

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

|                   |   |                            |
|-------------------|---|----------------------------|
| Intel Corporation | § |                            |
|                   | § |                            |
| Opposer,          | § |                            |
| v.                | § | Opposition No. 123,312     |
|                   | § |                            |
| Mr. Stephen Emeny | § | Application No. 75/825,218 |
|                   | § |                            |
| Applicant.        | § |                            |

TRADEMARK TRIAL AND  
 APPEAL BOARD  
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**MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

Pursuant to FED. R. CIV. P. 15(a) and the Trademark Trial and Appeal Board Manual of Procedure, Opposer Intel Corporation hereby requests leave to amend its Notice of Opposition to add, as a new and separate ground for opposing Applicant Stephen Emeny’s intent-to-use application for the “IDEAS INSIDE” mark, Applicant’s lack of bona fide intent to use the applied-for mark in commerce on the services specified in the opposed application.

Amendments to pleadings in inter partes proceedings before the Board are governed by FED. R. CIV. P. 15; Trademark Trial and Appeal Board Manual of Procedure Rule 507.01. Under FED. R. CIV. P. 15(a), “leave shall be freely given when justice so requires”. If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, plaintiff ought to be afforded an opportunity to test its claims on the merits. *Foman v. Davis*, 371 U.S. 178, 182 (1962). Consistent with the Supreme Court’s holding in *Foman*, the Trademark Trial and Appeal Board has recognized that “amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any

opposing parties.” *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 U.S.P.Q. 471, 473 (TTAB 1971). Accordingly, a motion for leave to amend should be granted where the amendment is legally sufficient and where there is no undue prejudice to the opposing party.

15 U.S.C. § 1051(b) requires that a trademark applicant have a bona fide intent to use the applied-for mark in commerce, and thus, the absence of such intent is a basis for opposition. *See also Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993). Applicant alleges, in his application, that he intends to use the “IDEAS INSIDE” mark on a wide variety of online services. However, Opposer has learned, through discovery, that Applicant has taken no affirmative steps, preliminary or otherwise, which would evidence an intent to use the applied-for marks for the goods specified in the applications.<sup>1</sup> As a consequence, Applicant can produce no documentation supporting his professed intent to use these marks. This latter deficiency alone is a sufficient basis for opposition. *See id.* at 1507. (“[A]bsent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is

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<sup>1</sup> Moreover, it appears that Applicant has applied for various intent-to-use marks for closely related goods and services, but has yet to commence and prove use for *any* such marks in the United States. These include Ser. No. 75/885374 for the mark INTERNET SURF SUIT (abandoned for failure to file a statement of use); Ser. No. 75/825226 for the mark CYBERSPACE ESSENTIALS (abandoned for failure to file a statement of use); Ser. No. 75815571 for the mark BYTE SIZE CLOTHING (abandoned for failure to file a statement of use); Ser. No. 75/885342 for the mark MULTIMEDIA POCKET (abandoned for failure to file a statement of use); Ser. No. 75/415374 for the mark WHEN YOU’RE GOING PLACES (fourth extension of time to file statement of use granted); Ser. No. 75/415363 for the mark I S (fourth extension of time to file statement of use granted); Ser. No. 75/263386 for the mark ROOKIESAURUS (abandoned for incomplete response to office action); and Ser. No. 75/263382 for the mark INTERNET SURFWEAR (fourth extension of time to file statement of use granted).

sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b).”).

Given the legal sufficiency of Opposer’s proposed amendment, the only issue remaining is whether Applicant would be unduly prejudiced if the Board were to allow Opposer to amend its Notice of Opposition to add Applicant’s alleged lack of bona fide intent as a basis for the Opposition. There is no likelihood of undue prejudice here. Opposer does not request any additional discovery on this issue, and throughout this proceeding, Applicant has not propounded any discovery requests. Accordingly, notwithstanding that this proceeding is currently in Opposer’s testimony period, there is no need to re-open discovery for *either* party; thus, there would be no delay on the proceedings attributable to this requested amendment. *See Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d. 1216 (TTAB 1990) (allowing amendment during testimony period); *American Optical Corp. v. American Olean Tile Co.*, 168 U.S.P.Q. 471 (TTAB 1971) (allowing amendment requested during opposer’s testimony period, but before applicant’s testimony period).

On a more pragmatic level, Applicant’s testimony period has yet to open, and Applicant is free to produce, and indeed should produce, any documentation that supports his claimed intent to use the applied-for marks. *See id.* Additionally, since it is Applicant’s intent to use that is at issue, nearly all of the relevant documents should be in the Applicant’s custody or control. For the foregoing reasons, Opposer respectfully requests that the Board grant Opposer leave to amend its Notice of Opposition. An executed, proposed Amended Notice of Opposition accompanies this motion.

**CONCLUSION**

Respectfully submitted,  
INTEL CORPORATION

Date: 11/14/02

By: 

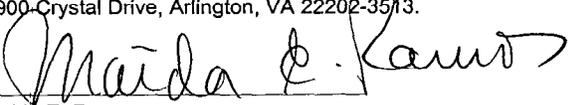
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CERTIFICATE OF EXPRESS MAIL

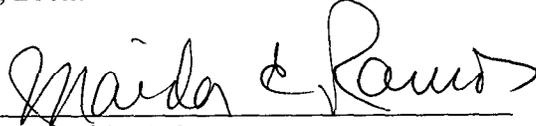
NUMBER: EU430694531US  
DATE OF DEPOSIT: November 14, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

  
Maida E. Ramos

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing "Motion for Leave to Amend Notice of Opposition" was served on Mr. Brian Hall, 1973 South East 15<sup>th</sup> Court, Pompano Beach, FL 33062 by First Class mail, postage prepaid, this 14<sup>th</sup> day of November, 2002.

  
Maida E. Ramos



11-14-2002  
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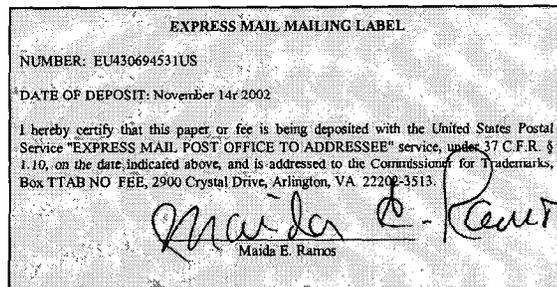
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November 14, 2002

Via Express Mail No. EU430694531US

**BOX TTAB – NO FEE**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513



RE: *Opposition No. 123,312*  
*Serial No. 75/825,21*  
*Mark: IDEAS INSIDE*  
*Applicant: Steven Emeny; Opposer: Intel Corporation*

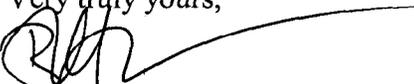
Dear Madam:

Enclosed for filing in connection with the above-referenced opposition are the following documents:

1. Motion for Leave to Amend Notice of Opposition;
2. Amended Notice of Opposition, in duplicate, along with Exhibits, also in duplicate (no fee required);
3. A return postcard to acknowledge receipt of these materials. Please date-stamp and return the postcard to us by mail.

Please forward any reply to this communication directly to our Menlo Park office for docketing purposes. The mailing address is 301 Ravenswood Avenue, Menlo Park, California 94025, and the Menlo Park fax number is 650-463-8380.

Very truly yours,

  
Bobby A. Ghajar

Enclosures

cc: Michele Huntzinger

TTAB

K