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

Proceeding	91207022
Party	Defendant Calvert Enterprises, Inc.
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Date	08/20/2014
Attachments	Motion to Amend Drawing Mark - 022.pdf(115195 bytes) Motion to Suspend Proceedings - 022.pdf(59065 bytes)

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

In re Application Nos. 85441320 and 85441324

Johnson & Johnson and)	
RoC International s.a.r.l.)	
)	Opposition No. 91207022
Opposers,)	
)	
v.)	
)	
Calvert Enterprises, Inc.,)	
)	
Applicant.)	
_____)	

STIPULATED MOTION TO AMEND MARK

With Opposer’s consent, Applicant, Calvert Enterprises, Inc. (“Calvert”), respectfully petitions the Board to amend its stylized ROX SPA drawing mark in International Classes 003, 005 and 041 (the “Current ROX SPA Mark”) from the mark depicted below to the amended ROX SPA mark (“Amended ROX SPA Mark”) depicted below.



Current ROX SPA Mark



Amended ROX SPA Mark

During consideration of the proposed amendment, the parties respectfully request that the Proceedings¹ be suspended, as set forth in the concurrently filed Motion to Suspend Proceedings.

¹ The “Proceedings” are herein defined collectively as these proceedings and the related proceedings identified by Opp. No. 91206910. For the sake of convenience, this Motion is being filed concurrently in both proceedings.

I. STIPULATED MOTION TO AMEND MARK

Pursuant to 37 CFR § 2.72, an applicant may amend the drawing of a mark based on a bona fide intention to use the mark in commerce under section 1(b) of the Lanham Act, so long as the proposed amendment does not materially alter the mark.

Section 1609.02(a) of the TMEP further states that the “general test of whether an alteration is material is whether, if the mark in an application for registration had been published, the change would require republication in order to present the mark fairly for purposes of opposition,” and that “an amendment of a registered mark is acceptable if the modified mark contains the essence of the original mark...and the mark as amended creates essentially the same impression as the original mark.” *See also* TMEP §§ 807.14 *et seq.* *In re Hacot-Colombier*, 105 F.3d 616, 620 (Fed. Cir. 1997). This test applies to an amendment of a design mark drawing as well as to a wordmark. *In re Thrifty, Inc.*, 274 F.3d 1349 (Fed Cir. 2001).

Marks entirely comprised of words can sometimes be varied as to their style of lettering, size, and other elements of form without resulting in a material alteration of the mark. *See Ex parte Squire Dingee Co.*, 81 USPQ 258, recon. denied, 81 USPQ 543 (CCPA 1949) (amendment from block lettering to script not a material alteration). TMEP § 1609.02(a).

Calvert respectfully asserts that the amended mark ROX SPA as shown above creates the same commercial impression as the mark in the original application.

In general, courts have held that the addition of material to an existing registration tends to qualify as a material alteration of the original mark. However, in this case Calvert is seeking only to align the terms ROX and SPA in its stylized mark and to present all letters in the same size and typeface. Such variations in lettering style and size do not amount to a material alteration in this case since the literal elements of the marks remain the same.

Literal elements are deemed to be the dominant portions of trademarks. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (the word portion of a mark is often considered the dominant feature); *Fram Trak Indus. Inc. v. Wiretracks, LLC*, 77 USPQ2d 2000 (TTAB 2006), citing *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, USPQ2d 1375 (Fed. Cir. 2002) (words are the dominant portion of a mark); *Ceccato v. Manifatura Lane Gaetano Marzetto & Figli S.p.A.*, 32 U.S.P.Q.2d 1192 (TTAB 1994) (literal portion of a mark makes a greater and long lasting impression).

This is particularly true where, as here, the stylization of both the current mark and the proposed mark is slight. *See In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (“we do not consider the slight stylization of the registrant's mark or the added "L" in applicant's mark to be differences that would overcome the essential similarity of [the marks]”); *Centraz Indus., Inc. v. Spartan Chem. Co., Inc.*, 77 USPQ2d 1698, 1700 (TTAB 2006) (“...the stylization of applicant’s mark is not striking or otherwise dramatic; thus, prospective purchasers would readily perceive the essence of applicant’s mark”).

Because the dominant elements of the marks remain unchanged, and because the stylization of the proposed amended marks is similar in appearance to the stylization used in the original applications, Applicant respectfully submits that the marks will have the same commercial impression on consumers, who are not likely to perceive the proposed mark as a different mark. *See Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743 (TTAB 1983) (finding that modifications to drawing marks are acceptable and do not amount to a material alteration if the modified mark contains what is the “essence of the original mark” and creates the impression of being essentially the same mark).

Contrary to the situation at hand, the Board typically sustains decisions refusing modifications of marks when they consist of the addition of matter not contained in the original application. In situations where additional matter is included in a revised drawing, it is easy to see that such an amendment would materially alter the mark and create a differing commercial impression.

