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

Proceeding	91263671
Party	Defendant Wolfgang Joop
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Date	07/15/2021
Attachments	Applicant JOOP Motion to Amend ID Delete Class 42 with ExA-1 and redacted ExA-2.pdf(458449 bytes ) EX A-2 WolfgangJoop Motion to Amend - Delete CI 42 Confidential.pdf(60756 bytes )

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

WOLFGANG PUCK and WOLFGANG PUCK  
LICENSING LLC,

Opposers,

v.

WOLFGANG JOOP

Applicant

Proceeding No. 91263671

Mark: THE WOLFGANG

Serial No. 79263615

**APPLICANT'S MOTION TO AMEND APPLICATION – DELETION OF CLASS 42**

Applicant, Wolfgang Joop, hereby respectfully moves that the Board amend the application at issue by limiting the services identified through deletion of Class 42 in its entirety, pursuant to 37 C.F.R. §§ 2.133(a). The grounds for Applicant's motion are as follows: (1) the deletion of Class 42 in its entirety limits the recitation of services of the application overall, (2) Applicant consents to the entry of judgment as to the broader recitation of services, (3) Applicant makes a prima facie showing that the amendment serves to change the nature and character of the services or restricts the channels of trade and customers in such a manner that a substantially different issue for trial has been introduced from the issue presented by the opposition against the application based on the original recitation of services, (4) the amendment corresponds with Applicant's current bona fide intent to use the mark at issue as Applicant testified to in his deposition on June 22, 2021; and (5) there is no prejudice to Opposers as a result of this amendment to the application despite having conducted an expert survey on the original services of the application at issue.

Applicant's counsel sought consent to amendment of the application, but consent was not provided.

## ARGUMENT

Rule 2.133(a) states that, “An application subject to an opposition may not be amended in substance [], except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, *or upon motion granted by the Board.*” (emphasis added). In this regard, “the Board has jurisdiction over the application and will determine the propriety of the amendment.” TBMP § 212.07 (Amendment During Opposition); see TBMP § 514 (Motion to Amend Application or Registration).

The Board has discretion to grant a motion to amend that Applicant files without consent of the Opposer. TBMP § 514.03 (Amendment Without Consent); see *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007); see also, e.g., *Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016).

**1. *Deletion of Class 42 in its entirety limits the recitation of services of the application.***

Applicant moves the Board to allow amendment of the application at issue, Application Serial No. 79263615, to delete Class 42 in its entirety, shown by redline below:

~~International Class 42: Design of restaurants, namely, interior and architectural design; furnishing design services for the interiors of buildings; design of building interiors; interior design.~~

The Board already issued an order on Applicant’s prior filed Motion to Amend denying partial removal of certain services identified in Class 42 and deferring consideration of the proposed amendment to Class 43, which entails removal of all services other than hotel services and providing temporary accommodation, until final decision or the case is decided upon summary judgment. (Dkt #16)

In this case, by deleting Class 42 (and, if in the end, the amendment to Class 43 is granted), any restaurant related services have been taken out of the analysis. Accordingly, the trial will be simplified to a comparison of the marks as used for hotel/temporary accommodation services.

**2. Applicant consents to the entry of judgment as to the broader recitation of services.**

Applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification. *See, Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993) (where applicant consented to entry of judgment against itself with respect to a geographically unrestricted registration). Applicant asserts that it is at least entitled to a registration with the restriction set out above. Applicant does not object to accepting judgment with respect to the broader identification of services if amendment of the application allows registration for those remaining limited services.

**3. The amendment serves to change the nature and character of the services or restricts their channels of trade and customers.**

The examining attorney did not cite Opposers' mark against registration of the entirety of the original application being opposed herein. No marks were cited for any issue of likelihood of confusion. With the limitation to remove all services relating to restaurants and leaving only hotel and temporary accommodation services, there is even less chance of likelihood of confusion between the Class 43 services that remain (if Applicant's motion to leave only hotel and temporary accommodation services is granted).

