UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

February 10, 2022

Opposition No. 91256413

Olé Mexican Foods, Inc.

v.

Cerveza Citrus L.L.C.

Mary Beth Myles, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Applicant's motion (filed October 21, 2021) to amend its mark, without Opposer's consent. Opposer filed a response on November 10, 2021 and a cross-motion, in the alternative, to reopen discovery.

By way of its motion, Applicant seeks to amend the drawing of its mark as follows:

From: OLE' CHAMOYLE

To: OLÉ CHAMOYLE

On October 25, 2021, the Board provided Opposer time in which to provide its consent to the amendment, failing which the Board advised the parties that consideration of the proposed amendment may be deferred until final decision. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 514.02 (2021).

On November 10, 2021, Opposer filed a response opposing Applicant's proposed amendment. In its response, Opposer argues that the amendment should be denied as untimely, because it was made after the close of discovery or, in the alternative, that discovery be reopened to allow for discovery "of all Applicant's proposed marks." 19 TTABVUE 4.

The amendment of any application or registration that is the subject of an inter partes proceeding before the Board is governed by Trademark Rule 2.133. Trademark Rule 2.133(a) provides that an application or registration 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. For that reason, a contested motion to amend the involved application or registration is generally deferred until final decision or until the case is decided upon summary judgment. *See, e.g., Zachry Infrastructure LLC v. American Infrastructure Inc.,* 101 USPQ2d 1249, 1255-56 (TTAB 2011); *Enbridge Inc. v. Excelerate Energy L.P.,* 92 USPQ2d 1537, 1539 n.3 (TTAB 2009); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990); *Fort Howard Paper Co. v. G.V. Bambina Inc.*, 4 USPQ2d 1552, 1554 (TTAAB 1987); *see also* TBMP § 514.03.

Applicant's motion to amend is timely inasmuch as it was made prior to trial. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990). A proposed amendment to any application which is the subject of an inter partes proceeding must also comply with all applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TBMP § 514.01. An applicant may amend the drawing of the

mark only if the proposed amendment does not materially alter the mark. *See* Trademark Rules 2.72(a)(2) and (b)(2). The controlling question is always whether the old and new forms of the mark create essentially the same commercial impression.[1] *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.,* 797 F.3d 1363, 116 USPQ2d 1129, 1132 n.1 (Fed. Cir. 2015).

In keeping with Board practice, consideration of the proposed amendment is **deferred** until final decision. *See e.g., Zachry Infrastructure LLC v. American Infrastructure Inc.,* 101 USPQ2d 1249, 1255-56 (TTAB 2011); *Enbridge Inc. v. Excelerate Energy L.P.,* 92 USPQ2d 1537, 1539 n.3 (TTAB 2009); *Space Base Inc.*, 17 USPQ2d at 1219; *see also* TBMP § 514.03.

Opposer argues that it will be prejudiced by a deferral of a decision on the motion to amend, because it did not have an opportunity to take discovery on the "OLE' portion" of Applicant's involved mark. Applicant's mark, as filed, is OLE' CHAMOYLE. Although both parties apparently proceeded with discovery and summary judgment briefing under the mistaken assumption that Applicant's involved mark included a diacritical mark as opposed to an apostrophe, Opposer certainly had an opportunity to conduct discovery on the applied-for mark. In any event, any potential prejudice to Opposer caused by the parties' mutual mistake may be alleviated by a reopening of the discovery period.

[1] Neither party addresses whether the proposed amendment constitutes a material alteration of the involved mark.

In the event the Board defers consideration of the motion to amend, Opposer seeks to reopen discovery to allow the parties to take discovery on "the OLE' portion of Applicant's applied-for mark." 19 TTABVUE 3. Applicant did not file a timely response to Opposer's cross-motion to reopen. Accordingly, Opposer's cross-motion to reopen discovery is **granted** as conceded to the extent that discovery is reopened for a period of 45 days. *See* Trademark Rule 2.127(a).

Proceedings are resumed. Remaining dates are reset as follows:[2]

Discovery Closes	**3/28/2022**
Plaintiff's Pretrial Disclosures Due	**5/12/2022**
Plaintiff's 30-day Trial Period Ends	**6/26/2022**
Defendant's Pretrial Disclosures Due	**7/11/2022**
Defendant's 30-day Trial Period Ends	**8/25/2022**
Plaintiff's Rebuttal Disclosures Due	**9/9/2022**
Plaintiff's 15-day Rebuttal Period Ends	**10/9/2022**
Plaintiff's Opening Brief Due	**12/8/2022**
Defendant's Brief Due	**1/7/2023**
Plaintiff's Reply Brief Due	**1/22/2023**
Request for Oral Hearing (optional) Due	**2/1/2023**

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 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,

[2] The Board considers proceedings retroactively suspended as of the filing date of Applicant's motion to amend its application.

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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.[3] The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

[3] To facilitate accuracy, ESTTA provides previews of each page before submitting.