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

Proceeding	91227225
Party	Defendant Universidad Autonoma De Nuevo Leon
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Attachments	Reply in Support of Motion to Amend FINAL.pdf(15786 bytes)

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

In the Matter of App. Serial No. 85/483,872

Mark: TIGRES U UANL and Design

Filing Date: November 30, 2011

HEINEKEN ASIA PACIFIC PTE. LTD.

Opposer,

v.

UNIVERSIDAD AUTONOMA DE NUEVO LEON

Applicant.

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) Opposition No. 91227225

APPLICANT’S REPLY IN SUPPORT OF MOTION TO AMEND APPLICATION

Applicant Universidad Autonoma De Nuevo Leon (“Applicant” or “UANL”) respectfully submits this reply brief in further support of Applicant’s Motion to Amend Application. The rule clearly states that the Board may use its discretion to grant contested motions to amend. TBMP § 514.03 (“The Board in its discretion, may grant a motion to amend an application or registration which is subject to an inter partes proceeding, even if the other party or parties do not consent thereto.”). Despite Opposer’s¹ arguments in its Response Brief, there is simply no requirement that the Board defer ruling on motions to amend applications until final judgment or that the applicant must consent to judgment with respect to the broader identification. The Board has exercised its discretion on a number of occasions to consider, and grant, contested motions to

¹ In Opposer’s Reply to Motion to Amend Application, Opposer states that Counsel for Opposer has not yet received a copy of Applicant’s Motion to Amend, which was sent via First Class Mail. It has now been determined that the P.O. Box listed as the address for Opposer’s Counsel is no longer valid.

amend even where the applicant did not consent to a judgment. *See Technology Advancement Group, Inc. v. LVMH Swiss Manufactures SA*, 2013 WL 11247274, *2 (TTAB 2013) (“We elect to exercise our discretion and consider the motion to amend at this time. Although the proposed amendment limits applicant’s identification of goods, application has not consented to entry of judgment on the question of likelihood of confusion as to the broader identification.” (internal citations omitted).); *McDonald’s Corp. v. McSweet LLC*, Opposition No. 91178758, *Order Approving Amendment* (Dkt. No. 22), dated June 3, 2008 (granting motion to amend prior to final determination); *See also Saint-Gobain Corporation v. 3M Company*, 90 USPQ2d 1425, *3 (TTAB 2007) (considering and granting contested motion to amend application prior to final judgment).

Because it is squarely within the Board’s discretion to consider Applicant’s Motion to Amend and, as explained in detail below, Applicant’s proposed amendment will significantly narrow the issues of this proceeding and not prejudice Opposer, Applicant requests its Motion to Amend be granted.

The Board Has Discretion To Consider Motions To Amend Prior To Final Determination And Absent Consent To Judgment

The case law is clear that the Board has discretion to consider and act on motions to amend prior to final judgment and without Applicant’s consent to judgment on the broader description of goods. For instance, in *Technology Advancement Group, Inc. v. LVMH Swiss Manufactures SA*, the Board exercised its discretion to consider applicant’s motion to amend even though the opposer did not consent and applicant did not consent to entry of judgment on the question of likelihood of confusion as to the broader identification. *Technology*

Advancement, 2013 WL 11247274 at *2². Similarly, in *McDonald's Corp. v. McSweet LLC*, the Board granted applicant's motion to amend absent any consent to judgment. *McDonald's Corp.*, Opposition No. 91178758, *Order Approving Amendment* (Dkt. No. 22), dated June 3, 2008. As such, it is clearly within the Board's discretion to consider and grant Applicant's Motion to Amend at this time.

**Amendment of Application Narrows The Issues Before The Board And Serves
The Interest Of Judicial Economy**

There is no dispute that Applicant's proposed amendment will serve to narrow the issues present in this action. Here, Opposer is challenging Applicant's application in International Class 31 and International Class 32. Removing International Class 31 and International Class 32 narrows the description of goods in the application and removes any basis for the opposition. *See Saint-Gobain Corp.*, 90 USPQ2d 1425 at *3 ("Because applicant's amendment to its identification of goods is a clarification that helps narrow the issues at trial, it is appropriate that we grant the motion to amend applicant's identification of goods." (internal citations omitted)). Therefore, allowing the proposed amendment will facilitate the Board's evaluation of the issues and would position this action for a motion to dismiss.

Opposer Will Not Be Prejudiced

Opposer's arguments that it "would be fundamentally unfair to Opposer for the Board to grant the Applicant's Motion to Amend Application in this situation" has no basis. Applicant's proposed amendment removes two entire classes of goods from its application. Opposer has not disputed that this amendment would remove all basis for the opposition. This Opposition is still

² In *Technology Advancement* the Board did not ultimately grant applicant's motion to amend because the proposed amendment did not narrow the issues before the Board. In this case, as explained herein, Applicant's proposed amendment significantly narrows the issues.

in the early stages. Initial disclosures have not been served and discovery has not opened. Granting this amendment will resolve the dispute among the parties and allow the parties to avoid the time and undue expense of proceeding with this opposition. Indeed because Applicant has requested this amendment, that is indisputably case dispositive, at the outset of the opposition it would be unjust and prejudicial to the parties to defer ruling on the motion.

Conclusion

Here, the Board has the discretion to grant the Motion to Amend and the proposed amendment will resolve the issues presented in this proceeding. For these reasons, Applicant requests that the Board grant its Motion to Amend.

Respectfully Submitted,

/s/ Sherry L .Rollo
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CERTIFICATE OF SERVICE

This is to certify that on the 13th day of July, 2016, I mailed Applicant's Reply in Support of Motion to Amend Application via certified mail, receipt requested, postage prepaid to the attorney of record for Opposer:

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