The channels of trade and customers between The Wolfgang hotel and Wolfgang Puck restaurants is delineated in different directions. This is not a comparison of dueling restaurant patrons; this is a comparison of people who specifically want to stay at a hotel designed by the famous Wolfgang Joop, with his specific style and flair. In this regard, Applicant's target consumers are people who want to stay at a high-end hotel and who are looking for a particular experience. Mr. Joop testified that his intended hotel guests are people who enjoy a certain attitude and who desire staying in a hotel that gives them a certain feeling, namely, people who like his fashionable style. (Exhibit A-1, page 23, lines 2-20; Exhibit A-2, page 34 line 25, page 35 lines 2-11). He specifically testified that his kind of clientele are not the same as Mr. Puck's restaurant clientele because for one, he is a fashion and style icon (Exhibit A-1, page 17 lines 5-15). Further, to his knowledge, Mr. Puck's restaurants feature steak, while his hotel is aiming for an Asian-style, that features sustainable materials and green materials (Exhibit A-1, page 39 lines 13-25, page 40 lines 1-5).

Applicant makes a prima facie showing that deletion of all of Class 42 changes the nature and character of the services contained in the application at issue. *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods); *see Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (noting principle that an acceptable amendment to the identification may be permitted despite opposer's objection if amendment limits identification and applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification). Granting the amendment of this

application will leave substantially different issues for trial. The final issue would be likelihood of confusion between THE WOLFGANG for hotel services versus WOLFGANG PUCK for restaurant services. Every hotel does not include a restaurant. Further, if Applicant's hotels include a restaurant, there is no evidence that the restaurant will be called the mark at issue.

**4. The amendment requested would be made and allowed for filing a Statement of Use after Notice of Allowance, conforming Applicant's current bona fide intent to use the Mark.**

A complete statement of use must include the following elements:

(1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the dates of first use of the mark anywhere and first use of the mark in commerce, and setting forth or incorporating by reference those goods/services specified in the notice of allowance on or in connection with which the mark is in use in commerce; .... ((2) and (3) omitted.)

37 C.F.R. §2.88(b); 15 U.S.C. §1051(d)(1); TMEP Sections 1109.06, 1109.13. When Applicant files its Statement of Use for this application, omitting the Class 42 services that would be listed in the Notice of Allowance, the United States Patent and Trademark Office will presume these same services are supposed to be deleted. TMEP Section 1714.01(f)(ii)(C). Applicant may state that the mark is in use on "those goods/services identified in the notice of allowance" or "those goods/services identified in the notice of allowance except ... [followed by an identification of the goods/services to be deleted]." TMEP Section 1109.13; *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972-73 (TTAB 1991) (although applicant filed no motion or amendment to narrow its identification, after granting summary judgment on identification of goods as published, the Board allowed applicant time to file a request to amend identification to accurately reflect goods sold under the mark).

**5. There is no prejudice to Opposers by deletion of Class 42.**

The Board has the discretion to adjust the discovery timeline in order to protect a party from prejudice in the context of motions to amend pleadings, even as late as during the trial phase of the case. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2008) ("the only way the Board could avoid prejudice to applicant would be by reopening the trial phase of this proceeding so that applicant could submit evidence addressing this ground [whether applicant had a *bona fide* intent to use its mark]"); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703-04 (TTAB 2000) (reopened for limited purpose of conducting discovery on new claim); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990) (reopened solely for applicant's benefit); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 431 (TTAB 1985) (applicant to advise whether it would need additional discovery). Accordingly, in the context of a motion to amend when there is still time in the discovery phase of the case, there is no prejudice to Opposer by granting this motion.

There is time in the case for Opposers to have the opportunity to refine their expert survey, if even necessary, which Applicant doubts. Moreover, Opposers' survey was intended to support of their case as to a likelihood of confusion for all the services originally listed in the application at issue, so there is no need for any do-over.

The scope of the application in this case will be limited by the amendment sought, with such amendment sought pre-trial, pre-testimony, during fact discovery, while there is still sufficient time to make adjustments in their litigation strategy, if Opposers deem any such adjustments necessary. In addition, Opposer cannot point to a specific prejudice in allowing the





CERTIFICATE OF SERVICE

I hereby certify that a true and exact copy of the foregoing APPLICANT'S MOTION TO AMEND APPLICATION – DELETION OF CLASS 42 was served on July 15, 2021, via email addressed to the following:

Mr. Robert Chapman  
Sauer & Wagner LLP  
1801 Century Park East, Suite 1150  
Los Angeles, CA 90067  
rchapman@swattys.com

s/JAK/  
One of the Attorneys for Applicant

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on July 15, 2021, the foregoing APPLICANT'S MOTION TO AMEND APPLICATION – DELETION OF CLASS 42 is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) at the uspto.gov website.

