

ESTTA Tracking number: **ESTTA1072407**

Filing date: **08/03/2020**

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

Proceeding	91256175
Party	Defendant Amir Cehaja
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Attachments	MotionToAmend.pdf(58430 bytes )

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

<p><b>SR84 S.R.L.,</b>  Opposer,  v.  <b>Amir Cehaja,</b>  Applicant.</p>	<p>Opposition No. 91256175  Mark: PHYZK Int'l Class: 025 Serial No.: 88/764,830 Filed: January 18, 2020</p>
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**CONSENT MOTION TO AMEND**

Applicant moves to amend the identification of goods in App. Ser. No. 88764830 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. No. 88764830 as follows:

*Class 025: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms all the aforementioned goods are not for cycling or cycling-related activities; Athletic footwear not for cycling or cycling-related activities; Athletic pants not for cycling or cycling-related activities; Athletic shirts not for cycling or cycling-related activities; Athletic shoes not for cycling or cycling-related activities; Athletic shorts not for cycling or cycling-related activities; Athletic skirts not for cycling or cycling-related activities; Athletic tights not for cycling or cycling-related activities.*

If this amendment is allowed, the resulting identification of goods will be “*Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms all the aforementioned goods are not for cycling or cycling-related activities; Athletic footwear not for*

*cycling or cycling-related activities; Athletic pants not for cycling or cycling-related activities; Athletic shirts not for cycling or cycling-related activities; Athletic shoes not for cycling or cycling-related activities; Athletic shorts not for cycling or cycling-related activities; Athletic skirts not for cycling or cycling-related activities; Athletic tights not for cycling or cycling-related activities” in Class 25.*

**2. *The proposed amendment is appropriate***

The Board has stated 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 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. Specifically, opposer's claim under Section 2(d) of the Trademark Act alleges a likelihood of confusion between applicant's mark, when applied to the goods identified in the application as published, and the mark FI'ZI:K, when applied to the goods identified in Reg. Nos. 2045461 and 3468144. The narrowing of the 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. Similarly, opposer's claim of dilution will also be substantially altered by the narrowing of the items from applicant's identification of goods. The need for trial on these claims will be eliminated if the proposed amendment is granted, since it eliminates all identifications of goods relating to cycling for which Reg. Nos. 2045461 and 3468144 require.

The fourth circumstance mentioned by the Board in *Johnson & Johnson* is satisfied by the specimen previously submitted by applicant.

***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 discovery and presentation of evidence on opposer's Section 2(d) claim will be narrowed and simplified. 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. Conclusion**

The present motion should be granted for the reasons stated above. Specifically, applicant requests that the Board immediately amend the identification of goods in App. Ser. No. 88764830 to be "*Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms all the aforementioned goods are not for cycling or cycling-related activities; Athletic footwear not for cycling or cycling-related activities; Athletic pants not for cycling or cycling-related activities; Athletic shirts not for cycling or cycling-related activities; Athletic shoes not for cycling or cycling-related activities; Athletic shorts not for cycling or cycling-related activities; Athletic skirts not for cycling or cycling-related activities; Athletic tights not for cycling or cycling-related activities*" in Class 25.

Dated: August 3, 2020

Respectfully Submitted,

By: /Michael L. Bartholomew/

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I hereby certify that on August 3, 2020, I filed the foregoing CONSENT MOTION TO AMEND via the TTAB's ESTTA electronic filing system which effectuated service on all counsel of record. A copy of the foregoing has also been electronically served on Opposer's counsel of record by email as of the same date as follows:

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