

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

Baxley

Mailed: December 31, 2008

Opposition No. **91176744**

DC Comics and Marvel
Characters, Inc.

v.

Michael Craig Silver

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of opposers' motion (filed October 31, 2008) for leave to file an amended notice of opposition. The motion has been fully briefed.

As an initial matter, applicant filed one change of correspondence address in the involved application file on October 3, 2008 and another on October 22, 2008.¹ Contrary to applicant's apparent belief, the filing of the changes of correspondence address in the application file did not cause the correspondence address in the Board file for this proceeding to be changed as well and further did not affect service thereof upon opposers. For applicant to change his correspondence address in the Board file for this proceeding and to notify opposers of such changes, applicant should have also filed changes of correspondence address in the

¹ Applicant also filed changes of correspondence address in this case on November 2, 2007 and March 20, 2008.

Board file for this proceeding and served copies thereof upon opposers. See Trademark Rules 2.119(a) and 2.193(a); TBMP Section 117.07 (2d ed. rev. 2004). Because opposers served their motion for leave to file an amended notice of opposition on applicant at what was his correspondence address of record in the Board file for this proceeding when such motion was filed, the Board finds that such motion was properly served.

Because opposers served their motion upon applicant at by mail on October 31, 2008, applicant's brief in response thereto was due by November 20, 2008. See Trademark Rules 2.119(c) and 2.127(a). Applicant, however, did not file his brief in response to that motion until November 25, 2008, five days late. Accordingly, before the Board will consider applicant's brief in response, applicant must establish that his failure to respond in a timely manner to opposers' motion was the result of excusable neglect.

In *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable is:

at bottom an equitable one, taking account of all relevant circumstances surrounding the

party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

Pioneer Investment Services Co. v. Brunswick Associates L.P., 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d at 1586, fn.7 and cases cited therein.

In considering the third *Pioneer* factor herein, the Board finds that applicant's failure to respond in a timely manner to opposers' motion was caused by his mistaken belief that submission of changes of correspondence address in the involved application file was sufficient to change his correspondence address for this proceeding and to provide opposers with notice of his new addresses. Applicant's failure to respond in a timely manner was also caused by a delay in receiving opposer's motion for leave to file an amended notice of opposition that resulted from his failure to keep current his correspondence address in the Board file

for this proceeding.² Although such failure was within his control, the failure appears to have been a result of applicant's inexperience with USPTO matters. Nonetheless, such failure weighs somewhat against a finding of excusable neglect.

With regard to the second *Pioneer* factor, the delay caused by applicant's five days' late filing of his brief in response is minimal. With regard to the first *Pioneer* factor, there is nothing in the record to indicate that opposers were prejudiced by the late filing of applicant's brief. That is, opposers have failed to show that their ability to prosecute this case is in any way impacted by applicant's five-day delay. See *Pratt v. Philbrook*, 109 F.3d 18 (1st^t Cir. 1997); TBMP Section 509.01(b) (2d ed. rev. 2004). With regard, to the fourth *Pioneer* factor, there is no evidence of bad faith by applicant. Accordingly, the remaining *Pioneer* factors weigh slightly in favor of a finding of excusable neglect. The Board finds that, based on the totality of the circumstances,

² Applicant admits that he receives e-mail notices from the USPTO. However, applicant also admits that he neither relies upon nor checks his e-mail and instead relies solely on United States mail for receipt of correspondence in this case. Inasmuch as applicant has changed his correspondence address four times during the pendency of this case, solely relying upon United States mail may be ill-advised. Rather, applicant should review regularly both his e-mail and the online record of this case at <http://ttabvueint.uspto.gov/ttabvue/> to assure that he is aware of the current status of this case and that his correspondence information in the Board file for this proceeding is accurate.

applicant's failure to act in a timely manner was the result of excusable neglect. Therefore, the Board will consider applicant's brief in response to opposers' motion for leave to file an amended notice of opposition.³

Because applicant has filed his answer to the original notice of opposition, opposers may amend their notice of opposition only by written consent of applicant or by leave of the Board; leave is to be freely granted when justice so requires. See Fed. R. Civ. P. 15(a); TBMP Section 507.02(a) (2d ed. rev. 2004). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law, be prejudicial to the rights of the adverse party or parties, or be futile. See *id.*

Opposers seek leave to file an amended notice of opposition to add a claim that applicant did not have a bona fide intent to use the mark on the goods identified in the involved application when he filed his involved application. After reviewing the parties' arguments and exhibits, the Board finds that granting opposers such leave is warranted under the circumstances.

³ Applicant is advised, however, that the Board will view with disfavor any further failure by him to act in a timely manner in this case that is caused by his failure to keep current his correspondence address in the Board file for this proceeding.

The proposed new claim is adequately pleaded in paragraph 21 of the amended notice of opposition⁴ and, in view of applicant's scant provision of documents and information evidencing his claimed intent to use his mark, does not appear to be futile.⁵ See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Further, opposers have not unduly delayed in seeking to add such claim because they filed the motion for leave to file an amended notice of opposition after reviewing discovery responses and document production that applicant served less than one month prior to the filing of the motion and which applicant confirmed as being complete only nine days prior to the filing of that motion. In addition, any potential prejudice to applicant can be mitigated by reopening the discovery period for the limited purpose of taking discovery in connection with the newly added claim. See *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000).

⁴ The Board notes, however, that opposers' dilution claim is insufficiently pleaded in both the original and amended notices of opposition because opposers do not expressly allege that their pleaded marks became famous prior to any date upon which applicant can rely in support of his application. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001); *Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001). If opposers intend to pursue a dilution claim at trial, they should file a second amended notice of opposition within thirty days of the mailing date set forth in this order, failing which the dilution claim will receive no consideration. See Fed. R. Civ. P. 15(a); TBMP Section 507 (2d ed. rev. 2004).

⁵ Whether opposers can prevail on that claim is a matter for trial. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

In view thereof, opposers' motion for leave to file an amended notice of opposition is granted. The amended notice of opposition that was concurrently filed with that motion is the operative complaint herein. Applicant is allowed until thirty-five days from the mailing date set forth in this order to file an answer to the amended notice of opposition.

Proceedings herein are resumed. The discovery period is reopened for the limited purpose of taking discovery regarding opposers' newly pleaded claim that applicant did not have a bona fide intent to use the mark in commerce when he filed the involved application. Discovery and testimony periods are reset as follows.

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| DISCOVERY PERIOD TO CLOSE: | February 6, 2009 |
| Plaintiff's 30-day testimony period to close: | May 7, 2009 |
| Defendant's 30-day testimony period to close: | July 6, 2009 |
| Plaintiff's 15-day rebuttal testimony period to close: | August 20, 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.

Opposition No. **91176744**

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.