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

Proceeding	91247347
Party	Defendant Charge Automotive Ltd.
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Attachments	Motion to Amend Application.pdf(26551 bytes)

UNITED STATES PATENT AND TRADEMARK
OFFICE TRADEMARK TRIAL AND APPEAL
BOARD

In the matter of App. Ser. No. 79189784 and 79218619 to register the marks CHARGE,
published in the *Official Gazette* of November 27, 2018, and January 8, 2019, respectively.

FCA US LLC., Opposer, v. CHARGE AUTOMOTIVE LTD., Applicant.	Opposition No. 91/247,347 Serial Nos. 79189784 and 79218619 Mark: CHARGE & design Filing Date: March 10, 2016, and July 26, 2017
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MOTION TO AMEND APPLICATION

Applicant moves to amend the identification of goods in App. Ser. Nos. 79189784
and 79218619 pursuant to 37 C.F.R. § 2.133 and TMEP § 514. For the reasons stated
below, this motion should be granted.

1. Proposed Amendment

Applicant proposes to amend the identification of goods in App. Ser. Nos.
79189784 and 79218619 as follows:

*Class 12: Engines and motors for land vehicles; drivetrains for land vehicles;
transmissions for land vehicles, namely, continuously variable transmissions and
auxiliary drive transmissions; clutches and couplings for land vehicles; parts of
transmissions for land vehicles, namely, mechanical control systems and
hydraulic control systems for regulation of drive speed ratio or drive torque;
motors for use as auxiliary power sources and range extenders for electric
vehicles; and structural parts therefor; all the aforesaid goods relating to
electric buses and electric trucks and range extended electric buses and range-
extended electric trucks and not including forced induction and pressure-
charging systems and parts and fittings for forced induction and pressure-
charging systems*

Opposition No. 91247347

If this amendment is allowed, the resulting identification of goods in Class 12, in both applications, will be narrowed to zero, i.e., it will be completely eliminated.

2. *The proposed amendment is appropriate*

The Board restated the standard for allowing the amendment of an opposed application in *Johnson & Johnson v. Stryker Corp.*, 109 U.S.P.Q.2d 1077, 1078-1079 (T.T.A.B. 2013):

In determining whether to accept a proposed amendment to an identification that, while contested, is otherwise acceptable, the Board looks to see whether the following circumstances are present:

1) the proposed amendment must serve to limit the broader identification of goods or services;

2) 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 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.

Accord Drive Trademark Holdings LP v. Inofin, 83 U.S.P.Q.2d 1433, 1435 (T.T.A.B. 2007); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 U.S.P.Q. 940 (T.T.A.B. 1980).

In the present case, the first circumstance is present because the proposed

Opposition No. 91247347

amendment clearly limits the broader identification of goods in the application as published.

The second circumstance is also present. 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.

The third circumstance listed above also exists, since the proposed amendment serves to change the nature and character of the goods or services so as to introduce substantially different issues for trial; in fact, the proposed amendment completely eliminates the issues for trial. Specifically, Opposer's claims are directed to the Class 12 goods listed in the two applications of the Applicant. The deletion of all Class 12 items from Applicant's identification of goods will substantially alter the arguments and presentation of evidence by the parties, and the evaluation of the issues by the Board, by giving the Opposer the relief that it seeks. The need for trial on these claims will be eliminated if the proposed amendment is granted, since it eliminates all identifications of Class 12 goods.

The fourth circumstance mentioned by the Board in *Johnson & Johnson* is inapplicable to the present case because the application at issue was filed under Section 1(b) of the Trademark Act.

3. The proposed amendment should be accepted immediately

Although the Board usually defers the determination of motions to amend the identification of goods until final hearing or a motion for summary judgment, it is not required to do so. *Johnson & Johnson v. Stryker Corp.*, 109 U.S.P.Q.2d 1077, 1078-1079 (T.T.A.B. 2013). If the proposed amendment is granted immediately, the scope of

Opposition No. 91247347

discovery and presentation of evidence on Opposer's Section 2(d) claim will be eliminated entirely. There is simply no point in requiring the parties to develop and present evidence and arguments regarding Opposer's claims when Applicant has already agreed to the entry of judgment on those claims.

4. Request for suspension pending disposition of this motion

The current deadline to for the discovery conference is March 9, 2020. Applicant requests that proceedings be suspended pending the disposition of the present motion under 37 C.F.R. § 2.117(c).

Suspension is appropriate from the standpoint of judicial economy because the content of applicant's answer will depend in part on whether the proposed amendment is granted.

5. Conclusion

The present motion should be granted for the reasons stated above. Specifically, applicant requests that the Board (a) immediately amend the identification of goods in App. Ser. Nos. 79189784 and 79218619 by deleting all of the goods in Class 12; and (b) suspend proceedings pending the disposition of this motion.

Respectfully submitted,

March 6, 2020
Date

/Mark D. Simpson/
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of Applicant's Answer is being sent by email, this 7th day of November 2019, to the email addresses of record for the Attorney for Opposer as follows:

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