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

Proceeding	92050616
Party	Plaintiff Riowell, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No.: 3,228,958  
For the Mark: LEAN FOR LIFE  
Date Registered: April 17, 2007

Riowell, LLC	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92050616
v.	)	
	)	
Lindora, Inc.	)	
	)	
Registrant.	)	
	)	

**REPLY IN SUPPORT OF PETITIONER’S MOTION  
FOR LEAVE TO FILE AMENDED PETITION TO CANCEL**

Justice is served by allowing Petitioner’s Motion, which seeks only to prevent Registrant from claiming exclusive rights in an admittedly descriptive mark. Despite pervasive “mud-slinging,” Defendant’s Response boils down to three simple and unavailing arguments: (1) Petitioner was compelled to bring its claim without any discovery and based on incomplete facts; (2) Registrant is prejudiced not by Petitioner’s “delay”, but rather because an additional claim will “drive up litigation costs;” and (3) Petitioner’s claim is “legally insufficient.” The foregoing arguments are factually and legally flawed.

**I. Amendments are Freely Given, and Justice is Served by Allowing the Proposed Amendment**

Trademark Rule 2.115 and Fed. R. Civ. P. 15 instruct that leave to amend pleadings shall be freely given when justice so requires. Justice is served by allowing the

proposed amendment in this case. *See, See's Candy Shops, Inc. v. Campbell Soup Company*, 12 U.S.P.Q.2D 1395 (TTAB 1989). Petitioner's Motion serves to protect the interests of consumers, competitors and the integrity of the Principal Register by disallowing the assertion of exclusive rights in a mark that Registrant admits is descriptive. For that reason alone, Petitioner's Motion should be granted.

## **II. Petitioner's Delay (If Any) Has Not Prejudiced Registrant**

Registrant makes the bald-faced assertion that it will be prejudiced "by Petitioner's delay." *Registrant's Response* at [un-numbered] p. 6. However, the only thing Registrant asserts as "prejudice" is the fact that it may have to issue additional discovery requests and increase "litigation costs." *Id.* at [un-numbered] p. 7. Leaving aside the fact that evidence bearing on the descriptiveness of Registrant's *own* mark as applied to its *own* goods in its *own* industry is in Registrant's *own* possession, Registrant misconstrues the type of "prejudice" that would prevent an untimely amendment. Registrant's claimed "prejudice" is not caused by the passage of time, or by any alleged delay. Rather, Registrant mistakenly labels as "prejudice" the time and expense brought about by having to defend against Petitioner's claim. Put another way, if Petitioner had brought its claim of Descriptiveness as part of its original pleading, Registrant would have incurred the exact same time and expense in defending it that Registrant now claims is prejudicial. Registrant points to nothing indicating that the mere passage of time has made Petitioner's claim more costly, more time-consuming or more difficult to defend.

Petitioner has the burden of proving its claim. Petitioner sought amendment prior to the close of discovery in this proceeding. Indeed, discovery is *still* open in this matter,

and does not close until July 6, 2010 (over a month from the date of this filing).<sup>1</sup> Finally, as stated in foot-note 1, *supra*, Petitioner consents to a further extension of discovery so that Registrant may conduct whatever remaining investigation it deems necessary as a result of the proposed amendment. In light of this stipulated extension of discovery, Registrant can hardly argue that it has been prejudiced.

Conversely, there is a compelling argument to allow the proposed amendment in order to prevent prejudice to *Petitioner*. If Registrant's position is that Petitioner is estopped from challenging Registrant's registration on the basis of descriptiveness if such challenge is not brought in the instant proceeding (*i.e.* the claim was compulsory), then clearly Petitioner is prejudiced by a denial of its timely motion to amend. If, however, Registrant contends that Petitioner is *not* estopped from bringing its claim if leave to amend is denied, then Petitioner will be forced to file a separate proceeding attacking Registrant's registration. While this added expense of filing a separate proceeding is not "prejudicial" *per se*, certainly the more sensible and cost-effective approach (to the parties and the Board) is to allow the amendment and a resolution of the claims on their merits.

### **III. Petitioner's Delay Was Neither "Inexcusable" Nor "Undue"**

Despite Registrant's assertions to the contrary, Petitioner did not have full knowledge of all the facts necessary to bring its claim at the time it filed the original Petition to Cancel. Petitioner lacked knowledge of the manner and extent to which

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<sup>1</sup> In truth, there may be need for an additional extension of discovery in this matter in order to resolve issues concerning the completeness of Registrant's production of documents in this matter. Petitioner has notified Registrant of several deficiencies in Registrant's production which may in fact give rise to additional claims against Registrant's registration (including fraud, lack of use in interstate commerce and falsified dates of first use).

Registrant actually uses (or used) its mark in commerce (if at all). Petitioner lacked actual and complete knowledge of Registrant's trade channels and consumers, as well as the connotation intended by Registrant in its mark. Petitioner lacked any knowledge of the extent to which Registrant may or may not have obtained secondary meaning in its LEAN FOR LIFE mark. Petitioner also lacked knowledge of the general marketplace for Registrant's goods, and the manner and extent to which third parties use the LEAN FOR LIFE mark (or portions thereof) to describe their own goods and services.

