

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
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WF

December 20, 2019

Opposition No. 91231833

Birds Eye Foods, LLC

v.

Hawaiian Chip Company LLC

Winston Folmar, Interlocutory Attorney:

On December 2, 2019, the law firm of Cozen O’Conner (“Cozen”) filed an entry of appearance, which the Board construes both as a motion for entry of Opposer’s new counsel and a motion to join Kennedy Endeavors, LLC as a party-plaintiff. 44 TTABVUE. The motion was filed on behalf of Kennedy Endeavors, LLC. *Id.*

MOTION TO JOIN KENNEDY ENDEAVORS, LLC¹

The Board notes that an assignment of the involved registration, namely, Registration No. 3697408 (“Registration ’408”), from Birds Eye Foods, LLC (“Opposer”), the original opposer, to Peak Finance Holdings LLC via a merger was recorded on August 23, 2019 at Reel/Frame 6727/0813.² In addition to common law

¹ Because a party could potentially be joined on the Board’s own initiative, the Board finds that a response to Opposer’s motion for entry of appearance and joinder of a party is unnecessary in this case.

² The assignment was effective May 27, 2019.

use of Opposer's HAWAIIAN Mark dating back to 1998, Opposer claimed Registration '408 to establish its priority and standing for the present opposition. 1 TTABVUE 1-2. The Board further notes that a subsequent assignment of Registration '408 was executed on May 27, 2019 conveying the entire interest from Peak Finance Holdings LLC to Kennedy Endeavors, Incorporated, and recorded on August 26, 2019 at Reel/Frame 6728/0929.

However, there is no assignment of record documenting the conversion from Kennedy Endeavors, Incorporated to Kennedy Endeavors, LLC, which is alleged in the entry of appearance to have been effective as of October 21, 2019. 44 TTABVUE 2. Although the motion includes a copy of the certificate of conversion from the Secretary of State of the State of Washington corroborating the conversion, the Board prefers that the assignment be recorded with the Assignment Branch prior to joining Kennedy Endeavors, LLC as a party-plaintiff. *Id.* at 81. **“When there has been an assignment of a mark** that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate...” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 512.01 (2019) (emphasis added). Accordingly, the motion to join Kennedy Endeavors, LLC is **denied without prejudice.**

Opposer is allowed until **thirty days from the date of this order** in which to (i) record the alleged conversion with the Assignment Branch and (ii) advise the Board and submit copies of the appropriate documents that are submitted for the

assignment. *See* Trademark Act § 10 and Patent and Trademark Rules 3.71(d) and 3.73.

MOTION FOR ENTRY OF APPEARANCE AND WITHDRAWAL OF PRIOR COUNSEL

Opposer's motion for entry of appearance of new counsel, namely, Cozen, is not signed by Opposer (or an authorized agent of Kennedy Endeavors, LLC). 44 TTABVUE. In order to replace legal counsel when a party is previously represented by a qualified practitioner, new counsel must file a power of attorney that meets the requirements of Trademark Rule 2.17(c). Trademark Rule 2.17(c). New counsel may only submit and/or sign a document on behalf of a party as a means of entry of appearance when the party is not already represented by a qualified practitioner. *Id.*

Accordingly, Opposer's entry of appearance is **denied without prejudice**.

Opposer is allowed until **thirty days from the date of this order** in which to submit a new power of attorney that complies with Trademark Rule 2.17(c).

The Board also notes the prior counsel's motion to withdraw as counsel of record filed on December 6, 2019. 46 TTABVUE. The motion to withdraw Husch Blackwell LLP ("HB LLP") as legal counsel is hereby **denied without prejudice** because it fails to comply with the requirements of Trademark Rules 2.19(b) and Patent and Trademark Rule 11.116.

Specifically, the motion does not include the following requirements: (1) a statement that all documents and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (2) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded;

and (3) proof of service of the request upon the client and upon every other party to the proceeding.³ *See* Trademark Rule 2.19(b). *Cf. In re Legendary Inc.*, 26 USPQ2d 1478 (Comm'r 1992).

In view thereof, HB LLP is allowed until **sixty days from the date of this order** to submit a motion which complies with Trademark Rules 2.19(b) and Patent and Trademark Rule 11.116, as indicated above.⁴

Proceedings are otherwise **suspended** pending response(s) to this order.

OPPOSER'S MOTION TO SUSPEND WITH CONSENT FOR SETTLEMENT NEGOTIATIONS

The Board notes the consent motion to suspend the proceedings to allow for settlement negotiations, filed December 3, 2019. 45 TTABVUE. However, the present motion will be held in abeyance until the aforementioned issues are resolved. Once the above-referenced motions are adjudicated, the Board will consider whether a suspension for settlement is appropriate.

A copy of this order has been sent to all parties listed below.

cc:

KENNEDY ENDEAVORS, LLC
c/o Mackenzie Hart, Assistant Secretary
900 High Street
Hanover, PA 17331

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³ The motion also fails to provide evidence of service of the motion upon Opposer (or Kennedy Endeavors, LLC), as counsel only sent notice to Applicant and Cozen, which has yet to submit an effective entry of appearance.

⁴ In the event that Cozen submits a compliant new power of attorney and entry of appearance is accepted, HB LLP will be removed as counsel of record, thereby eliminating the need for HB LLP to supply an amended motion to withdraw.

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