

ESTTA Tracking number: **ESTTA569136**

Filing date: **11/05/2013**

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

Proceeding	91210412
Party	Defendant Abbott Laboratories
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Submission	Stipulated/Consent Motion to Extend
Filer's Name	Tatyana V. Gilles
Filer's e-mail	officeactions@norvellip.com, jnorvell@norvellip.com, tgilles@norvellip.com
Signature	/Tatyana V. Gilles/
Date	11/05/2013
Attachments	131105 Motion for Extension - SIMILAC TOTAL COMFORT - with consent.pdf(18732 bytes) Exhibit 1.pdf(100004 bytes)

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

In re Application No. 85/648,078
Filed: June 11, 2012
Mark: SIMILAC TOTAL COMFORT
Published in the *Official Gazette* (Trademarks) on: October 30, 2012

GENERAL MILLS, INC., GENERAL MILLS)	
IP HOLDINGS II, LLC,)	
)	
Opposers,)	
)	
v.)	Opposition No. 91210412
)	
ABBOTT LABORATORIES,)	
)	
)	
Applicant.)	

**APPLICANT’S MOTION FOR EXTENSION OF TIME OF ANSWER,
DISCOVERY AND TRIAL DEADLINES WITH OPPOSERS’ CONSENT**

Pursuant to Section 310.03(c) of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Applicant, Abbott Laboratories, (“Applicant”) respectfully requests that the Trademark Trial and Appeal Board (the “Board”) grant it an extension of time to file an answer until twenty (20) days after the Board rules on Applicant’s Motion to Strike Immaterial Matter from Opposers, General Mills, Inc. and General Mills IP Holdings II, LLC, (“Opposers”) Notice of Opposition and an extension of all discovery or trial deadlines. Opposers consent to this extension request.

BACKGROUND

Applicant filed its application to register the mark SIMILAC TOTAL COMFORT Serial No. 85/648,078 (“Applicant’s Mark”) on June 11, 2012. The trademark Examining Attorney entered an amendment to the identification of goods of the application on

September 13, 2012, and the application was published for opposition on October 30, 2012.

On November 20, 2013, Opposers requested a 90-day extension of time to file a notice of opposition against Applicant's Mark. The extension was granted until February 27, 2013. On February 26, 2013, Opposers requested their second 60-day extension of time to file a notice of opposition against Applicant's Mark with Applicant's consent. The second extension was granted until April 28, 2013.

On April 29, 2013, Opposers filed the Notice of Opposition. In the Notice of Opposition, Opposers asserted that Applicant's Mark creates likelihood of confusion with Opposers' TOTAL mark and dilutes Opposers' TOTAL mark. Opposers stated in paragraph 3 of their Notice of Opposition that Opposer General Mills IP Holdings II, LLC ("GMI Holdings") is the owner of "valid and subsisting, unrevoked, and uncanceled" federal trademark registration for TOTAL U.S. Reg. No. 1,119,067 for "multi-vitamin and iron supplements" (registration date 5/29/1979). Opposers attached a printout from the United States Patent and Trademark Office ("USPTO") Trademark Status & Document Retrieval ("TSDR") and ASSIGN databases for the U.S. Reg. No. 1,119,067 as Exhibit C to the Notice of Opposition.

In fact, GMI Holdings failed to renew the U.S. Reg. No. 1,119,067 in 2009. As a result, the USPTO canceled the trademark registration. See attached as Exhibit 1 a printout from the USPTO TSDR database showing the current status of the U.S. Reg. No. 1,119,067 as canceled.

The deadline for Applicant to file its answer was set for June 8, 2013. On June 7, 2013, Applicant filed a motion to suspend the proceeding for settlement for 90 days with

consent. As a result, the proceeding was suspended until September 5, 2013. Subsequently, on August 26, 2013, Applicant filed a Motion for an Extension of Answer, with consent, which extended Applicant's deadline to file its answer until November 5, 2013.

On November 5, 2013, Applicant filed a Motion to Strike the canceled U.S. Reg. No. 1,119,067 as immaterial matter from Opposers' Notice of Opposition ("Motion to Strike"). Accordingly, Applicant submits this motion for an extension of time to file Applicant's answer, which is currently set for November 5, 2013, and extension of other discovery or trial deadlines until 20 days after the Board rules on Applicant's Motion to Strike. Opposers consented to this extension of time on November 5, 2013.

ARGUMENT

TBMP Rule 310.03(c) allows for an extension of time to file an answer by stipulation of the parties. In this matter, both parties consent to this extension request.

On November 4, 2013, Applicant filed Motion to Strike an immaterial matter from Opposers' Notice of Opposition. In the Motion to Strike, Applicant asked the Board to strike from Opposers' Notice of Opposition all references to Opposers' canceled registration for the mark TOTAL Reg. No. 1,119,067. Applicant filed its Motion to Strike for a couple of reasons.

