

ESTTA Tracking number: **ESTTA366706**

Filing date: **09/03/2010**

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

Proceeding	91194379
Party	Plaintiff Cornfields, Inc.
Correspondence Address	RICHARD B. BIAGI NEAL & MCDEVITT, LLC 1776 ASH STREET NORTHFIELD, IL 60093 UNITED STATES pto@nealmcdevitt.com
Submission	Other Motions/Papers
Filer's Name	Jeremy M. Roe
Filer's e-mail	pto@nealmcdevitt.com
Signature	/jmr/
Date	09/03/2010
Attachments	20100903 Motion for Judgment on the Pleadings.pdf ( 14 pages )(42466 bytes )

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

*In the matter of Trademark Application No. 77/780,921  
For the Mark SKINNY MUNCH – Int. Class 30  
Filed on July 14, 2009  
Published on December 1, 2009*

_____	)	
CORNFIELDS, INC.	)	
	)	
Opposer,	)	
	)	Opposition No. 91194379
v.	)	
	)	
ADEENA WEISS,	)	
d/b/a SKINNY MUNCH CORP.	)	
	)	
Applicant.	)	
_____	)	

**OPPOSER’S MOTION FOR JUDGMENT ON THE PLEADINGS**

Opposer Cornfields, Inc. (hereinafter “Opposer”), by and through its attorneys, hereby moves for Judgment on the Pleadings, pursuant to Fed. R. Civ. P. 12(c) and T.B.M.P. § 504. Opposer notes that it has filed this Motion after the pleadings have closed,<sup>1</sup> but prior to the opening of the first testimony period. *See* T.B.M.P. § 504.01.

**I. INTRODUCTION AND PROCEDURAL HISTORY**

On July 14, 2009, Applicant Adeena Weiss d/b/a Skinny Munch Corp. (hereinafter “Applicant”) filed an intent-to-use application to register the mark SKINNY MUNCH for “grain-based snack foods” in International Class 30. Opposer has opposed registration on the ground

<sup>1</sup> Opposer filed its Answer to Applicant’s Counterclaim on August 13, 2010. *See* Docket No. 11.

that Applicant's applied-for mark so resembles Opposer's SKINNY Mark for "food products, namely snack chips of a corn meal nature" in International Class 30 that it is likely to cause confusion, mistake, or deceive prospective consumers.

Opposer filed its Notice of Opposition against Applicant on March 26, 2010. *See* Docket No. 1. On May 10, 2010, Applicant moved for an extension of time to Answer or Otherwise Plead, which was granted by the Trademark Trial and Appeal Board ("TTAB") on June 21, 2010.<sup>2</sup> Thereafter, Applicant filed its Answer and Counterclaim for Cancellation on June 25, 2010.<sup>3</sup> *See* Docket No. 7. Opposer filed its Answer to Applicant's Counterclaim on August 13, 2010. *See* Docket No. 11.

Opposer now moves for judgment on the pleadings. There are no genuine issues of material fact to be resolved, and Opposer is entitled to judgment on the merits, as a matter of law, for the reasons described herein. *See, e.g., Cesari S.R.L. v. Peju Province*, Opp. No. 91158374, 2004 WL 1703103 (T.T.A.B. 2004) [non-precedential].

## II. LEGAL STANDARD

"A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice." T.B.M.P. § 504.02, *citing Scotch Whiskey Ass'n v. U.S. Distilled Prods. Co.*, 13 U.S.P.Q. 2d. 1711, 1714 n.1 (T.T.A.B. 1989). A party may move for judgment on the pleadings after the

---

<sup>2</sup> Opposer initially opposed Applicant's motion for an extension of time to answer, but subsequently withdrew its objection after a teleconference with the interlocutory attorney. *See* Docket No. 6.

