

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

EJW

Mailed: January 10, 2012

Opposition No. 91193987

Tata Sons Limited

v.

Tata's Natural Alchemy, LLC

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

This case now comes up for consideration of opposer's motion (filed October 6, 2011) to amend its notice of opposition and its motion (filed October 20, 2011) to suspend this proceeding pending the Board's consideration of the motion to amend. Both motions are fully briefed.

On Friday, January 6, 2012, the assigned Interlocutory Attorney, Elizabeth Winter, conducted a telephone conference with the parties, Tata Sons Limited (represented by Paul Kilmer, Anthony Masiello and Charles McLaurin of Holland & Knight LLP) and Tata's Natural Alchemy, LLC (represented by Angelo Notaro, John Zaccaria and Brad Corsello of Notaro and Michalos and Zaccaria PC), regarding opposer's pending motions. See Trademark Rules 2.120(i)(1) and 2.127(c); and TBMP § 502.06 (3d ed. 2011).

This order sets forth the Board's orders issued during the conference regarding opposer's motions, discusses the

import of additional information provided by opposer during the conference, and clarifies the current status of this proceeding.

**Motion to Amend the Notice of Opposition**

During the conference, the Board turned first to opposer's motion to amend<sup>1</sup> paragraph 6 (*i.e.*, "Point 6") of its notice of opposition to add a claim of ownership of U.S. Reg. No. 3858676 for the mark TATA (and design).<sup>2</sup> The Board reviewed the parties' arguments in detail, and then issued the following order, to-wit:

The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amended pleading would be prejudicial to the rights of the adverse party or parties, would violate settled law, or would serve no useful purpose. Fed. R. Civ. P. 15(a). In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *See Foman v. Davis*, 371 U.S. 178, 182 (1962), *cited in Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001). *See also* TBMP § 507.02 (3d ed. 2011), and

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<sup>1</sup> Opposer's motion was accompanied by a proposed amended pleading.

<sup>2</sup> Registration issued on October 12, 2010, under Section 44(e) of the Trademark Act.

cases cited therein. The granting of a motion for leave to amend a pleading is within the discretion of the Board and is allowed only when justice so requires. *Trek Bicycle*, 54 USPQ2d at 1541.

The timing of the motion for leave to amend is a principal factor in determining whether the non-movant would be prejudiced by allowance of the proposed amendment. A motion for leave to amend should be filed as soon as any ground for such amendment becomes apparent. *See Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (2008) ("allowing piecemeal prosecution of this case would unfairly prejudice respondent by increasing the time, effort, and money that respondent would be required to expend to defend against petitioner's challenge to its registration"); and *Trek Bicycle Corp.*, 64 USPQ2d at 1541. Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion. *See* 6 Fed. Prac. & Proc. Civ.2d § 1488 (2008); Chapman, "Tips from the TTAB: Amending Pleadings: The Right Stuff," 81 *Trademark Reporter* 302, 307 (1991).

On review of the parties' arguments and evidence of record, the Board finds that opposer unduly delayed in filing its motion. *See Trek Bicycle*, 64 USPQ2d 1540, 1541

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(TTAB 2001) (motion for leave to amend filed prior to close of discovery but based on facts known to opposer prior to institution of the case denied due to unreasonable delay); and *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1287 (TTAB 2008) ("It is incumbent on [plaintiff] to identify all claims promptly in order to provide [the defending party] with proper notice").

Specifically, opposer filed the application underlying the registration at issue on November 6, 2006, based on its intent to use the mark in commerce, and more than three years later, petitioned the Director of the U.S. Patent and Trademark Office to approve an amendment to the application to seek registration solely under Section 44(e). The Director approved the amendment changing the basis of the application on February 22, 2010, and all the foreign registrations on which the Section 44(e) registration would be based were either renewed in 2009 or have an expiration date in the year 2013.<sup>3</sup> Clearly, when the notice of opposition was filed on March 2, 2010, opposer knew that the application existed and that the Director had approved the change in filing basis. Similarly, when the second opposition period closed on August 26, 2010, or when

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<sup>3</sup> See the following record from the USPTO TARR database: <http://tarr.uspto.gov/tarr?regser=registration&entry=3858676&action=Request+Status>, unnumbered exhibit to declaration of Charles McLaurin (reply), and Exhibit C to declaration of Angelo Notaro (response).

