

ESTTA Tracking number: **ESTTA927287**

Filing date: **10/09/2018**

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

Proceeding	91238546
Party	Defendant Clariant AG
Correspondence Address	ERIC R MORAN MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 SOUTH WACKER DRIVE, 31ST FLOOR CHICAGO, IL 60606 UNITED STATES moran@mbhb.com, potempa@mbhb.com, dineen@mbhb.com, LSGDocket@mbhb.com, lovsin@mbhb.com 312-913-3302
Submission	Motion to Amend Application
Filer's Name	James L. Lovsin
Filer's email	lovsin@mbhb.com, moran@mbhb.com, dineen@mbhb.com, potempa@mbhb.com, lsgdocketing@mbhb.com
Signature	/James L. Lovsin/
Date	10/09/2018
Attachments	Clariant Motion to Amend Application.pdf(137406 bytes )

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

**In the matter of Trademark  
Application Serial No.: 79/194,431**

**For the mark: HIFORMER**

**Published in the Official Gazette on: Nov. 21, 2017**

**WESTLAKE LONGVIEW CORPORATION**

**Opposer,**

**v.**

**OPPOSITION NO. 91238546**

**CLARIANT AG**

**Applicant.**

**APPLICANT CLARIANT AG'S MOTION TO AMEND APPLICATION  
AND BRIEF IN SUPPORT OF THE MOTION**

Pursuant to Trademark Rule 2.133 and Trademark Board Manual of Procedure § 514, Applicant Clariant AG ("Clariant") hereby respectfully moves the Board to amend Application Serial No. 79/194,431 (the "Application"). In this regard, Clariant requests that the Board enter amendments to the identifications of goods and services in the Application. Clariant further requests that the Board enter these amendments before discovery and, at a minimum, before final decision and summary judgment deadlines.

Opposer Westlake Longview Corporation ("Westlake") does not consent to this motion.

**I. Background and Procedural History**

On December 14, 2017, Westlake filed its notice of opposition. 1 TTABVue. In the notice, Westlake alleged under Section 2(d) that there is a likelihood of confusion between Clariant's HIFORMER mark and Westlake's registrations for the HIFOR, HIFOR CLEAR, and HIFOR XTREME marks. *Id.* at 4-5.

On August 13, 2018, Clariant filed its answer and affirmative defenses. 20 TTABVUE. In its answer, Clariant denied that there is any likelihood of confusion with respect to Clariant's HIFORMER mark and goods and services as set forth in the Application and Westlake's registrations for the HIFOR, HIFOR CLEAR, and HIFOR XTERME marks. *Id.* at 1-8. Further, as its First Affirmative Defense, Clariant alleged that it would also be entitled to a registration of its HIFORMER mark with a restricted identification of goods and services, and Clariant proposed amendments to the identifications of goods and services in the Application. *Id.* at 9-12.

In this motion, Clariant requests that the Board enter the proposed amendments set forth in Clariant's First Affirmative Defense. *Embarcadero Techs., Inc. v. Rstudio, Inc.*, 105 U.S.P.Q.2d 1825, 1828 (TTAB 2013) ("Ideally, the Section 18 affirmative defense should be asserted in the defendant's answer to put the plaintiff on notice and shortly thereafter followed by a corresponding motion to amend the application.").

## **II. Clariant's Requested Amendments**

Clariant requests the following changes to the identification of goods in International Class 1 (proposed language for deletion stricken through):

~~Chemical used in industry, science and photography; chemicals for use in agriculture, horticulture and forestry except fungicides, herbicides, insecticides and parasiticides; unprocessed artificial resins, unprocessed plastics; soil fertilizers; fire extinguishing compositions; tempering and soldering preparations in the nature of soldering chemicals, soldering flux and soldering fluxes; chemical products for preserving foodstuffs; tanning materials, namely, tanning agents for use in the making of artificial leather but not meant for coloring; adhesives used in industry.~~

Such that the identification of goods in class 1 would be amended to recite no goods and class 1 would be deleted from the Application.

Clariant further requests the following changes to the identification of goods in International Class 2 (proposed new language underlined and proposed language for deletion stricken through):

~~Paints, varnishes, lacquers; rust preservatives in the nature of a coating; wood preservatives against deterioration;~~ colorants; colorants, namely, color master batches in liquid form; colorants, namely, liquid master batches containing pigment; colorants, namely, liquid master batches containing dye; colorants, namely, liquid color master batches containing additives; none of the aforementioned containing resins ~~mordants for use in dyeing; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art.~~

Such that the identification of goods in class 2 would be amended to state:

Colorants; colorants, namely, color master batches in liquid form; colorants, namely, liquid master batches containing pigment; colorants, namely, liquid master batches containing dye; colorants, namely, liquid color master batches containing additives; none of the aforementioned containing resins.

