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

Proceeding	92060308
Party	Plaintiff SFM, LLC
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Signature	/Christian G. Stahl/
Date	01/02/2015
Attachments	Brief in Opposition to Corcamore's Motion to Dismiss Petition.pdf(32987 bytes) Exhibit A - Declarations of Use.pdf(5825818 bytes) Exhibit B - Non-precedential cases.pdf(60055 bytes)

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

In the Matter of Registration No. 3,708,453
Mark: SPROUT
Date of Registration: November 10, 2009

SFM, LLC)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92060308
)	
CORCAMORE, LLC)	
)	
Respondent.)	

**PETITIONER’S MEMORANDUM OF LAW IN OPPOSITION TO THE
RESPONDENT’S MOTION TO DISMISS AMENDED PETITION**

Petitioner SFM, LLC (“SFM” or “Petitioner”), pursuant to TBMP § 502.02(b), submits this brief in response to Respondent Corcamore, LLC’s (“Corcamore” or “Respondent”) Motion to Dismiss Amended Petition.

SUMMARY OF THE ARGUMENT

Corcamore attempts to summarily try this action on its merits by improperly importing and relying on irrelevant extra-pleading material. SFM has standing and its petition is proper. SFM is the senior user to the SPROUTS Trademarks in retail grocery store services and its trademarks have become known to consumers as originating from itself and its related companies. Corcamore is the junior user of the SPROUT trademark in a similar channel of trade, namely, vending machine services offering various goods also found in grocery stores such as potato chips, cookies, popcorn, chocolate bars, fruit juice, and flavored waters. Corcamore’s continued registration of its SPROUT trademark for vending machine services will

harm SFM because it is likely to cause confusion, cause mistake, or deceive, when used on or in connection with the goods and services of Corcamore. As a result, SFM wishes to cancel Corcamore's confusingly similar and junior trademark for SPROUT for vending machine services. Corcamore's Motion should be denied for five reasons:

First, SFM's Petition to Cancel is timely. SFM's amendment properly relates back to its Original Petition and claims the same causes of action as before.

Second, SFM has standing to petition for cancellation. Owners of trademarks have standing to protect and enforce their trademarks.

Third, Corcamore improperly relies on papers outside the pleadings. Even if considered, the papers are irrelevant.

Fourth, SFM is not pleading Lanham Act Section 43(a). Rather, SFM is properly pleading Lanham Act Section 2(d), the most common allegation in cancellation proceedings.

Finally, SFM has adequately and plausibly pleaded its grounds for cancellation of Corcamore's SPROUT trademark under the Board's standards.

PROCEDURAL HISTORY

SFM filed its Petition for Cancellation ("Original Petition") on November 4, 2014, seeking to cancel Corcamore's U.S. Trademark Registration No. 3,708,453 for SPROUT on the grounds of priority of use, likelihood of confusion, and dilution. On November 14, 2014, Corcamore filed a Motion to Dismiss SFM's Original Petition. On December 1, 2014, SFM filed its First Amended Petition for Cancellation ("Amended Petition") within 21 days after service of Corcamore's Motion to Dismiss, in accordance with TBMP § 507.01(1)(A) on the grounds of priority of use and likelihood of confusion. On December 12, 2014, Corcamore again moved to dismiss. As set forth below, Corcamore's Motion to Dismiss should be denied.

LEGAL STANDARD

Corcamore merely glosses over the standard necessary for a motion to dismiss, likely because it cannot meet its burden. *See generally* Dkt. No. 8. A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. TBMP § 503.02 (2014); *see also Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 988 F.2d 1157, 1160, 26 U.S.P.Q.2d (BNA) 1038, 1041 (Fed. Cir. 1993). To withstand a motion to dismiss, a petition need only allege such facts as would, if proved, establish that the petitioner is entitled to the relief sought, that is, that (1) the petitioner has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the subject registration. TBMP § 503.02 (2014); *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d (BNA) 1536, 1538 (T.T.A.B. 2007). To survive a motion to dismiss, a complaint must “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A petitioner need only allege enough factual matter to suggest its claim is plausible and raise a right to relief above the speculative level. *Id.* at 555, citing 5 C. Wright & A. Miller, *Federal Practice and Procedure* § 1216, pp. 235–236 (3d ed. 2004).

In evaluating a petition, the Board should accept all well-pleaded allegations as true and construe the petition in the light most favorable to the petitioner. *See Advanced Cardiovascular Sys. Inc.*, 988 F.2d at 1161, 26 U.S.P.Q.2d (BNA) at 1041. Furthermore, the Board should examine the petition in its entirety, construing all allegations liberally, as required by Fed. R.Civ. P. 8(e), to determine whether the petition contains any allegations, that, if proved, would entitle the petitioner to the relief sought. TBMP § 503.02 (2014); *IdeasOne Inc. v. Nationwide Better Health*, 89 U.S.P.Q.2d (BNA) 1952, 1953 (T.T.A.B. 2009); *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d (BNA) 1536, 1539 (T.T.A.B. 2007).

ARGUMENT

I. SFM's Amended Petition is Timely.

A. SFM's Amended Petition Relates Back to its Original Petition.

Corcamore's argument that SFM's Amended Petition is untimely is misguided. *See* Dkt. No. 8 at 3. SFM's Amended Petition properly relates back to its Original Petition because there are no new claims or causes of action in SFM's amendment. An amended pleading relates back to the date of the original pleading when "the amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading." Fed. R. Civ. P. 15(c)(1)(B). When evaluating whether an amended pleading falls within the rule, courts search for a common core of operative facts in the two pleadings and inquire into whether the opposing party has been put on notice regarding the claim raised in the original pleading. *See Tiller v. Atlantic Coast Line R. Co.*, 323 U.S. 574, 581 (1945); *Bensel v. Allied Pilots Ass'n*, 387 F.3d 298, 310 (3d Cir. 2004).

For example, in *Bensel*, the court reasoned that in the original complaint the defendant was "unquestionably [put] on notice that it would be held liable for every possible breach of its fair representation duty occasioned by the outlined facts." 387 F.3d at 310. The court explained "[t]he additional [facts] particularized in the Second Amended Restated Complaint derive directly from the factual circumstances adumbrated in the original Complaint." *Id.* Therefore, defendant was not disadvantaged or prejudiced by the amendment and was, by virtue of the original complaint, undoubtedly aware of the general facts and legal theory upon which the plaintiffs' claims were based. *Id.*

Here, SFM's Amended Petition asserts a claim that arose out of the same conduct, transaction or occurrence set out in its Original Petition, and therefore relates back to the

Original Petition. Like in *Bensel*, Corcamore is not disadvantaged or prejudiced by the amendment and is, by virtue of the Original Complaint, undoubtedly aware of the general facts and legal theory upon which SFM's likelihood of confusion and priority claims are based.

Corcamore's reliance on *Mayle v. Felix* in support of its argument that the Amended Petition does not relate back is improper for at least two reasons. Dkt. No. 8 at 3; *Mayle v. Felix*, 545 U.S. 644, 645-646 (2005). First, the holding of *Mayle* is limited to the context of federal habeas proceedings. *Tucker v. Sch. Bd. of the City of Virginia Beach*, No. 2:13CV530, 2014 WL 5529723, at *1 (E.D. Va. Oct. 31, 2014). Second, the facts of this case are distinct from those in *Mayle*. In *Mayle*, the defendant's amended pleading asserted a Fifth Amendment challenge to admission of his own pretrial statements that did not relate back to his originally-pleaded Sixth Amendment challenge. In holding the pleadings did not relate back, the court explained the statements upon which defendant's Fifth Amendment challenge was based were "separated in time and type" from those that formed the basis of defendant's Sixth Amendment challenge. *See Mayle*, 545 U.S. at 645-646. Unlike *Mayle*, this case does not involve discrete episodes separated in time and type. Rather, SFM's claim is that SFM is the senior user and that Corcamore's continued registration of its SPROUT trademark for vending machine services will harm SFM because it is likely to cause confusion with SFM's SPROUTS Trademarks.

