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

Proceeding	91194379
Party	Plaintiff Cornfields, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In the matter of Trademark 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 REPLY IN SUPPORT OF ITS
MOTION FOR JUDGMENT ON THE PLEADINGS**

Opposer Cornfields, Inc. (hereinafter “Opposer”), by and through its attorneys, hereby files its Reply in Support of its Motion for Judgment on the Pleadings (the “Motion”).

I. INTRODUCTION

On September 3, 2010, Opposer filed its Motion, contending that there were no genuine issues of material fact in the pleadings, and Opposer was entitled to judgment on the merits as a matter of law. In its Motion, Opposer stated that the pleadings established that it had standing to oppose the pending application for SKINNY MUNCH and that registration of the pending application should be refused under Section 2(d) of the Lanham Act. Opposer pled ownership a

family of SKINNY marks, including Registration No. 911,254 for the mark SKINNY, which has been in use in interstate commerce since 1969. Opposer further pled that registration of the pending application for SKINNY MUNCH would be likely to cause confusion with its SKINNY marks, based on the high degree of similarity between the marks and high degree of relatedness between the respective goods.

On September 17, 2010, Applicant Adeena Weiss d/b/a Skinny Munch Corp. (hereinafter “Applicant”) filed its Response to the Motion. Applicant feebly argued that the distinction between its goods and those owned by Opposer created a genuine issue of fact which precluded judgment on the pleadings. Applicant further alleged that Opposer had no standing to plead a reasonable basis for the belief of damage, and that third party registrations for “skinny” formative marks undercut Opposer’s argument that Applicant’s goods are within its natural zone of expansion.

For the reasons that follow, Applicant has failed to raise any factual issues and Opposer’s Motion should be granted.

II. OPPOSER IS ENTITLED TO JUDGMENT ON THE MERITS

A. Applicant’s Response Raises No Genuine Issues of Material Fact.

Applicant filed its pending application for SKINNY MUNCH for “grain-based snack foods” in International Class 30. Opposer’s SKINNY registrations and applications, on the other hand, encompass “food products, namely snack chips of a corn meal nature,” “potato-based snack foods,” and “vegetable-based snack foods.” Applicant appears to argue that the degree of similarity between the respective goods can only be analyzed after discovery is conducted. Opposer is unaware of any authority that supports this proposition. In contrast, Opposer

provided ample case law in its Motion to support judgment on the pleadings for goods as highly similar as these. *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.”).

Moreover, Applicant appears to be misguided in emphasizing its intended use of the SKINNY MUNCH mark in connection with goods not yet in development. For purposes of this Opposition, it is Applicant’s identification of goods, not its undefined future plans, which determines registrability.¹ “It is well established that in a proceeding such as this, the question of likelihood of confusion must be determined on the basis of an analysis of the mark as applied to the goods and/or services recited in applicant’s application vis-a-vis the goods and/or services recited in an opposer’s registration, rather than what the evidence shows the goods and/or services to be.” *Interstate Brands Corp.*, 53 U.S.P.Q. 2d 1910 (T.T.A.B. 2000) (precedential).

There is simply no factual dispute regarding the respective goods. Opposer does not contend that the goods are identical, nor do they need to be for registration to be refused. *See, e.g., Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q. 2d 1283 (T.T.A.B. 2007). This argument is a red herring and creates no genuine issue of material fact that would preclude judgment on the pleadings.

¹ For instance, Applicant states that its “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.” While this may be intriguing, the fact remains that the Applicant’s identification of goods controls the Board’s analysis.

B. Opposer Has Properly Pled a Reasonable Basis for Damage.

Applicant also asserts that Opposer has no reasonable basis for belief that it would be damaged by registration of the SKINNY MUNCH application. Opposer's Notice of Opposition clearly states that registration of the application would seriously damage Opposer, its business, and its goodwill. *See* Notice of Opp. ¶¶ 9-11. This belief is well founded, based on the similarities between the marks and the relatedness of the goods. A fundamental problem with Applicant's Response is that it believes that terms and products that are "distinct" necessarily create no risk of confusion. This is plainly untrue, as neither identical marks nor identical goods are required to support a finding of likelihood of confusion. *See, e.g., In re Microsoft Corp.*, 68 U.S.P.Q.2d 1195, (T.T.A.B. 2003) ("[W]hen marks appear on or in connection with virtually identical or closely related goods, the degree of similarity of the marks necessary to support a conclusion of likely confusion is not as great as when the goods are different."); *In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812 (T.T.A.B. 2001) ("[T]he greater the degree of similarity between the applicant's mark and the cited mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion."); T.M.E.P. § 1207.01(a)(i).

