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Filing date: **10/30/2020**

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

Proceeding	92074533
Party	Defendant ES Distribution LLC
Correspondence Address	DUANE H DREGER CESARI AND MCKENNA LLP ONE LIBERTY SQUARE, SUITE 310 BOSTON, MA 02109 UNITED STATES Primary Email: docket@c-m.com Secondary Email(s): dhd@c-m.com, mrr@c-m.com 617-951-2500
Submission	Motion to Amend Registration (Requires a Fee and a Declaration)
Filer's Name	Duane H. Dreger
Filer's email	dhd@c-m.com, docket@c-m.com, mrr@c-m.com, liz@c-m.com
Declaration and Signature of Registrant or Attorney for Registrant	The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that the facts set forth above are true, all statements made of his or her own knowledge are true, and all statements made on information and belief are believed to be true.  /Duane H. Dreger/
Date	10/30/2020
Attachments	MotionToAmendRegistration.pdf(47380 bytes )

Registration Subject to the filing

Registration No.	5698712	Registration date	03/12/2019
Registrant	ES Distribution LLC 365 BOSTON POST RD. SUDBURY, MA 01776 UNITED STATES		

Goods/Services Subject to the filing

Class 018. First Use: 2015/01/19 First Use In Commerce: 2015/01/19 Requested goods and services in the class: Dog leashes
Class 028. First Use: 2017/02/17 First Use In Commerce: 2017/02/17 All goods and services in the class are requested, namely: Exercise balls; Exercise equipment, namely, exercise resistance bands and foam exercise rollers; Jump ropes; Exercise equipment in the nature of straps that are affixed to exercise equipment for performance of weight resistance exercises; Weight lifting gloves

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

In the Matter of U.S. Reg. No. 5,698,712

Registered: March 19, 2019

BEAST GEAR LIMITED	)	
	)	
Petitioner	)	Cancellation No. 92074533
	)	Registration No. 5,698,712
v.	)	
	)	
ES DISTRIBUTION, LLC	)	
	)	
Registrant/Respondent	)	
	)	

**MOTION TO AMEND REGISTRATION**

Pursuant to 37 C.F.R. §2.133, Registrant, ES Distribution, LLC, hereby moves to amend the identification of goods in Reg. No. 5,698,712.

***1. Proposed Amendment***

Registrant proposes to amend the identification of goods in Reg. No. 5,698,712 as follows:

*Class 18:* Backpacks; ~~Dog leashes~~; Duffel bags; Fanny packs; Handbags; Wallets; All-purpose carrying bags.

*Class 21:* Sports bottle belts for running; Plastic water bottle holders and attached carabiner clip sold as a unit.

*Class 22:* Lanyards for holding smartphones.

*Class 28:* ~~Exercise balls; Exercise equipment, namely, exercise resistance bands and foam exercise rollers; Jump ropes; Exercise equipment in the nature of straps that are affixed to exercise equipment for performance of weight resistance exercises; Weight lifting gloves.~~

If the Board allows the amendment, the resulting identification of goods for Reg. No. 5,698,712 will be:

*Class 18:* Backpacks; Duffel bags; Fanny packs; Handbags; Wallets; All-purpose carrying bags.

*Class 21:* Sports bottle belts for running; Plastic water bottle holders and attached carabiner clip sold as a unit.

*Class 22:* Lanyards for holding smartphones.

*Class 28:* Jump ropes.

***2. The Proposed Amendment is Appropriate***

37 C.F.R. §2.133(a) states that

An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, 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.

In *Johnson & Johnson v. Stryker Corp.*, 109 U.S.P.Q.2d 1077, 1078-1079 (TTAB 2013), the Board set out the following standard for allowing a contested motion to amend in an Opposition proceeding:

In determining whether to accept a proposed amendment to an identification that, while contested, is otherwise acceptable, the Board looks to see whether the following circumstances are present:

1) the proposed amendment must serve to limit the broader identification of goods or services;

2) applicant must consent to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;

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; and

4) where required to support the basis of the subject application, any specimens of record must support the goods or services as amended; and applicant must then introduce evidence during its testimony period to prove use of its mark with the remaining goods or services prior to the relevant date as determined by the application's filing basis.

Registrant submits that the same factors should be considered in this Cancellation proceeding.

Regarding item 1) from the *Johnson & Johnson* decision, the proposed amendment clearly limits the broader identification of goods in the registration. For example, the proposed amendment strikes existing goods in the registration and does not add any goods. Item 1) is thus satisfied.

