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Attorney Docket No.: 235048US-56

BOX TTAB FEE

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

SAFEWAY INC.,)
)
Petitioner,)
)
v.)
)
PROMOTION IN MOTION, INC.,)
)
Respondent.)

Cancellation No.: 92/041,801
Registration No.: 2,162,698
Mark: TUXEDOS BLACK TIE

MOTION TO AMEND PETITION FOR CANCELLATION

Petitioner, Safeway Inc., by and through its undersigned counsel, hereby moves the Board to amend its petition for cancellation pursuant to Rule 15(a) of the Federal Rules of Civil Procedure and Trademark Rule 2.115.



02-04-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

I. BACKGROUND

On February 3, 2003, Petitioner filed its Petition for Cancellation of Respondent's TUXEDOS BLACK TIE Mark, U.S. Reg. No. 2,162,698, based on information and belief (1) that Respondent abandoned use of its mark on the goods encompassed in its registration with no intent to resume such use; and, alternatively, (2) that Respondent abandoned use of its trademark in retail marketing channels with no intent to resume such use. As a result of discovery obtained in this proceeding in the past month, culminating with information received from Respondent on February 2, 2004, Petitioner seeks to amend its Petition for Cancellation of Respondent's Mark to allege that, on information and belief, Respondent abandoned use of its mark in the domestic market in connection with goods identified in Respondent's registration. In short, Petitioner asserts that Respondent uses its mark only in Canada in connection with goods listed in its

registration. As Petitioner is amending its own application to recite use of its mark in connection with goods sold in its own supermarkets, Petitioner asserts that if partial cancellation is granted limiting Respondent's identification of goods to "candy sold only for export", there is no likelihood of confusion, and therefore there are valid grounds for partial cancellation.

II. DISCUSSION

A. The Board Has Discretion To Grant Petitioner's Motion To Amend.

The Trademark Rules provide that "[p]leadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court." Trademark Rule 2.115; *see also* TBMP § 315. The TBMP further states that amendments to pleadings are governed by Rule 15 of the Federal Rules of Civil Procedure. TBMP § 507. Under Rule 15, a party may amend its pleading by leave of the Board, and "leave shall be freely given when justice so requires." Fed. R. Civ. P. 15(a). "In view thereof, the Board liberally grants leave to amend pleadings at any given stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party." TBMP § 507.02. Finally, Section 18 of the Trademark Law Revision Act, 15 U.S.C. § 1068, gives the Board jurisdiction to modify the statement of goods in a registration which is the subject of a petition to cancel. TBMP § 309.03(d) (stating also that an action to restrict or modify goods in this manner must be tied to the question of likelihood of confusion).

In general, "if the board proceeding is still in the pre-trial stage (i.e., in discovery, or prior to any testimony having been taken by the plaintiff in its testimony period), leave to amend, if otherwise appropriate, will be allowed." Beth A. Chapman, *Tips from the TTAB: Amending Pleadings: The Right Stuff*, 81 TRADEMARK REP. 302, 305 (1991). In other words, if discovery is

still open, an adverse party will generally not be prejudiced and amending the pleadings will permit the Board to adjudicate fully the merits of the proceeding. *Space Base, Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1217 n.1 (T.T.A.B. 1990); *see also United States Olympic Committee v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221, 1222 (T.T.A.B. 1993) (granting Opposer's motion to amend its pleading because it was germane and applicant would not be prejudiced since proceeding was still in the pre-trial phase).

