

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: April 4, 2016

Opposition No. **91216326**

Tom Miles

v.

Continental Mills, Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

On May 11, 2014, Opposer filed a notice of opposition against Application Serial No. 85823549¹ alleging priority and likelihood of confusion. On

¹ Filed January 15, 2013, under Section 1(b) of the Trademark Act and published for opposition on November 12, 2013, for REAL FOOD FOR REAL PEOPLE and design for “organic and non-organic foods, namely, dehydrated fruit and fruit snacks; frozen vegetables; trail mix consisting primarily of processed nuts and dried fruit and also including blended yogurt chips; snack mix consisting of wasabi peas, processed nuts, processed edamame and also including sesame sticks; kale chips; trail mixes consisting primarily of processed nuts and dried fruit; trail mixes consisting primarily of processed nuts, dried fruit and also including chocolate; trail mixes consisting primarily of processed nuts and seeds; trail mixes consisting primarily of processed nuts and also including processed grains; trail mixes consisting primarily of processed nuts, dried fruit and also including confectionery items; trail mixes consisting primarily of processed nuts, dried fruit and also including coconut milk-based chips; snack mixes consisting of processed nuts and seeds; snack mixes consisting primarily of processed nuts and also including processed grains; snack mixes consisting of processed nuts and also including processed cereal; snack mixes consisting primarily of processed nuts and also including cereal-based snack foods; snack mix consisting of processed nuts, seeds, beans or legumes” in International Class 29 and “cookies; crackers; prepackaged pasta; sauces, namely, salad dressings, barbeque sauces, tomato sauces, pasta sauces and spaghetti sauces; corn chips; corn tortilla chips; corn chips containing whole grains and seeds; quinoa chips; wheat germ for human consumption; milled flax seed flour; processed cereal-based food to be used as a breakfast food; prepackaged brown rice; prepackaged couscous mix, consisting primarily of

January 21, 2015, Opposer sought leave to amend the notice of opposition to add a claim of lack of bona fide intent. On February 7, 2015, the Board granted the motion and accepted the amended notice of opposition as Opposer's operative pleading. Applicant responded to the amended notice of opposition on March 16, 2015, and the parties held their discovery conference on April 13, 2015, with the Board's participation. Pursuant to the Board's order of April 15, 2015, Applicant filed an amended answer on April 27, 2015.

This matter now comes up on the following motions:

- Applicant's motion to amend its application (filed October 23, 2015);
- Applicant's motion to compel discovery (filed October 23, 2015);
- Opposer's motion to amend his pleading (filed October 27, 2015).

Applicant's motions have been fully briefed; Opposer's motion is contested.

Applicant's Motion to Amend Application

By its motion, Applicant seeks to amend the identification of goods in International Class 30 to delete "sauces, namely, salad dressings, barbeque sauces, tomato sauces, pasta sauces and spaghetti sauces."² Opposer has not consented to the proposed amendment.

Where an unconsented motion to amend an application is filed in an *inter partes* proceeding before trial, the Board generally will defer determination until final decision or until the case is decided upon summary judgment. *See, e.g., Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3

couscous, dried pasta, and also including processed garbanzo beans and quinoa; prepackaged, unpopped popcorn kernels" in International Class 30. An allegation of use has yet to be filed.

² International Class 29 remains unchanged.

(TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing). On the other hand, if the proposed amendment limits the identification of goods or services and the applicant consents to the entry of judgment on the question of, for example, a likelihood of confusion with the goods or services to be deleted, it may be approved, even where an opposer objects. *See Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (approving applicant's motion to amend the identification of goods in its application and accepting applicant's consent to judgment with respect to the broader identification of goods). Here, Applicant has explicitly withheld its consent to entry of judgment with regard to the goods to be deleted. *Motion to Amend Application*, 20 TTABVUE 4. **As such, determination of Applicant's proposed amendment is hereby DEFERRED until final decision or until this matter is decided upon summary judgment.**

Applicant's Motion to Compel Discovery

By this motion, Applicant seeks further responses to its first set of interrogatories and requests for production. As noted during the discovery conference, a motion to compel must be supported by a written statement from the moving party that it has made a good faith effort to resolve with the other party the issues presented in its motion, and that it has been unable to reach agreement. *See Trademark Rule 2.120(e)(1) and TBMP § 523.02 (2014)*. In determining whether a good faith effort to resolve the discovery dispute

has been made, the Board may consider, *inter alia*, whether the moving party has investigated the possibility of resolving the dispute, whether sufficient effort was made towards resolution, and whether attempts at resolution were incomplete. *See Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014). For the reasons that follow, the Board does not find Applicant to have discharged the good faith effort requirement under Trademark Rule 2.120(e)(1).

Applicant's assertion of a good faith effort to resolve the discovery dispute consists essentially of emailing Opposer to schedule a meet and confer with a follow-up telephone call nearly four (4) months after the last email communication. Although it is Applicant's position that its efforts are sufficient to discharge the good faith requirement in view of Opposer's refusal to schedule a conference or to otherwise cooperate in resolving the discovery dispute, the Board finds Applicant's characterization of Opposer's response to be overstated and inaccurate. Opposer's suggestion to meet and confer sometime after Applicant had responded to Opposer's discovery requests and his opinion that "[a]rguing about discovery looks to be a complete waste of the parties [sic] and the Board's time" are just that, a suggestion and an opinion, and do not rise to the level of an outright refusal to meet and confer so as to warrant a motion to compel. Indeed, according to Applicant's declaration, the only time that Applicant appears to have contacted Opposer telephonically

was “to advise [Opposer] that a motion to compel would be forthcoming.”³
Motion to Compel, Declaration of John Halski, 21 TTABVUE 15.