B. SFM's Amendments Merely Expound Upon and Further Detail Claims Made in its Original Petition.

The relation between SFM's Original Petition and its Amended Petition are related when directly compared. First, both SFM's Original Petition and Amended Petition state that Corcamore's continued registration of its SPROUT trademark for vending machine services will harm SFM because it is likely to cause confusion, cause mistake, or to deceive, when used on or

in connection with the goods of Corcamore. Thus, SFM's petitions provided notice to Corcamore on its likelihood of confusion and priority claims. Specifically:

- a. Both the Original Petition and the Amended Petition state that it "believes that it is and will continue to be damaged by [Corcamore's] Registration No. 3,708,453 and hereby petitions to cancel same." *Compare* Dkt. No. 1 at 1 *with* Dkt. No. 6 at 1.
- b. Both the Original Petition and the Amended Petition state that Corcamore's date of first use of its SPROUT mark is May 1, 2008. *Compare* Dkt. No. 1 ¶ 4 *with* Dkt. No. 6 ¶ 4.
- c. Both the Original Petition and Amended Petition plainly state that SFM is the owner of U.S. Trademark Registration Nos. 2,798,632; 3,322,841; and 4,002,187 for its SPROUTS Trademarks, and that SFM's use of its SPROUTS Trademarks pre-dates Corcamore's date of first use of its SPROUT trademark. *Compare* Dkt. No. 1 ¶ 5 *with* Dkt. No. 6 ¶ 5.
- d. Both the Original Petition and the Amended Petition state that Corcamore's SPROUT trademark is nearly identical in sound, appearance, and commercial impression to SFM's mark and therefore, when applied to the goods of Corcamore, it is likely to cause confusion or mistake, or to deceive the purchasing public. *Compare* Dkt. No. 1 ¶ 6 *with* Dkt. No. 6 ¶ 9.

Second, all amendments in SFM's Amended Petition were made merely to clarify SFM's use of the SPROUTS Trademarks and expand the facts alleged in the Original Petition, which fall within Rule 15(c)(1)(B) and therefore relate back. *See Bensele*, 387 F.3d at 310. For instance:

- a. SFM amended its Original Petition to provide specific dates of first use of SFM's SPROUTS Trademarks. *Compare* Dkt. No. 1 ¶ 5 *with* Dkt. No. 6 ¶ 5.
- b. SFM amended other paragraphs to clarify the relationship between Petitioner SFM, LLC and its related companies. *See, e.g.*, Dkt. No. 1 ¶ 1 and Dkt. No. 6 ¶ 3.

Despite SFM's amendments clarifying the use of the SPROUTS Trademarks, the underlying claims remain unchanged. Both petitions assert that SFM is the owner of U.S.

Trademark Registration Nos. 2,798,632; 3,322,841; and 4,002,187 for its SPROUTS Trademarks, that SFM has superior rights in the SPROUTS Trademarks, and that SFM “believes that it is and will continue to be damaged by Respondent's Registration No. 3,708,453” remains unchanged. Indeed, the most significant change is Petitioner’s *removal* of a claim (i.e., dilution), not the addition of claims. As such, SFM’s Amended Petition relates back to its Original Petition and was thus timely filed.

II. SFM Has Standing in this Cancellation Proceeding.

Corcamore’s argument that SFM lacks standing because it cannot show damage to it is without merit. *See* Dkt. No. 8 at 11. SFM has standing because both its Original Petition and Amended Petition establish that SFM has a direct and personal stake in the outcome of this cancellation proceeding and a reasonable basis for its belief that it is and will be damaged. *See* TBMP § 303.03 (2014); *see also Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 U.S.P.Q.2d (BNA) 1023, 1025 (Fed. Cir. 1999); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 492-493, 2 U.S.P.Q.2d (BNA) 2021, 2023 (Fed. Cir. 1987). At the pleading stage, all that is required is that a petitioner allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief in damage, and there is no requirement that the petitioner allege any actual “damage” to establish standing or even to prevail in a cancellation proceeding. *Ritchie*, 170 F.3d at 1095, 50 U.S.P.Q.2d (BAN) at 1025.

SFM’s direct and personal stake in the outcome of this cancellation proceeding and basis for damage are clearly pleaded in its petitions. SFM owns U.S. Trademark Registration Nos. 2,798,632; 3,322,841; and 4,002,187 for its SPROUTS Trademarks. Dkt. No. 6 at ¶ 5. SFM, as owner of the SPROUTS Trademarks, has a real interest in the use of its trademarks by itself and its related companies and has standing to protect and enforce its trademarks. *See Cabot Co.*

Ltd. d/b/a Cabot Watch Co. v. Combat Watch Co., LLC, No. 92053554, 2013 WL 6040029 at *3, *6 (T.T.A.B. 2013) (unpublished, non-precedential¹) (finding that petitioner’s reliance upon the use by a related company was appropriate and that “years of precedent make it very clear that proper use of a mark by a trademark owner’s ... related company constitutes ‘use’ of that mark attributable to the trademark owner.”) citing *Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 U.S.P.Q. 2d (BNA) 1389, 1392 (T.T.A.B. 2007); 15 U.S.C. § 1055 (“Where a registered mark...is or may be used legitimately by [a] related compan[y], such use shall inure to the benefit of the registrant...”). Contrary to Corcamore’s argument, SFM does operate and run grocery stores.² See SFM’s Declaration of Use for U.S. Trademark Registration Nos. 2,798,632 and 3,322,841 attached as Exhibit A. In this regard, SFM and its related companies used SFM’s SPROUTS Trademarks before Corcamore used its SPROUT trademark. Dkt. No. 6 at ¶¶ 7, 8. SFM’s rights in SPROUTS Trademarks are superior to any rights that Corcamore may have. Dkt. No. 6 at ¶¶ 7, 8. SFM is and will continue to be damaged due to a likelihood of confusion between its SPROUTS Trademarks and Corcamore’s SPROUT trademark. Dkt. No. 6 at ¶¶ 9, 13, 15.

¹ Unpublished, non-precedential opinions attached as Exhibit B.

² SFM’s Amended Petition to Cancel incorrectly stated: “SFM, through its exclusive licensee...” when it should have read “SFM, through it and its related companies...”. Nevertheless, even use by a related company provides SFM with standing. See *Cabot Co. Ltd.*, No. 92053554, 2013 WL 6040029 at *3.

