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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CME/LTS

March 21, 2019

Opposition No. 91238546

Westlake Longview Corporation

v.

Clariant AG

**Before Zervas, Shaw, and Greenbaum,
Administrative Trademark Judges.**

By the Board:

Before the Board is Applicant's fully-briefed motion, filed October 9, 2018, to amend the identification of goods and services in Applicant's involved application Serial No. 79194431.¹

We have carefully considered all of the parties' arguments, presume the parties' familiarity with the factual bases for their filings, and do not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

¹ Applicant pleaded the proposed restriction in its answer as an affirmative defense under Section 18 of the Trademark Act, 15 U.S.C. § 1068, and timely filed its motion before trial. *Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828-29 (TTAB 2013); TBMP § 514.03 (2018).

Background

On December 14, 2017, Opposer filed a notice of opposition against Applicant's application Serial No. 79194431 for the mark HIFORMER, in standard characters, for goods and services in International Classes 1, 2, and 42,² pleading priority and likelihood of confusion under Section 2(d) of the Trademark Act based on Opposer's Registration Nos. 3661578 for the mark HIFOR,³ 3661577 for the mark HIFOR CLEAR,⁴ and 3670225 for the mark HIFOR XTREME,⁵ each in standard characters for "polyethylene resins for use in the plastics industry" in International Class 1. 1 TTABVUE.

Applicant's application Serial No. 79194431 was published for the following goods and services:

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, in International Class 1;

Paints, varnishes, lacquers; rust preservatives in the nature of a coating; wood preservatives against deterioration; colorants; mordants for use in dyeing; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art, in International Class 2; and

² Filed September 27, 2016 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

³ Issued July 28, 2009.

⁴ Issued July 28, 2009.

⁵ Issued August 18, 2009.

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; Scientific and technological design services, namely, design services for customers to design new products in the nature of new product design services; design and development of computer hardware and software, in International Class 42.

On October 9, 2018, Applicant filed an unconsented motion to amend the identifications of goods and services in the involved application. 21 TTABVue. Applicant seeks to delete all of the identified goods in Class 1 and amend the identifications of goods and services in Classes 2 and 42 as follows:⁶

~~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, in International Class 1;~~

~~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, in International Class 2; and~~

~~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

⁶ In setting forth the amendments, wording in strikethrough is to be deleted, and wording in bold is to be added.

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,~~ in International Class 42.

Id. at 3-5. The resulting identifications of goods and services would be:

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, in International Class 2; and

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, in International Class 42.

Id.

Standard for Unconsented Motions to Amend Before Trial

Our decision in *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077 (TTAB 2013) (“*Stryker*”) provides a framework for deciding Applicant’s motion to amend. Although we generally defer determination of such a timely (i.e., pretrial) unconsented motion until final decision or until the case is decided upon motion for summary judgment, *see* TBMP § 514.03 and cases cited therein, under *Stryker*, 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 or 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 the 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.

Stryker, 109 USPQ2d at 1078-79 (citing *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007)); see also *Wis. Cheese Grp. LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1265-66 (TTAB 2016); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 964 (TTAB 1986); *Int'l Harvester Co. v. Int'l Tel. & Tel. Corp.*, 208 USPQ 940, 941 (TTAB 1980).

Analysis

Because Applicant filed its involved application under Section 66(a) of the Trademark Act, rather than based on a claim of use under Section 1(a) of the

Trademark Act, only the first three *Stryker* requirements apply. *See Wis. Cheese*, 118 USPQ2d at 1266 (fourth *Stryker* factor not applicable to intent-to-use applications); Trademark Rule 2.33(e)(1) (application under Section 66(a) must include a verified statement alleging a bona fide intent to use the mark in commerce); TMEP § 904 (Oct. 2018) (“No specimen showing use of the mark is required in an application based solely on §44 or §66(a) of the Trademark Act, 15 U.S.C. §1126 or §1141f(a).”). Applicant meets the three applicable *Stryker* requirements.

First *Stryker* Factor

Applicant’s proposal to delete goods and services is clearly limiting in nature. The language Applicant proposes to add to the identifications also is limiting in nature. Contrary to Opposer’s argument, the proposed addition of the words “liquid master batches” and “additives” to the identification of goods in Class 2 would narrow the scope of “colorants.” 21 TTABVUE 4. Applicant further proposes to clarify that the goods in Class 2 do not contain resins. Likewise, the language proposed to be added to the Class 42 services would narrow Applicant’s “chemical research services to develop innovations mainly carrier systems, dosing units and service concepts” to those “for liquid color master batches” and the “scientific and technological design services” to those “for liquid color master batches and for equipment for producing liquid color master batches.” 21 TTABVUE 5-6. Because the proposed amendments permissibly narrow the identifications of goods and services, the first *Stryker* requirement is satisfied.

