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

Proceeding	91238546
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**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.

RESPONSE TO MOTION TO AMEND APPLICATION AND BRIEF IN SUPPORT

Opposer, Westlake Longview Corporation files this its response to Applicant's motion to amend and would respectfully show the Board the following.

I. BACKGROUND

On September 27, 2016, Applicant filed Trademark Serial No. 79/194,431 requesting an extension of protection, under 15 U.S.C. § 66(a), based on a trademark registration in Switzerland ("Application"). The request extended to goods in classes 1 and 2 and services in class 42.

On December 14, 2017, Opposer timely filed its Notice of Opposition. The Notice is based on a likelihood of confusion with commonly owned Trademark Registration Nos. 3,661,578; 3,661,577; and 3,670,225.

On October 9, 2018, Applicant filed its Motion to Amend Application and Brief in Support (“Motion”) [No. 21].

For the following reasons, the Board should deny Applicant’s Motion and refuse to enter the proposed amendment, or at least defer a decision until the time of trial.

II. ARGUMENT AND AUTHORITIES

A. The Proposed Amendment Fails to Satisfy the *Stryker* Test.

An application subject to an opposition may not be amended in substance, except with the consent of the other party and approval of the Board, or upon motion granted.¹

The Board may decide a motion to amend before trial if the following circumstances are present:

1. The proposed amendment serves to limit the broader identification of goods or services;
 2. Applicant consents to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;
 3. 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. Any specimens of record must support the goods or services as amended; and applicant must then introduce evidence during its testimony period 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.² (“*Stryker* test”).
1. The proposed amendment to class 2 and 42 broadens and fails to clarify the description of goods and services.

a. The proposed class 2 amendment fails to narrow the description of goods.

With respect to the class 2 goods, Applicant proposes to add “liquid master batches” to its

¹ 37 C.F.R. § 2.33(a).

² See, *Johnson & Johnson v. Stryker Corp.*, Opp. No. 91209134, *4 (TTAB Dec. 5, 2013).

description. But, “liquid master matches” is not listed in the original description nor is it covered by any goods that are listed. For example, “colorants” does not imply a liquid nor does it imply a master batch. More importantly, Applicant seeks to add “additives” to its description. “Additives” can of course include a broad range of chemicals that are beyond “paints,” “varnishes,” “lacquers” and all other goods listed in the original description of goods for class 2. “Additives” in fact overlaps many of the goods that Applicant now seeks to exclude from class 1, such as “chemicals used in industry.”

b. *The proposed class 42 amendment fails to clarify or narrow the description of services.*

With respect to the class 42 services, Applicant’s proposed amendment fails to clarify and indeed further confuses the description. For example, Applicant proposes, in part, to amend its class 42 services as follows:

... 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.³

First, the phrase “*design services for customers to design new products in the nature of new product design services*” is extremely vague. This phrase is present in the original class 42 description and remains in the proposed amendment. As a result, Applicant’s proposed amendment does nothing to clarify the description.

Second, Applicant’s proposed amendment impermissibly broadens the scope of “carrier systems” and “dosing units” to include “equipment for producing color master batches.”

Since the proposed amendment broadens and further confuses the description of services, it fails the second element of the *Stryker* test and must be denied.

³ Motion, p. 4.

2. The proposed amendment fails to introduce a substantially different issue for trial.

Applicant has the burden to 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.⁴

The number of issues at trial will be the same. The only cause of action in this case is a likelihood of confusion. A likelihood of confusion necessarily implicates an analysis of the *DuPont* factors. Therefore, since the proposed amendment does not change the cause of action, it does not change the *DuPont* factors or issues that must be considered.

The amendment proposed by Applicant does not change the *nature or character* of the goods and services identified in the Application sufficient to create a substantially different issue for trial. For example, the proposed amendment to the class 2 goods excludes “resins.” But yet it broadens the description to include “liquid master batches” and all conceivable “additives.” The scope of “additives” includes at least the goods of “chemicals used in industry,” as originally recited in class 1. Therefore, the trial issues related to Applicant’s use of the mark on “chemicals used in industry,” goods sold under the mark and advertising will all be substantially the same. A determination of how these goods relate to the goods of Opposer must also still be made. In the same way, the *DuPont* factors related to the similarity of customers and channels of trade also will remain whether or not the proposed amendment is allowed.

