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

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|------------------------|---|
| Proceeding | 91207517 |
| Party | Plaintiff ic! berlin brillen GmbH, RalphAnderl |
| Correspondence Address | Teresa C. Tucker Grossman Tucker Perreault & Pflieger PLLC 55 South Commercial Street Manchester, NH 03101 UNITED STATES ttucker@gtp.com |
| Submission | Motion to Amend Pleading/Amended Pleading |
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| Signature | /tct/ |
| Date | 08/20/2013 |
| Attachments | Second Motion to Amend Notice of Opp.8.20.13.pdf(54056 bytes) SecondAmendedOpposition.8.20.13.pdf(81687 bytes) |

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

In Re Trademark Appln.)
Serial No. 85092577)
Filed: July 26, 2010)
Published in the Official Gazette)
of June 19, 2012)
Mark: EYE SEE (design plus words))
Class: INT. 09)
ic! berlin brillen GmbH,)
and)
Ralph Anderl)
Opposers) Opposition No. 91207517
v.)
EYE SEE Courtesy Glasses)
Applicant)
*

OPPOSER'S SECOND MOTION FOR LEAVE TO AMEND
NOTICE OF OPPOSITION

NOW COME the Opposers, ic! berlin brillen GmbH and Ralph Anderl, and move to amend the pleadings under Federal Rule of Civil Procedure 15(a) and Rules 315 and 507 of the Trademark Trial and Appeal Board Rules of Procedure, to add to the grounds for opposition that Applicant lacked a bona fide intent to use the applied-for mark at the time the application was filed. Submitted herewith is Opposers' proposed Second Amended Notice of Opposition.¹

¹ Opposers filed a first Motion for Leave to Amend Notice of Opposition on August 14, 2013 with respect to updating the status of a pleaded application to an issued registration.

The Notice of Opposition was filed October 17, 2012 and included priority and likelihood of confusion as the grounds for opposition.

Opposers request that the Notice of Opposition be amended to include the following allegations:

At the time of filing its application on July 26, 2010, Applicant did not have a bona fide intent to use the proposed “EYE SEE” mark in association with the goods identified in the Application.

Applicant does not have, and never has had, a bona fide intent to use the proposed “EYE SEE” mark in association with the goods identified in the Application.

Under Federal Rule of Civil Procedure 15(a), leave to amend shall be freely given when justice so requires. Likewise, the Board recognizes that “amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” See *American Optical Corp. v. Am. Olean Tile Co.*, 168 U.S.P.Q. 471, 473 (TTAB 1971).

Here, Opposers were only able to confirm Applicant’s lack of evidence to support its purported bona fide intent after Applicant failed to respond to discovery requests, including Requests for Admission which, unanswered, are now deemed admitted, despite having been given additional time to do so by Opposers. Furthermore, prior to formal discovery, Opposers’ counsel requested from Applicant’s counsel, samples of the manner in which Applicant had used or made efforts to use its trademark, yet Applicant’s counsel never provided such materials.

Applicant, Eye See Courtesy Glasses, will suffer no undue prejudice from Opposers’ additional ground for opposition, since Applicant would not require discovery on the issue of its

own bona fide intent to use the “EYE SEE” mark in commerce, and has been on notice of Opposers’ intention by way of Opposers’ discovery, namely requests for documents and admissions and interrogatories directed specifically toward the question of Applicant’s intent to use the subject mark.

Based on the foregoing, Opposers respectfully request the Motion for Leave to Amend Notice of Opposition be GRANTED.

ic! berlin brillen GmbH
and Ralph Anderl

Dated: August 20, 2013

By: /s/Teresa C. Tucker
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CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the subject Opposers’ Motion for Leave to Amend Notice of Opposition was served upon the Applicant via First Class mail, postage prepaid, this 20th day of August, 2013, to the following address:

Anthony Pinizzotto
Attorney at Law
3959 S. Nova Road, Suite 23
Port Orange, Florida 32127

/s/ Teresa C. Tucker
Teresa C. Tucker

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SECOND AMENDED
NOTICE OF OPPOSITION

ic! berlin brillen GmbH, a Limited Liability Company organized in Germany, with an address of Saarbrücker Str. 37 Berlin, 10405, Germany, and Ralph Anderl, a citizen of Germany with an address of Linienstrasse 40, Berlin, 10119, Germany, (hereinafter collectively “Opposers”), believe they will be damaged by the registration of the mark “EYE SEE” shown in Application Serial No. 85092577 filed on July 26, 2010, by EYE SEE Courtesy Glasses, and hereby oppose the same.