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"Opposer became aware in late October 2010, that the Underlying Application would mature to registration" (reply at 7), opposer could have sought to amend its pleading at either of those times, but apparently chose not to do so. Likewise, opposer failed to seek to amend its pleading to claim ownership of its new registration during the four months after registration issued and before the proceeding was suspended pending consideration of its motion to compel.

In view of the foregoing facts, and given that it is common practice for plaintiffs in Board proceedings to plead ownership of pending applications, the Board is not persuaded that opposer's rationale<sup>4</sup> for not pleading ownership of the application earlier in the proceeding mitigates opposer's delay in seeking to claim ownership of the registration. Rather, by missing at least four opportunities early in the proceeding to plead ownership of the underlying application or the recently issued registration at issue, opposer failed to identify all of its claims promptly<sup>5</sup> so to provide applicant with proper notice

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<sup>4</sup> In responding to applicant's statement that the pending application was not referenced in its initial disclosures, opposer reveals that it "did not intend to rely upon the Underlying Application, in view of its extremely limited evidentiary value and indeterminate status" (reply at 6).

<sup>5</sup> During the conference, the parties were directed to the Board's discussion in *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93 (TTAB 1984). The decision in *Aron v. Remington* was based on different circumstances from the case at bar, that is, the order

of its intention to rely on the registration at issue. At a minimum, opposer could have sought to amend its pleading to add the new registration when opposer became aware in October 2010, that the underlying application would mature to registration.

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therein related to respondent's motion to dismiss based on lack of standing and petitioner's asserted failure to file a compulsory counterclaim in a related opposition. Nonetheless, the Board's discussion therein of the importance of early notice to the defending party of the registration(s) on which the plaintiff will rely is relevant to this matter, inasmuch as opposer here waited until the last weeks of the discovery period to seek to amend its pleading.

Specifically, in denying the motion to dismiss with respect to mandatory counterclaim issue, the Board in *Aron v. Remington* directed respondent's attention to the following comments contained in the final rule notice by which Rules 2.106(b) and 2.114(b) were amended to provide for compulsory counterclaim. The Board's comments after the Final Rule comments are also of interest.

[Final Rule Comments:] *It is expected that in the original notice of opposition or petition for cancellation, an opposer or cancellation petitioner will identify ... each registration upon which it expects to rely. The deliberate withholding, until the testimony period of an opposer ... of the identification of the registration ... intended to be introduced in evidence in support of the claim of damage causes unwarranted surprise and prejudice to an applicant .... Such a practice frustrates proper discovery and preparation for trial. The burden is upon an opposer ... to present initially a pleading that gives fair notice of the case that an applicant ... must meet.*

[Board's comments] The Patent and Trademark Office recognizes that situations will arise where an opposer ... will want to introduce a registration which was not originally pleaded. ... It should be remembered that a long and unexplained delay in the filing of a motion to amend a notice of opposition ... , when there is no question of newly discovered evidence (as there would not be when a party is pleading its own registration), may render the amendment untimely if the defendant is thereby prejudiced. *It therefore behooves an opposer ... to plead its registration ..., if not in the original notice of opposition ..., as soon as possible after the omission (or newly issued registration) comes to the opposer's ... attention.*

*Id.* at 96 (emphasis added).

Notably, in arguing that good cause exists for suspending this proceeding pending the Board's consideration of its motion to amend (discussed *infra*), opposer, states as follows:

"[t]he disposition of Opposer's motion to amend ... will affect the parties' focus upon particular facts at issue in this case, and could therefore have a **significant impact** on the subject matter of discovery depositions and testimony."

