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

Proceeding	91194379
Party	Defendant Adeena Weiss d/b/a Skinny Munch Corp.
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Date	09/17/2010
Attachments	skinnymunch response judg on pldngs.txt ( 11 pages )(14222 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 of SKINNY MUNCH ? Int. Class 30  
Filed on July 14, 2009  
Published on December 1, 2009  
CORNFIELDS, INC., )

)  
Opposer, )

) Opposition No.

\_\_\_\_\_ )  
v. )

ADEENA WEISS, )  
d/b/a SKINNY MUNCH CORP., )

)  
)  
Applicant. )

)  
APPLICANT'S RESPONSE TO OPPOSER'S MOTION  
FOR JUDGMENT ON THE PLEADINGS

NOW COMES APPLICANT, Adeena Weiss, and for her Response to Oppos  
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Motion for Judgment on the Pleadings, states as follows:

INTRODUCTION

On September 3, 2010, Opposer filed it Motion for Judgment on th  
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Pleadings alleging that there are no genuine issues of material fact  
such that Opposer is entitled to judgment as a matter of law. Opposer's  
Motion, p. 2. Applicant respectfully submits that said allegation in  
misplaced. Opposer is correct that Applicant filed its mark ?Skinny  
Munch? for the class of goods for International Class 30, but the  
important distinction is that Applicant's food product is not a snack  
chip, does not contain corn, nor does it contain potato, nor is it  
confusingly similar. This fact may only be elicited through  
discovery. Opposer uses the mark ?Skinny? for its product ?Skinny  
Sticks? and ?Skinny Minis? which is a potato based snack chip.

LEGAL STANDARD

A party may not obtain judgment on the pleadings if the nonmovin  
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party's pleading raises issues of fact which, if proved, would  
establish the non-moving's party entitlement to judgment. Baroid  
Drilling Fluids Inc. v. Sun Drilling Products, 24 U.S.P.Q.2d 1048  
(T.T.A.B. 1992). Emphasis added. It is incumbent upon one seeking to  
preserve and thereafter extend a family of marks to be vigilant and  
alert against the invasion of the family domain. Id.

ARGUMENT

I. OPPOSER HAS NO STANDING AS THERE IS NO REASONABLE BASIS FOR THE  
BELIEF OF DAMAGE

In RE/MAX Intern., Inc. v. Equity Max Reality, Inc. 2007 WL  
1110590, (S.D.Cal. 2007) Defendant filed a motion for judgment on the  
pleadings. The court denied the motion since movant failed to satisfy  
their burden of proof. The court reasoned that trademark cases are  
inherently factual. Id. Emphasis added. Particularly with respect to

the infringement element of likelihood of confusion, "a full record is usually required to fully assess the facts." Id. citing *KP Permanent Make-Up v. Lasting Impression I, Inc.*, 408 F.3d 596, 608 (9th Cir.2005) (citing *Clicks Billiards*, 251 F.3d at 1265); see also *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1075 (9th Cir.2006). The court further stated that in construing the allegations of the Complaint in the light most favorable to the non movant, and in light of the inherently factual nature of trademark infringement, the court cannot conclude at this stage that, as a matter of law. Id.

In the instant matter, Opposer contends that there is a reasonable basis for the belief of damage. This argument is far-fetched, as the word "Skinny" has been substantially diluted and has become generic with the thousands of food products bearing the name "Skinny?". Additionally, and most importantly in this case, is that the products are in no way similar. Again, this can only be confirmed via discovery; however the Applicant states that the products are in no way similar. Applicant's product is not a chip, is not vegetable based, does not look like any of Opposer's products, nor in fact any food product on the market.

Opposer contends that it has satisfactorily satisfied the requirement of the belief of damage, yet does not state how? How can two distinct products with two distinct names, with distinct ingredients and labeling cause confusion to the public, when the word "Skinny" is used on thousand of products, of which Opposer has no ownership. If Opposer is attempting to contend the ownership in a family of products bearing the name "Skinny" then it falls on its own sword. One, because Opposer only uses the name "Skinny" for Skinny Sticks and Skinny Minis- that's it. Thus, there is no risk of confusion, because Applicant's product and Opposer's products are distinct. Second, if Opposer contends ownership in any product bearing the name "Skinny" it fails as it has not been vigilant in protecting the name "Skinny" for use only by its client.