Contrary to Corcamore’s argument, SFM does not aver that its related company made “nominative” use of the pleaded service marks. *See* Dkt. No. 8 at 8. Rather, SFM averred that its related companies have used the SPROUTS Trademarks, which include the SPROUTS word mark and other marks containing SPROUTS and the nominative term, FARMER’S MARKETS, for grocery store services for over 12 years, and that it also uses these trademarks in connection with various goods in its grocery stores that are also often found in vending machines. Dkt. No. 6 at ¶¶ 5, 6. Moreover, SFM itself also uses the SPROUTS Trademarks, which include the SPROUTS word mark and other marks containing SPROUTS and the nominative term, FARMER’S MARKETS, for grocery store services for over 12 years, and that it also uses these trademarks in connection with various goods in its grocery stores that are also often found in vending machines. *See* Exhibit A. Because Corcamore’s services covered under its SPROUT trademark are vending machine services, including goods and services likely to be found in SFM’s or its related companies’ grocery stores, there is a likelihood of confusion between Corcamore’s SPROUT trademark for vending machine services and SFM’s SPROUTS Trademarks for retail grocery store services and its common law uses, and SFM therefore has a direct and personal stake in the outcome of this cancellation proceeding as the owner of the SPROUTS Trademarks. Accordingly, SFM has standing to bring this cancellation proceeding.

Corcamore’s reliance on *Lexmark* is misplaced. Dkt. No. 8 at 11-14. First, *Lexmark* does not involve standing to file a petition for cancellation nor does it involve likelihood of confusion. *See Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377, 188 L.Ed.2d 392 (2014). Rather, the Court “granted certiorari to decide ‘the appropriate analytical framework for determining a party’s standing to maintain an action for *false advertising* under the [Section 43(a)] Lanham Act.’” *Id.* at 1385 (emphasis added). Second, even if the standard

for standing under *Lexmark* did apply, as put forth by Corcamore, SFM still has standing to bring this cancellation proceeding. In *Lexmark*, the Supreme Court held that a plaintiff has standing to sue for false advertising under the Lanham Act if the plaintiff's interests fall within the "zone of interests" protected by the Lanham Act. *Id.* at 1388. To come within the zone of interests, the pleader must allege an injury to a commercial interest in reputation or sales. *Id.* at 1390. The plaintiff must also properly allege that the defendant's false advertising was the proximate cause of an injury for which the Lanham Act provides redress. *Id.*

Even under the *Lexmark* standard, SFM's interests fall within the "zone of interests" protected by the Lanham Act (*e.g.* likelihood of confusion under Lanham Act § 2(d)) and Corcamore's use of the SPROUT trademark is the proximate cause of SFM's injury. Indeed, here, as pleaded by SFM, the trade and purchasing public have come to know SFM's SPROUTS Trademarks and recognize that any goods or services so marked originate from it or its related companies. Dkt. No. 6 at ¶ 15. Corcamore's use of a virtually identical mark for similar goods and services, particularly in a retail food setting, is likely to cause confusion, mistake or to deceive, and has impaired SFM's ability to conduct its business in certain channels of trade. SFM's assertion represents an injury to a commercial interest in reputation or sales that is proximately caused by Corcamore's (mis)conduct, and therefore meets the standard for standing outlined by the Supreme Court in *Lexmark*.

III. Corcamore's Motion is Largely Based Upon Materials Outside the Pleadings, Which are Not Properly Considered in a Rule 12(b)(6) Motion.

Further, Respondent's Motion requests the Board to improperly consider matters outside the pleadings, which are not properly considered in a Rule 12(b)(6) motion. *See, e.g.*, Dkt. No. 8 at 6-8; *see also Advanced Cardiovascular Sys., Inc.*, 988 F.2d at 1164, 26 U.S.P.Q.2d (BNA) at 1044. Even if the Board could consider these matters outside the pleadings, this would still not

properly be a motion under Rule 12(b)(6). *See* Fed. R. Civ. P. 12(d). Rather, if matters outside the pleadings are submitted in a Rule 12(b)(6) motion and are not excluded by the Board, the motion will be treated as a motion for summary judgment. *Id.*; *see also* *Compagnie Gernais Danone v. Precision Formulations, LLC*, 89 U.S.P.Q.2d (BNA) 1251, 1255–56 (T.T.A.B. 2009), citing Fed. R. Civ. P. 12(b); *Advanced Cardiovascular Sys., Inc.*, 988 F.2d at 1164, 26 U.S.P.Q.2d (BNA) at 1044; *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 U.S.P.Q.2d (BNA) 1594, 1596–1597 (T.T.A.B. 1992); TBMP § 503.04 (2014). Under such a motion for summary judgment, SFM must be given notice and “an opportunity to discover or to provide additional evidence.” *BJC Health Sys. v. Columbia Cas. Co.*, 348 F.3d 685, 688-89 (8th Cir. 2003). This includes “if necessary, conducting discovery,” as provided under Rule 56(d). *See* *Gibb v. Scott*, 958 F.2d 814, 816-17 (8th Cir. 1992) (finding that the District Court erred by not giving plaintiff notice and opportunity to provide further materials before considering matters outside the pleadings); *see also* Fed. R. Civ. P. 56(d).

In particular, Corcamore’s motion requests the Board to improperly consider various unrelated litigation matters in which SFM or its related companies were a party. *See, e.g.*, Dkt. No. 8 at 6-8. These matters were not included or incorporated by reference in the Amended Petition, and are therefore improper for consideration under a Rule 12(b)(6) motion to dismiss. Furthermore, conversion of the motion into a motion for summary judgment is also improper because SFM has not been given notice or the opportunity to discover or provide additional evidence. *BJC Health Sys.*, 348 F.3d at 688-89 (8th Cir. 2003). Therefore, the Board should not consider any materials outside the pleadings that were introduced in Corcamore’s Motion.

IV. SFM Does Not Plead a Cause of Action Based on Lanham Act Section 43(a).

SFM does not allege any causes of action under Lanham Act § 43(a). Therefore, Corcamore’s argument that SFM’s Lanham Act § 43(a) allegations should be dismissed are meritless. *See* Dkt. No. 8 at 17. In a cancellation, a petitioner must plead statutory grounds for cancellation and may raise any available statutory ground for cancellation that negates the defendant’s right to registration. TBMP § 309.03(c) (2014). Included in such grounds is likelihood of confusion, which is “the most frequently encountered issue in Board inter partes proceedings.” *Id.* SFM’s allegations, including Paragraphs 9 and 13, rely on Lanham Act § 2(d), as is appropriate in a petition to cancel:

2(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...

15 U.S.C. § 1052(d); Lanham Act § 2(d).

For the foregoing reasons, Corcamore’s argument is moot. To the extent Corcamore is arguing that SFM cannot argue likelihood of confusion under Lanham Act §2(d), Corcamore is incorrect as it is the single most pleaded claim before the Board. *See* § TBMP 309.03(c) (2014) (stating that likelihood of confusion is the most frequently encountered issue in Board inter partes proceedings).

V. SFM has Adequately and Plausibly Pleaded its Grounds for Cancellation of Corcamore’s SPROUT Trademark Registration.

A pleading should include enough detail to give the defendant fair notice of the basis for each claim. *See* TBMP § 309.03(a)(2) (2014). The elements of each claim should be stated

simply, concisely, and directly, and taken together “state a claim to relief that is plausible on its face.” *See Twombly*, 550 U.S. at 570; *see also* TBMP § 503.02 (2014).

SFM’s Amended Petition explains in detail its grounds for cancellation of Corcamore’s registration. Specifically, SFM pleaded that it is the owner of U.S. Trademark Registration Nos. 2,798,632; 3,322,841; and 4,002,187 for its SPROUTS Trademarks, that it has priority in the SPROUTS Trademark and due to the likelihood of confusion between Corcamore’s SPROUT trademark and SFM’s SPROUTS Trademarks, SFM believes that it is and will continue to be damaged by Corcamore’s Registration No. 3,708,453 for SPROUT. Dkt. No. 6 ¶¶ 5, 7, 9, 16. SFM’s allegations provide “facial plausibility” and allow the Board “to draw the reasonable inference” that SFM is damaged by Corcamore’s registration, and that Respondent’s registration should therefore be cancelled. *See Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009).