<sup>3</sup> When first filed, the Board declined to consider Applicant's Counterclaim for failure to pay the proper fee. *See* Docket No. 8. The Board issued an Order vacating its prior Order and reinstating the Counterclaim on July 16, 2010. *See* Docket No. 9.

pleadings are closed but within such time as not to delay trial. Fed. R. Civ. P. 12(c). Opposer acknowledges that when considering a Rule 12(c) motion, the Board must accept as true all well-pleaded factual allegations of the nonmoving party, and all reasonable inferences from the pleadings should be drawn in favor of the nonmoving party. T.B.M.P. § 504.03. “A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law.” *Id.*

### **III. OPPOSER IS ENTITLED TO JUDGMENT ON THE MERITS**

#### ***A. Opposer Has Standing to Oppose the Pending Application.***

The Lanham Act states that “[a]ny person who believes that he would be damaged by the registration of a mark” may file an opposition. 15 U.S.C. § 1063. A party seeking to oppose a pending trademark application based on a potential likelihood of confusion must first establish that it has standing to oppose registration of the pending application. *Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q. 2d 1283 (T.T.A.B. 2007) [precedential]. There are two requirements for standing in an *inter partes* case; an opposer must have (1) a “real interest” in the proceedings, and (2) a reasonable basis for the belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999). The core issue is whether the opposer would be somehow damaged if a registration were granted to the applicant. *Wilson v. Delaunay*, 245 F.2d 877 (C.C.P.A. 1957). The TTAB has stated that “[a]ll that is necessary . . . is that the ‘person’ bringing the opposition establish conditions and circumstances from which damage to it from the opposed mark can be assumed.” *FBI v. Societe: “M. Bril & Co.”*, 172 U.S.P.Q. 310 (T.T.A.B. 1971).

Opposer’s pleading clearly satisfies these requirements. Opposer pled, and Applicant

admitted, that Opposer owns the SKINNY Marks which are used in connection with snack foods, directly related to Applicant's "grain-based snack foods." See Notice of Opp., ¶¶ 1, 3, 5; Answer to Notice of Opposition, ¶ 1. Opposer further pled that the proposed mark SKINNY MUNCH would likely cause confusion, deception, and mistake among purchasers, and that the mark would dilute the distinctive quality of Opposer's famous SKINNY Marks. Notice of Opp., ¶¶ 9, 10. Opposer also pled that registration of the proposed mark SKINNY MUNCH will seriously damage Opposer, its business and its goodwill. *Id.* at ¶ 11. These statements demonstrate that Opposer has a real interest in these proceedings and a reasonable basis for its belief of damage if registration of the SKINNY MUNCH mark were to issue. Thus, Opposer has successfully pled standing to oppose the pending application.

***B. The Pleadings Establish That Registration of the Application for SKINNY MUNCH Should Be Refused Under Section 2(d).***

In addition to the preliminary matter of standing, to prevail on its Section 2(d) ground of opposition, Opposer must prove ownership of a registration and/or priority of use and that the applicant's mark is likely to cause confusion. See *Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q. 2d 1283 (T.T.A.B. 2007) [precedential].

***1. Opposer has ownership of a registration and priority of use.***

Opposer pled ownership of a family of SKINNY marks, including U.S. Registration No. 911,254 for the mark SKINNY. See Notice of Opp., ¶ 1. Applicant admitted that Opposer owns the mark SKINNY. See Answer to Notice of Opposition, ¶ 1. Thus the issue of ownership is not in dispute.

Furthermore, the SKINNY mark was registered on April 13, 1971, thirty-eight years prior

to Applicant's filing date for U.S. Serial No. 77/780,921. This registration is valid and subsisting. There is no dispute that Opposer has actual priority of use on snack foods. *See* Answer to Notice of Opposition, ¶¶ 1, 2. Because Opposer has undisputed ownership of a registration and priority of use, its opposition to the pending application should be granted, as a matter of law.