Additionally, Opposer contends that the Applicant's good is in the natural zone of expansion of Opposer. Opposer bases this solely on the class of goods Applicant filed its registration under, yet has no idea what Applicant's product is. Again, this argument fails as it is speculative, and without discovery is not well placed. Opposer's claim that the dominant portion of Applicant's mark is the work "Skinny" and "Munch" is merely descriptive. This also fails. The name must be viewed as a whole "Skinny Munch?". When broken down into words, Applicant submits that the dominant portion is "Munch?", as "Skinny" has become generic.

If Opposer contends that that the natural zone for expansion of its product is grain based products, then it can contend the natural zone of expansion is any other type of product as well, i.e. ice cream "Skinny Cow" tm- which is owned by Nestle , or "Skinnygirl"tm products owned by Bethanny Frankel, or "Skinny Dippers" tm for flatbreads owned by Ozery Holdings, registration number 3738302, or "Skinny Lips Chips" for potato chips owned by Linden Oaks Corporation, registration number 3262957. Where is the limit? Essentially, Opposer contends it has a monopoly on the word "Skinny?", and this is not true. See Exhibit A which demonstrates, in part, at least 626 products using the word "Skinny?". Opposer does not have a monopoly on the word Skinny for every food product because Opposer cannot demonstrate a risk of

confusion for every food product as the Board very well is aware of since there are a variety of trademarks issued with the word "Skinny".

Opposer then relies on the case of *Cesari SRL v. Peju Province*, 2004 WL 1703103 (T.T.A.B.) regarding the similarity of marks. However, Opposer's argument is misplaced. The above cited case involves the following two names: LIANO and LIANA. This instant matter can be easily distinguished. *Cesari* involved two names for the same type of product, wines, which were one letter different from each other. In the case at bar, the products are completely dissimilar both in name, final product and type of ingredients.

Next, Opposer relies on *Barbara's Bakery Inc. v. Landesman*, 2007 WL 196406, 82 U.S.P.Q.2d 1283 (T.T.A.B. 2007) for the proposition that that the goods need not be competitive or identical to support a likelihood of confusion. What Opposer quite conveniently fails to state to the Board is that that case involved the following two names: applicant's "Barb's Buns Bakery, Inc." mark for printed recipes, recipe books, and newsletters is likely to cause confusion with opposer's "Barbara's" and "Barbara's Bakery" marks, (since opposer uses its marks on newsletters, printed recipes, and recipes included as part of packaging for its prepared food products, and these goods are legally identical to various "newsletters" and "recipes sold as a component of food packaging?"). The instant matter can again be easily distinguished from *Barbara's Bakery, Inc.* Applicant understands that in *Barbara's Bakery, Inc.* there was a risk of confusion, in that the names were confusingly similar, for similar products and printed material, however that is not the case here. Applicant's product contains completely different ingredients (i.e. no overlay of ingredients), packaging, etc., and do not target the same purchasers. Opposer then relies on a variety of cases regarding the similarity of snack goods, however all of those cases were non precedential and involved the difference of one ingredient or where the product names are nearly identical, i.e. *Manwich* and *Candwich*. Opposer's Motion, p. 88

The court assesses likelihood of confusion for trademark infringement purposes based on the following factors, which it refers to as "digits of confusion": (1) strength of the plaintiff's mark, (2) similarity of design between the marks, (3) similarity of the products, (4) identity of retail outlets and purchasers, (5) similarity of advertising media used, (6) the defendants' intent, (7) actual confusion, and (8) degree of care exercised by potential purchasers. Lanham Act, § 32(1)(a), 15 U.S.C.A. § 1114(1)(a). Likelihood of confusion, is generally a fact question, summary judgment may be proper if the undisputed facts in the summary judgment record compel the conclusion that the movant is entitled to judgment as a matter of law. Lanham Act, § 32(1)(a), 15 U.S.C.A. § 1114(1)(a). Although showing of actual confusion is not mandatory to demonstrate trademark infringement, it is patently the best evidence of likelihood of confusion. Lanham Trade-Mark Act, § 43(a), 15 U.S.C.A. § 1125(a);

Addressing each factor of likelihood of confusion, weighs in favor of Applicant. There is no similarity of design, nor product, nor purchasers, advertising nor any evidence that there would be actual confusing by the consumer. Opposer speculates that there would be a likelihood of confusion but does not state how- presumably because no discovery has been conducted.