Second *Stryker* Factor

Applicant makes the following statement in its motion:

[Applicant] 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. [Applicant] 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.

Id. at 7 (citations and quotations omitted). By way of this statement, Applicant unconditionally consents to judgment as to the Section 2(d) claim with respect to the broader identifications of goods and services for which the involved application was published for opposition.

Third *Stryker* Factor

Opposer's goods are "polyethylene resins for use in the plastics industry." Accordingly, Applicant's proposal to delete "unprocessed artificial resins" from Class 1, "raw natural resins" from Class 2, and "scientific and technological services, namely, chemical solution analysis and related consulting services for the ... plastic ... industr[y]" from Class 42, and to limit its remaining Class 42 services to those "for liquid color master batches" and "for liquid color mater batches and for equipment for producing liquid color master batches" would change the nature and character of Applicant's goods and services in a way that introduces a substantially different issue for trial.⁷ *See Wis. Cheese*, 118 USPQ2d at 1266; *Stryker*, 109 USPQ2d at 1079.

⁷ To the extent the parties dispute the impact the amendments have on discovery (23 TTABVUE 7-8; 25 TTABVUE 8-9), the Board reminds the parties that Fed. R. Civ. P. 26(b) defines the scope of discovery, "[u]nless otherwise limited," as including "nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case" It also sets forth limits on the scope of discovery. The Board has applied the principle

Contrary to Opposer's argument (23 TTABVUE 6-7), an applicant does not have to amend its goods and services to eliminate a cause of action. Opposer's only cause of action is under Section 2(d), and the issues that must be tried under that claim are directly impacted by the proposed amendments. *See Stryker*, 109 USPQ2d at 1079 (finding amendment presented substantially different issue for trial where only cause of action was under Section 2(d)).

For all of these reasons, Applicant's motion to amend is **granted**. Application Serial No. 79194431 will be amended accordingly.⁸ Judgment is entered in favor of Opposer as to its Section 2(d) claim with respect to all goods encompassed by Applicant's broader identifications of goods and services, except for the goods and services identified by the amended identifications. The following identifications of goods and services in application Serial No. 79194431 are accepted and are now the operative identifications of goods and services:

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

of proportionality to define the proper subjects of and expanse of inquiry in inter partes proceedings under various circumstances. *Cf. Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (proportionality principle applied to interrogatories, document requests and requests for admission); *The Phillies v. Philadelphia Consol. Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (proportionality discussed with respect to requests for admissions). See also TBMP §§ 402.01 and 414(11). For example, a party may not be entitled to information regarding goods and services not identified in an involved application. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 n.2 (TTAB 1985). Here, while Applicant's deletion of goods and services from its application does not automatically alter the scope of discovery, the parties should keep these principles in mind as they agree to the appropriate scope of and limits on discovery in this proceeding given the amendments to Applicant's identification of goods and services. *See Wis. Cheese*, 118 USPQ2d at 1266-67, n.10.

⁸ Applicant's proposed amendment will be entered and the USPTO's records will be updated in due course.

color master batches containing additives; none of the aforementioned containing resins, in International Class 2; and

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, in International Class 42.

Proceedings Resumed and Dates Reset

Proceedings are **resumed**. Dates are reset as follows:

Initial Disclosures Due ⁹	4/8/2019
Expert Disclosures Due	8/6/2019
Discovery Closes	9/5/2019
Plaintiff's Pretrial Disclosures Due	10/20/2019
Plaintiff's 30-day Trial Period Ends	12/4/2019
Defendant's Pretrial Disclosures Due	12/19/2019
Defendant's 30-day Trial Period Ends	2/2/2020
Plaintiff's Rebuttal Disclosures Due	2/17/2020
Plaintiff's 15-day Rebuttal Period Ends	3/18/2020
Plaintiff's Opening Brief Due	5/17/2020
Defendant's Brief Due	6/16/2020
Plaintiff's Reply Brief Due	7/1/2020
Request for Oral Hearing (optional) Due	7/11/2020

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

⁹ Because the issues for trial have changed, and because Applicant may have filed its motion to amend in lieu of serving initial disclosures, the Board resets the deadline to serve initial disclosures.

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