Likewise, the proposed amendment to the class 42 services expands the services to include those related to “liquid color master batches” but does nothing to limit the *DuPont* factors for trial. Applicant’s services are still chemical research services and scientific and technological design services. So, a comparison of these services to those of Opposer must still

⁴ *Stryker Corp.*, Opp. No. 91209134 at *4.

be made. Likewise, the same comparisons of how the marks are presented to the consumer and how the services move through channels of trade must be considered and determined at trial. Hence, the nature and character of the services do not change and the issues for trial remain substantially the same.

Also with respect to the class 42 services, the scope of the description is vague. Applicant's proposed amendment does nothing to cure it. Hence, the Board will necessarily need to determine the scope of the class 42 services, whether or not the amendment is entered. So, this issue for trial will also be substantially the same.

Applicant relies on *Wisconsin Cheese Grp. LLC v. Comercilizadora de Lacatoes y Derivados, S.A. de C.V.*, 118 U.S.P.Q.2d 1262 (TTAB 2016) to support its position that it should be allowed to amend the description of goods and services.⁵ However, the case does not support Applicant's position. In *Wisconsin Cheese*, the Notice of Opposition asserted three (3) causes of action - likelihood of confusion, deceptiveness, and deceptive misdescription.⁶ The deceptiveness and deceptive misdescription causes of action were based on the fact that the term "soy" appeared in the mark, but that applicant's goods were not limited to products containing soy. Applicant filed a motion to amend its description of goods to include only "soy-based" products. The Board granted the motion because the amendment eliminated the 2(a) deceptiveness and 2(e)(1) deceptive misdescription causes of action, and so necessarily changed the scope of the issues for trial.⁷

In our case, the only asserted cause of action is a likelihood of confusion. The proposed amendment would in no way eliminate that cause of action. Since the cause of action remains

⁵ See, Motion, p. 5.

⁶ *Wisconsin Cheese*, Opp. No. 91224131, *2 – 3 (TTAB Mar. 30, 2016).

⁷ *Wisconsin Cheese*, 118 U.S.P.Q 2d at 1267.

the same in our case, the reasoning of the Board in *Wisconsin Cheese* does not apply. There will be no advantage gained by allowing Applicant's proposed amendment here because there can be no cause of action eliminated. Therefore, *Wisconsin Cheese* fails to support Applicant's argument that its proposed amendment introduces substantially different issues for trial.

B. The Burden of Discovery will not be Substantially Reduced by the Proposed Amendment.

When considering a cause of action for likelihood of confusion, the Board primarily considers the marks and the descriptions of goods and services as they appear in the application and the registration.⁸ However other relevant evidence of record must also be considered by the Board.⁹ For example, how the marks are actually presented to the consumer in commerce is relevant to a likelihood of confusion.¹⁰ Similarly, the customers and potential customers of the goods and services are also relevant to a likelihood of confusion.¹¹ Likewise, evidence of the scope of use of the registered mark is relevant to the strength of the mark and the scope of protection to which it is entitled.¹²

In our case, the discovery that the parties must conduct will not significantly change because of the proposed amendment. For example, both Applicant and Opposer will most likely produce documents related to their respective customers, advertising and channels of trade. None of this will be affected by the proposed amendment. Similarly, both parties will most likely need depositions about how their products are related technically – how for example “colorants” of Applicant are used with the “resins” and waxes of Opposer in the compounding and production of plastic products. The scope of Applicant's goods covered in the proposed

⁸ See, *In re E. I. DuPont deNemours & Co.*, 476 F.2d 1357, 1361 (Fed. Cir. 1973).

⁹ See, *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001).

¹⁰ See, *DuPont*, 476 F.2d at 1361.

