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

Proceeding	91256413
Party	Plaintiff OlÃ© Mexican Foods, Inc.
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Date	11/10/2021
Attachments	Opposition to Motion to Amend Mark.pdf(93683 bytes)

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

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In the Matter of Trademark Appl'n No.:
88-646,951

For the Mark: OLE' CHAMOYLE

Filing date: October 8, 2019

OLÉ MEXICAN FOODS, INC.,

Opposer,

v. Opposition No. 91256413

CERVEZA CITRUS L.L.C.,

Applicant.
----------X

MEMORANDUM IN OPPOSITION TO MOTION TO AMEND TRADEMARK

Following the close of discovery, and on the eve of Opposer's Trial Period, Applicant is seeking to amend its applied-for mark, OLE' CHAMOYLE, to a different mark, OLÉ CHAMOYLE. Although Applicant cites no rule or authority for this request, the Board has treated the request as if it were governed by 37 C.F.R. § 2.133, TBMP §514.03 [18 TTABVUE 1].

The Rule states, in pertinent part: "The amendment of any application or registration that is the subject of an inter partes proceeding before the Board is governed by 37 C.F.R. § 2.133. Thus, an application that is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. An uncontested motion to amend in substance is generally deferred until final decision or until the case is decided upon summary judgment."

For the most part, amendments to applications governed by 37 C.F.R. § 2.133 concern amendments to the identification of goods, *see, e.g*., *Space Base Inc. v. Stadis Corp.,* 17 U.S.P.Q.2d 1216 (TTAB 1990), or dates of use, *see, e.g., Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 U.S.P.Q.2d 1552 (TTAB 1987), and are thus amenable to deferring until final decision or until the case is decided upon summary judgment. TBMP §514.01. Indeed, the Board has noted "Where genuine issues of material fact remain for trial, deferred consideration of a proposed amendment allows the parties to more appropriately develop the record and argue the effect of the amendment." *Hertz Technologies, Inc. v. Nuhertz Technologies, LLC*, Opposition No. 124,487, 2002 TTAB LEXIS 437 (July 10, 2002)(not precedential)

However, in this case, Opposer would be prejudiced by deferral of the decision because of the uncertainty as to the precise mark being opposed, and the inability to more appropriately develop the record inasmuch as discovery has closed.

As noted by the Board in its decision denying Opposer's Motion for Summary Judgment, 10 TTABVUE 2, fn 3 (emphasis added):

> We note that Applicant's mark is comprised in part of the term OLE' (with an apostrophe after – rather than an accent mark over – the "e"). Nonetheless, Applicant describes its mark as follows: "Applicant's Mark is OLÉ CHAMOYLE, which comprise the word OLÉ, which is a Spanish word that is pronounced 'oh-lay'." 7 TTABVUE 8. The examples of packaging embedded in Applicant's brief show the mark OLÉ CHAMOYLE. *Id.* at 9. Opposer also refers to Applicant's mark as OLÉ CHAMOYLE. *See, e.g.,* 5 TTABVUE 6 (discussing "Applicant's OLÉ CHAMOYLE Mark"). **The parties have not submitted any evidence or argument as to the appearance, pronunciation, meaning, or overall commercial impression of the OLE' portion of Applicant's involved mark.**

Accordingly, should the Board defer decision on Applicant's Motion to Amend, or deny the motion as untimely, Opposer would need to seek to re-open discovery in order to develop evidence regarding the OLE' portion of Applicant's applied-for mark. The prejudice to Opposer

is manifest. If the Board defers decision on the Motion to Amend until after trial, Opposer would be forced to litigate to decision without knowing exactly what Applicant's mark is. As the Board suggests in the above-mentioned footnote, OLE' CHAMOYLE may be considered a different mark from OLÉ CHAMOYLE in appearance, pronunciation, meaning, or overall commercial impression.

Opposer therefore respectfully requests that Applicant's Motion to Amend Trademark be denied as untimely since it has been made after the close of discovery or, in the alternative, that discovery be re-opened to permit discovery of all Applicant's proposed marks, and for such other and further relief as to the Board seems just.

Dated: November 10, 2021

Respectfully submitted,

/paul s. owens/

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CERTIFICATE OF SERVICE

I hereby certify that on this 10th day of November, 2021, a true and correct copy of the foregoing Memorandum in Opposition to Motion to Amend Trademark was served on Applicant by emailing a copy to Applicant's attorney of record at:

Richard A. Ryan, Esq.
Email: Richard@fresnopatentlaw.com

/paul s. owens/
Paul S. Owens, Esq.