Applicant's reliance on an unpublished federal case is also misplaced. *See Re/Max Int'l, Inc. v. Equity Max Realty, Inc.*, No. 06-cv-1345, 2007 WL 111590 (S.D. Cal. April 3, 2007). First, this unpublished Ninth Circuit opinion has limited persuasive authority on this proceeding before the Trademark Trial and Appeal Board. More directly, though, in *Re/Max*, the defendant, not the plaintiff, was the movant for judgment on the pleadings. The court found that, when construing the pleadings in a light most favorable to the plaintiff, it could not conclude that there was no trademark infringement as a matter of law. In contrast, the current Motion was brought

by Plaintiff, who sufficiently pled statements that demonstrate that there is a likelihood of confusion between its SKINNY marks and the application for SKINNY MUNCH.

Finally, Opposer's basis for damage is clear from the pleadings: it owns a family of SKINNY marks used in connection with snack foods, and registration of the SKINNY MUNCH application would harm Opposer's goodwill in those marks. Again, Applicant has raised no genuine issue of fact and Opposer's Motion should be granted.

C. Applicant's Third Party Evidence Is Entitled to Little Weight.

Applicant also takes umbrage with Opposer's argument that its goods are within the natural zone of expansion for Opposer, based on the presence of additional "skinny" formative marks used in connection with food products. Opposer is not claiming to have a monopoly on all uses of the term "skinny" with food products. Applicant's goods are highly related to Opposer's goods, and Opposer vigilantly enforces its rights in its marks against uses that are confusingly similar. Indeed, the mark cited by Applicant with goods most similar to Applicant's, SKINNY LIPS CHIPS (Registration No. 3262957, for "potato chips"), was expressly surrendered by the registrant after Opposer learned of its registration.

Additionally, the mere presence of various other "skinny" formative marks on the Principal Register does not mean that the term has become generic. First, the vast majority of those marks have nothing to do with snack foods. Most importantly, though, it is well settled that third-party registrations are entitled to little weight on the question of likelihood of confusion because they are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406 (C.C.P.A. 1973); *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (T.T.A.B. 1991); T.M.E.P.

§1207.01(d)(iii). Quite simply, the existence on the Principal Register of other “skinny” formative marks does not provide a basis for registrability for the applied-for mark. *AMF*, 474 F.2d at 1406; *In re Total Quality Group, Inc.*, 51 U.S.P.Q.2d 1474, 1477 (T.T.A.B. 1999).

Yet again, Applicant has raised no genuine issue of fact and Opposer’s Motion should be granted.

III. CONCLUSION

Opposer has met its burden of showing that there are no genuine issues of material fact to be resolved after the pleadings have closed in this case, and Opposer is entitled to judgment as a matter of law. 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: October 7, 2010

Respectfully submitted,

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

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TABLE OF AUTHORITIES

CASES

- AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406 (C.C.P.A. 1973)
- Arrowhead Mills, Inc. v. Good Health Natural Foods, Inc.*, Opp. No. 91118502 (T.T.A.B. 2004)
- Barbaras Bakery, Inc. v. Barbara Landesman*, 82 U.S.P.Q. 2d 1283 (T.T.A.B. 2007)
- Cesari S.R.L. v. Peju Province*, Opp. No. 91158374, 2004 WL 1703103 (T.T.A.B. 2004)
- Interstate Brands Corp.*, 53 U.S.P.Q. 2d 1910 (T.T.A.B. 2000)
- In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (T.T.A.B. 1991)
- In re Microsoft Corp.*, 68 U.S.P.Q.2d 1195, (T.T.A.B. 2003)
- In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812 (T.T.A.B. 2001)
- Re/Max Int'l, Inc. v. Equity Max Realty, Inc.*, 2007 WL 111590 (S.D. Cal. April 3, 2007)
- In re Total Quality Group, Inc.*, 51 U.S.P.Q.2d 1474, 1477 (T.T.A.B. 1999)

STATUTES AND RULES

Trademark Manual of Examination Procedure, §§ 1207.01(a)(i), 1207.01(d)(iii).

CERTIFICATE OF SERVICE

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

Adeena Weiss
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Correspondent for Applicant

on this 7th day of October, 2010.

/s/ Jeremy M. Roe

One of the Attorneys for Opposer