CONCLUSION

For the reasons stated above, Corcamore’s motion to dismiss should be denied. Moreover, if the Board will consider Corcamore’s extra-pleading material, SFM respectfully requests an opportunity to conduct discovery and respond pursuant to Fed. R. Civ. P 56(d). SFM also requests leave to amend to the extent the Board determines SFM should clarify any pleading.

Dated: January 2, 2015

By: /s/ Christian G. Stahl
Christian G. Stahl

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EXHIBIT A

From: TMOfficialNotices@USPTO.GOV
Sent: Friday, December 13, 2013 11:01 PM
To: tm-dept@quarles.com
Subject: Trademark RN 2798632: Official Notice of Acceptance and Renewal under Sections 8 and 9 of the Trademark Act

Serial Number: 76347816
Registration Number: 2798632
Registration Date: Dec 23, 2003
Mark: SPROUTS FARMERS MARKET
Owner: SFM, LLC

Dec 13, 2013

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF REGISTRATION RENEWAL UNDER SECTION 9

The renewal application filed for the above-identified registration meets the requirements of Section 9 of the Trademark Act, 15 U.S.C. §1059. **The registration is renewed.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
035

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION IN SUCCESSIVE TEN-YEAR PERIODS

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE**

REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.***

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=76347816>.

NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	2798632
REGISTRATION DATE	12/23/2003
SERIAL NUMBER	76347816
MARK SECTION	
MARK	SPROUTS FARMERS MARKET
ATTORNEY SECTION (current)	
NAME	Nicole Murray
FIRM NAME	QUARLES & BRADY, LLP
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CITY	CHICAGO
STATE	Illinois
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COUNTRY	United States
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FAX	312-715-5155
EMAIL	tm-dept@quarles.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY SECTION (proposed)	
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FIRM NAME	QUARLES & BRADY, LLP

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STATE	Illinois
POSTAL CODE	60654
COUNTRY	United States
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FAX	312-715-5155
EMAIL	tm-dept@quarles.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
DOCKET/REFERENCE NUMBER	146845.00021
OTHER APPOINTED ATTORNEY	Richard W. Young, Nicholas P. Schmidbauer, Nicole A. Bashor, Heather L. Buchta, Cameron E. Robinson

CORRESPONDENCE SECTION (current)

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FAX	312-715-5155
EMAIL	tm-dept@quarles.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
DOCKET/REFERENCE NUMBER	146845.00021
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	035
GOODS OR SERVICES	Retail grocery store services
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPNO-1-209234151254-113206468_146845.00021 - SPROUTS FARMERS MARKET - renewal specimen.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\763\478\76347816\xml3\S890002.JPG
SPECIMEN DESCRIPTION	Page from Registrant's website showing the mark in connection with Registrant's services.
OWNER SECTION (current)	
NAME	SFM, LLC
STREET	11811 N. TATUM BLVD., SUITE 2400
CITY	PHOENIX
STATE	Arizona
ZIP/POSTAL CODE	85028
COUNTRY	United States
LEGAL ENTITY SECTION (current)	
TYPE	limited liability company
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Delaware

LEGAL ENTITY SECTION (proposed)

TYPE	limited liability company
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Delaware

PAYMENT SECTION

NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	500
TOTAL FEE PAID	500

SIGNATURE SECTION

SIGNATURE	/Brandon Lombardi/
SIGNATORY'S NAME	Brandon Lombardi
SIGNATORY'S POSITION	Chief Legal Officer
DATE SIGNED	12/11/2013
SIGNATORY'S PHONE NUMBER	xxxxxxxxxx
PAYMENT METHOD	DA

FILING INFORMATION

SUBMIT DATE	Wed Dec 11 15:02:14 EST 2013
TEAS STAMP	USPTO/S08N09-209.234.151. 254-20131211150214043581- 2798632-5007823fb5d80dcec bd9943852955ae9b2aa192b2f 13d7b442228de9b6cc73a5c7- DA-1663-20131210113206468 698

**Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of
Registration of a Mark under Sections 8 & 9
To the Commissioner for Trademarks:**

REGISTRATION NUMBER: 2798632

REGISTRATION DATE: 12/23/2003

MARK: SPROUTS FARMERS MARKET

The owner, SFM, LLC, a limited liability company legally organized under the laws of Delaware, having an address of

11811 N. TATUM BLVD., SUITE 2400

PHOENIX, Arizona 85028

United States

is filing a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9.

For International Class 035, the mark is in use in commerce on or in connection with **all** goods or services listed in the existing registration for this specific class: Retail grocery store services ; or, the owner is making the listed excusable nonuse claim.

The owner is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Page from Registrant's website showing the mark in connection with Registrant's services..

Original PDF file:

[SPN0-1-209234151254-113206468 . 146845.00021 - SPROUTS FARMERS MARKET -
_renewal_specimen.pdf](#)

Converted PDF file(s) (1 page)

[Specimen File 1](#)

The registrant's current Attorney Information: Nicole Murray of QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois (IL) 60654
United States

The registrant's proposed Attorney Information: Nicole Murray of QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois (IL) 60654
United States

The docket/reference number is 146845.00021.

The Other Appointed Attorney(s): Richard W. Young, Nicholas P. Schmidbauer, Nicole A. Bashor, Heather L. Buchta, Cameron E. Robinson.

The phone number is 312-715-5241.

The fax number is 312-715-5155.

The email address is tm-dept@quarles.com.

The registrant's current Correspondence Information: Nicole Murray of QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois (IL) 60654
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The phone number is 312-715-5241.

The fax number is 312-715-5155.

The email address is tm-dept@quarles.com.

A fee payment in the amount of \$500 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

Section 8: Declaration of Use and/or Excusable Nonuse in Commerce

Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Section 9: Application for Renewal

The registrant requests that the registration be renewed for the goods/services identified above.

Signature: /Brandon Lombardi/ Date: 12/11/2013

Signatory's Name: Brandon Lombardi

Signatory's Position: Chief Legal Officer

Signatory's Phone Number: xxxxxxxxxx

Mailing Address (**current**):

QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois 60654

Mailing Address (**proposed**):

QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois 60654

Serial Number: 76347816

Internet Transmission Date: Wed Dec 11 15:02:14 EST 2013

TEAS Stamp: USPTO/S08N09-209.234.151.254-20131211150

214043581-2798632-5007823fb5d80dcecbd994

3852955ae9b2aa192b2f13d7b442228de9b6cc73

a5c7-DA-1663-20131210113206468698

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About



It's Healthy Living for Less.

Sprouts is a neighborhood grocery store with the feel of an old-fashioned farmers market. Our bright, friendly stores are filled with everyday staples and specialty items at a great value. You'll find mountains of fresh fruits and vegetables, barrels of wholesome grains, nuts and sweets, full-service deli, meat and seafood counters—complete with homemade burgers and sausages. Roam around our spacious aisles and you'll find fresh baked goods, eclectic beer and wine, gourmet cheese, sensibly-priced vitamins and supplements, and thousands of natural, organic and gluten-free groceries. Our friendly and knowledgeable team members are here to help you make healthier choices that are better for you and your budget.

Find a Store

Sprouts operates more than 160 stores throughout Arizona, California, Colorado, Nevada, New Mexico, Oklahoma, Texas and Utah. [Find a store](#) near you.