Clariant further requests the following changes to the identification of services in International Class 42 (proposed new language underlined and proposed language for deletion stricken through):

~~Scientific and technological services, namely, chemical solution analysis and related consulting services for the paint, textile, plastic, cosmetic and transportation industries;~~ Chemical research services to develop innovations, mainly carrier systems,

dosing units and service concepts for liquid color master batches; Scientific and technological design services, namely, design services for customers to design new products in the nature of new product design services for liquid color master batches and for equipment for producing liquid color master batches; ~~design and development of computer hardware and software.~~

Such that the identification of services in class 42 would be amended to state:

Chemical research services to develop innovations, mainly carrier systems, dosing units and service concepts for liquid color master batches; Scientific and technological design services, namely, design services for customers to design new products in the nature of new product design services for liquid color master batches and for equipment for producing liquid color master batches.

### **III. Grounds for the Requested Amendments**

#### **A. Clariant's Motion Is Timely**

Motions to amend are timely if they are filed before trial. *Wis. Cheese Grp. LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, 118 U.S.P.Q.2d 1262, 1265 (TTAB 2016) (granting a motion to amend prior to discovery opening and directing the opposer to file an amended notice of opposition). Here, Clariant filed this motion before trial and before either party has exchanged initial disclosures or discovery requests. 19 TTABVue (Westlake's trial period ends June 9, 2019). Accordingly, Clariant submits that this motion is timely.

#### **B. Clariant Requests That the Board Enter the Requested Amendments Before Discovery and, at a Minimum, Before Final Decision and Summary Judgment Deadlines**

The requested amended identifications of goods and services more accurately convey the goods and services that Clariant uses and intends to use with the HIFORMER mark.

Clariant is not using the HIFORMER mark on the goods and services that would be effectively excluded from the Application if the requested amendments are entered. Thus, if the requested amendments are entered immediately, the scope of discovery and presentation of evidence on Westlake's Section 2(d) claim will be narrowed and simplified. *See Wis. Cheese Grp.*, 118 U.S.P.Q.2d at 1267 n.10. It is a waste of the Board's and the parties' resources for the parties to present evidence and arguments regarding goods and services that Clariant is willing to delete or limit.

The Board reiterated in *Wisconsin Cheese* that an unconsented motion to amend may be granted prior to trial under the following circumstances:

- 1) the proposed amendment must serve to limit the broader identification of goods and services;
- 2) the applicant must consent to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;
- 3) if applicant wishes to avoid the possibility of a *res judicata* effect by the entry of judgment on the original identification, the applicant must make a *prima facie* showing that the proposed amendment serves to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial; and
- 4) where required to support the basis of the subject application, any specimens of record must support the goods or services as amended; and the applicant must then

introduce evidence during its testimony period to prove use of its mark with the remaining goods or services prior to the relevant date as determined by the application's filing basis.

*Id.* at 1265-66 (quoting *Johnson & Johnson v. Stryker Corp.*, 109 U.S.P.Q.2d 1077, 1078-79 (TTAB 2013)). Clariant's motion meets the first, second, and third requirements.<sup>1</sup>

**1. First Requirement: The Requested Amendments Limit the Identifications of Goods and Services**

The requested amendments serve to clarify and limit but in no way broaden the identifications of goods and services in the Application. In the requested amendments, for example, Clariant proposes to delete all goods in International Class 1, delete many goods in International Class 2, delete two services in International Class 42, further limit "colorants" in International Class 2, and clarify with respect to all of the remaining goods in International Class 2 that "none of the aforementioned contain[] resins." Such deletion and limitation "permissibly narrows the identification[s]." *Stryker*, 109 U.S.P.Q.2d at 1079. Accordingly, Clariant submits that the first requirement is satisfied.

**2. Second Requirement: Consent to Entry of Judgment for Deleted Goods and Services**

Clariant consents to the entry of judgment on the grounds for opposition with respect to any goods or services identifications to be deleted from the Application pursuant to this motion.

---

<sup>1</sup> The fourth requirement is not applicable because the Application is based on Section 66(a). *See Wis. Cheese*, 118 U.S.P.Q.2d at 1266 (fourth requirement not applicable to intent-to-use applications). Section 66(a) applications are considered intent-to-use applications. *See* Trademark Rule 2.33(e)(1); TMEP § 806.01(e).

