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

Proceeding	91178927
Party	Plaintiff Royal Crown Company, Inc. and Dr. Pepper/Seven Up, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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ROYAL CROWN COMPANY, INC. and	:	
DR PEPPER/SEVEN UP, INC.,	:	<u>Consolidated Proceedings:</u>
	:	Opposition No. 91178927
Opposers,	:	Opposition No. 91180771
	:	Opposition No. 91180772
- against -	:	Opposition No. 91183482
	:	Opposition No. 91185755
THE COCA-COLA COMPANY,	:	Opposition No. 91186579
	:	Opposition No. 91190658
Applicant.	:	
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**OPPOSERS’ OPPOSITION TO APPLICANT’S MOTION TO AMEND APPLICATIONS  
AND REPLY IN FURTHER SUPPORT OF OPPOSERS’ BRIEF ON REMAND**

Opposers Royal Crown Company, Inc. and Dr Pepper/Seven Up, Inc. (together, “Opposers”) submit this memorandum in opposition to the Motion to Amend Applications (“Motion”) filed by Applicant The Coca-Cola Company (“Applicant”) and in further support of Opposers’ Brief on Remand dated December 17, 2018.

**I. Background**

Following remand of these consolidated oppositions from the Federal Circuit, the Board, on September 27, 2018, ordered the parties to rebrief the question of whether the term “zero” is generic or descriptive when used for the goods identified in the opposed applications focusing on “the critical evidence of record relevant to the legal standards set forth by the court in its decision on appeal.” (177 TTABVUE.)<sup>1</sup> Opposers filed their brief in response to the Board’s order on December 17, 2018. (181 TTABVUE.) In lieu of filing its own brief, and in an apparent attempt to avoid a determination that “zero” in fact is not protectable, Applicant instead filed the instant

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<sup>1</sup> All citations to TTABVUE docket numbers refer to the parent case (Opp. No. 91178927).

Motion to Amend Applications, requesting the Board to permit Applicant to amend the applications at issue to disclaim the term “zero.” In its Motion, Applicant reasons that because “the only relief sought by [Opposers] in these proceedings is the entry of a disclaimer of the term ‘zero’ in the applications at issue” “entry of these disclaimers will resolve the issues in these proceedings without any further activity needed on the part of the Board.”

Applicant is mistaken. Opposers’ request for relief has always been a determination that “zero” is generic or merely descriptive. Entry of a disclaimer is the manner in which that relief is demonstrated, but a disclaimer in and of itself does not resolve the legal issues in this opposition. Moreover, Board practice dictates that Applicant cannot short circuit a decision on the merits through an unconsented motion to amend. Opposers therefore respectfully submit that the Board should defer ruling on the Motion until final decision.

## **II. Argument**

Applicant asserts that the only relief sought in these proceedings is a disclaimer of the term “zero.” That is incorrect. Opposers in fact seek a ruling that Applicant’s marks are not entitled to registration without a disclaimer of the term “zero.” Adding a disclaimer, as Applicant seeks to do through its Motion, does not by itself indicate whether a term is generic or whether it is instead descriptive. *See* Trademark Manual of Examining Procedure (“TMEP”) § 1213.03(a)-(b). Not surprisingly, Applicant has not indicated in its Motion whether it seeks to disclaim “zero” as a generic or a descriptive term. But that distinction makes all the difference. If the Board determines that “zero” is generic, Applicant cannot at a later point seek registration of the opposed marks (or another “zero”-inclusive mark) on grounds of acquired distinctiveness. But if a disclaimer is added without resolution of whether “zero” is generic or merely descriptive, the parties will be back where they started over a decade ago. But after all this time,

Opposers – and the public, if not Applicant – deserve final resolution of the question whether “zero” is generic in the context of Applicant’s goods or whether it is instead descriptive without sufficient evidence of secondary meaning.

Moreover, Board practice confirms that Applicant is not permitted to avoid a decision on the merits simply by voluntarily adding a disclaimer to its applications. According to Board practice, unconsented motions to amend such as Applicant’s here are generally deferred until final decision or summary judgment. TBMP 514.01. Thus, the practice is for the Board to decide the substantive issues in the case, and then consider how the proposed amendment fits with the ruling. Here, for example, if the Board rules that “zero” is either generic or descriptive without sufficient secondary meaning, then it could grant Applicant’s Motion in the same ruling, thus avoiding the typical procedure wherein the Board gives an applicant time after decision to make a motion to add the disclaimer. *See, e.g.*, 171 TTABVUE at 36.

Finally, Opposers note that by electing not to respond to Opposers’ brief on remand and instead filing the instant Motion, Applicant may be deemed to have waived any arguments against a finding that “zero” is generic or descriptive without sufficient evidence of secondary meaning. *See, e.g., Viacom Int’l Inc. v. Fanzine Int’l Inc.*, 56 U.S.P.Q.2d 1363, 1368 (S.D.N.Y. 2000).

### **III. Conclusion**

Opposers respectfully request that the Board should proceed to issue a full decision on the issues identified in the Board’s September 27, 2018 order and should defer ruling on Applicant’s Motion to Amend Applications until the time of final decision.

Dated: New York, New York  
March 7, 2019

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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Dr Pepper/Seven Up, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that, on this 7<sup>th</sup> day of March, 2019, I caused a true and correct copy of the foregoing **Opposers' Opposition to Motion to Amend and Reply in Further Support of Opposers' Brief on Remand** to be served on counsel for The Coca-Cola Company, Bruce W. Baber, Esq., at the email address bbaber@kslaw.com.

/Laura Popp-Rosenberg/  
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