

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

Mailed: November 22, 2017

Opposition No. 91235601  
Opposition No. 91237114

*Gluten Free Classes, LLC*

*v.*

*JHMJLL Inc.*

**M. Catherine Faint,  
Interlocutory Attorney:**

This case now comes up on the following motions:

1. Opposer's motion to consolidate, filed October 9, 2017 in Opposition No. 91237114;
2. Applicant's renewed motion in Opposition No. 91235601, filed October 10, 2017, to dismiss the amended notice of opposition, which motion is contested;
3. Opposer's motion, embedded in its response to the motion to dismiss filed in Opposition No. 91235601, to further amend the pleadings to include its Registration No. 5295420;
4. Applicant's motion in Opposition No. 91237114, filed November 17, 2017,, to dismiss the notice of opposition; and
5. Applicant's motion for Rule 11 sanctions in Opposition No. 91237114, filed October 10, 2017.

***Consolidation***

Opposer filed a motion to consolidate these proceedings. There was no response to the motion.

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993).

It is noted that the parties to these proceedings captioned above are identical, and the issues are similar or related. In view thereof the motion to consolidate is **granted** as conceded and for good cause. Accordingly, proceedings are hereby **consolidated** and may be presented on the same record and briefs. *See Hilson Research* 27 USPQ2d 1423; and *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. 91235601 as the “parent case.” As a general rule, from this point onward, only one copy of any submission should be filed herein; but that copy should include all proceeding numbers in its caption in ascending order. The exception to this rule is that any pleadings should be filed in the particular proceeding to which they pertain.

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

While these proceedings were filed almost 3 months apart, in keeping with Board practice, the Board adopts the calendar of the most recently filed case as reset below.

***Motion for Sanctions***

Applicant moves for sanctions under Fed. R. Civ. P. 11 alleging Opposer failed to timely file the notice of opposition in Opposition No. 91237114. The Board notes that the motion was accompanied by a “safe harbor” letter, and did not include a certificate of service. Thus the motion is not properly filed.

Applicant’s application was published in the Official Gazette on August 15, 2017, and the Notice of Opposition was filed October 9, 2017. Applicant fails to note, however, that Opposer filed an extension of time to oppose on September 12, 2017, which was granted and extended Opposer’s time to file the notice of opposition until October 14, 2017. *See* Trademark Rule 2.102, 37 C.F.R. § 2,102. The notice of opposition was filed prior to that date and thus is timely.

Applicant is reminded that a motion for Rule 11(c) sanctions is a serious matter, and must not be made for any improper purpose. Fed. R. Civ. P. 11(b) provides:

(b) REPRESENTATIONS TO THE COURT. By presenting to the court a pleading, written motion, or other paper—whether by signing, filing,

submitting, or later advocating it—an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

- (1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;
- (2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;
- (3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

A Rule 11 motion that violates Fed. R. Civ. P. 11(b) may result in entry of Rule 11(c) sanctions against the party that files such a motion. *See* Patent and Trademark Office Rule 11.18; TBMP § 527.02.

Accordingly, Applicant's motion for Rule 11 sanctions **will be given no consideration.**

***Motion to Further Amend the Notice of Opposition***

Opposer seeks to leave to further amend the notice of opposition in Opposition No. 91235601 to add the mark in its Registration No. 5295420, which underlying application was claimed in the pleading and has matured to registration since the filing of the amended notice of opposition.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would

be prejudicial to the rights of the adverse party or would violate settled law. *See* Fed. R. Civ. P. 15(a); and TBMP §507.02 and cases cited therein.

Opposer's motion for leave to amend the notice of opposition is **granted** and paragraph five of the amended notice of opposition is deemed amended to include Registration No. 5295420.

### ***Motions to Dismiss***

Applicant filed a renewed motion to dismiss in Opposition No. 91235601 and a motion to dismiss in Opposition No. 91237114. Neither filing included a certificate of service as required by Trademark Rule 2.119. Further, the filings included declarations and attachments.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys., Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). Matters outside the pleadings will not normally be considered on a motion to dismiss. *See Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 n.2 (TTAB 2013) (motion to dismiss amended counterclaim accompanied by evidence was not treated as a motion for summary judgment).