Leadership

Sprouts executives bring a balance of strategic and practical experience. They all grew up in different parts of the food industry in the Southwest and West, and they don't wear ties to the office. [Meet the executives.](#)

History

Since 2002, Sprouts Farmers Market has been synonymous with fresh foods, great prices and superior customer service. We've come a long way in a short time. Read more about [how it all began.](#)

Community Involvement

At Sprouts, the "triple bottom line" is alive and well, as we seek to do right, do well and do good in support of people, profits and the planet. And in part, that means we're striving to play an active role in the communities in which we operate. Learn more about [Sprouts' giving programs.](#)

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Do you share our passion for "healthy living for less?" Find out about current [career opportunities](#) throughout our company.

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New products are the lifeblood of the food business, so we're always interested in hearing about what's out there. To contact Sprouts regarding your product (or service), please complete our [contact form.](#)

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Gift Cards
What's on Sale
Coupons

COOK & EAT

Recipes
Feature Stories
Food Tips & Guides
Bulk Nutritional Info



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ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 2798632



Serial Number: 76347816



RAM Sale Number: 2798632

RAM Accounting Date: 20131212

Total Fees: \$500

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20131211	\$100	1	1	\$100
Application for Renewal (§9)	7201	20131211	\$400	1	1	\$400

Physical Location: 900 - FILE REPOSITORY (FRANCONIA)

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20131211



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Leadership Team
Community Involvement
Investor Relations
Careers
FAQs
Contact Us

From: TMOfficialNotices@USPTO.GOV
Sent: Monday, September 9, 2013 11:00 PM
To: tm-dept@quarles.com
Subject: Trademark RN 3322841: Official Notice of Acceptance and Acknowledgement under Sections 8 and 15 of the Trademark Act

Serial Number: 77080961
Registration Number: 3322841
Registration Date: Oct 30, 2007
Mark: SPROUTS(STANDARD CHARACTER MARK)
Owner: SFM, LLC

Sep 9, 2013

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15

The declaration of incontestability filed for the above-identified registration meets the requirements of Section 15 of the Trademark Act, 15 U.S.C. §1065. **The Section 15 declaration is acknowledged.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
035

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

Requirements in the First Ten Years

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between the 9th and 10th years after the registration date. See 15 U.S.C. §§1058, 1059.

Requirements in Successive Ten-Year Periods

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=77080961>.

NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

Combined Declaration of Use and Incontestability under Sections 8 & 15

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	3322841
REGISTRATION DATE	10/30/2007
SERIAL NUMBER	77080961
MARK SECTION	
MARK	SPROUTS
ATTORNEY SECTION (current)	
NAME	Nicole Murray
FIRM NAME	QUARLES & BRADY, LLP
STREET	300 N. LASALLE, STE. 4000
CITY	CHICAGO
STATE	Illinois
POSTAL CODE	60654
COUNTRY	United States
PHONE	312-715-5241
FAX	312-715-5155
EMAIL	tm-dept@quarles.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY SECTION (proposed)	
NAME	Nicole Murray
FIRM NAME	QUARLES & BRADY, LLP
STREET	300 N. LASALLE, STE. 4000

CITY	CHICAGO
STATE	Illinois
POSTAL CODE	60654
COUNTRY	United States
PHONE	312-715-5241
FAX	312-715-5155
EMAIL	tm-dept@quarles.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
DOCKET/REFERENCE NUMBER	146845.00022
OTHER APPOINTED ATTORNEY	Richard W. Young, Nicholas P. Schmidbauer, Nicole A. Bashor, Heather L. Buchta, Cameron E. Robinson
CORRESPONDENCE SECTION (current)	
NAME	Nicole Murray
FIRM NAME	QUARLES & BRADY, LLP
STREET	300 N. LASALLE, STE. 4000
CITY	CHICAGO
STATE	Illinois
POSTAL CODE	60654
COUNTRY	United States
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EMAIL	tm-dept@quarles.com
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NAME	Nicole Murray
FIRM NAME	QUARLES & BRADY, LLP
STREET	300 N. LASALLE, STE. 4000
CITY	CHICAGO
STATE	Illinois

POSTAL CODE	60654
COUNTRY	United States
PHONE	312-715-5241
FAX	312-715-5155
EMAIL	tm-dept@quarles.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
DOCKET/REFERENCE NUMBER	146845.00022
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	035
GOODS OR SERVICES	Retail Grocery Store Services
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN0-209234151254-101114294 . 146845.00022 - SPROUTS - 8 15 specimen.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\770\809\77080961\xml3\8150002.JPG
SPECIMEN DESCRIPTION	page from Registrant's website showing use of the mark in connection with Registrant's services
OWNER SECTION (current)	
NAME	SFM, LLC
STREET	11811 N. TATUM BLVD., SUITE 2400
CITY	PHOENIX
STATE	Arizona
ZIP/POSTAL CODE	85028
COUNTRY	United States
LEGAL ENTITY SECTION (current)	
TYPE	limited liability company
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Delaware
LEGAL ENTITY SECTION (proposed)	

TYPE	limited liability company
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Delaware
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	300
TOTAL FEE PAID	300
SIGNATURE SECTION	
SIGNATURE	/brandon lombardi/
SIGNATORY'S NAME	Brandon Lombardi
SIGNATORY'S POSITION	General Counsel & Secretary
DATE SIGNED	08/22/2013
SIGNATORY'S PHONE NUMBER	xxxxxxxxxx
PAYMENT METHOD	DA
FILING INFORMATION	
SUBMIT DATE	Thu Aug 22 18:24:52 EDT 2013
TEAS STAMP	USPTO/S08N15-209.234.151. 254-20130822182452518952- 3322841-5002bd3169d37cb2c 184b1b553d882f123efec25fa a4a7140b62aee5736f8a8aab5 -DA-5463-2013082110581682 2947

**Combined Declaration of Use and Incontestability under Sections 8 & 15
To the Commissioner for Trademarks:**

REGISTRATION NUMBER: 3322841

REGISTRATION DATE: 10/30/2007

MARK: SPROUTS

The owner, SFM, LLC, a limited liability company legally organized under the laws of Delaware, having an address of

11811 N. TATUM BLVD., SUITE 2400

PHOENIX, Arizona 85028

United States

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 035, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class: Retail Grocery Store Services; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one(or more) specimen(s) for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) page from Registrant's website showing use of the mark in connection with Registrant's services.

Original PDF file:

[SPN0-209234151254-101114294 . 146845.00022 - SPROUTS - 8 15 specimen.pdf](#)

Converted PDF file(s) (1 page)

[Specimen File 1](#)

The registrant's current Attorney Information: Nicole Murray of QUARLES & BRADY, LLP

300 N. LASALLE, STE. 4000

CHICAGO, Illinois (IL) 60654

United States

The registrant's proposed Attorney Information: Nicole Murray of QUARLES & BRADY, LLP

300 N. LASALLE, STE. 4000

CHICAGO, Illinois (IL) 60654

United States

The docket/reference number is 146845.00022.

The Other Appointed Attorney(s): Richard W. Young, Nicholas P. Schmidbauer, Nicole A. Bashor,

Heather L. Buchta, Cameron E. Robinson.

The phone number is 312-715-5241.

The fax number is 312-715-5155.

The email address is tm-dept@quarles.com.

