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

Proceeding	91263649
Party	Plaintiff Traxxas, L.P.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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TRAXXAS, L.P.	§	
	§	Opposition No. 91263649
Opposer	§	
	§	
v.	§	
	§	
Maxxus Group GmbH & Co. KG	§	
	§	Mark: MAXXUS
Applicant	§	Application No.: 79282117
	§	

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO AMEND

On January 22, 2021, Applicant Maxxus Group GmbH & Co. KG ("Applicant") filed an unconsent motion ("Applicant's Motion") to amend the above-referenced application (the "Application") for the opposed MAXXUS mark. Applicant's Motion asserts the proposed amendment to the Application would delete all goods specifically objected to in the Opposition and that the proposed amendment narrows the Application and will avoid a likelihood of confusion as alleged in the Notice of Opposition.

Opposer objects to Applicant's Motion and the proposed amendment because the proposed amendment does not delete all of the goods specifically objected to in the opposition as proposed by Applicant.

I. The proposed amendment fails to delete all of the goods objected to in the Opposition as proposed by Applicant.

Applicant's Motion proposes deleting from the Application "all of the goods specifically objected to in the Opposition." *See* Dkt. No. 12, Applicant's Motion, p 2.

The grounds for opposition asserted in this proceeding by Opposer include both (1) priority and likelihood of confusion with Opposer's TRAXXAS, MAXX, E-MAXX, MINI MAXX, T-MAXX, X-MAXX, XMAXX marks, Opposer's MAXX family of marks, and Opposer's conjoint use of the MAXX and TRAXXAS mark, and (2) lack of *bona fide* intent by Applicant to use the MAXXUS mark in commerce for "Games equipment, namely playing cards, chips, gaming tables and gaming cloths; toys and playthings, namely scooters, robots, toy gliders." *See* Dkt. No. 1, Notice, ¶¶ 16-18.

However, Applicant has only requested deletion of (and consented to entry of judgment on) "Games equipment, namely playing cards, chips, gaming tables and gaming cloths; toys and playthings, namely scooters, robots, toy gliders." Applicant's proposed amendment therefore only addresses the issue of Applicant's lack of *bona fide* intent to use the MAXXUS mark in commerce as asserted by Opposer. *See* Dkt. No. 12, Applicant's Motion, p 1.

The amendment requested therefore does not include all other goods put in issue by the Notice of Opposition. In the Notice of Opposition, Opposer has pleaded its likelihood of confusion claim as follows:

> 16. By virtue of Opposer aforementioned prior and senior rights arising from the registration and use of the Opposer's TRAXXAS, MAXX, E-MAXX, MINI MAXX, T-MAXX, X-MAXX, XMAXX marks, Opposer's MAXX family of marks, and Opposer's conjoint use of the MAXX and TRAXXAS mark, Applicant is barred from obtaining a registration of the MAXXUS Mark, because the use and attempt to register by Applicant of the MAXXUS Mark for the **Applicant's Goods**[1], without authorization by Opposer,

[1] In paragraph 9 of the Notice of Opposition, the tern "Applicant's Goods" is defined to include all goods in Class 28 of the opposed Application, as follows:

> The Application for the MAXXUS Mark seeks registration for Games equipment, namely playing cards, chips, gaming tables and gaming cloths; toys and playthings, namely scooters, robots, toy gliders; gymnastic and sporting articles, namely gymnastic benches, gymnastic apparatus, sleds being sports articles, waist trimmer exercise belts being sports articles; gymnastics and sports equipment, namely basketballs, footballs, lacrosse sticks; gymnastic and sporting articles, namely bar-bells, exercise bars, weight lifting plates, racks for holding dumbbells, stands for weight lifting plates, exercise weights,

> will create a likelihood of confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), including, without limitation, that there exists a common source, affiliation, approval, or sponsorship with the goods provided by Opposer in connection with its marks, families of marks, and conjointly used marks. (Emphasis added).
>
> *See* Dkt. No. 1, Notice, ¶ 16.

Accordingly, Applicant's request to partially amend the identification of goods in Class 28 does not delete all of the goods specifically objected to in the Notice of Opposition as claimed by Applicant, contrary to the assertion of Applicant's Motion.

II. Applicant's proposed amendment and resulting judgment creates uncertainty whether *res judicata* effect should be given in this proceeding.

While Applicant has indicated its willingness to consent to the entry of a judgment against it in the opposition with respect to the broader recitation of goods (in this case, the goods sought to be deleted), Applicant has failed to make the requisite showing that the proposed amendment serves to introduce a substantially different issue for trial from the issue presented based on the original identification of goods.