Nor will the Board consider the motions as ones for summary judgment. Pursuant to the Board's rules, neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of res judicata or lack of Board jurisdiction, which were not alleged in the motions at issue here) can occur until the parties have made their initial disclosures as required by Fed. R. Civ. P.

26(f). There is no indication that Applicant has served its initial disclosures, nor is it time to do so. Thus to the extent Applicant intended its motions as ones for summary judgment they are premature.

The motions and the attachments **will be given no consideration.** *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures). Strict compliance with the Board's rules is required for all papers filed with the Board.

Nonetheless, the Board exercises its discretion to review the pleadings and has determined the following. *See* Fed. R. Civ. P. 12(f).

Considering whether Opposer has asserted standing and a proper Section 2(d) claim, the Board finds that the allegations set forth in paragraphs two, three, four and five of the notices of opposition provide adequate notice of Opposer's reliance on its trademark registrations for the marks FIND ME GLUTEN FREE to establish standing and priority. Further, paragraphs nine through eleven provide adequate notice of Opposer's claims of likelihood of confusion. Opposer therefore has sufficiently alleged its standing and the ground of priority and likelihood of confusion. *See Giersch v. Scripps Nets., Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009). Proof of Opposer's standing and ground are left to final decision. *See Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (at final decision, inquiry is not whether pleading of standing is sufficient, but whether allegations have been proven).

Applicant is allowed until the date set out below to file and serve its answers in each of the oppositions. As noted above, the answers should be filed in the proceeding to which each pertains.

***Certificate of Service Required***

Trademark Rules 2.119(a) and (b) require that every submission filed in a proceeding before the Board must be served upon the other party or parties, and **proper proof of such service must be made before the submission will be considered by the Board.** Accordingly, all submissions filed in this proceeding must be accompanied by a statement, signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made, the name of each party or person upon whom service was made, and the email address or address. *See* TBMP § 113.03. Service must be made by email unless otherwise stipulated, or unless the filing party has satisfied the requirements for another method of service as set forth in Trademark Rule 2.119(b). The statement will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a Certificate of Service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by forwarding said copy on (insert date of emailing), via email (or insert other appropriate method of delivery) to: (set out name, address, and email address of opposing counsel or party).

Signature \_\_\_\_\_  
Date \_\_\_\_\_

Submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with Trademark Rules 2.126(a) and (b). *See* TBMP § 110.01. The ESTTA user manual, ESTTA forms, and instructions for their use are at <http://estta.uspto.gov/>.

It is recommended that every party be familiar with the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. Parties should also be familiar with the Trademark Trial and Appeal Board Manual of Procedure (TBMP), available at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>, the TTABVUE system for viewing the record for all Board proceedings, available at <http://ttabvue.uspto.gov/ttabvue/>, and the Standard Protective Order, available at <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is required of all parties, whether or not they are represented by counsel. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

***Dates Reset***

To the extent proceedings were suspended by the filing of Applicant's motions to dismiss, they are now resumed. *See* Trademark Rule 2.127(d). Dates are reset as set out below.



Applicant is allowed until the date set out below to file and serve its answers in each of the oppositions. As noted above, the answer should be filed in the proceeding to which it pertains.

Time to Answer	12/28/2017
Deadline for Discovery Conference	1/27/2018
Discovery Opens	1/27/2018
Initial Disclosures Due	2/26/2018
Expert Disclosures Due	6/26/2018
Discovery Closes	7/26/2018
Plaintiff's Pretrial Disclosures Due	9/9/2018
Plaintiff's 30-day Trial Period Ends	10/24/2018
Defendant's Pretrial Disclosures Due	11/8/2018
Defendant's 30-day Trial Period Ends	12/23/2018
Plaintiff's Rebuttal Disclosures Due	1/7/2019
Plaintiff's 15-day Rebuttal Period Ends	2/6/2019
Plaintiff's Opening Brief Due	4/7/2019
Defendant's Brief Due	5/7/2019
Plaintiff's Reply Brief Due	5/22/2019
Request for Oral Hearing (optional) Due	6/1/2019

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at

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final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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