s/JAK/  
One of the Attorneys for Applicant

EXHIBIT A-1

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

In the Matter of Application Serial No. 79263615  
Published in the Official Gazette of March 17, 2020

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WOLFGANG PUCK and WOLFGANG PUCK	)	Proceeding No.
LICENSING LLC,	)	91263671
	)	
Opposers,	)	
	)	
v.	)	
	)	
WOLFGANG JOOP,	)	
	)	
Applicant.	)	

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PORTIONS OF THIS TRANSCRIPT ARE  
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REMOTE DEPOSITION OF WOLFGANG JOOP  
Potsdam, Germany  
Tuesday, June 22, 2021  
Volume I

Reported by:  
JULIE T. MILLER  
CSR No. 13638  
Job No. 4626230  
PAGES 1 - 58  
PAGES 26 - 36, 46 - 58 ARE MARKED CONFIDENTIAL ATTORNEYS  
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2                   BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD  
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5                   ) Proceeding No.  
6                   ) 91263671  
7                   )                   Opposers,  
8                   )                   v.  
9                   )                   WOLFGANG JOOP,  
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Remote deposition of WOLFGANG JOOP, Volume I, taken on behalf of Opposers, with all parties, the witness, and court reporter appearing remotely, Potsdam, Germany, beginning at 4:59 p.m. and ending at 6:15 p.m., on Tuesday, June 22, 2021, before JULIE T. MILLER, Certified Shorthand Reporter No. 13638.

1 APPEARANCES:

2

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1 APPEARANCES (Continued):

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3 Also Present (Appearance Via Zoom Videoconference):

4 Diana Olivo, Sauer & Wagner, LLP

5 Judith Visher, The Wolfgang

6 Mariel Sarmiento, Veritext Concierge

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1 A An office?

2 Q An office, where you work?

3 A An office? An office; the office is in Zurich.

4 Q And do you work there?

5 A No, because I'm a designer, I'm an artist, and  
6 I'm -- I'm on myself. I'm on my own feet, and I'm just  
7 giving ideas or taste -- or hints for taste and style.

8 And -- and, also, I'm an artist. I'm painting  
9 also sometimes. So I'm -- I'm known for my style,  
10 lifestyle. This will be, perhaps, translated on hotels.  
11 That's what the plan is, to give them more personality.

12 I'm also a fashion designer. I had many shows in  
13 New York, also, and I was very, very successful in  
14 creating perfume. So all those kind of lifestyle  
15 products, they coming from my hand.

16 Q So you were a designer of clothing, for example,  
17 correct?

18 A Also -- also, but mainly for perfume. Also, I  
19 mean, I had many homes -- one in New York which I styled.  
20 It became very known by CNN. It was reported by CNN. I  
21 had a house in Monte Carlo. I had a house in Berlin.

22 I had -- now, I'm at -- at my -- my parents'  
23 place which -- my parents died, and so I moved into their  
24 places because they have a huge, huge, garden, about  
25 20,000, 30,000 square meters.

1 yes, I've heard that.

2 Q And, sir, what level of hotel do you intend to  
3 use The Wolfgang name for?

4 A Oh, something --

5 Q Five star?

6 A -- new.

7 Q What?

8 A Oh, I -- I would like to create something new.  
9 Like, after -- after our -- our drama Cor- -- pandemic, I  
10 think we have to change our lifestyle a little bit.

11 So I thought about a very, very eclectic, a  
12 little bit of sustainable, green, all those adject- --  
13 adjectives we always talking about in high fashion and  
14 high living, and we have to be like -- like respectful  
15 with our resources.

16 I mean, I have seen many hotels which having big  
17 luxury ideas but wasting also so much energy. Like,  
18 under -- in the modern -- modern -- modern demands, that's  
19 what we are trying to do, if we are doing the -- our  
20 hotel.

21 Q And so the restaurants in the hotels that you're  
22 talking about will also use sustainable foods, for --

23 A Yes.

24 Q -- example?

25 A Yeah, also, green, because I per- -- personally,

1 similar to the customers you saw in Mr. Puck's restaurant?

2 A In what? I didn't understand. If I saw people  
3 in -- in which restaurant?

4 Q The Puck restaurant that you said you went to --

5 A Yeah.

6 Q -- in Los Angeles.

7 A You say Pook. Puck -- Puck is -- is a bad word.  
8 I mis- -- it's very misunderstandable if you pronounce it  
9 Puck. We -- he's called Pook, I guess, so because he is  
10 not American.

