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

Proceeding	91269478
Party	Defendant Home Brew Mart, Inc.
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Attachments	Applicant_s Motion to Amend Application - 07 02 2021.pdf(150422 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Tootsie Roll Industries, Inc.,)	
)	
Opposer,)	Opp. No. 91269478
)	
v.)	Mark: DOT'S
)	Serial No. 90/294,127
Home Brew Mart, Inc.,)	
)	
Applicant.)	

APPLICANT’S MOTION TO AMEND APPLICATION AND SUSPEND PROCEEDINGS

Applicant, Home Brew Mart, Inc. (“Home Brew Mart”), under 15 U.S.C. § 1068, 37 C.F.R. § 2.133, Rule 514.03 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), and governing precedent including Wisconsin Cheese Grp., Inc. v. Comercializadora de Lácteos y Derivados, S.A. De C.V., 118 U.S.P.Q.2d 1262 (TTAB 2016), hereby moves for an order granting amendment of the identification of goods of Applicant’s pending Application, Serial No. 90/294,127, for the mark DOT’S (the “Application”). For the reasons stated below, this motion should be granted.

I. Proposed Amendment

Applicant proposes to amend the identification of goods in the Application to delete the Class 32 goods shown in bold and strikethrough (the “Proposed Excluded Goods”) as follows:

Beer; Beer-based cocktails; ~~**Fruit drinks and fruit juices; Mineral and aerated waters**~~

For clarity, if this amendment is allowed, the resulting identification of goods would be as follows: “Beer; beer-based cocktails” in Class 32 (the “Proposed Amended Goods”).

The reason for this amendment is that Applicant does not now have an intent to use the applied-for mark for the Proposed Excluded Goods.

II. The Proposed Amendment is Appropriate and Necessary for Efficient Litigation of this Opposition Proceeding

The Board recently re-stated the standard for allowing the amendment of an opposed application in Wisconsin Cheese Grp., Inc. v. Comercializadora de Lácteos y Derivados, S.A. De C.V., 118 U.S.P.Q.2d 1262 (TTAB 2016) (precedential) (granting unconsented motion to amend identification of goods and directing the parties to file amended pleadings). While the Board generally defers determination of motions to amend until trial or consideration of a summary judgment motion, “an unconsented motion to amend [an application based on intent to use] may be granted prior to trial under the following circumstances”:

- 1) the proposed amendment must serve to limit the broader identification of goods or services;
- 2) the applicant must consent to the entry of judgment on the grounds for opposition with respect to the goods to be deleted or excluded, by the amendment, from the broader identification of goods or services present at publication; and
- 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.¹

Wisconsin Cheese Group, 118 U.S.P.Q.2d 1265-66 (citing Johnson & Johnson v. Stryker Corp., 109 U.S.P.Q.2d 1077, 1078-79) (TTAB 2013) (precedential) (citations omitted).

¹ For use-based applications, a fourth element exists, but for applications “based on an intent to use, only the first three [Wisconsin Cheese Group elements] apply.” Id. at 1266.

Applicant satisfies all three elements, thus meriting the Board's immediate granting of the proposed amendment. The first element is satisfied because the proposed amendment clearly limits the broader identification of goods under which the Application was published for opposition. See id. at 1266. The proposed amendment does so by deleting the Proposed Excluded Goods from the Application.

Applicant also satisfies the second element, because Applicant consents to the entry of judgment on the grounds for opposition with respect to the Proposed Excluded Goods that appeared in the broader identification of goods present at publication. Furthermore, if the proposed amendment is granted immediately, the scope of discovery and presentation of evidence on Opposer's likelihood of confusion claim will be narrowed and simplified.² In fact, the need for discovery, presentation of evidence, and arguments regarding Opposer's likelihood of confusion claim with respect to the Proposed Excluded Goods will be eliminated entirely. Consistent with the circumstances in Wisconsin Cheese Group, "[t]here simply is no point in requiring the parties to develop and present evidence and arguments regarding [Opposer's grounds for opposition with respect to the Proposed Excluded Goods] when Applicant has already agreed to the entry of judgment on [the Proposed Excluded Goods]." Id. at 1266. Moreover, granting Applicant's proposed amendment prior to trial is necessary because Applicant does not now have an intent to use the applied-for mark for the Proposed Excluded Goods. See Combe Inc. v. Dr. August Wolff GmbH & Co. KG