Regarding item 2), if the Board grants the present interlocutory motion, Registrant hereby consents to entry of judgment on the grounds for cancellation with respect to the broader identification of goods in Reg. No. 5,698,712. Item 2) is thus satisfied.

Regarding item 3), the proposed amendment changes the nature and character of the goods so as to introduce substantially different issues for trial. In its Petition to Cancel, Petitioner only alleges that Registrant abandoned the following goods:

*Class 18:* Dog leashes.

*Class 28:* Exercise balls; Exercise equipment, namely, exercise resistance bands and foam exercise rollers; Jump ropes; Exercise equipment in the nature of straps that are affixed to exercise equipment for performance of weight resistance exercises; Weight lifting gloves.

The requested deletion will substantially alter – and greatly simplify – the arguments and presentation of evidence by the parties. It will also simplify the evaluation of issues by the Board. If the proposed amendment is granted, the need for trial on the goods in class 18 will be eliminated entirely, and the trial on the goods in

class 28 will be reduced from six items to a single item – jump ropes. That is, the proposed amendment will reduce the items in the description of goods that are being contested from seven to one – jump ropes. Item 3) is thus satisfied.

Regarding item 4), the specimens of record support the goods as amended. Specifically, the specimens submitted Jan. 10, 2019 with the Statement of Use are for items remaining in the description of goods following the present amendment, i.e., fanny packs in class 18, sports bottle belts for running in class 21, lanyards for holding smartphones in class 22, and jump ropes in class 28. Item 4) is thus satisfied.

***3. The Proposed Amendment Should be Granted Immediately***

Although the Board usually defers the determination of motions to amend the identification of goods until final hearing or a motion for summary judgment, it is not required to do so. *See e.g., Johnson & Johnson*, 109 U.S.P.Q.2d 1077 (granting motion to amend); *Wisconsin Cheese Group, LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, Oppos. No. 91224131 (TTAB Mar. 30, 2016) (granting motion to amend). As noted above, all four items identified in the *Johnson & Johnson* decision are satisfied here. In addition, if the proposed amendment is granted immediately, the scope of discovery, the presentation of evidence on Petitioner's claim of abandonment, and the issues to be resolved by the Board will be dramatically narrowed and simplified. The need for discovery and the presentation of evidence and arguments regarding class 18 will be eliminated entirely. The need for discovery and the presentation of evidence and arguments regarding class 28 will be reduced from six items to just a single item – jump ropes. There is simply no reason to require the parties to expend significant resources developing and presenting evidence and arguments regarding the seven items of goods

challenged in the Petition for Cancellation, when Registrant agrees, by virtue of the present motion, to entry of judgment on six of those items.

***4. Request for Suspension Pending Disposition of the Present Motion***

Registrant also hereby requests that the proceedings be suspended pending the disposition of the present motion under 37 C.F.R. §2.117(c). Although discovery has opened, neither party has propounded any discovery in this proceeding. As noted, the present motion would eliminate the need for discovery on the majority of issues raised in the Petition for Cancellation. The parties should not be required to expend resources propounding and responding to discovery requests on issues that may be resolved by the present motion.

***5. Conclusion***

Registrant respectfully requests that the Board grant the present motion for the reasons stated herein. Specifically, Registrant requests that the Board

(a) immediately amend Reg. No. 5,698,712 by deleting “Dog Leashes” in class 18 and “Exercise balls; Exercise equipment, namely, exercise resistance bands and foam exercise rollers; Exercise equipment in the nature of straps that are affixed to exercise equipment for performance of weight resistance exercises; Weight lifting gloves” in class 28; and

(b) suspend proceedings pending the disposition of this motion.

Registrant submits that granting the present motion immediately will serve the administration of justice in this proceeding.

Please charge any fee due from this motion to our Deposit Account No. 03-1237.

Dated: October 30, 2020

Respectfully submitted,

ES DISTRIBUTION, LLC  
By Its Attorneys,

/Duane H. Dreger/

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**Certificate of Service**

I hereby certify that a true and complete copy of the foregoing Motion to Amend Registration has been served on Amanda Osorio, attorney for Beast Gear Limited by forwarding said copy on October 30, 2020, via email to: amanda@revisionlegal.com and trademarks@revisionlegal.com.

Signature: /Duane H. Dreger/

Date: October 30, 2020