The grounds for opposition against said application are as follows:

OPPOSERS' MARKS AND REGISTRATIONS

1. Opposers are the owners of the marks "IC! BERLIN" for pre-recorded cds and dvds featuring musical, dramatic, marketing, advertising and promotional recordings; surveying instruments; surveying apparatus, namely, level measuring machines, leveling rods, magnetic compasses, and surveying chains; photographic apparatus and instruments, namely, photographic cameras, photographic projectors, and photographic viewfinders; cinematographic machines and apparatus; optical apparatus and instruments, namely, optical lenses and optical glasses; weighing apparatus and instruments, namely, weighing machines, scales, and balances; measuring apparatus and instruments, namely, bevels, rain gauges, and instruments for measuring length; signaling apparatus and instruments, namely, marking buoys, signaling buoys, rotating lights, signal bells, and signal whistles; lifesaving apparatus and instruments, namely, life belts, life jackets, life-buoys, life preservers, life-saving rafts, and lifesaving vests for use by dogs; teaching apparatus and instruments, namely, computers and children's educational software; apparatus, devices, and instruments for conducting, switching, transforming, accumulating, regulating and controlling electricity, namely, adapters, electric wires and cables, continuity test apparatus for electrical circuits, electric accumulators, electric conductors, electric connections and connectors, electric switches and junction boxes, electric resistors and transformers, and electric fuses; apparatus for recording, transmission or reproduction of sound and images; magnetic data carriers, namely, blank magnetic data carriers and prerecorded magnetic data carriers featuring musical, dramatic, marketing, advertising and promotional recordings; recording discs, namely, blank cd-roms for sound or video recording and blank recordable dvds; automatic vending machines and mechanisms for coin-operated apparatus; fire-

extinguishing apparatus, namely, fire extinguishers in Class 9, clothing, namely, tops, bottoms, coats, jackets, belts, jeans, swimwear, scarves, ties, sweat pants, sweat shirts, t-shirts, sweaters, pajamas, gloves and underwear; footwear; headgear, namely hats and caps in class 25 and retail store services featuring spectacles, sunglasses, spectacle cases, spectacle frames, spectacle arms, spectacle accessories, optical goods, printed matter, books, cds, dvds, clothing, headgear and footwear; wholesale store services featuring spectacles, sunglasses, spectacle cases, spectacle frames, spectacle arms, spectacle accessories, optical goods, printed matter, books, cds, dvds, clothing, headgear and footwear; online retails store services featuring spectacles, sunglasses, spectacle cases, spectacle frames, spectacle arms, spectacle accessories, optical goods, printed matter, books, cds, dvds, clothing, headgear and footwear; organization of exhibitions and trade fairs for commercial and advertising purposes, in particular organisation of exhibitions and trade fairs for optical goods, spectacles, sunglasses and spectacle accessories; mediation and conclusion of commercial transactions for others, including within the framework of e-commerce; organization and conducting of product presentations in the nature of goods and service presentations; advertising; marketing; public relations; business management services; business administration; office functions in class 35 as shown in Trademark Registration No. 3,531,209; “ic! – berlin” for spectacles, sunglasses, spectacle frames, spectacle glasses, spectacle cases in Class 9 as shown in Federal Trademark Registration No. 2,611,684; and “ic!” for spectacles; sunglasses; spectacle frames; spectacle cases; spectacle glasses; spectacle accessories, namely, temples for spectacles, spectacle lenses and contact lenses in Class 9 as shown in U.S. Trademark Registration No 4254190, (hereinafter collectively “Opposers’ Marks”).

