

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**

Mailed: March 22, 2005

Opposition No. 91150298

Baxter International Inc.

v.

Inviro Medical Devices Ltd.

Albert Zervas, Interlocutory Attorney

On December 23, 2003, opposer and counterclaim defendant (hereinafter "opposer") filed a consented motion to extend the discovery period until January 17, 2004 to allow the parties "to gather and produce those specific documents and items requested in the depositions, and to take document authentication depositions if the parties cannot agree on authenticity stipulations." The Board granted the consented motion on January 29, 2004.

This case now comes up on (a) the December 22, 2003 motion filed by applicant and counterclaim plaintiff (hereinafter "applicant") to amend its answer and counterclaim to assert a claim of fraud in obtaining and maintaining Registration No. 1821178;<sup>1</sup> and (b) the January

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<sup>1</sup> Applicant maintains that opposer's "sworn testimony on December 15, 2003 [that opposer] has never used the INTERLINK trademark on "drug vials" or "drug vial stoppers" as set forth in Registration No. 1,821,178" is the basis for its fraud claim.

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20, 2004 motion filed by opposer to amend its notice of opposition to delete Registration No. 1821178 "from the case, and merely assert commonlaw rights in its use of INTERLINK in connection with syringes and drug vial adapters (which are listed in the registration at issue)." Each motion has been contested by the non-moving party.<sup>2</sup>

Leave to amend a pleading is liberally granted at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See Fed. R. Civ. P. 15(a); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); and TBMP § 507.02 (2d ed. rev. 2004) and cases cited therein.

The Board first turns to applicant's motion to amend its counterclaim to assert a claim of fraud. Because applicant only learned of the basis for the fraud claim on December 15, 2003 during a discovery deposition, promptly moved to amend its counterclaim on December 22, 2003 just one week after the discovery deposition, and moved to amend its counterclaim prior to January 17, 2004, and because the Board does not find any prejudice to opposer if applicant's motion is granted (aside from the usual delay and expense involved in any legal proceeding), applicant's motion to

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<sup>2</sup> The Board presumes familiarity with the pleadings, motions and arguments of the parties and does not repeat them in this order.

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amend is granted.<sup>3</sup> The amended answer and counterclaim (filed December 22, 2003) is now applicant's operative pleading in this case.

The Board next turns to opposer's motion to amend the notice of opposition. In view of applicant's opposition to opposer's motion, and because opposer's motion only comes *after* applicant has counterclaimed to cancel opposer's registration, opposer's motion is denied.

Thus, proceedings are resumed, and opposer is allowed until **THIRTY DAYS** from the mailing date of this order to file an answer to the amended counterclaim. See Trademark Rules 2.114(b)(2)(iii) and 2.121(b)(2). Further, the discovery period is reopened and the discovery and testimony period are reset as stated below. *Discovery, however, may only be taken by the parties in connection with applicant's allegation of fraud in obtaining and maintaining Registration No. 1821178.*

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<sup>3</sup> Opposer's objections to the motion due to "its timing and the inevitable delay and additional discovery it would require" are not well taken. First, applicant only learned of the basis for its claim of fraud just one week prior to filing its motion during a discovery deposition. (Applicant maintains too that it would have filed the motion sooner if the parties were not holding settlement discussions during that week.) Second, while opposer complains that applicant waited until late in the discovery period to take depositions, applicant only obtained opposer's documents in response to its discovery requests in December 2003 - just prior to the depositions - that "confirmed [opposer's] lack of usage of the INTERLINK trademark." Third,

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**THE PERIOD FOR DISCOVERY *ONLY ON*  
*THE ISSUE OF ALLEGED FRAUD IN*  
*OBTAINING AND MAINTAINING*  
*REGISTRATION NO. 1821178***

TO CLOSE: May 30, 2005

30-day testimony period for party in  
position of plaintiff in the cancellation  
to close: August 28, 2005

30-day testimony period for party  
in position of defendant in  
the cancellation and plaintiff in  
the counterclaim to close: October 27, 2005

30-day rebuttal testimony period  
for plaintiff in the cancellation  
and defendant in the counterclaim  
to close: December 26, 2005

15-day rebuttal testimony period for  
plaintiff in the counterclaim to  
close: February 9, 2006

**Briefs shall be due as follows:  
[See Trademark Rule 2.128(a)(2)].**

Brief for plaintiff in the  
cancellation shall be due: April 10, 2006

Brief for defendant in the  
cancellation and plaintiff in  
the counterclaim shall be due: May 10, 2006

Brief for defendant in the  
counterclaim and reply brief,  
if any, for plaintiff in the  
cancellation shall be due: June 9, 2006

Reply brief, if any, for  
plaintiff in the counterclaim  
shall be due: June 24, 2006

If the parties stipulate to any extension of these dates,  
the papers should be filed in triplicate and should set forth

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the scope of additional discovery and duration of the additional  
discovery period can be restricted.

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the dates in the format shown in this order. See Trademark Rule 2.121(d).

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.

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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