***2. Registration of Applicant's mark is likely to cause confusion.***

Opposer must prove that registration of the pending application is likely to cause confusion with its SKINNY Marks, based on an analysis of the various factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973); *see also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405 (Fed. Cir. 1997). Again, Opposer pled ownership of a family of SKINNY Marks for use in connection with various snack foods. *See* Notice of Opp. ¶ 1.<sup>4</sup>

Opposer's SKINNY Marks contain no limitations on channels of trade or classes of purchasers, nor does Applicant's application. Thus the Board must presume that Applicant's goods would be marketed in all normal trade channels and to all normal classes of purchasers. *In re Elbaum*, 211 U.S.P.Q. 639 (T.T.A.B. 1981). Moreover, even if the respective goods are not closely related, Applicant's goods are within the natural zone of expansion for Opposer. The most relevant *du Pont* factors remaining are the degree of similarity between the respective marks, and the degree of similarity between the respective goods. *In re E. I. du Pont de Nemours*

---

<sup>4</sup> Opposer notes that U.S. Serial No. 77/826529 has now proceeded to registration. *See* U.S. Registration No. 3,820,740. Opposer respectfully requests that the Board take judicial notice of this change in status.

& Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

***a. The respective marks are highly similar.***

With regard to the similarity or dissimilarity of the respective marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 U.S.P.Q.2d 1715 (T.T.A.B. 2008). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of the trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106 (T.T.A.B. 1975). Although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985).

The respective marks at issue are standard character marks, and each mark consists of the term SKINNY. The only distinction is that Applicant's proposed mark includes the term MUNCH. The dominant portion of Applicant's mark is SKINNY. The term "MUNCH," as used in Applicant's mark, is not dominant because it describes an element or characteristic of snack foods. There is no factual dispute in the pleadings about the high degree of similarity between the respective marks.

Opposer respectfully directs the Board to consider this matter in light of a prior TTAB decision, *Cesari S.R.L. v. Peju Province*, Opp. No. 91158374, 2004 WL 1703103 (T.T.A.B. 2004) [non-precedential]. In *Cesari*, the Opposer, owner of the prior registration LIANO for

“wines,” opposed a pending application for the mark LIANA for “wine.” The Board granted Opposer’s motion for judgment on the pleadings, finding that there were no genuine issues of material fact, given that the marks were virtually identical and the goods were identical. The Board engaged in an analysis of the respective marks from the perspective of the average purchaser, finding that registration of applicant’s mark should be refused. Likewise, the Board should conclude here that the overwhelming similarities between the respective marks and goods should preclude registration of Applicant’s mark.

***b. The respective goods are quite similar and Applicant’s goods are within the natural zone of expansion for Opposer.***

The Board has provided the following guidance with regard to analyzing the degree of similarity of the respective goods:

It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods.

*Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q. 2d 1283 (T.T.A.B. 2007). There is no genuine issue of fact in the pleadings with regard to the respective goods at issue in this case.

The parties are in agreement that Opposer’s snack foods are corn and potato based, while Applicant’s proposed goods are grain-based. This is an insignificant difference, at best. The respective goods are snack foods and are likely to be encountered by the same purchasers in similar channels, such as a grocery store.



The respective goods are closely related and thus competitive, based on the Board's prior analysis of similar snack foods. *See, e.g., Arrowhead Mills, Inc. v. Good Health Natural Foods, Inc.*, Opp. No. 91118502 (T.T.A.B. 2004) [non-precedential] (finding "vegetable-based snack foods" to be closely related to "grain based snack food," stating that "[b]oth products are snack foods, albeit different in a basic ingredient."); *In re Grande Foods*, Serial No. 75/816,791 (T.T.A.B. 2002) [non-precedential] (finding tortilla chips and corn chips to be closely related to pretzels); *In re Krinos Foods, Inc.*, Serial No. 76/047,170 (T.T.A.B. 2002) [non-precedential] (finding cookies and corn-based products to be closely related). Here, the only difference between the respective goods is a single ingredient, which is not enough to prevent consumer confusion.

Moreover, Applicant's goods are within Opposer's natural zone of expansion. "A trademark owner is entitled to protection against the registration of a similar mark on products that might reasonably be expected to be produced by him in the normal expansion of his business." T.M.E.P. § 1207.01(a)(v). The test is whether a potential purchaser would believe that the applicant's product (in this case, grain-based snack foods) is within the registrant's logical zone of expansion. *Id.*, citing *In re 1<sup>st</sup> USA Realty Professionals, Inc.*, 84 U.S.P.Q. 2d 1581 (T.T.A.B. 2007). Certainly, grain-based snack products are well within the natural zone of expansion for the manufacture of corn and potato snack chips. *Cf. ConAgra Foods RDM, Inc. v. Sandwich Food Corp.*, 2008 WL 3211817, Opp. No. 911770341 (T.T.A.B. 2008) [non-precedential] (refusing registration of the proposed mark CANDWICH and finding that "food items packaged in cans, namely meat-based sandwiches" were within the natural zone of expansion for the MANWICH marks, used with "sandwich sauce" and "spice and seasoning mixes for meats").