¹¹ *Id.*

¹² *Id.*

amendment includes chemical “additives” which is similar to the class 1 goods it seeks to delete. So, the proposed amendment will not substantially change the scope of the products or the technical fields involved. In the same way, evidence both in the nature of documents and deposition testimony related to the fame of Opposer’s mark will likely be provided. Applicant’s proposed amendment will have no effect on this discovery either.

Applicant’s argument in favor of discovery efficiencies fails as a straw man. Applicant states that the amendments “more accurately” convey the goods and services that Opposer intends to use with the its mark.¹³ And yet, if Applicant sells no products that match the goods and services in the Application, then it will have no evidence to produce in discovery, with or without the proposed amendment. Hence, discovery will not be impacted substantially by the proposed amendment.

Applicant relies on *Wisconsin Cheese* to support its argument that narrowing of goods and services means that the scope of discovery will be “simplified.”¹⁴ But, this reliance is misplaced. The Board did not allow the amendment in *Wisconsin Cheese* because of a reduction in the discovery burden. Rather, the amendment was allowed because it eliminated two causes of action from the case. In fact, the Board stated that “Applicant’s deletion of goods from its application does not automatically alter the scope of discovery....”¹⁵ Therefore, *Wisconsin Cheese* does not support the contention that the deletion of goods and services by Applicant will alter the scope of discovery.

C. The Decision as to Whether or not to Allow the Amendment Should be Deferred Until After Substantive Disposition of the Case.

The Board typically defers deciding a motion to amend until after trial or until the case is

¹³ Motion, p. 4.

¹⁴ See, Motion, p. 5.

¹⁵ See, *Wisconsin Cheese*, 118 U.S.P.Q 2d at 1267 n.10.

decided upon summary judgment.¹⁶ One reason to defer the decision is to allow sufficient time to determine whether or not the amendment is necessary. If the Board determines that the Applicant is entitled to a registration because of the proposed amendment, then the proposed amendment is entered.¹⁷ But, if the Board determines that registration is not proper either way, then the proposed amendment is moot.

There is no reason to deviate from the Board's typical practice in this case.

The Board will be better able to decide the issue of likelihood of confusion if it allows complete discovery. This case includes technical issues related to how two chemical products are related and how they are used in commerce. It may indeed be the case that Applicant's products include resins and waxes such as those sold by Opposer and listed in Opposer's description of goods. It also may be the case that Applicant continues to sell all the class 1 goods that it now seeks to delete from its description. The more information the Board has from discovery, the easier it will be to correctly decide how the goods of the parties are related. In the same way, full discovery will aid the Board in determining the similarity of customers and customer sophistication. Applicant's proposed amendment could be argued to limit discovery to only certain of Applicant's products, thereby limiting the Board's access to information necessary for a correct decision at trial. The Board should rule in favor of a broader scope of discovery and defer the decision on this Motion.

¹⁶ TBMP 514.01 and 514.03; *see also*, *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1255-56 (TTAB 2011) (unconsented motion to amend to Supplemental Register deferred to summary judgment or final hearing); *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1307 (TTAB 2002) (motion to amend to substitute a basis deferred to final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554-55 (TTAB 1987) (motion to amend dates of use deferred); *see also*, *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985).

¹⁷ *See*, TBMP 514.03; *see also*, *Embarcadero Tech., Inc. v. RStudio, Inc.*, Opp. No. 91193335, *43 (TTAB Feb. 14, 2013).

III. CONCLUSION

Applicant has the burden to show the Board why it should amend its description of goods and services. Applicant has failed to meet this burden. The proposed amendment fails the *Stryker* test because it fails to narrow the goods and services and further fails to create any substantially different issues for trial. Further, the proposed amendment fails to present any substantial savings in discovery because the technical issues and issues related to use of the mark remain. Finally, the Board should defer a decision on Applicant's Motion until the time of trial in order to promote full discovery. For these reasons, Opposer requests that the Motion be denied or at least deferred until the time of trial.

Dated: October 29, 2018.

Respectfully submitted,



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CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Response to Motion to Amend Application and Brief in Support was served upon the persons listed below in the manner indicated on October 29, 2018.

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