In order to avoid the possibility of a *res judicata* effect of the entry of judgment, an applicant seeking to amend its identification of goods or recitation of services must set forth adequate reasons for the amendment. *Drive Trademark Holdings LP v. Insofin*, 83 U.S.P.Q.2d 1433, 1435 (TTAB 2007) (setting forth requirements for unconsented amendments prior to trial). That is, an applicant must make a *prima facie* showing that the proposed amendment serves to change the nature and character of the goods and services or to restrict their channels of trade and customers in such a manner that a substantially different issue for trial has been introduced

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> kettlebells, stands for kettlebells, exercise benches, back muscle exercise equipment, benches for bench press, stomach exercisers, treadmills, cross trainers, ergometers, rowing machines, apparatus and equipment for weight lifting, namely weight lifting machines, hand and finger trainers, namely strength and dexterity trainers, aerobic fitness steppers, gymnastic balls **("Applicant's Goods")** in International Class 028. (Emphasis added).

from the issue presented by the opposition against the application based on the original identification of goods and services. *Id.*

In Applicant's Motion, on the issue of Applicant's reasons for the proposed amendment and the issue of likelihood of confusion, Applicant merely states:

> 3. The third factor relates to cases where the applicant wishes to avoid the possibility of a res judicata effect by the entry of judgment on the original identification. This factor is not relevant here as Applicant is consenting to entry of judgment with respect to the goods to be deleted.

See Dkt. No. 12, Applicant's Motion, p 2.

Accordingly, there is uncertainty with regards to whether the amendment and resulting judgment should be given *res judicata* effect.

In Applicant's Motion, Applicant proposes amending the Application as follows:

> ~~**Games equipment , namely playing cards, chips, gaming tables and gaming cloths; toys and playthings, namely scooters, robots, toy gliders**~~; gymnastic and sporting articles, namely gymnastic benches, gymnastic apparatus, sleds being sports articles, waist trimmer exercise belts being sports articles; gymnastics and sports equipment, namely basketballs, footballs, lacrosse sticks; gymnastic and sporting articles, namely bar-bells, exercise bars, weight lifting plates, racks for holding dumbbells, stands for weight lifting plates, exercise weights, kettlebells, stands for kettlebells, exercise benches, back muscle exercise equipment, benches for bench press, stomach exercisers, treadmills, crosstrainers, ergometers, rowing machines, apparatus and equipment for weight lifting, namely weight lifting machines, hand and finger trainers, namely strength and dexterity trainers, aerobic fitness steppers, gymnastic balls

See Dkt. No. 12, Applicant's Motion, p 1.

The goods remaining in the identification however are not sufficiently different enough so as to avoid a likelihood of confusion; therefore, the proposed amendment does not create a fundamentally different issue for trial. Applicant's proposed amendment and consent to judgment on the issue of a likelihood of confusion with regards to the goods proposed to be deleted include "games equipment" and "toys and playthings" goods. A variety of the goods

remaining in the identification all fall within the scope of equipment for games and toys/things to be played with, including at least "Gymnastic apparatus, Sleds, Basketballs, Footballs, Lacrosse sticks, and Gymnastic balls." Because the proposed amendment only seeks to delete some of the related goods, Applicant's amendment does not change the nature and character of the goods remaining in the identification. As such, further overlap also exists between "games equipment" and "toys and playthings" and the remaining broad categories of "gymnastics and sports equipment" and "apparatus and equipment for weightlifting" in the identification.

Moreover, the proposed amendment also does not serve to restrict the trade channels and customers in such a manner as to present a new issue. To the contrary, all of the goods in the identification can be found through the same retail locations, and Applicant has presented no evidence in this case (or on this motion) to suggest otherwise. Thus, the same class of consumers will be exposed to Applicant's remaining identification as would be exposed to the "games equipment" and "toys and playthings" goods Applicant proposes deleting.

Without a clear distinction between the goods proposed for deletion and those remaining, the proposed amendment does not present an issue for trial substantially different from the issue presented by the opposition against the Application based on the original identification of goods and services. Instead, the proposed amendment will lead to uncertainty about the extent of any *res judicata* effect applicable in the future and whether the remaining goods in the identification should be deleted as well at this time.

III. Conclusion

Opposer has demonstrated that Applicant's Motion to Amend is improper and Applicant's Motion should be denied. Specifically, Applicant has mischaracterized the Notice of

Opposition by stating that the proposed amendment to delete "Games equipment, namely playing cards, chips, gaming tables and gaming cloths; toys and playthings, namely scooters, robots, toy gliders" deletes from the Application all of the goods specifically objected to in the Opposition. Applicant has also failed to make a *prima facie* showing that its proposed amendment changes the nature and character of the goods or restricts the channels of trade and customers in such a manner as to present a substantially different issue for trial. Accordingly, the proposed amendment creates uncertainty whether any judgment that is entered with respect to the broader class of goods should be given *res judicata* effect in this proceeding with respect to the closely related goods remaining in the identification and at issue.

For at least the reasons discussed above, Opposer respectfully requests that the Board deny Applicant's Motion or reserve decision on Applicant's Motion until such time as it has ruled on the merits of the entire dispute.

Dated: February 11, 2021

Respectfully Submitted,

/s/ Gregory W. Carr

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CERTIFICATE OF SERVICE

I hereby declare under penalty of perjury that **on February 11, 2021** a true copy of the foregoing OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO AMEND was served **via email** on Deborah L Shapiro at Moses & Singer LLP, 405 Lexington Avenue, The Chrysler Building, New York, NY 10174, attorney of record for Applicant, sent to the email address noted below:

trademarks@mosessinger.com

/s/ Gregory W. Carr
Gregory W. Carr
Attorney for Opposer