In the present case, Petitioner's proposed amended pleading will neither violate the law nor prejudice Respondent. (See Exhibit 1: Petitioner's Proposed Amended Pleading, with changes marked in bold or in the margin.) First, rather than violate settled law, Petitioner's proposed amended pleading will restrict Respondent's unlimited identification of trade channels to geographic areas where Respondent actually sells goods (partial cancellation), and will clarify the Petition and conform it to facts learned in discovery through February 2, 2004. *See Chapman, supra*, at 307 (explaining "that a motion to amend any pleading under FRCP 15(a) should be made as soon as the grounds for the amendment become apparent"). Petitioner's pleading is also directly tied to a statutory ground for its desired restriction of Respondent's registration, as required by the Board. *See, e.g., Microsoft Corp. v. Qantel Business Sys. Inc.*, 16 U.S.P.Q.2d 1732,1734 (T.T.A.B. 1990) (requiring a petitioner to tie its request to restrict goods listed in a respondent's registration to a ground for cancellation such as non-use or abandonment). Specifically, Petitioner asserts that Respondent has abandoned sales of goods bearing its mark in the United States; Respondent only sells goods bearing its mark for export in Canada. By geographically restricting Respondent's registration, the Board will ensure there is

no likelihood of confusion between Respondent's Mark and Petitioner's Mark, which Petitioner is attempting to register.¹

Second, Respondent will not be prejudiced because the proceeding is still in the pre-trial stage and discovery has not yet ended. *Marmark Ltd. v. Nutrexpa S.A.*, 12 U.S.P.Q.2d 1843, 1844 (T.T.A.B. 1990) (finding that an applicant would not be prejudiced by the opposer's new cause of action which was based on information not possessed at the time of filing its notice of opposition). Without question, Petitioner has moved this Board in a timely manner so as to avoid delaying the proceedings. Wright, Miller *et al.*, Federal Practice & Procedure: Civil 2d § 1488 (1990) (stating that an amendment to the pleadings is not allowed where a moving party attempts to delay the proceedings or to prejudice the other party). Petitioner filed this Motion the same week Petitioner discovered that Respondent has no documentary proof of valid commercial use of its mark in the United States, in connection with the goods listed in its registration. Petitioner's proposed amended pleading takes into account this new, relevant information, which bears directly on the issue of likelihood of confusion between Respondent's Mark and on the mark for which Petitioner seeks application for registration outside this proceeding.

Finally, the interests of justice and judicial economy support granting Petitioner's motion to amend its petition to cancel Respondent's registration. *Space Base, Inc.*, 17 U.S.P.Q.2d at 1217 n.1 (granting an opposer's motion to amend its notice of opposition "on the ground that the interests of justice and judicial economy would best be served by permitting all claims, including counterclaims, between the parties to be adjudicated in one proceeding"). The interests of justice

¹ To eliminate any possibility of confusion, Petitioner has filed an amendment to the identification of goods in its U.S. Application Ser. No. 75/512,027 to register its TUXEDOS mark, to state that the mark will be used in connection with "cookies, namely, cookies sold in the trademark owner's retail grocery stores in International Class 30." Petitioner's Request for Amendment to Its Application for Registration, annexed hereto as Exhibit 2.

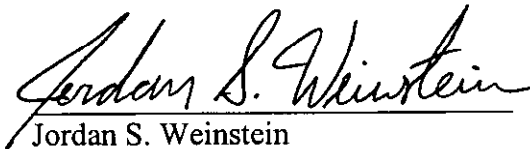
are satisfied because only this week did Petitioner learn facts which support its assertion that the goods sold under Respondent's mark are not the subject of valid sales within the U.S. Were Petitioner not permitted to amend its pleading based on this new information, Petitioner could be prohibited from asserting such claim during trial. TBMP § 314 (stating that "[a] plaintiff may not rely on an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended)"). In addition, the Board's time will be spent more efficiently and effectively by adjudicating all the issues in dispute at one time, and by focusing on the extent of Respondent's actual geographic use of its Mark, which Petitioner asserts does not legitimately occur within the United States.

III. CONCLUSION

The Board should grant Petitioner's motion to amend its Petition for Cancellation. Petitioner's motion does not violate the law, Respondent will not be prejudiced, and the Board's interest in economy and justice will be well-served in granting such motion.

Respectfully submitted,

SAFEWAY INC.

