

Goodman

**THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB**

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

Mailed: January 28, 2008

Opposition No. **91162780**

Message in a Bottle, Inc.
f/k/a/ Gold Shells, Inc.

v.

Keith Cangiarella

Before Hohein, Drost and Walsh, Administrative Trademark
Judges.

By the Board:

This case now comes up on the following motions:

- 1) applicant's second motion for summary judgment,
filed August 20, 2007;
- 2) applicant's motion to dismiss the opposition and to
disallow the affidavit of Roger Rojas, filed
October 10, 2007; and
- 3) applicant's motion to amend his petition to cancel,
filed October 26, 2007.¹

We turn first to applicant's motion to dismiss based on
applicant's assertion that opposer Gold Shells Inc. "ceased
to exist" and that "opposer's predecessor failed to notify
the Board or the USPTO and has forfeited its rights to
oppose."

¹ The Board construes this filing as a motion to amend the
counterclaim.

In response, opposer advises that applicant's assumption that opposer has dissolved is false, inasmuch as it "simply changed its name to Message In A Bottle, Inc. which has no effect on the present proceeding."

Inasmuch as opposer has not been dissolved but effected a change of name, applicant's motion to dismiss is denied. The Board has changed the title of this proceeding to reflect opposer's new name. Opposer is advised that recordation of the change of name with the Assignment Branch of the Office is advisable because it facilitates proof of ownership of its pleaded registration. TBMP § 514 (2d. ed. rev. 2004).

We turn next to applicant's motion for leave to amend his counterclaim so as to add claims of genericness and descriptiveness.

It is opposer's position that it is "too late" for applicant to amend the pleadings to add a claim of genericness and, with respect to the descriptiveness claim, such issue is "moot" because this ground is unavailable inasmuch as opposer's pleaded registration is over five years old.

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 or parties. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). In deciding applicant's motion for leave to amend, the Board must consider whether there is any undue prejudice to opposer and whether the amendment is legally sufficient. See *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). With regard to prejudice, the timing of the motion for leave to amend is a major factor in determining whether opposer would be prejudiced by allowance of the proposed amendment. See TBMP § 507.02 and cases cited therein.

With regard to applicant's request for leave to amend to add a mere descriptiveness claim,² we agree with opposer that this ground for cancellation is unavailable as the opposition was filed on October 21, 2004, which is more than five years after the May 4, 1999, issuance date of opposer's pleaded registration. Under the Trademark Act, a mere descriptiveness claim must be filed within five years from the date of registration of a mark. See 15 USC § 1064 and TBMP § 307.02. Therefore, applicant's motion to amend to

² With regard to applicant's assertion that it has already pleaded descriptiveness and/or genericness in the original counterclaim, we cannot agree. Applicant's allegation "that the Registrant Roger Rojas intentionally mischaracterized his goods as 'telecommunication services' with the intent to avoid a potential descriptiveness refusal" goes only to applicant's fraud claim.

add the mere descriptiveness ground to the counterclaim is denied as legally insufficient.

With regard to the ground of genericness, we find that applicant unduly delayed in asserting such a claim. In the instant case, applicant's request to amend the counterclaim comes nearly three years after the original counterclaim was filed. We find that applicant has offered no sufficient justification as to why he failed to raise the genericness claim sooner. See e.g., *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001) (motion to amend to add dilution claim eight months after filing notice of opposition denied due to undue delay). Moreover, it is apparent that prejudice would result from allowance of such a late motion as it would inject a new issue into the case on the eve of trial.³

Accordingly, applicant's motion to amend to add the counterclaim to add claims of mere descriptiveness and genericness is denied.

We now turn to applicant's second motion for summary judgment in his favor on the grounds of mere descriptiveness, genericness, and fraud.

Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is

³ In this regard, it is noted that applicant's second motion for summary judgment was filed one day before opposer's testimony period was scheduled to open.

entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

With respect to the grounds of mere descriptiveness and genericness, since we have denied applicant's motion to amend, applicant's second motion for summary judgment as to those grounds is based on unpleaded claims. A party may not obtain summary judgment on unpleaded claims. See Fed. R. Civ. P. 56(a) and 56(b); and *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994). In view thereof, applicant's second motion for summary judgment is denied with respect to the grounds of mere descriptiveness and genericness.

With respect to applicant's second motion for summary judgment on the ground of fraud, we have carefully considered the arguments and evidence presented; however, we find, as we did previously, that genuine issues of material fact exist with respect to applicant's claim of fraud.⁴

⁴ We note that "[a]s a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment." See *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Accordingly, applicant's second motion for summary judgment is denied as to the ground of fraud.⁵

Additionally, the Board finds that no further summary judgment motions are warranted in this proceeding and that this case should accordingly proceed to trial. Therefore, the parties are advised that the Board will not entertain any further motions for summary judgment.

Proceedings herein are resumed. Trial dates are reset as follows:

Discovery period:	CLOSED
30-day testimony period for plaintiff in the opposition to close:	March 25, 2008
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	May 24, 2008
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	July 23, 2008
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	September 6, 2008
Briefs shall be due as follows: [See Trademark rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	November 5, 2008
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	December 5, 2008

⁵ Applicant's motion to disallow the affidavit of Roger Rojas, submitted in opposition to applicant's motion for summary judgment is denied. The Board notes that the declaration filed with the Board is properly signed and stamped by the notary public and, as noted previously, Gold Shells Inc. was not dissolved but merely effected a change of name.

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due:

January 4, 2009

Reply brief (if any) for plaintiff in the
Counterclaim shall be due:

January 19, 2009

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

* * * *

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31,

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2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>