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

EJW

Mailed: March 28, 2013

Opposition No. 91202562

Boston Athletic Association

v.

Velocity, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of opposer's fully briefed motion (filed September 19, 2012) to amend the notice of opposition.

On March 28, 2013, the parties, Boston Athletic Association (represented by Barbara Barakat and Michael Bevilacqua of Wilmer Cutler Pickering Hale and Dorr LLP) and Velocity, LLC (represented by Andrea Mealey of Hinckley, Allen & Snyder LLP), and Elizabeth Winter, the assigned Interlocutory Attorney, all participated in a telephone conference regarding opposer's pending motion, discussed below. *See* Trademark Rules 2.120(i)(1) and 2.127(c); and TBMP § 502.06 (3d ed. 2011).

Decision

- *Sufficiency of Allegations in Notice of Opposition*

  As will be discussed *infra*, opposer seeks to amend the

notice of opposition and, in support thereof, contends that its proposed amendments thereto merely "clarify" the allegations and claims set forth in its original pleading. Conversely, applicant argues, *inter alia*, that opposer's motion is an untimely attempt to add a new claim to the opposition. Insofar as whether opposer is actually proposing to add a new claim will affect the Board's decision to deny or grant opposer's motion to amend, the Board first considers *sua sponte* whether the notice of opposition sets forth claims upon which relief may be granted.

To state a claim upon which relief may be granted, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Specifically, a complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-

pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (*citing Twombly*, 550 U.S. at 555).

Further, all of opposer's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to opposer. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.,* 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *McDermott v. San Francisco Women's Motorcycle Contingent,* 81 USPQ2d 1212 (TTAB 2006), *aff'd,* unpublished No. 07-110 (Fed. Cir. July 11, 2007). Additionally, under the simplified notice pleading rules of the Federal Rules of Civil Procedure, the allegations of a complaint should be "construed so as to do justice." Fed. R. Civ. P. 8(e); *Scotch Whisky Ass'n v. United States Distilled Products Co.,* 952 F.2d 1317, 1319, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991).

Turning first to opposer's allegation related to standing, opposer alleges that "applicant's registration … will prevent Opposer from fairly describing its own services" (¶13). By said allegation, opposer has sufficiently alleged standing by essentially stating that it is a competitor of applicant, and that it is in a position to use the opposed mark in a descriptive manner. *See, e.g.,*

Golomb v. Wadsworth, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979) ("'damage' in either [an opposition or cancellation] -- will be *presumed or inferred* when the mark sought to be registered is descriptive of the goods and the opposer or petitioner is one who has a *sufficient interest* in using the descriptive term in its business").

With respect to opposer's asserted claim of false suggestion of a connection, to sufficiently plead this claim, opposer must allege:

(1) that applicant's mark is the same or a close approximation of opposer's previously used name or identity;

(2) that applicant's mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to opposer;

(3) that opposer is not connected with the goods that are sold or will be sold by applicant under his mark; and

(4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on his goods, a connection with opposer would be presumed.

See L. & J.G. Stickley Inc. v. Cosser, 81 USPQ2d 1956 (TTAB 2007); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). Here, opposer alleges that the mark MARATHON MONDAY has "long been associated" with the Boston Marathon and with the opposer (¶7), that since long prior to the filing date of the instant application, said mark has been associated with opposer and its services (¶8), and that "applicant's mark is not unique and cannot be a source

identifier to applicant due to the mark's longstanding association with the opposer and with the Boston Marathon" (¶12). Opposer has not alleged clearly any of the four elements required under *Buffett v. Chi-Chi's*, including previous use. In view thereof, the notice of opposition fails to state a claim under Section 2(a) of the Trademark Act upon which relief may be granted.

With respect to opposer's claim of likelihood of confusion, opposer must plead (and ultimately prove) that it has a proprietary interest in MARATHON MONDAY and that the interest was obtained prior to the filing date of applicant's intent-to-use application. *See* Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991), *cited in Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993). Opposer has only alleged that "the term 'Marathon Monday' has long been *associated with* the Boston Marathon and with the Opposer (¶7), and that since long prior to the filing date of the instant application, said mark has been *associated with* opposer and its services (¶8) (Board emphasis). Opposer has not specifically identified any particular point in time when opposer began to use the applied-for mark MARATHON MONDAY, therefore, all that the notice of opposition can unequivocally be read to imply is a claim that consumers

began to "associate" the applied-for mark with opposer prior to the filing date of the instant application. The allegations therefore do not allege such facts that, if proved, would establish that opposer is entitled to the relief sought.