By: 

Jordan S. Weinstein
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax (703) 413-2220

Date: February 4, 2004

JSW/JAC/dlb (I:\ATTY\JSW\SAFEWAY\TTAB-CIVIL MATTER\10885-235048US-MOT3.DOC)

EXHIBIT 1

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

SAFEWAY INC.,)
)
Petitioner,)
)
v.)
)
PROMOTION IN MOTION, INC.,)
)
Respondent.)
)

Cancellation No.: 92/041,801
Registration No.: 2,162,698
Mark: TUXEDOS BLACK TIE

AMENDED PETITION FOR CANCELLATION

Petitioner, Safeway Inc., a corporation under the laws of the State of Delaware, with its principal executive offices at 5918 Stoneridge Mall Road, Pleasanton, California 94588-3229, believes that it is or will be damaged by the continued registration of the mark identified above and hereby petitions to cancel the registration.

As grounds for this petition, Safeway Inc. alleges:

1. Respondent, Promotion in Motion, Inc., is the record owner of Registration No. 2,162,698 for the trademark TUXEDOS BLACK TIE in connection with "candy in International Class 30".
2. Upon information and belief, Respondent has never used, or has abandoned use of, the trademark of Registration No. 2,162,698 in connection with goods sold within the United States, with no intent to resume said use prior to institution of this proceeding.
3. Petitioner will be damaged by the continued registration of U.S. Registration No. 2,162,698, in that the Trademark Office has refused registration of Petitioner's U.S. Application Serial No. 75/512,027 ("Petitioner's Application") for the trademark TUXEDOS in connection

with “cookies, namely, cookies sold in retail grocery stores in International Class 30.” The stated ground for the Examining Attorney’s refusal is a likelihood of confusion with Respondent’s registered trademark within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). A copy of the Examining Attorney’s Office Action of February 12, 2001 is attached hereto as Exhibit A.

4. To eliminate completely any likelihood of confusion between Petitioner’s Application and Respondent’s Registration No. 2,161,698, Petitioner has filed an amendment in Petitioner’s Application, further limiting the channels of trade to “Cookies, namely, cookies sold in the trademark owner’s retail grocery stores.” A copy of the amendment Petitioner filed in connection with Petitioner’s Application is annexed hereto as Exhibit B.

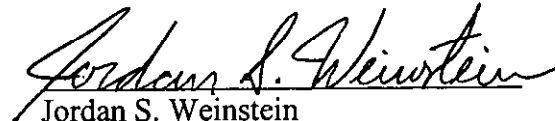
5. Restricting the channels of trade in Respondent’s Registration No. 2,162,698 as aforesaid would avoid a likelihood of confusion with Petitioner’s Application.

WHEREFORE, Petitioner prays that this Petition for Cancellation be granted and that the identification of goods in Respondent’s Registration No. 2,162,698 be restricted to read “candy sold only for export”, to avoid the conflict with Petitioner’s mark as asserted by the Trademark Office in Petitioner’s Application Serial No. 75/512,027.

The filing fee for this Petition to Cancel in the amount of \$300 is enclosed herewith. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

SAFEWAY INC.

By: 
Jordan S. Weinstein
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax (703) 413-2220

Date: February 4, 2004

JSW/dlb [I:\ATTY\JSW\SAFEWAY\TTAB-CIVIL MATTER\10885-235048US-PET-AMEND2.DOC]

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

SAFEWAY INC.,)
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Cancellation No.: 92/041,801
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Mark: TUXEDOS BLACK TIE

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As grounds for this petition, Safeway Inc. alleges:

1. Respondent, Promotion in Motion, Inc., is the record owner of Registration No. 2,162,698 for the trademark TUXEDOS BLACK TIE in connection with "candy in International Class 30".

2. Upon information and belief, Respondent has never used, or has abandoned use of, the trademark of Registration No. 2,162,698 in connection with goods sold within the United States, with no intent to resume said use prior to institution of this proceeding.

3. Petitioner will be damaged by the continued registration of U.S. Registration No. 2,162,698, in that the Trademark Office has refused registration of Petitioner's U.S. Application Serial No. 75/512,027 ("Petitioner's Application") for the trademark TUXEDOS in connection

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4.

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with "cookies, namely, cookies sold in retail grocery stores in International Class 30." The stated ground for the Examining Attorney's refusal is a likelihood of confusion with Respondent's registered trademark within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). A copy of the Examining Attorney's Office Action of February 12, 2001 is attached hereto as Exhibit A.