Board intervention should only be sought in relation to those discovery disputes that the parties have been unable to resolve ***despite their best efforts to do so***. Here, little effort was made “to promote a *frank exchange* between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before [seeking] judicial resolution.” *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (emphasis added), quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass’n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a similar but less rigorous local rule than Trademark Rule 2.120(e)(1)).

In view of Applicant’s failure to discharge the good faith requirement of Trademark Rule 2.120(e)(1), Applicant’s motion to compel is hereby **DENIED**.

Opposer’s Motion to Amend Pleading

Fed. R. Civ. P. 15(a)(2), made applicable to Board proceedings by Trademark Rule 2.116, directs a court to “freely give leave [to amend] when justice so requires.” Accordingly, the Board is generally liberal in granting leave to amend pleadings “unless entry of the proposed amendment would

³ The non-resolution of the parties’ discovery dispute seems to have been a foregone conclusion for Applicant as it had already determined to proceed with a motion to compel. Applicant’s telephone call appears to have been precipitated by its desire to obtain Opposer’s consent to its proposed amendment rather than an interest in resolving the discovery dispute. *Response to Opposer’s Motion to Amend Notice of Opposition, Declaration of John Halski* (“Second Halski Declaration”), 25 TTABVUE 21.

violate settled law or be prejudicial to the rights of the adverse party or parties.” *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). Where the moving party seeks to add a new claim or defense and the proposed pleading thereof is legally insufficient or would serve no useful purpose, the Board normally will deny the motion for leave to amend. *See, e.g., Leatherwood Scopes Int’l Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702-03 (TTAB 2002) (proposed amendment to plead abandonment found insufficient and leave to amend denied as futile).

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board’s determination of whether the adverse party would be prejudiced by the allowance of the amendment. A long and unexplained delay in seeking to amend a pleading when there is no question of newly discovered evidence may render the amendment untimely. *See, e.g., Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008).

Opposer seeks to amend its pleading to add a claim of fraud based on Applicant’s proposed amendment to delete certain goods and Applicant’s failure, in supplemental disclosures served on October 22, 2015, to produce any documentary evidence to “show that Applicant has ever sold the goods.” *Motion to Amend Notice of Opposition*, 22 TTABVUE 2.

First, the Board finds the amendment untimely. The newly proposed fraud claim appears to be based on facts within Opposer’s knowledge at the time he filed his amended notice of opposition as there is little difference

between the factual allegations in support of Opposer's lack of bona fide intent claim and Opposer's newly proposed fraud claim, i.e., Applicant has a propensity to apply for long "wish lists" of goods in connection with Applicant's other marks and Applicant did not have a bona fide intent to use all of the goods. Underscoring the notion that the factual bases for the fraud claim were already within Opposer's knowledge are Opposer's contention in his motion that "Applicant has already had notice of the basis for [the fraud] claim," *id.* at 3, and Opposer's mistaken belief that he had already pleaded fraud as a ground for opposition. *See Second Halski Declaration*, 25 TTABVue 21 ("Opposer's counsel further responded that the proposed amendment [to the identification] would not defeat a fraud claim. I informed Opposer's counsel that Opposer had not plead fraud against Applicant but rather lack of bona fide intent to use Applicant's Mark with the Sauce Goods. Opposer's counsel responded that she would review the pleadings to confirm ...").

Second, fraud in procuring or maintaining a trademark registration occurs when an applicant or registrant knowingly makes false, material representations of fact with the intent to deceive the USPTO. *See In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009). Subjective intent to deceive "is an indispensable element in the analysis," *id.*, and while such intent may be averred generally under Fed. R. Civ. P. 9(b), the pleadings must contain "explicit rather than implied expression of the circumstances constituting

fraud.” *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 1010 (CCPA 1981). That Applicant has sought to amend the involved application to delete certain goods is an insufficient basis for pleading a subjective intent to deceive the USPTO so as to now give rise to a fraud claim. *See SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 USPQ2d 1300, 1305 (TTAB 2010) (It is incorrect “to conflate the requirements for pleading and proving the lack of a bona fide intent to use a mark with the requirements for pleading and proving fraud. ... [T]he absence of evidence of an applicant’s bona fide intent to use a mark does not necessitate a showing that such applicant acted in bad faith. Simply put, the lack of a good faith intent to use a mark does not equate to bad faith.”). The same can be said for the lack of documentary evidence in Applicant’s supplemental responses of October 22, 2015. *See id.* at 1304 (“The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof that is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce.”). In short, Opposer has alleged insufficient underlying facts “from which a court may reasonably infer that a party acted with the requisite state of mind.” *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009). Thus, Opposer’s fraud claim is legally insufficient and Opposer’s motion to amend the notice of opposition is hereby **DENIED**.

Dates are **RESET** as follows:

Discovery Closes	4/8/2016
Plaintiff's Pretrial Disclosures Due	5/23/2016
Plaintiff's 30-day Trial Period Ends	7/7/2016
Defendant's Pretrial Disclosures Due	7/22/2016
Defendant's 30-day Trial Period Ends	9/5/2016
Plaintiff's Rebuttal Disclosures Due	9/20/2016
Plaintiff's 15-day Rebuttal Period Ends	10/20/2016

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **THIRTY DAYS** after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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