For all of these reasons, Opposer is entitled to judgment on the merits as a matter of law, and the Board should refuse registration of the pending application for SKINNY MUNCH accordingly.

***C. Applicant's Affirmative Defenses and Counterclaim Raise No Genuine Issues of Material Fact.***

Applicant's responsive pleading included three affirmative defenses and a counterclaim to cancel Opposer's SKINNY mark on the basis of genericness. The first affirmative defense, titled "Lack of Secondary Meaning," includes a series of unsupported allegations about Opposer's mark. Applicant failed to provide any facts to support its claim that the mark is not inherently distinctive or lacks secondary meaning. Opposer pled that it has owned and used its SKINNY Marks, through a predecessor-in-interest, since 1969 in connection with snack foods. *See* Notice of Opp. ¶ 3. Even assuming *arguendo* that the mark lacks inherent distinctiveness, there is no question that the mark has acquired distinctiveness based on more than forty years of widespread extensive use and promotion.

Applicant's second affirmative defense, captioned "Likelihood of Confusion/Fair Use," contains a denial of any likelihood of confusion based on the fact that Opposer's snack foods are made from corn and potato, while Applicant intends to use its mark with grain-based snacks. As stated above, while Opposer agrees that this is a *de minimus* distinction, the goods are overwhelmingly similar and would be encountered by the same purchasers. Moreover, Applicant asserts that third party uses of the term SKINNY undercut Opposer's exclusive rights in its marks, yet Applicant has provided absolutely no evidence to support this bald and unsubstantiated allegation. Applicant's final affirmative defense, "Attack on Validity of U.S.

Trademark Registration,” simply fails to state any claim for relief. Affirmative defenses, like other pleadings, must be well pled and must include more than mere conclusory allegations. *See Ashcroft v. Iqbal*, 129 S. Ct. 2430, 2431, 174 L.Ed.2d 226 (2009); *Bell Atlantic v. Twombly*, 550 U.S. 544, 570, 127 S. Ct. 1955, 167 L.Ed.2d 929 (2007); *CTF Dev. Inc. v. Penta Hospitality LLC*, 2009 WL 3517617, at \*7-8 (N.D. Cal. Oct. 26, 2009) (“Under the Iqbal standard, the burden is on the defendant to proffer sufficient facts and law to support an affirmative defense”); *Tracy ex rel. v. NVR Inc.*, 2009 WL 3153150, at \*7-8 (W.D.N.Y. Sept. 30, 2009) (striking conclusory affirmative defenses). Each of Applicant’s affirmative defenses falls far short of this standard and should be disregarded by the Board.

With regard to Applicant’s Counterclaim for cancellation of the registration, Applicant failed to provide any factual allegations to support its theories. “A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used.” *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Applicant has failed to sufficiently plead this allegation. *Ashcroft v. Iqbal*, 129 S. Ct. 2430, 2431, 174 L.Ed.2d 226 (2009). Applicant has also failed to show that use of the term “skinny” as a common noun with unrelated goods and services has any bearing on whether Opposer’s mark is generic. Clearly, the term “skinny,” as used in Opposer’s mark, does not describe a “thing” or any genus of goods. *See, e.g., In re Veeco Instruments, Inc.*, Serial No. 76/383240 (T.T.A.B. March 22, 2006) [non-precedential] (reversing genericness refusal of the mark DIGITAL INSTRUMENTS with metrological scientific research services). Moreover, even assuming *arguendo* that the SKINNY Marks are descriptive, Opposer’s undisputed

evidence of forty years of use provides ample support for the mark's acquired distinctiveness.