In view of the foregoing, the Board finds that the result of opposer's undue delay in filing its motion to amend, if granted, would be to prejudice applicant by increasing the time, effort, and money that it will be required to expend to defend against opposer's new challenge to its application. See *Media Online*, 88 USPQ2d at 1287.

To mitigate its failure to promptly file a motion for leave to amend its pleading once the registration issued, opposer contends that its actions during the course of the proceeding provided adequate notice of opposer's intent to rely on said registration. The Board disagrees.

First, as shown by applicant's submissions, there was no reference to the application underlying the registration in either opposer's initial disclosures or in opposer's response to Interrogatory No. 2.

Second, the December 7, 2011 letter to applicant only notifies applicant that the registration issued. The

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statement of opposer's counsel, viz. "that registration opened new lines of inquiry regarding the relationship of the goods of the parties which we determined were best initially explored in written discovery," neither informs applicant that opposer will rely on the new registration, nor does it inform applicant that opposer intends to amend its pleading to plead ownership of said registration.

Further, providing applicant with a copy of its registration and samples of clothing and bags bearing the TATA and design mark is not equivalent to seeking to amend a pleading to reference a new registration. Rather, the *pleading* of an application provides sufficient notice to the defending party that the plaintiff intends to rely on a registration that issues from the underlying application. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (noting that pleading ownership of a pending application provides "sufficient notice to the applicant that the opposer would rely on a registration from the application for its likelihood of confusion claim," such that later amendment of a notice of opposition is not required prior to making a subsequently issued registration of record).

Likewise, applicant was not obliged to take discovery regarding an unpleaded mark. In fact, opposer could have objected to any discovery propounded by applicant regarding



opposer's unpleaded registration on the basis of relevancy.<sup>6</sup> *Cf. Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1455<sup>7</sup> (TTAB 1998) (noting that opposer had objected to applicant's interrogatories insofar as they might be directed to marks not pleaded in the notice of opposition, the Board concluded that "opposer's actions during the discovery phase of this proceeding would lead any reasonable person to believe that the only mark which opposer was asserting rights in was the word mark ... pled in the notice of opposition").

Alternatively, a discovery request that addresses issues raised by an unpleaded mark may be deemed irrelevant for purposes of discovery. *See, e.g., Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988) (questions concerning specific goods on which opposer uses mark are proper to extent scope of inquiry is limited to those goods identified in application, or involve goods of type marketed by applicant, or mentioned by opposer

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<sup>6</sup> In fact, opposer's responses to applicant's first set of interrogatories, requests for production of documents, and requests for admission include the following objection:

(2) Opposer objects to interrogatories and requests calling for information irrelevant to this proceeding and unlikely to lead to the production of relevant evidence. Such interrogatories and requests will not be answered.

<sup>7</sup> "At a minimum, in its interrogatory answers and responses to requests for admission, opposer should have disclosed to applicant all marks (registered and unregistered) upon which opposer intended to rely to prove likelihood of confusion. Not only did opposer fail to do so, but indeed opposer's answers and responses actually reinforced the notion that opposer was relying simply upon the only mark set forth in the notice of opposition, namely, the word mark FOSSIL." *Id.*

during discovery); *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 n.2 (TTAB 1985) (information regarding goods other than those in involved application and registration is irrelevant); and TBMP § 414(11) (3d ed. 2011) ("A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto").

In view of the foregoing, because opposer's pending application or recently issued registration was not pleaded, opposer's contention that applicant's counsel ignored opposer's new registration "at their peril after receiving notice thereof from the Opposer" (reply at 6) is not well taken.