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A fee payment in the amount of \$300 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

The mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce. There has been no final decision adverse to the owner's claim of ownership of such mark, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /brandon lombardi/ Date: 08/22/2013

Signatory's Name: Brandon Lombardi

Signatory's Position: General Counsel & Secretary

Signatory's Phone Number: xxxxxxxxxx

Mailing Address (current):

QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois 60654

Mailing Address (proposed):

QUARLES & BRADY, LLP
300 N. LASALLE, STE. 4000
CHICAGO, Illinois 60654

Serial Number: 77080961

Internet Transmission Date: Thu Aug 22 18:24:52 EDT 2013

TEAS Stamp: USPTO/S08N15-209.234.151.254-20130822182

452518952-3322841-5002bd3169d37cb2c184b1

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WEEKLY SPECIALS



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ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 3322841



Serial Number: 77080961



RAM Sale Number: 3322841

RAM Accounting Date: 20130823

Total Fees: \$300

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20130822	\$100	1	1	\$100
§15 affidavit	7208	20130822	\$200	1	1	\$200

Physical Location: - UNKNOWN

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20130822



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Sprouts is a neighborhood grocery store with the feel of an old-fashioned farmers market. Our bright, friendly stores are filled with everyday staples and specialty items at a great value. You'll find mountains of fresh fruits and vegetables, barrels of wholesome grains, nuts and sweets, full-service deli, meat and seafood counters—complete with homemade burgers and sausages. Roam around our spacious aisles and you'll find fresh baked goods, eclectic beer and wine, gourmet cheese, sensibly-priced vitamins and supplements, and thousands of natural, organic and gluten-free groceries. Our friendly and knowledgeable team members are here to help you make healthier choices that are better for you and your budget.

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EXHIBIT B

2013 WL 6040029 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

CABOT COMPANY LIMITED D/B/A CABOT WATCH COMPANY

v.

COMBAT WATCH COMPANY, LLC

Cancellation No. 92053554

July 12, 2013

*1 Before [Holtzman](#), [Wellington](#), and [Kuczma](#)
Administrative Trademark Judges

By the Board:

Combat Watch Company, LLC (“respondent”) registered the mark CWC in standard character form for “[c]locks and watches; [w]atch straps; [w]atches and clocks” in International Class 14.¹

Cabot Watch Company (a d/b/a for Cabot Company Limited and hereinafter “petitioner”) filed a petition to cancel respondent's registration on the ground of likelihood of confusion with its mark CWC for watch straps, watch cases, and watch covers; watches, which it claims to have used in commerce since at least as early as 1997. Petitioner alleges that, on November 8, 2010, it filed application Serial No. 85193341, for the mark CWC for watch straps, watch cases, and watch covers; watches, based on such use; that, on November 19, 2009, respondent, filed application Serial No. 77876646, which matured into the involved registration; that, because respondent made no use of the involved CWC mark prior to the alleged date of first use set forth in the registration therefor, petitioner has priority; and that the marks are identical and are used on the same goods.

Respondent, by its answer, is deemed to have admitted that petitioner has priority of use and that petitioner filed the application identified in the petition.² The remaining salient allegations have been denied.

On March 23, 2012, petitioner filed a motion for leave to file an amended petition to cancel wherein it corrects its identification to “Cabot Company Limited,” explaining that Cabot Watch Company is a name under which it does business. In an April 12, 2012 order, the Board determined that “petitioner ha [d] not shown to the Board's satisfaction that it is not seeking to amend the petition to cancel to name a different existing legal entity as petitioner”³ and therefore denied that motion without prejudice, but allowed petitioner time in which to file a renewed motion.

On May 11, 2012, petitioner filed a renewed motion for leave to file an amended petition to cancel in which it corrected petitioner's name, which the Board granted in a September 18, 2012 order.⁴ Because the amended petition to cancel was otherwise identical to the original amended petition to cancel, the Board stated in that order that it would treat the answer to the original petition to cancel as being responsive to the amended petition to cancel.

This case now comes up for consideration of: (1) petitioner's motion (filed April 26, 2013) for summary judgment on its pleaded Section 2(d) claim;⁵ and (2) respondent's cross-motion (filed May 9, 2013) to dismiss under the Board's inherent authority based on petitioner's repeated references to itself and its sole owner/parent company Silverman's Limited (“Silverman's D”) collectively as “petitioner” throughout its brief in support of the motion for summary judgment, which was incorporated into its brief in response to the motion for summary judgment.⁶

*2 In support of its motion for summary judgment, petitioner contends that entry of summary judgment is warranted because it has standing based on its ownership of the CWC mark and because the marks, goods, trade channels, and target consumers are all identical; that there has been “actual confusion and evident bad faith;” and that petitioner has prior rights in the involved mark that respondent effectively conceded in its answer.

Petitioner's evidence in support of its motion includes a declaration of petitioner's attorney, Michael Chiapetta, which introduces: (a) copies of respondent's responses to petitioner's discovery requests; and (b) an excerpt from Z.M. Wesolowski, *A Concise Guide to Military Timepieces 1880-1990* (1996), which refers to petitioner's CWC watches. Petitioner also submitted a declaration of petitioner's director and company secretary, Richard Bliss. Evidence introduced through Mr. Bliss' declaration includes: (a) documents which show the transfer of “all shares” of petitioner to Silverman's; (b) excerpts from petitioner's website which feature CWC watches; (c) petitioner's business records showing sales of CWC watches in the United States from 1997 through 2012; (d) sample invoices of sales to United States customers; (e) advertisements for CWC watches which appeared in *Soldier of Fortune* magazine; (f) excerpts from Silverman's catalogs from 1998 through 2005 which show CWC watches offered for sale; (g) petitioner's November 24, 2010 cease and desist letter to respondent; (h) respondent's December 9, 2012 cease and desist letter to petitioner; and (i) respondent's March 18, 2013 letter to petitioner stating that respondent has recorded its involved registration with United States Customs.

In response to the summary judgment motion and in support of its motion to dismiss, respondent contends that the motion for summary judgment is not properly before the Board because petitioner served “materially defective” initial disclosures in which petitioner refers to itself as both “[p]etitioner” and “[r]egistrant;” that petitioner, in the brief in support of the motion for summary judgment refers to itself and its distributor/owner Silverman's as ““petitioner” and, in doing so, improperly redefines itself “as a consortium of two separate legal entities;” that petitioner's responses to interrogatories are “misleading and untrue” because petitioner is relying upon sales by Silverman's without expressly saying so in those responses; that Silverman's, and not petitioner, sells petitioner's pleaded CWC watches; that respondent “refutes all claims and concedes nothing to date as it has been purposely misled and deceived by” petitioner; that petitioner concedes that it is a British company with no United States presence; that petitioner only sells watches to Silverman's, which has no overseas presence and/or agents; that petitioner concedes that it has no direct trading relationship with customers or retailers in the United States; that petitioner cannot successfully petition to cancel respondent's involved registration without joinder of Silverman's; that the Bliss declaration, upon which petitioner relies in support of its motion, is actually petitioner's expert disclosure, which petitioner failed to serve in a timely manner; that, although petitioner claims that the ovular design in its mark is inconsequential to the commercial impression of its pleaded mark, respondent understands that petitioner asserted trademark rights in that design in a dispute concerning Military Watch Company over the MWC mark with ovular design; and that a third party, Richemont International S.A., opposed registration of petitioner's mark in the European Trademark Office. Accordingly, respondent asks that the Board deny the motion for summary judgment and grant its motion to dismiss under the Board's inherent authority.

*3 Respondent's evidence submitted with its brief includes: (a) excerpts of communications between the parties regarding petitioner's initial disclosures; (b) copies of petitioner's initial disclosures; (c) excerpts from various Silverman's websites; and (d) copies of petitioner's responses to respondent's discovery requests.