² In making this Motion to Amend Application, Home Brew Mart does not in any way concede that any of the goods identified in the Application – whether the Proposed Amended Goods or the Proposed Excluded Goods – would create a likelihood of confusion with, or dilute, the mark subject to Opposer's cited registration. To the contrary, Home Brew Mart maintains that the applied-for mark would not cause any confusion with, or dilute, the mark subject to Opposer's cited registration.

Arzneimittel, Opp. No. 91209708, 2016 TTAB 283 (TTAB June 16, 2016) (not precedential) (granting motion to amend to delete goods for which applicant did not have intent to use).

Applicant also satisfies the third element, because the proposed amendment serves to change the nature and character of the goods so as to introduce substantially different issues for trial. Specifically, Opposer's cited registration forming the basis for its likelihood of confusion assertion solely covers "candy" in Class 30. The Proposed Amended Goods consist solely of alcoholic beverages, *i.e.*, "beer" and "beer-based cocktails" in Class 32, which are age-restricted and channel-restricted goods distinct from candy or other goods offered by Opposer, as well as from the Proposed Excluded Goods. Therefore, the deletion of the Proposed Excluded Goods from the Application will substantially alter – and greatly simplify – the arguments and presentation of evidence by the parties, and the evaluation of the issues by the Board. See Wisconsin Cheese Group., 118 U.S.P.Q.2d at 1266. For all these reasons, Applicant's Motion to Amend should be granted.³

III. The Proposed Amendment Should be Accepted Immediately

As noted above, Wisconsin Cheese Group re-affirmed that timely unconsented motions to amend can be granted by the Board *immediately* (as opposed to the Board waiting until trial or summary judgment motion) when the three elements discussed above are satisfied. Id. at 1265-66. In addition to the three elements being satisfied in this case as discussed, *supra*, if the proposed amendment is granted immediately in this

³ Applicant also notes, consistent with TBMP Rule 514.03, that (1) registration of the applied-for mark with the proposed amendment "will avoid a likelihood of confusion" among consumers between the respective sources of Applicant's and Opposer's goods, and (2) "Plaintiff is not using the [DOTS] mark on the [Proposed Amended Goods]." TMBP Rule 514.03.

case, then the scope of discovery and presentation of evidence on Opposer's likelihood of confusion claim will be narrowed and simplified, with discovery and assessment of likelihood of confusion factors such as the similarity or dissimilarity between the Proposed Excluded Goods and Opposer's registered or other goods eliminated entirely. There is no point in requiring the parties to develop and present evidence and arguments regarding such goods when Applicant already (1) has agreed to entry of judgment on the grounds for opposition with respect to the Proposed Excluded Goods and (2) does not have an intent to use the Proposed Excluded Goods. Furthermore, an immediate granting of the motion to amend would advance the interest of judicial economy, as the Board would no longer be required to assess such evidence and arguments over the course of the proceedings.

IV. Request for Suspension of Proceedings Pending Disposition of this Motion

Applicant requests that proceedings be suspended under 37 C.F.R. § 2.117(c) pending the disposition of the present motion. Suspension is appropriate from the standpoint of judicial economy because the granting of the motion to amend would substantially narrow the scope of discovery, arguments, and presentation of evidence by the parties, as well as narrow the scope of issues for the Board to assess in its evaluation of the claims in this case.

V. Conclusion

The present motion should be granted for the reasons stated above. Specifically, Applicant requests that the Board (1) immediately amend the identification of goods in Application Serial No. 90/294,127 by deleting the Proposed Excluded Goods in Class 32; and (2) suspend proceedings pending the disposition of this motion.

Respectfully submitted this 2nd day of July, 2021,

Home Brew Mart, Inc.

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CERTIFICATE OF SERVICE

The undersigned certifies that on July 2, 2021 the foregoing APPLICANT'S MOTION TO AMEND APPLICATION was served by email upon Opposer's attorney to the email addresses listed below:

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