For example, in the case of *In re Abolio y Rubio S.A.C.I y G.*, 24 USPQ2d 1152 (TTAB 1992), the Board found that an attempt to amend a mark by including additional design elements in an amended drawing mark constituted a material alteration of the original typed drawing. The applicant added pictorial elements to an original typed mark. The original typed mark was LA PAULINA, but the amended design mark is depicted below.



Clearly, the addition of the drawing of a character standing on a ring of cheese, as well as the stylized depiction of LA PAULINA amounts to a material alteration of the mark from a simple standard character mark.

The Board similarly refused to allow the applicant in the matter of *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989), to amend its design mark drawing. In that case, the applicant had submitted an original application for the mark THE WINE SOCIETY OF AMERICA, which consisted solely of a typed drawing. In response to subsequent office actions, the applicant submitted a new drawing specimen which consisted of the design mark below.



Again, in that case, the applicant was attempting to move from a standard character mark to a design mark which included a prominent new design element that appeared above the words. The Board sustained the examining attorney's decision that this significant addition amounted to a material alteration of the original mark.

Contrary to the decisions above in which the Board determined that such additional matter amounted to a material alteration of the original marks, Applicant is not attempting to append additional matter to the Original ROX SPA Mark through the submission of its Amended ROX SPA Mark. The literal elements are the same. Moreover, Applicant is not attempting to convert a standard character mark to a design mark. Rather, both the Original ROX SPA Mark and the Amended ROX SPA Mark are stylized word marks that are visually similar.

Similarly, the Board reviewed the examining attorney's refusal to amend the mark in *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983), and overturned the refusal.

When comparing the original and amended design marks from the case below, the Board reasoned that the general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to present the mark fairly for purposes of opposition.



Original



Amended

The Board determined that the amendment above did not amount to a material alteration of the mark because the new design created the same commercial impression. In the case above, the position of the airplane design and the triangle are inverted, and the words “Omni-Visa” have been repositioned from the top of the mark to the middle. Although these differences would be obvious to the casual observer, according to the Board, it did not amount to a change in the overall commercial impression of the mark. Surely, in the case at hand, the repositioning of the slightly stylized literal elements, by moving “spa” alongside “rox,” does not impact the overall commercial impression of the mark as a whole.

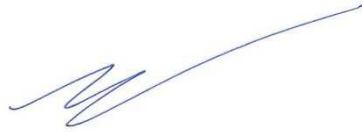
Based on the foregoing, Applicant respectfully requests that the Board grant its motion to amend its application to reflect the Amended ROX SPA Mark.

II. STATEMENT OF CONSENT

Applicant has secured the express consent of all other parties to these Proceedings for this Motion, the amendments requested herein, and the suspensions requested in the Motion to Suspend Proceedings filed concurrently herewith.

Applicant has provided an e-mail address herewith for itself and for the opposing parties so that any order on this motion may be issued electronically by the Board.

Respectfully submitted,

A handwritten signature in blue ink, appearing to read 'Konrad K. Gatien', written in a cursive style.

Dated: August 20, 2014

Konrad K. Gatien
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CERTIFICATE OF SERVICE

It is hereby certified that I served a true and correct copy of the foregoing document entitled:

STIPULATED MOTION TO AMEND MARK

on Opposers and their counsel of record, Drinker Biddle & Reath LLP, 1500 K Street, N.W., Suite 1100, Washington, DC 20005, by placing a true and correct copy thereof in a sealed envelope, postage prepaid, in First Class U.S. mail, for collection and mailing with the United States Postal Service on this 20th day of August 2014.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on August 20, 2014, at Los Angeles, California



Traci Escamilla

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

In re Application Nos. 85441320 and 85441324

Johnson & Johnson and)	
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Opposers,)	
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Applicant.)	
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STIPULATED MOTION TO SUSPEND PROCEEDINGS

With Opposer’s consent, Applicant, Calvert Enterprises, Inc. (“Calvert”), respectfully requests the Proceedings¹ be suspended while the Board considers Calvert’s concurrently filed Motion to Amend Mark. In addition, if the Motion to Amend is denied, the parties respectfully request that the Proceedings remain suspended while Applicant pursues new applications for the amended drawing marks set forth in the Motion to Amend. Pursuant to Fed. R. Civ. P. 11, this certifies that this request to suspend proceedings is not being presented for any improper purpose, such as to cause unnecessary delay or needlessly increase in the cost of litigation. To the contrary, the parties’ stipulation and concurrently filed Motion to Amend are being made jointly by the parties in order to promote judicial efficiency in expediting a resolution of this matter, and to conserve the parties’ time and resources in resolving this dispute. The parties further acknowledge that the granting of the stipulation will not result in prejudice to either party in preparing the Proceedings for trial, if necessary.

¹ The “Proceedings” are herein defined collectively as these proceedings and the related proceedings identified by Opp. No. 91206910. For the sake of convenience, this Motion is being filed concurrently in both proceedings.

I. STATUS OF THE PROCEEDINGS.

Significant progress has been made toward settlement of this matter. Since the institution of these proceedings on September 17, 2012 (and the related proceedings identified by Opp. No. 91206910, filed on September 10, 2012), Opposers' outside counsel and Applicant's outside counsel have worked diligently to jointly prepare and exchange several drafts of the proposed Agreement ("Agreement").