In reply, petitioner contends that respondent has raised a series of baseless procedural arguments, has failed to address petitioner's proof of ownership of prior rights in the CWC mark, and has only minimally addressed the likelihood of confusion factors in its brief. In particular, petitioner asserts that it served its initial disclosures twice and that any reference to itself as both ““[r]egistrant” and “[p]etitioner” is an innocuous drafting error; that Silverman's, as petitioner's sole owner, parent company, and exclusive distributor, is not, and need not be, a party to this case; that petitioner can rely upon Silverman's use of the mark as a related company; and that Mr. Bliss is a fact witness and not an expert witness.

As an initial matter, the record herein indicates that petitioner served its initial disclosures twice, on September 11, 2011, prior to amending the caption of this proceeding, and again on December 21, 2012, after so amending.⁷ Although petitioner incorrectly

refers to itself as “[r]egistrant” in both sets of initial disclosures,⁸ those initial disclosures leave no doubt that, as used in those initial disclosures, petitioner refers only to itself.⁹ Accordingly, the motion for summary judgment was properly filed.

We turn next to respondent's motion to dismiss based on the Board's “inherent authority.” In particular, respondent contends that petitioner is improperly attempting to join Silverman's as a party to this proceeding and that this warrants dismissal of the petition to cancel under the Board's inherent authority. Respondent points to the following statement in petitioner's brief: “(Given the collaborative effort of [p]etitioner, owner of the CWC brand, and Silverman's, [p]etitioner's exclusive distributor of CWC watches to consumers and retailers, for ease of reference, [p]etitioner and Silverman's hereinafter shall be referred to collectively as ‘[p]etitioner.’)” D' Brief in support of motion for summary judgment at 8.

Respondent's motion will be treated as one to dismiss under the Board's inherent authority to sanctions. The Board may dismiss proceedings under its inherent authority to sanction “where the conduct in question does not fall within the reach of other sanctioning provisions of” the Trademark Rules of Practice and the Federal Rules of Civil Procedure. TBMP Section 527.03.

We reject respondent's assertions that petitioner is somehow seeking to join Silverman's as a party plaintiff herein, and that petitioner cannot prevail in this case because Silverman's is a necessary party to this proceeding. The record herein indicates that use of the CWC mark by Silverman's, as parent company/sole owner of petitioner and exclusive distributor of petitioner's CWC watches, was with the express consent and authorization of petitioner. See Bliss declaration at paragraphs 3 and 5.¹⁰ Petitioner is merely seeking to rely upon use by Silverman's as a related company under Trademark Act Section 5, 15 U.S.C. § 1055. See TMEP Section 1201.03(c) (April 2013) (“Related-company use includes situations where a wholly owned related company of the applicant uses the mark, or where the applicant is wholly owned by a related company that uses the mark.”).

*4 Based on the foregoing, we find that petitioner's reference to itself and Silverman's collectively as “petitioner” does not warrant dismissal of the petition to cancel under the Board's inherent authority to sanction or any applicable rule regarding entry of sanctions. Respondent's motion to dismiss based on the Board's inherent authority is therefore denied.

We now turn to the motion for summary judgment. Such a motion is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts, thus leaving the case to be resolved as a matter of law. See [Fed. R. Civ. P. 56\(c\)](#). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. See [Celotex Corp. v. Catrett](#), 477 U.S. 317 (1987); [Sweats Fashions Inc. v. Pannill Knitting Co. Inc.](#), 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See [Opryland USA, Inc. v. Great American Music Show, Inc.](#), 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party “must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.” [Octocom Systems Inc. v. Houston Computers Services Inc.](#), 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

As a party moving for summary judgment in its favor on its Section 2(d) claim, petitioner must establish that there is no genuine dispute that (1) it has standing to maintain this proceeding; (2) that it is the prior user of its pleaded mark; and (3) that contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. See [Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.](#), 60 USPQ2d 1733, 1735 (TTAB 2001). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would

have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. See [Fed. R. Civ. P. 56\(c\)](#); *Celotex Corp. v. Catrett*, 477 U.S. at 322-23.

*5 With regard to whether petitioner has standing to maintain this proceeding, we find that petitioner has established its standing in this case based on: (1) respondent's deemed admission that petitioner, on December 8, 2010, filed pleaded application Serial No. 85193141 for the same mark for some of the same goods; (2) statements in the Bliss declaration regarding petitioner's manufacture and supplying of CWC watches commencing in 1972; (3) evidence of use of the CWC mark on watches sold in the United States through its owner/exclusive distributor Silverman's between 1997 and 2012, prior to any date upon which respondent can rely in support of the use of the mark in its involved registration; (4) the December 9, 2012 cease and desist letter from respondent to petitioner; and (5) the March 18, 2013 letter from respondent to petitioner in which respondent threatened to seek seizure of any imports of petitioner's CWC watches into the United States.¹¹ No genuine dispute as to any material fact exists on this issue.

We turn next to the issue of whether there is a genuine issue of material fact regarding petitioner's asserted priority of use. To establish priority on a likelihood of confusion ground brought under Trademark Act Section 2(d), a party must prove that, vis-a-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned..." Trademark Act Section 2, [15 U.S.C. Section 1052](#). A plaintiff may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act Sections 2(d) and 45, [15 U.S.C. Section 1052\(d\) and 1127](#); *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating *PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

As noted *supra*, respondent was deemed to have admitted petitioner's prior use of the CWC mark on some of the same types of goods in its answer. Even without such admission, petitioner has established that there is no genuine dispute that it is the prior user of the CWC and ovalar design mark in the following stylized form, <<Unknown Symbol>>, on watches in the United States and that, through its owner/distributor Silverman's, whose use inures to petitioner's benefit, it has established use of its pleaded CWC mark prior to any date upon which respondent can rely for use of that mark. With regard to the parties' respective uses of their marks, petitioner has established, through the declaration of Mr. Bliss, that, it has manufactured watches under the CWC mark since 1972; that Silverman's has been its exclusive distributor since the late 1980's; that, through Silverman's, it made its first use of the CWC mark on watches in the United States in 1997; and that Silverman's continuously sold watches under the CWC mark through December 2012. Mr. Bliss's declaration is internally consistent and not characterized by uncertainty. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, *supra* at 1736. Further, the summary of sales under the CWC mark that petitioner submitted with the Bliss declaration in support of its motion for summary judgment indicates that Silverman's made regular, continuous sales of petitioner's watches under the CWC mark since 1997, prior to any date upon which respondent relies in support of its involved registration.

*6 Even if we assume that petitioner has no United States offices and only sells watches in the United States indirectly through Silverman's, these business conditions do not create a genuine dispute as to whether petitioner has prior use of the CWC mark in commerce on watches. Trademark Act Section 45, [15 U.S.C. § 1127](#), states in relevant part, as follows: 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. ... [A] mark shall be deemed to be in use in commerce. ... on goods when ... it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and ... the goods are sold or transported in commerce.

Trademark Act Section 5, [15 U.S.C. Section 1055](#), states as follows:

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use

shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public. If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.

The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used. “The essence of “related company” is the control of the nature and quality of the goods and this is the basis for allowing [a party] to claim ownership of a mark based on the use by a related company.” *In re Pharmacia Inc.*, 2 USPQ2d 1883, 1884 (TTAB 1987). “[Y]ears of precedent make it very clear that proper use of a mark by a trademark owner’s ... related company constitutes ‘use’ of that mark attributable to the trademark owner.” *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007). Cf. TMEP Section 1201.03(c) (“Related-company use includes situations where a wholly owned related company of the applicant uses the mark, or where the applicant is wholly owned by a related company that uses the mark.”).