*Wis. Cheese*, 118 U.S.P.Q.2d at 1266 (second requirement met with similar statement). Clariant understands that such a judgment “will preclude applicant from seeking to register its mark at a later date for the goods removed or deleted from the original identification.” *Int’l Harvester Co. v. Int’l Tel. & Tel. Corp.*, 208 U.S.P.Q. 940, 941 (TTAB 1980). As alleged in its First Affirmative Defense, however, Clariant would be entitled to registration of the HIFORMER mark for the amended identifications of goods and services. 20 TTABVUE 9-12. Accordingly, Clariant submits that the second requirement is satisfied.

**3. Third Requirement: The Requested Amendments Introduce a Substantially Different Issue for Trial**

The requested amendments serve to change the nature and character of goods or restrict their channels of trade and customers so as to introduce a substantially different issue for trial with respect to Westlake’s Section 2(d) claim. Westlake’s marks are for one good (“polyethylene resins for use in the plastics industry”) in one class (International Class 1). In the requested amendments, Clariant proposes to delete all goods from International Class 1, including “unprocessed artificial resins.” Further, in the requested amendments, Clariant proposes to delete “raw natural resins” along with many other goods in International Class 2, to amend the remaining goods in International Class 2 to clarify that “none of the aforementioned contain[] resins,” and to delete two services in International Class 42. The requested amendments would thus substantially alter and greatly simplify the Opposition for at least the reasons that Clariant would not seek to register the HIFORMER mark for resin, much less any good in International Class 1, and instead focus registration of the HIFORMER mark for colorants, color master batches, liquid master batches, and liquid color master batches, and services related to liquid color master batches. Indeed, the scope of discovery and presentation of evidence would be narrowed and simplified. *Wis. Cheese Grp.*, 118 U.S.P.Q.2d at 1267 n.10.

The requested amendments therefore serve to change the nature and character of goods so as to introduce a substantially different issue for trial for at least the reasons that they focus registration of the HIFORMER mark on colorants, color master batches, liquid master batches, and liquid color master batches, and services related to liquid color master batches. *Id.* at 1266 (third requirement met with deletion of goods that were not “soy-based” or containing soy, and amendment of remaining goods to state they were “soy-based”). For at least the same reasons, the requested amendments also serve to restrict channels of trade and customers so as to introduce a substantially different issue for trial. *Stryker*, 109 U.S.P.Q.2d at 1078-79 (third requirement met where applicant specified “the use of its goods in osteochondral treatments”). Accordingly, Clariant submits that the third requirement is satisfied.

#### **IV. The Requested Amendments More Clearly Avoid a Likelihood of Confusion**

The requested amendments more clearly avoid a likelihood of confusion with respect to Clariant’s HIFORMER mark and Westlake’s registrations for the HIFOR, HIFOR CLEAR, and HIFOR XTREME marks for at least the same reasons that the third requirement for granting an unconsented motion to amend prior to trial is met. *Supra* pp. 6-7. The requested amendments focus the registration of the HIFORMER mark on colorants, color master batches, liquid master batches, and liquid color master batches, and services related to liquid color master batches, delete “unprocessed artificial resins” from International Class 1, delete “raw natural resins” from International Class 2, and clarify with respect to the remaining goods in International Class 2 that “none of the aforementioned contain[] resins.” Thus, the amended goods and services are vastly different from the one good (“polyethylene resins for use in the plastics industry”) in one class (International Class 1) for which Westlake’s marks are registered.

**V. Conclusion**

For the foregoing reasons, Clariant respectfully requests that the Board grant its motion to amend, enter Clariant's requested amendments before discovery and, at a minimum, before final decision and summary judgment deadlines, and for all other relief the Board deems proper and just.

Dated: October 9, 2018

Respectfully submitted,

/James L. Lovsin/  
Eric R. Moran  
James L. Lovsin  
MCDONNELL BOEHNEN HULBERT &  
BERGHOFF LLP  
300 South Wacker Drive  
Chicago, IL 60606  
Phone: (312) 913-0001  
Facsimile: (312) 913-0002  
moran@mbhb.com  
lovsin@mbhb.com

Attorneys for Applicant Clariant AG

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record by Email on this date.

rschultz@grspc.com, nmarsh@grspc.com, kneedham@grspc.com, docket@grspc.com

/James L. Lovsin/

James L. Lovsin

MCDONNELL BOEHNEN HULBERT &  
BERGHOFF LLP

300 South Wacker Drive

Suite 3100

Chicago, IL 60606

Phone: (312) 913-0001

Facsimile: (312) 913-0002

lovsin@mbhb.com