Finally, the Board responded to applicant's argument that, in addition to failing to amend its pleading earlier in the proceeding, opposer's motion is untimely because it did not mention its intention to seek to amend its pleading during the parties' conference with the Board on September 13, 2011. Specifically, the Board noted that opposer had waited until the discovery period was essentially closed to file the subject motion to amend. In particular, during that September 13th conference, although there were only three weeks remaining in the discovery period when opposer filed its motion to compel, the Board allowed time to the parties to respond to outstanding

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discovery requests or to supplement their responses as discussed during the conference (September 30, 2011 order at 15), and extended the discovery period through November 30, 2011, *to allow discovery depositions to be conducted by the parties* (*Id.* at 16). In view thereof, the Board considered the discovery period to be closed, except as set forth in that order.

However, during the subject conference, opposer's counsel advised the Board that applicant had actually served additional discovery requests to which opposer had responded, thus, essentially stating that neither party understood that the discovery period was closed.

**Upon further consideration, the Board addresses opposer's comments as follows.**

First, insofar as the Board's order mailed September 30, 2011 did not specifically state that discovery was closed *but for* the limited discovery allowed by the Board in that order, applicant's discovery requests served subsequent to the September 13, 2011 conference, and to which opposer responded, are deemed to have been properly served during the discovery period. Otherwise, to clarify, the discovery period remained open until November 30, 2011, solely for the purpose of allowing the parties time to respond to already served discovery requests in accordance with the Board's September 30, 2011 order, and to conduct

discovery depositions.

Second, with respect to applicant's argument that opposer could have informed applicant during the September 13, 2011 conference of its intent to file a motion for leave to amend its pleading, based on the following, the Board agrees.

- o In the Board's September 1, 2011 scheduling order regarding the September 13, 2011 conference, the Board advised that it would consider, *inter alia*, any additional issues raised by the parties in their submissions.
- o During the September 13th conference, the Board discussed applicant's informal motion (contained in its September 9, 2011 submission to the Board) to preclude opposer from asserting in this opposition any marks or trade names which are not specifically identified in opposer's response to applicant's Interrogatory No. 1.
- o The Board denied applicant's informal motion or request because it was improper in the context of the parties' informal, informational submissions, and was premature inasmuch as opposer had not violated a discovery order for which such an estoppel sanction could be ordered (*Id.* at 13).<sup>8</sup>

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<sup>8</sup> *Cf. M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (the Board will not rule on objections pertaining to

- o Although a motion to amend its pleading would not have been heard during that conference, in response to applicant's obvious concern regarding evidence of opposer's marks and tradenames that opposer may seek to adduce at trial, opposer did not bring to the Board or applicant's attention its intent to rely on the registered mark at issue or that it would be filing a motion to amend its pleading. Instead, opposer again delayed in providing notice to applicant that it intended to rely on its new registration by waiting until two weeks after the September 13, 2011 conference to file its motion to amend.

In view of the foregoing, and as stated during the conference, the Board does not find that applicant's service of additional discovery on opposer diminishes the effects on applicant and on this proceeding resulting from opposer's failure to seek to amend its pleading earlier in the proceeding.

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admissibility prior to final decision). See also TBMP § 502.01 (3d ed. 2011).

- *Order*

For the reasons discussed herein, opposer's motion to amend its notice of opposition is denied as untimely. Accordingly, opposer's notice of opposition filed on March 2, 2010 remains its pleading of record.

**Motion to Suspend**

By its motion, opposer argues that good cause exists for the Board to suspend this proceeding pending its consideration of opposer's motion to amend, namely, to allow the parties to efficiently complete their respective discovery depositions after the Board's ruling on the motion to amend, which may significantly affect discovery. Opposer also requests that, upon resumption, the Board allow a suitable time for completion of discovery and reset trial dates accordingly.

Applicant opposes the motion to suspend, essentially arguing that opposer caused the asserted inefficiencies in the remaining discovery period by failing to timely plead its pending application (now registration) in the original notice of opposition and by failing to mention the potential scheduling impact of the proposed amendment at the scheduling conference with the Board in September.

In view of the Board's order denying opposer's motion to amend its pleading, opposer's motion to suspend this proceeding is moot and will be given no further

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consideration.

Accordingly, trial dates remain as set in the Board's  
order mailed on September 30, 2011.

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