Petitioner has manufactured watches sold under the CWC mark since 1972 in “compli[ance] with established British Ministry of Defence watch standards,” long prior to the commencement of its relationship with Silverman’s, with “any and all goodwill will that developed as a result of Silverman’s use of the CWC trademark [on watches] inur[ing] to the benefit of petitioner.” Bliss declaration, paragraphs 2 and 5. Thus, petitioner controls the nature and quality of such watches, and is therefore the owner of the mark. See Trademark Act Section 5; see also, TMEP Section 1201.03(c). Accordingly, petitioner may rely upon sales of CWC watches by petitioner’s owner and exclusive distributor, Silverman’s, to establish priority herein.¹²

*7 Turning to the likelihood of confusion issue, two key factors are the degree of similarity of the parties’ marks and the degree of similarity of their respective goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). As to the letter marks at issue, the parties’ CWC marks are extremely similar. Although petitioner uses an oval design around the letters CWC on its watches, that design element in the mark is insufficient to create a genuine issue of material fact as to the similarities of the marks. See *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (words are dominant portion of mark); *Ceccato v. Manifattura Lane Gaetano Marzetto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (literal portion of mark makes greater and long lasting impression). The fact that respondent’s mark is presented in standard character form does not avoid likelihood of confusion with petitioner’s CWC and design mark because respondent’s mark could be presented in the same manner of display. See *In re Mighty Tea Leaf*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Squirco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (the argument concerning a difference in type style is not viable where one party asserts rights in no particular display).

With regard to the similarity of the goods at issue, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in respondent’s registration vis-à-vis the goods shown to be in use by petitioner, rather than what respondent’s goods are asserted or shown to actually be. See, e.g., *Octocom Systems*, 16 USPQ2d at 1787; *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). The goods identified in respondent’s involved registration, i.e., “[c]locks and watches; [w]atch straps; [w]atches and clocks,” overlap with petitioner’s goods which, as shown by the evidence, are “watches.”¹³ As such, respondent’s goods are presumed to travel in all the normal channels of trade for goods of these types, including eBay and Amazon.com, and would be purchased by the same class of customers. See *id.*

Based on the foregoing, we find that petitioner has met its burden by supporting its motion with the Bliss declaration and other evidence which establishes its right to judgment. Accordingly, the burden shifts to respondent to proffer countering evidence which establishes that there is a genuine factual dispute for trial. However, the evidence that respondent submitted in support of its cross-motion and in response to petitioner’s motion is insufficient to show that there is a genuine issue of material fact for trial. In summary, considering the extremely similar marks and the overlapping nature of the goods, trade channels and purchasers, we find that there is no genuine dispute that confusion is likely to result.

*8 In view thereof, petitioner's motion for summary judgment is granted. The petition to cancel is granted, and Registration No. 3814227 will be cancelled in due course.

Footnotes

- 1 Registration No. 3814227, issued July 6, 2010, and alleging January 19, 2008 as the date of first use anywhere and date of first use in commerce.
- 2 See Board order dated July 20, 2011. Respondent did not request reconsideration of that order and did not seek to amend its answer. Under the law of the case doctrine, we do not revisit our conclusion. See *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031 (TTAB 2010). Such doctrine holds that the Board generally does not reopen issues decided in earlier stages of the same litigation. *Agostini v. Felton*, 521 U.S. 203, 236 (1997). The doctrine does not apply unless the Board is “convinced that [its prior decision] is clearly erroneous and would work a manifest injustice.” *Arizona v. California*, 460 U.S. 605, 618, n. 8 (1983). Respondent has not persuaded us that there is an error in our prior decision.
- 3 The Board noted that the WHOIS search result that respondent submitted in opposition to the such motion indicates that Cabot Watch Company Ltd., a UK limited company, rather than Cabot Company Limited, registered the domain names www.cabotwatchcompany.com and www.cabotwatchcompany.co.uk on August 23, 2010, prior to the filing of the petition to cancel.
- 4 On September 21 and 24, 2012, respondent filed petitions to disqualify petitioner's attorneys, based on petitioner's apparent willingness to spend more to prosecute this case than it would cost to settle this case by purchasing the involved registration in accordance with respondent's most recent settlement offer. In an October 4, 2012 order, the Board declined to consider the petitions to disqualify.
 In a December 5, 2012 order, the Board denied respondent's motion to compel in view of respondent's failure to serve initial disclosures and stated that “respondent's responses to the discovery requests that petitioner served on September 19, 2011 are long past due.” The Board further stated that, in view of respondent's repeated improper filings, “unless respondent first obtains leave of the Board to file a motion in a telephone conference between the Board attorney assigned to this case, respondent's principal, and petitioner's attorney, the Board, in exercising its inherent authority to manage cases on its docket, will not consider any further unconsented motions from respondent other than motions to extend.”
- 5 In such motion, petitioner asked that the motion be decided on an expedited basis.
- 6 On April 30, 2013, respondent filed a “request for directions,” which it withdrew in its May 9, 2013 submission.
- 7 Under *Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii)* and *Trademark Rule 2.120(a)(3)*, each party must provide as initial disclosures to its adversary prior to serving discovery requests or filing a motion for summary judgment (except on limited bases not at issue herein), (i) the name and, if known, the address and telephone number of each individual likely to have discoverable information--along with the subjects of that information--that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment; [and]
 (ii) a copy--or a description by category and location--of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.
 In petitioner's original and amended initial disclosures, petitioner identifies as individuals believed to have discoverable information to support its claims: “Cabot Watch Company ... and any officers, employees and/or agents of [petitioner, and] ... Richard Bliss, Director.” Petitioner's identification of itself and “any officers, employees and/or agents thereof” is insufficient because it does not identify any individuals by name and instead appears merely to account for any possible deposition of petitioner under *Fed. R. Civ. P. 30(b)(6)*. However, petitioner's identification of Mr. Bliss, the sole employee of petitioner upon which petitioner relies in support of its motion for summary judgment is sufficient.
- 8 The better practice would have been to serve corrected initial disclosures upon being made aware of the misidentification of petitioner as “[r]egistrant.”
- 9 If respondent believed that, because petitioner referred to itself in those initial disclosures as “registrant,” those initial disclosures were inadequate, its remedy was to file a motion to compel initial disclosures prior to the close of the discovery period. See *Trademark Rule 2.120(e)(1)*. However, because the discovery period in this case has closed, respondent's time in which to file such a motion has lapsed.
- 10 Respondent's assertion that Mr. Bliss is an undisclosed expert witness is not well-taken. Mr. Bliss is a fact witness, who was named in petitioner's initial disclosures.

- 11 Although petitioner alleges in its brief that it has standing based on the refusal of its pleaded application under Trademark Act Section 2(d) based on respondent's involved registration, petitioner did not file a copy of the Office Action in which its pleaded application was so refused. Therefore, the refusal of registration of the pleaded application does not provide a basis for standing in connection with this motion.
- 12 Although it may have been preferable for Silverman's to be a co-petitioner, it is not necessary that Silverman's be a party plaintiff to this proceeding for petitioner to prevail in this case.
- 13 Even if we assume that petitioner does not use the pleaded CWC mark on clocks, likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).
2013 WL 6040029 (Trademark Tr. & App. Bd.)

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