2. The above-referenced registrations constitute prima facie evidence of ownership of the marks “ic! berlin,” “ic! – berlin,” and “ic!” Opposer Ralph Anderl’s rights in Registration No. 2611684 are incontestable under 15 U.S.C. §1065.

3. Opposers heavily rely on Opposers’ Marks in their businesses, including without limitation, in advertising and other marketing efforts, and have built up a significant amount of goodwill in Opposers’ Marks through many years of continuous use.

4. Opposer Ralph Anderl has used the “ic! - berlin” mark shown in Registration No. 2611684 in the U.S. since at least as early as 1997 in connection with the goods identified in said registration.

APPLICANT’S APPLICATION

5. On information and belief, on July 26, 2010 Applicant Eye See Courtesy Glasses filed an application with the United States Patent and Trademark Office for “EYE SEE” design plus words, assigned Serial No. 85092577 in Class 09, for “eye glasses; magnifying glasses,” which goods are identical and/or essentially identical, and/or closely similar to Opposers’ goods.

6. Applicant’s application indicates a filing date for Applicant’s proposed mark of July 26, 2010, and is based on Applicant’s intent to use the mark. Accordingly, Opposers’ filing dates and first use dates of “IC!” and “IC! BERLIN” precede Applicant’s filing date and use. Thus, Opposers are the senior users.

LIKELIHOOD OF CONFUSION

7. Opposers allege that there is a likelihood of confusion between Opposers’ Marks and Applicant’s proposed “EYE SEE” mark, given the similarities in the sight, sound, and overall commercial impressions of the marks. Consumers are therefore likely to be confused or

misled into believing that goods sold under Applicant's "EYE SEE" mark are sponsored by or affiliated with Opposers.

8. The "EYE SEE" mark proposed for registration by Applicant is similar in sound and thus maintains the same overall commercial impression as Opposers' Marks. Applicant's "EYE SEE" is the exact phonetic equivalent of "IC," as it appears in Opposer's Marks "IC!" and "IC! BERLIN." Thus, all the parties' marks phonetically comprise "I" "C" in the initial, and thus dominant, position. As a result, the overall commercial impression conveyed by Applicant's mark is essentially identical in meaning to Opposers' Marks, and Applicant's mark creates the impression that it is a formative of Opposers' Marks.

9. Furthermore, the Applicant's proposed "EYE SEE" mark is so similar in sound to Opposers' Marks that the ordinary consumer perceiving these marks would not likely focus on the slight distinctions in the marks because they sound identical.

10. The likelihood of confusion between Opposers' Marks and Applicant's proposed "EYE SEE" mark is heightened by the common identity of the parties' goods. Applicant's application includes eyewear, which is identical and/or closely similar to goods included in Opposers' registrations and application.

11. The likelihood of confusion between Opposers' Marks and Applicant's proposed "EYE SEE" mark is also furthered by the similarity between the parties' respective channels of trade, which are not limited in the respective application and registration but would reasonably include the same channels of trade in which such goods are sold.

12. In view of the similarity between Applicant's proposed mark "EYE SEE" and Opposers' Marks, as well as the similarity of the goods and channels of trade, Applicant's proposed mark is likely to cause confusion, mistake and/or deception.

13. This likelihood of confusion harms the extensive goodwill and consumer recognition that Opposers have in Opposers' Marks.

APPLICANT'S LACK OF BONA FIDE INTENT TO USE

14. At the time of filing its application on July 26, 2010, Applicant did not have a bona fide intent to use the proposed "EYE SEE" mark in association with the goods identified in the Application.

15. Applicant does not have, and never has had, a bona fide intent to use the proposed "EYE SEE" mark in association with the goods identified in the Application.

WHEREFORE, Opposer prays that application Serial No. 85092577 be refused, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposers.

RESPECTFULLY SUBMITTED this 20th day of August, 2013.

ic! berlin Brillen GmbH
and
Ralph Anderl

By /s/ Teresa C. Tucker
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/s/ Teresa C. Tucker _____
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