First, Opposers do not own any rights in the canceled U.S. Reg. No. 1,119,067 and, therefore, cannot rely on it in their Notice of Opposition. As a result, Applicant requested that this matter be stricken from the Notice of Opposition as immaterial to avoid confusion and a waste of the resources that Applicant and the Board would be required to expend addressing the immaterial matter.

Second, Applicant requested that all references to Opposers' canceled U.S. Reg. No. 1,119,067 be stricken from the Notice of Opposition because the canceled trademark registration covers class 5 goods which are pivotal to the issues of this opposition proceeding because the opposed application also covers class 5 goods. Opposers do not own any additional trademark registrations for the TOTAL mark in class 5, and, therefore, it is important to strike all references to Opposers' canceled U.S. Reg. No. 1,119,067 from the Notice of Opposition.

According to the rules, Applicant's Motion to Strike had to be filed before Applicant's answer. §506.01 TBMP. Thus, Applicant could not have previously filed its answer. Accordingly, it is reasonable to extend Applicant's time for answer and other discovery and trial deadlines until the Board rules on Applicant's Motion to Strike. As stated above, Opposers consent to this extension request.

CONCLUSION

Based upon the foregoing, Applicant respectfully requests the Board grant its request for a twenty (20) day extension of time to file an answer until after the Board rules on Applicant's Motion to Strike and an extension of all discovery or trial deadlines. Opposers consent to this extension request.

Respectfully submitted,

Abbott Laboratories

Dated: November 5, 2013

By: /Tatyana V. Gilles/
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Attorneys for Abbott Laboratories

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S MOTION FOR EXTENSION OF TIME OF ANSWER, DISCOVERY AND TRIAL DEADLINES WITH OPPOSERS' CONSENT and supporting EXHIBIT have been served upon counsel for General Mills, Inc., General Mills IP Holdings II, LLC via United States first class mail, postage prepaid, addressed to:

Sheri M. Hunter
FULBRIGHT & JAWORSKI L.L.P.
98 San Jacinto Blvd.Suite 1100
Austin, TX 78701

Dated: November 5, 2013

By: /Tatyana V. Gilles/
Tatyana V. Gilles

Exhibit 1

STATUS **DOCUMENTS**

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Generated on: This page was generated by TSDR on 2013-10-31 16:22:04 EDT

Mark: TOTAL

No Image exists for this case.

US Serial Number: 73157138

Application Filing Date: Jan. 31, 1978

US Registration Number: 1119067

Registration Date: May 29, 1979

Register: Principal

Mark Type: Trademark

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8 click on the Trademark Document Retrieval link at the top of this page.

Status Date: May 07, 2013

Date Cancelled: May 07, 2013

Mark Information

Mark Literal Elements: TOTAL

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US [0724897](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: MULTI-VITAMIN AND IRON SUPPLEMENTS

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: 1961

Use in Commerce: 1961

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes
Filed ITU: No	Currently ITU: No
Filed 44D: No	Currently 44D: No
Filed 44E: No	Currently 44E: No
Filed 66A: No	Currently 66A: No
Filed No Basis: No	Currently No Basis: No

Current Owner(s) Information

Owner Name: GENERAL MILLS IP HOLDINGS II, LLC

Owner Address: NUMBER ONE GENERAL MILLS BOULEVARD
MINNEAPOLIS, MINNESOTA 55426
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** DELAWARE

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent: DORI HUMMEL
Name/Address: GENERAL MILLS INC
NUMBER ONE GENERAL MLS BLVD
MINNEAPOLIS, MINNESOTA 55426
UNITED STATES

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 07, 2013	CANCELLED SEC. 8 (10-YR)	67657
Mar. 16, 2009	CASE FILE IN TICRS	
Apr. 30, 2003	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Apr. 30, 2003	REGISTERED - SEC. 9 GRANTED/CHECK RECORD FOR SEC. 8	
Apr. 30, 2003	REINSTATED	
Jul. 02, 2002	CANCELLED SEC. 8 (10-YR)/EXPIRED SECTION 9	
Feb. 23, 2000	OPPOSITION TERMINATED NO. 999999	103619
Feb. 23, 2000	OPPOSITION SUSTAINED NO. 999999	103619

Apr. 07, 1999	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Jan. 15, 1998	COUNTERCLAIM OPP. NO. 999999	103619
Jan. 25, 1990	CANCELLATION TERMINATED NO. 999999	17243
Feb. 02, 1989	CANCELLATION DISMISSED NO. 999999	17243
Sep. 19, 1988	CANCELLATION INSTITUTED NO. 999999	17243
Apr. 30, 1985	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jan. 18, 1985	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: May 29, 1999

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: May 07, 2013

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load