Lastly, Opposer addresses Applicants Affirmative Defenses and

claims Opposer's own distinctiveness in the word "Skinny". Applicant submits that any distinctiveness has long been lost and diluted. See Exhibit A. Opposer then concludes that while the ingredients in Applicant's and Opposer's product may be different, they would be encountered by the same purchasers and are overwhelmingly similar. This statement is unsubstantiated as Opposer is not even aware of the nature of Applicant's product.

Accordingly, Opposer has not satisfied its burden, the motion is premature and the motion should be denied.

WHEREFORE, Applicant respectfully requests that Opposer's motion be denied and for any other relief that is just and proper.

Date: September 17, 2010 Respectfully submitted,

By: /s/ Adeena J. Weiss

Adeena J. Weiss  
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Applicant

CERTIFICATE OF SERVICE

The undersigned, an attorney, deposes and states that she has used a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS was served by deposit with the United States Postal Service, First Class, upon:

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

on this 17 day of September, 2010.

By: /s/ Adeena J. Weiss

Applicant

EXHIBITA

TESS was last updated on Fri Sep 17 04:05:45 EDT 2010

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FIREFLY SKINNY TEA

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2  
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SKINNY FAT  
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3  
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BACK TO SKINNY  
TARR  
LIVE  
4  
85043978

YOU CAN NEVER BE TOO SKINNY OR TOO RICH  
TARR  
LIVE  
5  
85089709

SKINNY GUY  
TARR  
LIVE  
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85046178

FITNESS FROM HOME SKINNY IS NOT FOR EVERYONE... HEALTHY IS!  
TARR  
LIVE  
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85000516

DRINK SKINNY  
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SUMO SKINNY  
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SKINNY WATER CHILL  
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SKINNY WATER NATURAL  
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THE SKINNY DIET AIDE  
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SKINNYSHIRT MAMA  
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SKINNYSHIRT  
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SKINNYGIRL  
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RIPT SKINZ BY LEGENDS & HEROES POWERED BY SKINEEZ SKINCAREWEAR  
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LIVE  
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SKINNY MINI-MERGENCY KIT FOR HER  
TARR  
LIVE  
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SKINNY RICE  
TARR  
LIVE  
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FAT DAN'S BBQ NEVER TRUST A SKINNY COOK BBQ BURGERS AND BEER  
TARR  
LIVE  
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85010454

MAKES YOU SKINNY IN A MINUTE  
TARR  
LIVE



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SKINNY IN A MINUTE  
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LIVE  
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SKINNY SEASON THE FAT BURNING SPICE BLEND  
TARR  
LIVE  
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85099251

SKINNY POWDER  
TARR  
LIVE  
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85098379

SKINNY DIPPED PRETZELS  
TARR  
LIVE  
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85098318

SKINNY WINES  
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SKINNY WATER SPORT  
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SKINNY LIFE  
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SKINI MIXIN  
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SKINNY B  
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SKINNY ARSE  
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HEALTHY IS THE NEW SKINNY  
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SKINNY B\*TCH  
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SKINNY B\*TCH  
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SKINNY BRITCHES  
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ROCKIN SKINNIES  
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LIVE  
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QUICKWAY SKINNY MARGARITA MIX  
TARR  
LIVE  
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SKINNY LEG BOOTS  
TARR  
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SKINNY NOODLES  
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LIVE

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THE SKINNY GINGER  
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SKINNY CHIX  
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SKINNY WHIP  
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ROCKIN SKINNIES  
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SKINNY CHIA  
TARR  
LIVE  
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85057495

SKINNY GENES  
TARR  
LIVE  
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85052407

SKINNY PIG  
TARR  
LIVE  
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85047641

CASCADE ICE SKINNY COCKTAILS  
TARR  
LIVE  
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85046279

SKINNYTEES THE DIET YOU WEAR  
TARR  
LIVE

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85038473

SKINNYWEAR  
TARR  
LIVE  
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79051293

BIO-SYNERGY SKINNY  
TARR  
DEAD  
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78973826  
3348675

SKINNY BEAR BASS JIGS  
TARR  
LIVE  
50  
78945734

THE SKINNY BITCH  
TARR  
LIVE

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