

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

Baxley

Mailed: July 5, 2011

Opposition No. 91166487

Hasbro, Inc.

v.

Creative Action, LLC

By the Trademark Trial and Appeal Board:

On February 3, 2011, the Board issued an order wherein, among other things, it: (1) denied applicant's motion for summary judgment in the counterclaim to cancel opposer's pleaded registrations on the ground of genericness; (2) denied opposer's cross-motion for summary judgment on its claim for restriction of applicant's involved application; and (3) reset applicant's time in which to file a combined answer to the amended notice of opposition and counterclaim. In a March 4, 2011 order, the Board noted applicant's combined responsive pleading and left dates as last reset in the February 3, 2011 order.

On April 20, 2011, roughly one month after the close of the discovery period, opposer filed a motion for leave to file a second amended notice of opposition. That motion has been fully briefed.

Opposer, in support of its motion, contends that it is not seeking to add a new claim and rather that it is merely seeking to plead two alternative proposed restrictions to applicant's identification of goods that are as accurate as possible, based on applicant's earlier discovery responses, to address concerns that applicant and the Board have raised in connection with the proposed restriction. Opposer further contends that allowing it to amend its notice of opposition will not require any additional discovery. Accordingly, opposer asks that the Board grant it leave to file a second amended notice of opposition.

In opposition thereto, applicant contends that, because opposer's motion is based discovery that has been available to opposer for more than five years, that motion is untimely and prejudicial; that the proposed restrictions unnecessarily and unfairly restrict the scope of applicant's rights; and that opposer has failed to show that the proposed amendment will avoid likelihood of confusion between the parties' goods.

In reply, opposer contends that the proposed amended restriction is based in part on concerns raised by the Board in the February 3, 2011 order denying opposer's cross-motion for summary judgment on the original proposed restriction; that applicant has not identified any hardship that would result from allowing opposer to amend its claim for

restriction; and that the proposed amended claim for restriction is sufficiently pleaded.

Pursuant to Trademark Rule 2.107 and Fed. R. Civ. P. 15(a), pleadings in Board *inter partes* proceedings may be amended in the same manner and to the same extent as in a civil action in the U.S. District Court. That is, leave to amend shall be "freely give[n] ... 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, e.g., *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); TBMP Section 507.02 (3d ed. 2011).

A claim for partial cancellation or restriction of a registration under Trademark Act Section 18, 15 U.S.C. Section 1068, is linked to the question of likelihood of confusion. Accordingly, a party pleading such a claim must allege, and later prove, that (i) the entry of a proposed restriction to the goods or services in its opponent's application or registration will avoid a finding of likelihood of confusion, and (ii) the opponent is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered. See *Eurostar Inc. v.*

"Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266, 1270-72 (TTAB 1994). A claim for restriction of a registration must be specific in nature so that the defendant has fair notice of the specific restriction being sought. See TBMP Section 309.03(d). That is, a party that seeks to restrict a registration or application should state with as much precision as possible the restriction it seeks, so that the issue is properly framed for trial. See *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, *supra*.

As an initial matter, the motion for leave to file a second amended notice of opposition appears to have been filed largely in response to concerns about the original claim for restriction that the Board raised in the February 3, 2011 order. The Board finds that opposer's filing of that motion less than three months after the issuance of that order and prior to the due date for opposer's pretrial disclosures is timely.

Second, the Board is not persuaded by applicant's assertion that it has been prejudiced because applicant could have been spared the expense of opposing the present motion if opposer drafted the proposed restriction when it first sought to add the claim for restriction. Prejudice contemplates more than mere inconvenience, delay, or loss of any tactical advantage; rather, prejudice contemplates an adverse effect on a non-movant's ability to litigate a case,

such as through lost evidence or unavailable witnesses. See *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997); TBMP Section 509.01(b). Applicant has not requested that the Board reopen the discovery period. Moreover, any potential prejudice can be remedied by resetting the trial calendar to allow applicant sufficient time in which to prepare for trial based on the revised proposed restrictions.

In addition, the alternative proposed restrictions of applicant's involved application are adequately pleaded. In particular, opposer has pleaded in paragraphs 15 and 20 of the second amended notice of opposition that the alternative proposed restrictions would serve to avoid any likelihood of confusion with respect to its registered marks. With regard to the first alternative proposed restriction, opposer has alleged that applicant is not using and does not intend to use the involved mark on a "game," but instead only uses or intends to use the mark on a "therapeutic activity kit for persons with dementia or other mental impairments" and that goods sold under the mark are sold or intended to be sold only through "narrow, specialized channels of trade to a limited, identifiable class of consumer." Second amended notice of opposition, paragraphs 9-11. Accordingly, opposer contends that the identification of goods should be restricted to "properly reflect the actual goods sold or intended to be sold by [a]pplicant and the particular

channels of trade and class of consumer for such goods,"
namely,

therapeutic activity kit for groups and for people with dementia, head trauma or stroke living in long term care facilities or attending adult day care centers and older adults with these cognitive impairments living at home, comprised of printed 'calling' cards that contain trivia questions and related prompts for discussion, printed cards that contain any array of potential answers to the trivia question, and boards used to hold the printed answer cards, marketed through trade show exhibits, direct marketing, and distributors of products for the health and long term care industries, sold to long-term care facilities, adult day care centers, home health care agencies, psychiatric hospitals and units, and care givers of older adults with dementia, head trauma or stroke who live at home.

Id., paragraphs 12-13. Opposer further contends that, with regard to the first proposed restriction, applicant's goods should be reclassified in International Class 10 or 16. *Id.*, paragraph 14.

With regard to the second proposed restriction, opposer has pleaded that, if the Board determines that applicant uses or intends to use its mark on a game, the identification of goods should be restricted to

therapeutic game for groups and for people with dementia, head trauma or stroke living in long term care facilities or attending adult day care centers and older adults with these cognitive impairments living at home, comprised of printed 'calling' cards that contain trivia questions and related prompts for discussion, printed cards that contain any array of potential answers to the trivia question, and boards used to hold the printed answer cards, marketed through trade show exhibits, direct marketing, and distributors of products for the health and long term care

industries, sold to long-term care facilities, adult day care centers, home health care agencies, psychiatric hospitals and units, and care givers of older adults with dementia, head trauma or stroke who live at home.

Id., paragraphs 18-19. With regard to both proposed restrictions, opposer offers in addition to amend the identification of goods of its involved registrations to refer to "children's matching game(s)," if necessary.¹ *Id.*, paragraphs 16 and 21. Further, opposer adequately pleaded in paragraph 23 of the amended notice of opposition that applicant did not have a bona fide intent to use the mark in commerce on the identified goods as of the filing date of Creative's involved application. See Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

In view thereof, opposer's motion for leave to file a second amended notice of opposition is granted. The second amended notice of opposition is the operative complaint herein. Applicant is allowed until **twenty days** from the mailing date set forth in this order to file answer thereto.²

¹ Whether or not opposer can prevail on that claim is a matter for resolution on the merits. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

² If applicant does not include the counterclaim in its answer to the second amended notice of opposition, the Board may treat that counterclaim as withdrawn without written consent of opposer after the filing of an answer. See Trademark Rule 2.114(c); TBMP Section 507.02 (a party's amended pleading supersedes all prior pleadings).

Proceedings herein are otherwise suspended.³

³ The Board will resume proceedings upon the filing of applicant's answer to the second amended notice of opposition with the discovery period closed, but with testimony periods reset to allow the parties ample time in which to prepare for trial.