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

Proceeding	92067247
Party	Plaintiff Chef One Corporation
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Attachments	Reply Brief in Support of Motion to Amend Petition for Cancellation for CHEF ONE.pdf(11978 bytes)

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

In the Matter of Registration No. 4,787,760
For the mark: CHEFONE & Design
Registered: August 11, 2015

<p>CHEF ONE CORPORATION,</p> <p style="text-align:center">PETITIONER,</p> <p style="text-align:center">V.</p> <p>DAESANG CORPORATION,</p> <p style="text-align:center">RESPONDENT.</p>
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Cancellation No. 92-067,247

**PETITIONER’S REPLY BRIEF IN SUPPORT OF MOTION
TO AMEND PETITION FOR CANCELLATION**

Petitioner, Chef One Corporation, through its undersigned counsel, hereby submits its reply to Respondent’s Opposition to Petitioner’s Motion to Amend Petition for Cancellation (the “Opposition Brief”) pursuant to Section 503.02 of the Trademark Trial and Appeal Board’s Manual of Procedure.

As Petitioner asserted in its Motion to Amend, it is appropriate for the Board to grant Petitioner leave to amend its Petition for Cancellation at this early stage in the proceeding. Moreover, as is noted in one of the cases cited in Respondent’s Opposition Brief, trademark regulations as well as the Federal Rules of Civil Procedure “encourage the Board to look favorably on motions to amend pleadings.” *See Embarcadero Tech., Inc. v. Delphix Corp.*, 117 U.S.P.Q.2d 1518 (T.T.A.B. 2016). In the case of the instant proceeding, Petitioner’s amended Petition was filed as soon as Petitioner’s newly-retained counsel discovered a mistake in Petitioner’s original Petition for Cancellation filing. In fact, the amendment was filed prior to

even the *opening* of the discovery period in the instant proceeding. Respondent has not cited, nor could it cite, any case in which the Board has not granted a Motion to Amend prior to the commencement of discovery in a Board proceeding, because such a denial by the Board is unprecedented. Petitioner also notes that it is unfair for the Respondent to allege Petitioner's undue delay after it willingly consented to Petitioner's requests for extension of time to file its Answer.

Contrary to Respondent's assertion in its Opposition Brief, Petitioner has not in its amended Petition to add any new claims requiring an "entirely new course of defense" by the Respondent. The *cancelled* registration added to the Petition was added merely by way of providing additional relevant background information in the Petition. Petitioner's assertion that the addition of a reference to this registration to the Petition "is relevant to the DuPont factor of fame of the mark" does not even make sense. It is also noteworthy that all of the cases cited by Respondent in which the Board denied a Motion to Amend involved attempts to amend pleadings to add entirely new claims. *See, e.g., Trek Bicycle Corp. v. Styletrek Ltd.*, 64 U.S.P.Q.2d 1540 (T.T.A.B. 2001) (addressing proposed addition of dilution claim); *S&L Acquisition Co. v. Helene Arpels Inc.*, 9 U.S.P.Q.2d 1221 (T.T.A.B. 1988) (addressing proposed addition of counterclaim to answer); *Kellogg Co. and Kellogg North America v. Shakespeare Co.*, 2005 WL 1581551 (T.T.A.B. 2005) (addressing proposed addition of descriptiveness and other claims what is identified as non-citable precedent). Petitioner is not in the instant proceeding attempting to add a new claim to its Petition for Cancellation pleading.

In sum, Respondent has not in its Opposition Brief cited to any authority addressing facts remotely similar to those present in the instant case. By way of additional examples, the *Forman* case actually involved the Supreme Court's granting of plaintiff's motion to amend its complaint

after over two years of litigation and various appeals because the District Court did not justify its denial of granting the leave to amend, which was “inconsistent with the spirit of the Federal Rules.” *Forman v. Davis*, 371 U.S. 178, 182 (1962). The Board in *International Finance Corp.* did deny the Motion to Amend, but at a point that was almost four years after the cancellation proceeding was initiated and after discovery in the proceeding had closed. *International Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597 (T.T.A.B. 2002). Finally, the *Whitaker* case cited to assert that Petitioner must establish that its delay was due to “an oversight, inadvertence, or excusable neglect” involved a plaintiff’s attempt to amend its original pleading after the court had *considered and ruled on a Motion to Dismiss and had actually dismissed the complaint*. *Whitaker v. City of Houston, Tex.*, 963 F.2d 831, 836 (5th Cir. 1992).

Based on the foregoing, and for the reasons set forth in Petitioner’s Motion to Amend, Petitioner respectfully requests that the Board grant Petitioner’s Motion to Amend and accept the First Amended Petition for Cancellation that Petitioner submitted on May 18, 2018.

Dated: June 27, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Reply Brief in Support of Motion to Amend Petition for Cancellation has been served on Sung Joo, Esq. by forwarding said copy on June 27, 2018, via email and U.S. first class mail to:

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