING OF ROCK ‘N’ ROLL MUSIC,	)	
INC.	)	
Registrant.	)	
	)	

**PETITIONER’S RESPONSE IN OPPOSITION TO  
REGISTRANT’S MOTION FOR LEAVE TO AMEND ANSWER**

Petitioner Elvis Presley Enterprises, Inc. (“Petitioner”) hereby responds in opposition to registrant King of Rock ‘N’ Roll Music, Inc.’s (“Registrant”) motion for leave to amend its answer. In further support of this response, Petitioner states as follows:

**I. INTRODUCTION**

The motion by registrant King of Rock ‘N’ Roll Music, Inc. (“Registrant”) for leave to amend its answer and propose a modification to Reg. No. 1,909,802 is futile for two reasons and should be denied. First, 15 USC § 1068 (hereafter “Section 18”), which Registrant relies upon to support its proposed amendment, does not authorize the amendment Registrant proposes. The Board has repeatedly refused to entertain such proposed amendments where the moving party cannot show that the restriction sought would avoid a likelihood of confusion. Second, Registrant’s proposed amendment would do nothing to resolve the underlying issues of this proceeding.

## **II. FUTILE AMENDMENTS SHOULD BE DENIED**

If a proposed amendment is legally insufficient on its face or would serve no useful purpose, the Board should deny leave to amend. *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (denying motion for leave to amend opposition to add res judicata claim because opposers cannot prevail on claim and proposed amendment would be futile); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (noting that a proposed amendment ordinarily will be denied if it “seeks to add a claim or defense which is obviously insufficient under the law.”); *American Hygienic Laboratories, Inc. v. Tiffany & Co.*, 229 USPQ 855, 859 (TTAB 1986) (denying opposer’s motion for leave to amend opposition where the proposed amendment failed to state a claim and would serve no useful purpose.).

In this case, as discussed in greater detail below, the proposed amendment is both legally insufficient on its face *and* it would serve no useful purpose. Registrant’s amendment is legally insufficient because Section 18, upon which Registrant relies, is reserved for instances when the restriction would serve to avoid confusion but no likelihood of confusion claim has been made in this case. Moreover, the proposed amendment would serve no useful purpose because even if this motion were granted and Registrant amended its registration as proposed, the modification would do nothing to resolve this proceeding.

## **III. Section 18 Amendments Only Apply to Likelihood of Confusion Claims**

Registrant’s motion for leave to amend its answer and modify its registration should be denied because the proposed amendment is legally insufficient.

The proper use of a Section 18 amendment is to modify a recitation of goods and services to reflect market reality *in order to avoid a finding of likelihood of confusion*. *In Re Energistics*

*Consortium, Inc.*, 2009 WL 1228519, \*6 (TTAB 2009); *IdeasOne, Inc. v. Nationwide Better Health, Inc.*, 89 USPQ2d 1952 (TTAB 2009); *Micro Nutrient LLC v. Jeffrey D. Thompson*, 2009 WL 625592, \*2 (TTAB 2009); *Eurostar, Inc. v. Euro-Star Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1994). In *Eurostar*, the Board clarified confusion from prior Board decisions that did allow Section 18 restrictions in instances where the party moving for the restriction did not allege and prove avoidance of likelihood of confusion. The Board explained:

Over the last few years, the Board has seen a number of pleadings in which parties have sought to restrict their opponents' long-held restrictions, where such requests for restriction (although tied to grounds of abandonment) were not supported by claims that the requested restrictions would avoid findings of likelihood of confusion. The restrictions proposed in many of these pleadings have been of dubious "commercial significance," leading the Board to conclude that the requested restrictions have been made more for tactical reasons than substantive ones. By applying Section 18 in the manner we have now determined to apply it, we can virtually eliminate frivolous or harassing restriction proceedings and devote our administrative resources to those kinds of cases intended by the drafters of the amendment: those in which restrictions to applications and registrations serve to avoid findings of likelihood of confusion.

*Eurostar*, 34 USPQ2d at 1270. This understanding of the narrow scope of Section 18 authority is consistent with the legislative history of the provision. The Senate Judiciary Committee reported that Section 18 amendments would "permit the Board to base determinations of likelihood of confusion on marketplace realities rather than on hypothetical facts." See *Eurostar*, 34 USPQ2d at 1266. Similarly, the House Judiciary Committee reported that Section gives "the Trademark Trial and appeal Board the authority to cancel a registration in whole or in part, to limit or otherwise modify the goods or services in a registration or application in order to avoid a likelihood of confusion."

Here, Registrant makes a Section 18 motion against its own registration. While unique, Registrant's motion is no less improper. Registrant does not allege nor prove that restricting its own registration will serve to avoid the finding of a likelihood of confusion. Indeed, likelihood of confusion is not the issue in this proceeding. The restriction proposed is tactical and not substantive, and it is exactly the type of Section 18 motion the Board in *Eurostar* spoke so

adamantly against. Section 18 remedy is not available to Registrant in this case and, thus, Registrant's motion for leave to amend its answer to modify its registration should be denied.

#### **IV. Registrant's Proposed Amendment Would Have No Impact on Proceedings**

Registrant's motion for leave to amend its answer and modify its registration should be denied because the proposed amendment serves no useful purpose.

Petitioner has argued, *inter alia*, that Registrant's claimed use of KING OF ROCK 'N' ROLL MUSIC with "phonorecords" refers to phonograph records (or records), and that Registrant has abandoned use of the mark in connection with records (as well as cassette tapes). Registrant has argued that "phonorecords" refers to any object onto which a sound recording can be fixed (which is inclusive of cassette tapes, records and much more). Allowing Registrant's proposed amendment, which deletes cassette tapes from the identification of goods, has no impact on this proceeding.

If Petitioner is correct, then amending the registration to delete cassette tapes (leaving compact discs and "phonograph records") does not change the fact that Registrant has abandoned use of the mark with phonograph records and, thus, the entire class of goods (the only class covered under the registration) should be cancelled. If Registrant is correct, amending the registration to delete cassette tapes (leaving compact discs and "any object onto which a sound recording can be fixed") does not change the registration in any way – Registrant would still purport to be using the mark with cassette tapes and phonograph records, as well as the myriad other objects onto which a sound recording can be fixed, despite Registrant's inability to present any evidence of use, or intent to resume use, with cassette tapes and phonograph records (or the myriad other objects onto which a sound recording can be fixed).

**V. Conclusion**

Motions for leave to amend are routinely denied when futile. In this case, Registrant's motion should be denied because the proposed amendment is both legally insufficient and serves no useful purpose. For these reasons, and the reasons provided above, Petitioner asks the Board to deny Registrant's motion for leave to amend its answer and modify the registration.

Respectfully submitted,

Date: January 10, 2011

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