

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

Mailed: June 8, 2011

Opposition No. 91195823

OMS Investments, Inc.

v.

NCA Biotech, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of opposer's motion (filed April 21, 2011) for leave to file an amended notice of opposition. The motion has been fully briefed.

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06 (3d ed. 2011). On June 6, 2011, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's counsel Stephen Demm, applicant's counsel Stanley Hsiao, and the assigned Interlocutory Attorney.<sup>1</sup>

Opposer seeks leave to amend its notice of opposition to assert:

---

<sup>1</sup> At the outset of the conference, Mr. Hsiao confirmed that he is General Counsel and Vice President of applicant.

- 1) that after this proceeding was instituted, applicant entered into an agreement with opposer regarding applicant's use of the mark CHAMPIONGRO and abandonment of subject application Serial No. 77853842, and cannot demonstrate an intent to use the mark, because of said agreement (first amended notice of opposition, paragraphs 15 - 19); and
- 2) updated information regarding certain of opposer's pleaded registrations and applications.

Opposer concurrently filed an executed first amended notice of opposition.

The Board has thoroughly considered the parties' arguments and submissions, but for efficiency does not summarize them here. This order states relevant authorities, the Board's findings, and reasons therefor.

#### Analysis

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15, which is made applicable to Board proceedings by Trademark Rule 2.116(a). *See also* TBMP § 507.01 (3d ed. 2011). Pursuant to Fed. R. Civ. P. 15(a)(2), where a party may not amend its pleading as a matter of course under Fed. R. Civ. P. 15(a)(1),

...a party may amend its pleading only with the opposing party's written consent or the court's leave. The

court should freely give leave when justice so requires.

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 or be prejudicial to the rights of the adverse party or parties. See TBMP § 507.02 (3d ed. 2011). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990).

Regarding the timing of opposer's motion to amend, when it filed its original pleading, opposer was clearly unaware of the basis for its proposed added allegations regarding the alleged agreement inasmuch as the parties negotiated and/or entered into it subsequent to the filing of said pleading. With respect to potential prejudice, the relevant facts underlying the allegations are already known to applicant, it is probable that only minimal additional discovery will be necessary, and time remains in the existing discovery period. Furthermore, the need to answer, address and defend additional factual allegations does not, in itself, constitute prejudice that would justify denial of leave to amend.

Regarding the legal sufficiency of opposer's proposed amendments, the Board notes applicant's assertions that the disputed settlement should not be admissible, and that consideration of it is a matter beyond the Board's subject matter jurisdiction. However, the Board has considered the validity of and/or circumstances surrounding an agreement between parties to an inter partes proceeding. See *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008); *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001) (contractual estoppel); *Vaughn Russell Candy Co. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1637-1638 (TTAB 1998) ("while it does not lie within the jurisdiction of the Board to enforce the contract between the parties, agreements to cease use of a mark or to not use a mark in a certain format are routinely upheld and enforced," citing 2 *J.T. McCarthy, McCarthy on Trademarks and Unfair Competition*, Section 18:82, 4<sup>th</sup> Ed. 1997). In view thereof, the allegations that opposer seeks to add, with respect to an asserted agreement between opposer and applicant, go to matters that the Board may consider. Accordingly, the allegations that opposer seeks to add are not futile or lacking in useful purpose.

Finally, opposer's proposed amended information regarding certain of its pleaded applications and registrations constitutes a beneficial effort to clarify the pleading in this regard, and is allowable.

To the extent that either party has concerns regarding confidentiality, the parties are reminded that the Board's Standard Protective Order is applicable and enforceable as of the institution of this opposition and without any action on the part of either party. See Trademark Rule 2.116(g); see also the Board's July 28, 2010 order instituting this proceeding, p. 3.

In view of the circumstances, opposer's motion for leave to file an amended notice of opposition is granted. The first amended notice of opposition, filed April 21, 2011, is now opposer's operative pleading in this proceeding.

Suspension<sup>2</sup>

Proceedings herein are suspended pending disposition of opposer's motion (filed May 13, 2011) for summary judgment. Except as explicitly stated below, any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. See Trademark Rule 2.127(d).

Applicant's answer to the amended notice of opposition is due twenty (20) days from the date of the telephone conference on opposer's motion for leave to amend.

Applicant's brief in response to opposer's motion for summary judgment is due thirty-five (35) days from the date of

---

<sup>2</sup> The Board notes opposer's motion (filed May 23, 2011) to suspend proceedings pending disposition of its motion (filed May 13, 2011) for summary judgment. Said motion to suspend, while unnecessary in view of Trademark Rule 2.127(d) and the standard practice set forth therein, is nevertheless granted.

said conference. Opposer's reply brief thereon, if any, shall be due in accordance with Trademark Rule 2.127(e)(1).