For example, as early as October 29, 2012, Opposers' counsel sent a draft of the proposed Agreement to Applicant's counsel for review. Applicant's counsel promptly conferred with Applicant to discuss issues concerning the use and registration of Applicant's proposed mark. On December 20, 2012, Applicant's counsel revised and circulated the draft Agreement for Opposers' review and comment. Thereafter, the parties' counsel exchanged a significant amount of correspondence via electronic mail regarding the material points and substance of the Agreement.

As a result, on January 21, 2013, Opposers' counsel sent further revisions to Applicant's counsel for consideration. Applicant's counsel summarized the proposed revisions, which were promptly communicated to Applicant. Before a response could be prepared, Applicant's counsel became associated with a new law firm, which required several months in order to transition all clients and files to his new firm, which is the current firm of record for Applicant.

During the transition, however, Applicant's counsel continued to engage in internal discussions with Applicant on multiple occasions in order to address the objectives of his client and the scope of the Agreement. As a result, in June 2013 Applicant was able to provide several pages of comments to Opposers' counsel.

Applicant's counsel and Opposers' counsel continued to discuss the draft Agreement through several emails and telephone conferences. In July 2013, one of Opposers' primary outside counsel for these proceedings transitioned to a new legal practice, and this matter was transitioned to another counsel in the same firm who represents the Opposers regularly. The parties' respective counsel continued to work cooperatively to establish a new rapport and to ensure that both sides were informed of the past and current terms of the parties' negotiations.

Between June and November 2013, the parties exchanged correspondence and granted courtesy extensions while the parties were reviewing additional drafts of the settlement agreement. Due to these ongoing discussions and a good faith effort by both parties to work toward coexistence, on November 25, 2013, Opposers' counsel sent a revised draft of the Agreement to Applicant's counsel that significantly narrowed the remaining issues to be decided to only a few.

On December 20, 2013, Applicant filed its Answers in the Proceedings to preserve its rights while the parties continued to discuss settlement. Through holiday and weather related closures, counsel for both parties continued with an open line of communication and after the holidays, from January – April 2014, the parties continued to exchange settlement correspondence.

On April 2, 2014, Applicant's counsel prepared a revised version of the draft Agreement and forwarded same to Opposers' counsel for review and discussion with Opposers. Opposers' outside counsel discussed the terms of this Agreement with Opposers' inhouse counsel, and shortly thereafter on April 22, 2014, Opposers provided a revised draft of the Agreement to Applicant's counsel, who promptly reviewed and discussed the proposed revisions with Applicant.

On April 25, 2014, Applicant's counsel provided comments on the revised draft of the Agreement to Opposers' counsel. The principal issue with respect to the proposed revisions centered on Applicant adopting the Amended ROX SPA Mark.² After many written and oral exchanges regarding this matter, the parties agreed that the proposed amendment at issue in the concurrently filed Motion to Amend would be the most effective means to alleviate the parties' concerns and resolve the instant proceedings.

In sum, the parties have agreed that the amendment proposed in the concurrently filed Motion to Amend (or, if necessary, the filing of new trademark applications for the amended drawing marks at issue in said motion) will be the most effective means to alleviate the parties' concerns and resolve the instant Proceedings. The parties, therefore, respectfully request that the current Proceedings be suspended while the Board considers Applicant's Motion to Amend.

Although the parties are hopeful that the Motion to Amend will be granted, in the event the Motion to Amend is denied for any reason, the parties respectfully request that the Proceedings remain suspended to allow time for Applicant to file new trademark applications for the proposed amended drawing marks, and for said marks to reach the notice of allowance stage of their prosecution. In such case, Applicant agrees to provide the Board with periodic status reports for its new trademark applications including: (1) the filing of the new trademark applications (which shall occur within five business days of the entry of the Board's decision on Applicant's Motion to Amend if the motion is denied), (2) the publication of said marks for opposition, and (3) the granting of the notices of allowance for said applications, at which point the parties would promptly stipulate to dismiss the Proceedings.

² The nature of the amended mark is discussed in the concurrently filed Motion to Amend.

II. STATEMENT OF CONSENT.

Applicant has secured the express consent of all other parties to these Proceedings for this motion and the suspensions requested herein.

Applicant has provided an e-mail address herewith for itself and for the opposing parties so that any order on this motion may be issued electronically by the Board.

Respectfully submitted,



Dated: August 20, 2014

Konrad K. Gatien
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CERTIFICATE OF SERVICE

It is hereby certified that I served a true and correct copy of the foregoing document entitled:

STIPULATED MOTION TO SUSPEND PROCEEDINGS

on Opposers and their counsel of record, Drinker Biddle & Reath LLP, 1500 K Street, N.W., Suite 1100, Washington, DC 20005, by placing a true and correct copy thereof in a sealed envelope, postage prepaid, in First Class U.S. mail, for collection and mailing with the United States Postal Service on this 20th day of August 2014.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on August 20, 2014, at Los Angeles, California



Traci Escamilla