11 Q Let me ask you the question again, sir.

12 A Yes.

13 Q Are the types of customers you hope to attract  
14 to The Wolfgang hotels and restaurants similar to the  
15 customers that you saw at the Wolfgang Puck restaurant  
16 where you were?

17 A No, no, no. My customer would be not similar, I  
18 must say. Because, first of all, I'm not offering meat,  
19 and -- and it's not that cui- -- rich cuisine which  
20 Mr. Puck offers.

21 I have an idea, a very more Asian, very more,  
22 what can I say, vegan, much -- much more modern, much more  
23 esoteric. I mean, Wolfgang Puck's restaurant, I think I  
24 was there only once, is more known for the heavy, heavy  
25 stuff.



1           And I would -- I would think I -- my -- my -- my  
2 cuisine, if I would have one, would be more light and --  
3 and more vegan, yeah, more green.

4           Q     And that's part of your product --

5           A     I don't see any comparison.

6           Q     That's part of your plan, correct?

7           A     Yes.

8           Q     Now, sir, is the company Wunderkind still  
9 operating?

10          A     Why can I -- what? Operating?

11          Q     Is the company Wunderkind --

12          A     Yes.

13          Q     -- still operating?

14          A     No, not for the moment.

15          Q     Sir, have you ever attended any meetings with  
16 hotel owners concerning your idea about using "The  
17 Wolfgang" as a brand name?

18          A     Yeah, I mean, sometimes we were talking about  
19 many things, perhaps, also about that, but I cannot recall  
20 a certain moment or a certain importance. It's like a  
21 having a conversation about this and that with all I can  
22 do.

23                 I -- I -- I could do a movie. I did two -- five  
24 movies. I wrote two books. I painted many paintings,  
25 and -- and, if we're sitting all together, then, of

EXHIBIT A-2 REDACTED

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Volume I

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11 [REDACTED]

12 Q [REDACTED] [REDACTED]

13 [REDACTED]

14 A [REDACTED] [REDACTED] [REDACTED]

15 [REDACTED],

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1           A       Yeah. "Flemings Hotels are currently operating  
2       16 hotels in Europe have entered into" -- "into an LOE  
3       [sic] for the further expansion of hotels with The  
4       Wolfgang brand in Europe and the U.S."

5                        Yes, Fleming Hotels. I mean, we are building up  
6       a group. We -- yeah, what -- what can I say? I'm -- I  
7       didn't do the contract. I didn't do all that -- all the  
8       written paperwork. I'm just giving my name, and I'm  
9       designing.

10                      If you -- if you give me room, space, and, then,  
11       I make a cozy -- I think a cozy great room out of it. So  
12       this is just, for me, a naked skeleton. As an artist, you  
13       know, you are not so good in those people -- papers.

14           Q       And so the plan is, you will do the design of  
15       various rooms in the hotels --

16           A       Yes.

17           Q       -- correct?

18           A       Yes.

19           Q       And those -- that includes the restaurants,  
20       right?

21           A       Yeah, yeah. Why not?

22           Q       Now, sir, have you had any discussions with  
23       Mr. Schneider about who the customers are going to be for  
24       these Wolfgang hotels and restaurants?

25           A       The customer, I think, will be attracted, if

1 they're seeing it. I mean, I'm -- I'm having my own style  
2 over many years developed, and people knowing my style who  
3 can see it in many, many different positions -- either a  
4 collection of -- of -- of clothing or a collection of --  
5 of perfume and -- and different -- even in furniture, I  
6 designed.

7 So -- and I think they're -- I think and I hope  
8 there is a certain need living in a very personal style  
9 which is mine and -- because I lived in different  
10 countries, so I think my -- I have a very international  
11 oriented taste.

12 Q So your idea is that customers will walk in off  
13 the street attracted by your style, correct?

14 A Yes, and, then, perhaps, they -- we have a little  
15 boutique with some goodies, some souvenirs. Perhaps,  
16 some -- some people watch -- stepping out having a  
17 scarf -- a scarf or a blouse or a T-shirt or a sweater  
18 where it has "Wolfgang" written on.

19 Q And people will walk in off the street and,  
20 perhaps, go to the restaurant that you designed?

21 A Yeah, I -- I stayed -- I stayed in New York in  
22 The Wolfgang Hotel and that gave me a certain attitude and  
23 a certain feeling.

24 Q Now, sir, I'd like you to take a look at a  
25 document which is listed as APP 00350 and APP 00351.