

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Goodman

Mailed: March 5, 2003

Opposition No. 91123141

PUMA AG RUDOLF DASSLER SPORT

v.

SAMIR MOURAD DBA DON REGALON

Before Cissel, Hairston and Bottorff, Administrative  
Trademark Judges

By the Board:

This case now comes up on opposer's motion for leave to amend the notice of opposition and to extend the discovery period, filed August 9, 2002. The motion is fully briefed.

In support of its motion, opposer argues that the proposed amendment is timely since it was only after searching for responsive documents with respect to applicant's discovery requests that it "learned that opposer had adopted and used on goods in International Class 25 a mark consisting of the letter "D" with a cat silhouette leaping through the letter "D"<sup>1</sup> and a mark "consisting of

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<sup>1</sup> Opposer alleges in paragraph 4 of the amended notice of opposition that "[s]ince long prior to March 4, 2000, the filing date of Serial No. 75/936,519, Opposer adopted and commenced use of a design trademark comprised of the letter "D" with cat silhouette leaping through the letter "D" ("D" Design mark), as shown in Exhibit C attached to this Notice of Opposition, for

the letter "P" with a cat silhouette leaping through the letter "P"<sup>2</sup>; and that since the proceeding is still in the discovery period and opposer is proposing an extension of the discovery period so that applicant may seek discovery on these newly asserted claims, applicant will not be prejudiced by the proposed amendment.

In response, applicant argues that the "two new causes of action are frivolous" because they would not survive a motion for summary judgment and that the proposed amendment should be denied on this basis; that applicant also opposes the motion due to opposer's unreasonable delay of over one and a half years to seek to amend the notice of opposition to allege facts that opposer should have known at the time of filing; and that the proposed amendment is in bad faith in that opposer is making "improper use of governmental process" and "seeks to drive up costs and overwhelm applicant by burying him in the expense of defending this opposition."

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clothing, namely, shirts and footwear in International Class 25. Opposer first used the "D" Design Mark in U.S. commerce at least as early as the Fall of 1993 and has continuously used the "D" Design Mark in U.S. commerce to the present. On May 30, 2002, Opposer filed a US trademark application directed to the "D" Design mark for use on goods in International Class 25."

<sup>2</sup> Opposer alleges in paragraph 5 of the amended notice of opposition that [a] t least as early as June, 2001, opposer adopted and commenced use of a design trademark comprised of the letter "P" with cat silhouette leaping through the letter "P" ("P" Design mark), as shown in Exhibit D attached to this Notice of Opposition, for clothing, namely T-shirts in International Class 25."

In reply, opposer argues that opposer was diligent since it timely filed its motion for leave to amend shortly after it learned of the facts leading to the proposed amendment and that since the motion to amend was filed pre-trial it should be allowed; that the proposed amendment is legally sufficient, provides additional evidentiary details regarding allegations set forth in paragraph 3 of the notice, and is not for the purpose of asserting a new claim or defense or curing a defective pleading; that applicant's arguments going to the merits of opposer's proposed amendment is an inappropriate consideration for purposes of determining a motion to amend; that applicant's statements of bad faith are "untrue, unsubstantiated and reckless"; and that the fact that applicant may be inconvenienced as a result of some delay to the proceedings, that applicant may also need to prepare some additional discovery and that applicant may incur some additional costs, are factors which do not "rise to the level of cognizable prejudice sufficient to defeat a motion to amend."

We will now consider the issue of whether granting opposer's motion to amend the notice of opposition to add paragraphs 4 and 5 at this stage of the proceeding would unfairly prejudice applicant. Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally

grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See e.g. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); and *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993). The timing of the motion to amend is a major factor in determining whether applicant would be prejudiced by allowance of the proposed amendment. See TBMP Section 507.02 and cases cited therein.

After careful review of opposer's amended notice of opposition and consideration of the arguments of the parties, we conclude that opposer's proposed amendment will not be unduly prejudicial to applicant, and therefore should be granted. First, applicant would not be prejudiced because the proceeding is still in the pre-trial phase and discovery will be extended as indicated below. Second, opposer's proposed amendment to the pleading is essentially just an expansion of its allegation in paragraph 3 of the original notice of opposition in that paragraphs 4 and 5 and merely provide additional details of opposer's "use of a leaping cat silhouette, either alone or in combination with other words and/or designs, as a trademark" in connection with clothing (paragraph 3, original notice of opposition

and amended notice of opposition), and as such, the proposed amendment cannot be considered prejudicial. Third, opposer's delay in filing the motion was not unreasonable since opposer has indicated that it only recently became aware of these additional uses of the mark during a search for documents responsive to applicant's discovery requests, and additionally, with respect to paragraph 5 of the amended pleading, this is clearly a supplemental pleading under Fed. R. Civ. P. 15(d) based on events which have occurred since the original claim, since opposer could hardly have pleaded use of the "silhouette of the leaping tiger through the letter P" upon filing the opposition in February 2001 since the referenced mark was not adopted and used until June 2001.

As for applicant's remaining points, we do not find any bad faith motive in opposer's filing of the motion to amend, nor do we find undue prejudice from the fact that allowance of the amendment may result in applicant's additional expenditure of time, effort, or money for additional discovery. See *e.g. United States v. Continental Ill. National Bank & Trust Co. of Chicago*, 889 F.2d 1248, 1255 (2d. Cir. 1989). Finally, whether or not the evidence is sufficient to prove opposer's allegations in paragraphs 4 and 5 of the amended notice of opposition is a question of proof for trial. Inasmuch as applicant has not made a

showing that leave to amend should not be freely given, opposer's motion to amend its notice of opposition is granted.

Applicant is allowed until THIRTY DAYS from the mailing date of this order to file an answer to the amended notice of opposition.

In view of the foregoing, and to prevent any prejudice to applicant, opposer's motion to extend discovery for one month is granted.

Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **April 13, 2003**

30-day testimony period for party in position of plaintiff to close: **July 12, 2003**

30-day testimony period for party in position of defendant to close: **September 10, 2003**

15-day rebuttal testimony period for party in position of plaintiff to close: **October 25, 2003**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.