

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 7/12/00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Minuteman International, Inc.
v.
Royal Appliance Mfg. Co.

Opposition No. 99,534
to Application No. 74/602,203
filed on November 23, 1994

James J. Hill of Emrich & Dithmar for opposer.

Sandra M. Koenig and Patrick R. Roche of Fay, Sharpe,
Beall, Fagan, Minnich & McKee for applicant.

Before Walters, Wendel and Bottorf, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

On March 3, 2000, the Board sustained the opposition
in this case on the ground of priority and likelihood of
confusion under Section 2(d) of the Trademark Act. On
April 3, 2000, applicant filed a motion to amend its
identification of goods and a request for reconsideration
of the Board's decision. Opposer filed its response to the
request for reconsideration and its opposition to the

motion to amend the identification of goods.¹ Applicant filed a reply brief, which we have considered.

Motion to Amend Identification of Services

The identification of services in the opposed application is "electrical vacuum cleaners for both domestic and industrial use." More than a month after the close of opposer's trial period, applicant filed a motion to amend its identification of goods to "electrical vacuum cleaners for domestic use." In its final decision, the Board denied the motion on the ground that such an amendment would reframe the issues at a late date in the proceeding and, therefore, such action would be prejudicial to opposer.

Now, subsequent to the Board's final decision in this case, applicant has filed yet another motion to amend its identification of goods to "electrical vacuum cleaners for domestic use sold through ordinary consumer retail channels, including mass retailers, retail department stores and retail discount stores."² Applicant argues that

¹ Opposer filed a motion for an extension of time to file this response and opposition to the motion, stating that applicant did not oppose this request. We find that opposer has established good cause and therefore its motion is granted and its subsequent filing is timely.

² Applicant also asserted this amendment couched as a request for reconsideration of the Board's denial of applicant's first motion to amend its identification of goods. For the reasons stated therein, the Board stands by its decision denying applicant's first motion to amend its identification of goods.

this proposed amendment limits applicant's trade channels and is not prejudicial to opposer.

Opposer disagrees and contends that, not only is the amendment untimely, but the proposed amendment introduces a new issue, namely, what is "a specific definition of retail channels [of trade]."

We agree with opposer. As applicant's first proposed amendment to the identification of goods was untimely, so is this proposed amendment. In seeking to limit the trade channels as proposed, applicant would be seeking, again, to reframe the issues, this time after the issuance of the Board's final decision in this case.³ Not only is this amendment untimely, but it would be prejudicial to opposer. Thus, we deny applicant's motion to amend its identification of goods.

Request for Reconsideration

Applicant requests reconsideration of the Board's decision, contending that the Board erred in determining the issue of priority. Applicant argues that opposer should not be entitled to rely on its registration to establish priority. Rather, applicant notes that applicant filed its intent-to-use application prior to the filing

³ For example, an initial question that the proposed amendment raises is the extent to which janitorial supply houses are retail as well as wholesale trade channels.

date of opposer's application that matured into the relied-upon registration. Applicant states that the case of *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974), cited by the Board is inapposite in this case involving applicant's prior-filed intent-to-use application; and that applicant has priority based on its filing date. Applicant cites no authority for its position. Applicant also makes a number of arguments that appear to indicate its position that opposer does not have priority because it did not plead or prove use of its mark prior to the filing date of this application.

Despite applicant's contentions to the contrary, its position is an attack on the validity of opposer's registration and, as such, will not be heard during trial in the absence of a counterclaim to cancel opposer's registration. Despite the fact that applicant filed its application first, opposer's application was published for opposition and matured to registration before this application. Applicant chose neither to oppose nor petition to cancel opposer's registration. As our primary reviewing court stated in *King Candy Company, supra* at 110:

In an opposition, the board must consider existing registrations of subsequent-user opposers, because (1) the statute, 15 U.S.C. 1051-1127, requires such considerations; (2) the basic question in a opposition is an applicant's

right to register (not merely, as the board says [in its opinion below], whether the opposer "will be damaged"); (3) in determining applicant's right to register, the entire statute, including Section 2(d), must be considered; (4) Section 2(d) says an applicant can register, *unless* his mark is likely to cause confusion with a mark "registered in the Patent Office or *** previously used ***"; (5) the board's requirement [in the decision below] that the registrant-opposer also be a prior user impermissively negates the statutory distinction ("or") in Section 2(d) between a registered mark and a previously-used-but-unregistered mark, would permit simultaneous registration of the same mark for the same goods to different parties, and disregards - in effect conflicts with - Patent Office Rule 2.106(b), which forbids any attack (other than a request for cancellation) on the validity of a registration in an opposition; (6) the board's position [in the decision below] is unsupported by either statutory or definitive decisional authority; and (7) an opposer who, in the language of Section 13, "believes he would be damaged," may in fact suffer damage to his *registration*, (Sec. 7(b)), if the applicant's mark is registered.

See also, American Standard Inc. v. AQM Corporation, 208 USPQ 840, 841 (TTAB 1980).

Neither the Trademark Law Revision Act amendments to the statute nor the legislative history establish any reason for concluding that this principle would be different for an application based upon an allegation of a bona fide intention to use the mark in commerce. We find applicant's arguments to the contrary unsupported by either the law or precedent and, therefore, unpersuasive.

Finally, to the extent that our decision was ambiguous, we herein state that the evidence in this case supports the conclusion that opposer's use of its mark is prior in time to applicant's first use of its mark in connection with the parties' respective goods.⁴

Conclusion

For the reasons stated herein, we stand by our decision sustaining the opposition, and applicant's motion to amend its identification of goods is denied.

C. E. Walters

H. R. Wendel

Charles M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board

⁴ The evidence establishes that opposer first displayed its goods with the MPV mark thereon at a trade show on October 20-22, 1994, and orders for the goods were taken by opposer; and, further, that at least five of the orders were shipped prior to applicant's filing date of November 23, 1994.