In hind-sight, it is apparent now that Registrant used evasive and incomplete responses to Petitioner's document requests to hide the true manner and scope in which it uses its LEAN FOR LIFE mark. Only through discovery and independent investigation was Petitioner able to confirm its suspicions about the nature of Registrant's products and services, and the manner in which Registrant uses its mark, in order to bring a claim that is sufficient to withstand Fed. R. Civ. P. 11. In response to an interrogatory, Registrant has all but admitted that its mark is descriptive. Discovery has also revealed information concerning the channels through which Registrant offers its goods, as well as the type of consumers to whom those goods are sold and how they might perceive the LEAN FOR LIFE mark. Finally, since receiving Registrant's discovery responses,<sup>2</sup> Petitioner, through counsel, has had the opportunity to investigate the relevant marketplace, and identify the manner in which Registrant's mark (and the components thereof) is used by third parties.

As Registrant points out, Petitioner had suspicions of the descriptiveness of Registrant's mark at the time discovery commenced. However, Petitioner is unaware of

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<sup>2</sup> Responses that are still incomplete.

any authority (and Registrant has not identified any) which requires a petitioner to plead each and every claim upon which it has a suspicion or a hunch. To do so would flood the courts and this Board with half-cocked theories and parties on fishing expeditions for viable claims or defenses. Instead, Petitioner chose to wait until it was certain that it had a defensible claim of descriptiveness, and that Registrant had not acquired secondary meaning in its LEAN FOR LIFE mark. Once that determination was made, and prior to the close of discovery, it moved for leave to amend.

#### **IV. Petitioner's Claim is Not Legally Insufficient**

As addressed, *supra*, Petitioner acknowledges it has the burden of proving its claim of descriptiveness. Registrant cites to *McCarthy on Trademarks and Unfair Competition* § 20:50.50 (4<sup>th</sup> ed. 2009) (and cases cited therein) for the proposition that, to properly plead descriptiveness, a petitioner must plead and prove that a registration is inconsistent with the petitioner's equal right to use the term on similar goods as a description. However, Registrant's Response fails to reveal that the same section of *McCarthy* goes on to state that "it is not necessary that petitioner actually use the term in order to challenge on the basis of descriptiveness . . . . All that is necessary is that petitioner be in a position to have a right to use that term." *Id.* As stated in *De Walt, Inc. v. Maga Power Tool Corp.*, 289 F.2d 656 (also cited by *McCarthy*), "injury to a petitioner for cancellation will be presumed or inferred when the mark sought to be registered is descriptive of the goods, and the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business."

Registrant attempts to elevate form over function. The missing allegation pointed out by Registrant is required (if at all) to show standing (*i.e.* that a petitioner will

be damaged by maintenance of a registration for a descriptive term). Petitioner in this case has sufficiently pleaded standing to oppose Registrant's mark on the basis of descriptiveness. Petitioner in this matter has expressly alleged that it has been (and will be) damaged by the continued existence of Registrant's registration for the descriptive term LEAN FOR LIFE. *See, First Amended Petition for Cancellation* at ¶ 19 [Doc. No. 15]. Moreover, injury to Petitioner is presumed under *De Walt* because Petitioner is in the business of selling dietary supplements, as indicated in ¶ 11 of its proposed *First Amended Petition for Cancellation*. Petitioner's goods are targeted toward consumers seeking to lose weight and stay lean. Thus, Petitioner has a sufficient interest in using the term "LEAN FOR LIFE" in its own business (*i.e.* helping weight-conscious consumers stay "Lean for Life"). Standing is not an issue.

However, if the Board determines that an express statement that Registrant's "registration is inconsistent with the petitioner's equal right to use the term on similar goods as a description" (as submitted by Registrant), Petitioner respectfully requests that its Motion be granted, and that Petitioner be allowed five (5) days to further amend its claim to include the specific language deemed necessary to cure the alleged defect.

## **V. Conclusion**

In conclusion, Petitioner continues to act in good faith in attempting to resolve the issues between the parties in this proceeding. It is Petitioner's position (a position now supported by reliable evidence) that Registrant's LEAN FOR LIFE mark is descriptive and has not obtained secondary meaning. It benefits consumers, the Board and the marketplace at large for the Trademark Register to accurately reflect the nature of such descriptive marks. Registrations for descriptive marks such as the one in this proceeding

create virtual “dead wood” that clogs the Register and stifles otherwise fair competition. Rather than raise every conceivable claim possible “upon information and belief,” Petitioner chose instead to obtain reliable evidence to support its claim. There is no prejudice caused by Petitioner’s delay, as discovery is still open, and may indeed need to be extended yet again as Registrant apparently has yet to provide a complete production of responsive documents. Finally, as discussed herein, Petitioner’s claim is not insufficiently plead.<sup>3</sup>

WHEREFORE, Petitioner respectfully requests that the Board grant its motion for leave to file an Amended Petition for Cancellation.

Dated: June 1, 2010

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<sup>3</sup> But if the Board determines that it *is*, Petitioner seeks leave to correct what is only a technical deficiency in Petitioner’s failure to specifically plead that Registrant’s “registration is inconsistent with the petitioner’s equal right to use the term on similar goods as a description” (as submitted by Registrant).



**PROOF OF SERVICE**

I am over the age of 18 and not a party to the within action; my business address is Amin Talati, LLC, 444 North Orleans Street, Suite 400, Chicago, IL 60654. On **June 1, 2010**, a copy of the attached **REPLY** was served on all interested parties in this action via email, at the addresses as follows:

To: [ahunter@adorno.com](mailto:ahunter@adorno.com)

Executed on **June 1, 2010**, at Chicago, Illinois. I declare under penalty of perjury that the above is true and correct. I declare that I am employed in the office of Amin Talati, LLC at whose direction service was made.

/s/ Ryan M. Kaiser  
Ryan M. Kaiser

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office using the ESTTA system on **June 1, 2010**.

/s/ Ryan M. Kaiser  
Ryan M. Kaiser