In summary, there is no genuine issue of material fact with regard to any element of Opposer's claim or Applicant's Counterclaim, and Opposer is entitled to judgment as a matter of law.

#### IV. CONCLUSION

Opposer respectfully requests that the TTAB grant Opposer's Motion for Judgment on the Pleadings, that U.S. Trademark Application Serial No. 77/780,921 for the mark SKINNY MUNCH be rejected, and that registration by Applicant be denied.

Date: September 3, 2010

Respectfully submitted,

By: /s/ Jeremy M. Roe, Esq.

Richard B. Biagi  
Jeremy M. Roe  
NEAL & MCDEVITT, LLC  
1776 Ash Street  
Northfield, Illinois 60093  
Tel. – 847.441.9100  
Fax. – 847.441.0911

*Attorneys for Opposer,  
Cornfields, Inc.*

## **TABLE OF AUTHORITIES**

### **CASES**

*Arrowhead Mills, Inc. v. Good Health Natural Foods, Inc.*, Opp. No. 91118502 (T.T.A.B. 2004)

*Ashcroft v. Iqbal*, 129 S. Ct. 2430, 2431, 174 L.Ed.2d 226 (2009)

*Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q. 2d 1283 (T.T.A.B. 2007)

*Bell Atlantic v. Twombly*, 550 U.S. 544, 570, 127 S. Ct. 1955, 167 L.Ed.2d 929 (2007)

*Cesari S.R.L. v. Peju Province*, Opp. No. 91158374, 2004 WL 1703103 (T.T.A.B. 2004)

*ConAgra Foods RDM, Inc. v. Candwich Food Corp.*, 2008 WL 3211817, Opp. No. 911770341 (T.T.A.B. 2008)

*CTF Dev. Inc. v. Penta Hospitality LLC*, 2009 WL 3517617, at \*7-8 (N.D. Cal. Oct. 26, 2009)

*In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001)

*In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997)

*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973)

*In re Elbaum*, 211 U.S.P.Q. 639 (T.T.A.B. 1981)

*FBI v. Societe: "M. Bril & Co."*, 172 U.S.P.Q. 310 (T.T.A.B. 1971).

*In re Grande Foods*, Serial No. 75/816,791 (T.T.A.B. 2002)

*H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987 (Fed. Cir. 1986)

*In re Krinos Foods, Inc.*, Serial No. 76/047,170 (T.T.A.B. 2002)

*H.D. Lee Co. v. Maidenform Inc.*, 87 U.S.P.Q.2d 1715 (T.T.A.B. 2008)

*In re Majestic Distilling Company, Inc.*, 315 F.3d 1311 (Fed. Cir. 2003)

*In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)

*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005)

*Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999)

*Scotch Whiskey Ass'n v. U.S. Distilled Prods. Co.*, 13 U.S.P.Q. 2d 1711, 1714 n.1 (T.T.A.B. 1989)

*Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106 (T.T.A.B. 1975)

*Tracy ex rel. v. NVR Inc.*, 2009 WL 3153150, at \*7-8 (W.D.N.Y. Sept. 30, 2009)

*In re 1<sup>st</sup> USA Realty Professionals, Inc.*, 84 U.S.P.Q. 2d 1581 (T.T.A.B. 2007).

*In re Veeco Instruments, Inc.*, Serial No. 76/383240 (T.T.A.B. March 22, 2006)

*Wilson v. Delaunay*, 245 F.2d 877 (C.C.P.A. 1957)

## **STATUTES AND RULES**

15 U.S.C. § 1063

Trademark Manual of Examination Procedure, § 1207.01(a)(v)

TTAB Manual of Procedure, §§ 504.01, 504.02, 504.03

Federal Rule of Civil Procedure 12(c)

**CERTIFICATE OF SERVICE**

The undersigned, one of the attorneys for Opposer, hereby certifies that a true and correct copy of the foregoing **OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS** was served by deposit with the United States Postal Service, First Class, upon:

Adeena Weiss  
28 East Jackson Blvd. #10A  
Chicago, IL 60604-2263

*Correspondent for Applicant*

on this 3rd day of September, 2010.

*/s/ Jeremy M. Roe*

---

*One of the Attorneys for Opposer*