4. To eliminate completely any likelihood of confusion between Petitioner's Application and Respondent's Registration No. 2,161,698, Petitioner has filed an amendment in Petitioner's Application, further limiting the channels of trade to "Cookies, namely, cookies sold in the trademark owner's retail grocery stores." A copy of the amendment Petitioner filed in connection with Petitioner's Application is annexed hereto as Exhibit B.

5. Restricting the channels of trade in Respondent's Registration No. 2,162,698 as aforesaid would avoid a likelihood of confusion with Petitioner's Application.

WHEREFORE, Petitioner prays that this Petition for Cancellation be granted and that the identification of goods in Respondent's Registration No. 2,162,698 be restricted to read "candy sold only for export", to avoid the conflict with Petitioner's mark as asserted by the Trademark Office in Petitioner's Application Serial No. 75/512,027.

Deleted: WHEREFORE, Petitioner prays that this Petition for Cancellation be granted and that Registration No. 2,162,698 be cancelled, or alternatively that the identification of goods in Respondent's registration be amended to describe accurately the channels of trade in which Respondent sells its goods and

The filing fee for this Petition to Cancel in the amount of \$300 is enclosed herewith. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

SAFEWAY INC.

By:

Jordan S. Weinstein
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Alexandria, Virginia 22314
(703) 413-3000
fax (703) 413-2220

Deleted: Amy C. Sullivan

Date: February 4, 2004

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EXHIBIT 2

Attorney Docket No.: 214859US-56

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re the Application of:

SAFEWAY INC.

Application Serial No.: 75/512,027

Filed: July 7, 1998

Mark: TUXEDOS

International Class: 30

Examining Attorney

Linda M. King

Law Office 116

AMENDMENT

NO FEE

Honorable Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3514

Dear Commissioner:

AMENDMENT

Please delete the identification of goods in its entirety and substitute therefor the following:

--Cookies, namely, cookies sold in the trademark owner's U.S. retail grocery stores in International Class 30--.

REMARKS

Applicant has amended its application to further narrow the channels of trade to Applicant's retail grocery stores. Currently, this Application is suspended pending the outcome of Cancellation No. 92/041,801, in which Applicant seeks to have the channels of trade restricted for the goods in Registration No. 2,162,698 (cited against the present mark) to candy, sold only for export. Should the Board enter this restriction, Applicant respectfully submits that there will be no likelihood of confusion with the present mark because, Applicant asserts, the goods travel in completely different channels of trade. The amendments to the present application and to the

cited registration, if granted, will memorialize the lack of overlap in the parties' respective channels of trade.

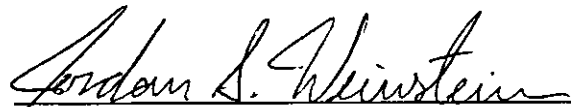
Wherefore, Applicant respectfully requests that the Examining Attorney enter the amendment set forth hereinabove, which narrows the channels of trade for the goods in the present application, and re-suspend proceedings in this application pending the outcome of Cancellation No. 92/041,801.

Should the Examining Attorney have any further questions, she is invited to contact the undersigned at (703) 412-6442 or jweinstein@oblon.com.

Respectfully submitted,

SAFEWAY INC.

By:



Jordan S. Weinstein
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
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(703) 413-3000
fax (703) 413-2220
e-mail: tmockett@oblon.com

Date: February 4, 2004

JSW/JAC/dlb {I:\ATTY\JSW\SAFEWAY\TTAB-CIVIL MATTER\10885-214859US-APP-AMEND.DOC}

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **MOTION TO AMEND PETITION FOR CANCELLATION; AMENDED PETITION FOR CANCELLATION and AMENDMENT** was served on counsel for Respondent, this 4th day of February 2004, by delivering same via E-Mail and First Class Mail, postage prepaid, to:

Mary L. Kevlin, Esquire
Susan Schick, Esquire
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036


Debra L. Bondurant