Additionally, to set forth a sufficient claim of likelihood of confusion, it is only necessary to generally plead likelihood of confusion. *See The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1639-40 n.21 (TTAB 2007). Here, opposer alleges that the goods identified in the application include goods provided by the opposer in association with the mark BOSTON MARATHON (¶10), and that the parties' respective goods will be marketed in the same or similar trade channels (¶11). Further, the ESTTA cover sheet indicates that one of opposer's claims is likelihood of confusion. Nonetheless, the ESTTA cover sheet and the foregoing allegations do not provide adequate notice that one of opposer's grounds for opposition is likelihood of confusion. Specifically, there is no allegation whatsoever in the notice of opposition that when the mark is used on or in connection with the identified goods, there is a likelihood of confusion, mistake, or deception. *See* 15 U.S.C. § 1052(d). Notice pleading does not require applicant to divine opposer's unstated intentions. In view of the foregoing, the notice of opposition fails to state a

claim under Section 2(d) of the Trademark Act upon which relief may be granted.

With respect to opposer's purported claim that the mark is merely descriptive, opposer's allegations also fail to state a claim upon which relief may be granted. To allege a sufficient claim of descriptiveness, opposer must sufficiently allege that the proposed mark serves merely to denote the ingredients, quality, composition, purposes or characteristics of the identified goods or services. *See, e.g., Virginia Maid Hosiery Mills, Inc. v. Collins & Aikman Corporation*, 203 USPQ 795 (TTAB 1979). Opposer alleges that "applicant's registration of the mark 'MARATHON MONDAY' … will prevent Opposer from fairly describing *its* services" (¶14) (Board emphasis), and that such registration "will prevent Opposer from communicating with participants, fans and the general public to a significant degree" (¶15). While opposer's pleading implies some idea of descriptiveness, or that opposer may use the phrase "Marathon Monday" to describe its own services, opposer has not alleged that the applied-for mark is merely descriptive of *applicant's* goods. In short, when considering opposer's allegations together, the Board cannot fairly read said allegations to provide adequate notice of a descriptiveness claim. *See Levi Strauss & Co. v. Joseph,* 36 USPQ2d 1328, 1330 (TTAB 1994) ("Although the purpose of notice pleading

is to obviate the need to allege particular 'magic words,' the pleading must give […] fair notice of the ground[s] [or defenses] alleged."). Accordingly, the notice of opposition fails to state a claim under Section 2(e)(1) upon which relief may be granted.

In view of the foregoing, opposer is allowed time, as indicated at the conclusion of this order, to submit, if appropriate, an amended notice of opposition with sufficiently pleaded claims for false suggestion of a connection and likelihood of confusion under Sections 2(a) and 2(d) of the Trademark Act.[1]

Further, insofar as the Board finds that applicant did not have proper notice of a claim of descriptiveness, *a fortiori*, opposer's motion to amend must be construed as requesting, in part, to add a claim that the applied-for mark is merely descriptive.

- *Motion to Amend Notice of Opposition*

As last reset in the Board's order dated August 20, 2012, the discovery period was set to close on September 21, 2012. Two days before the close of the discovery period, opposer filed the subject motion to amend (along with a proposed amended notice of opposition), seeking to "clarify" certain factual allegations and claims that are assertedly

[1] Opposer is reminded that the pages of its amended pleading must be numbered. *See* Trademark Rule 2.126(a)(5).

already set forth in the notice of opposition. In particular, opposer seeks to amend paragraphs 7 and 10 of the notice of opposition and to add a new paragraph 15, which opposer asserts is related to its claim that the mark MARATHON MONDAY is merely descriptive of the goods identified in the application. Opposer also contends that applicant will not be prejudiced by the additional reference to its licensees because "Opposer has been answering [discovery] requests with information about [its] goods with the information it has from its licensees" (motion at 2). The proposed new wording is shown below in bold type font and is underlined:

> "7. Since the Boston Marathon takes place on a Monday, the term "Marathon Monday" **is descriptive of the Monday in April on which the Boston Marathon is held and therefore creates an association with the** ~~has long been associated with the~~ Boston Marathon and with the Opposer.
>
> …
>
> 10. The goods identified in Application Serial No. 85/224698 include goods provided by the Opposer **and/or its licensees** in association with [the] mark BOSTON MARATHON and its tradename ("Opposer's Goods").
>
> …
>
> 15. **Application Serial No. 85/224698 for registration of the mark "MARATHON MONDAY" was filed on the basis of an intent to use the mark,**

> **<u>and on information and belief, applicant has not used the mark to a degree to acquire distinctiveness to qualify for registration under 15 U.S.C. § 1052(f).</u>**"

In response to opposer's motion, applicant argues that the motion to amend is untimely insofar as it was filed late in the discovery period and, thus, opposer improperly seeks to add a new ground for opposition, namely, that the applied-for mark is merely descriptive. Further, applicant contends that the changes sought to be made to the notice of opposition are not based on new information gathered during discovery but, rather, are based on information available to it when the notice of opposition was filed. Specifically, applicant argues with respect to ¶10, that opposer knew that it had licensees; and with respect to new ¶15, applicant contends that its date of first use of its mark was available from the application prosecution records and, therefore, opposer knew that applicant had not used its mark for five years or more.

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. rev. 2012), and 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, the Board finds that opposer unduly delayed in filing its motion to amend its pleading to include a new claim. *See Trek Bicycle*, 64 USPQ2d 1540, 1541 (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"). Opposer did not file its motion to amend to add the merely descriptiveness claim until two days prior to the close of the discovery period, and has given no reason why it did not allege its merely descriptiveness claim in its original pleading. Further, the Board does not find opposer's "inadvertent failure" to check the ESTTA box for descriptiveness claim under Trademark Act Section 2(e)(1) to provide sufficient cause for its ten-month delay in seeking to amend its pleading.

Given that opposer unduly delayed in seeking to add its merely descriptiveness claim, the Board also finds that the impact of this delay would be significant and prejudicial to

applicant.[2] It is incumbent upon opposer to identify all claims promptly in order to provide applicant with proper notice. Otherwise, allowing piecemeal prosecution of this case would unfairly prejudice applicant by increasing the time, effort, and money that applicant would be required to expend to defend against opposer's challenge to its application. *Media Online Inc. v. El Clasificado Inc.*, *supra* at 1287.

Additionally, even if opposer had pleaded a sufficient claim that applicant's mark is merely descriptive of its services, it is not necessary for opposer to also plead that the mark has not acquired distinctiveness. Rather, such an allegation is for applicant to assert as an affirmative defense to a claim that its mark is merely descriptive. *See, e.g., Coach Services, Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012); *Colonial Arms Corp. v. Trulock Firearms Inc.*, 5 USPQ2d 1678, 1680 n.5 (TTAB 1987). Therefore, amending the notice of opposition to include a claim that the mark has not acquired distinctiveness would serve no purpose. *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

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[2] It would also be prejudicial to the efficient prosecution of this case, for if the amended pleading were allowed, there would need to be a reopening of discovery and trial, additional briefing, and there would, therefore, be significant delay injected into the proceeding.

Accordingly, opposer's motion for leave to amend the notice of opposition to add proposed paragraphs 7 and 15 is hereby **denied**. Opposer's notice of opposition filed on November 16, 2011, remains opposer's operative pleading in this proceeding. However, insofar as the proposed addition to paragraph 10 (*i.e.*, adding the wording "and/or its licensees") merely serves to amplify the allegations in that paragraph, opposer's motion to amend is **granted** *to the extent* that, should opposer submit an amended notice of opposition pursuant to this order, opposer is allowed to include the proposed amendment to paragraph 10. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973) (allegations amplified).

Proceeding Resumed; Trial Dates Reset

As discussed, opposer is allowed until **THIRTY DAYS** from the mailing date of this order to file and serve an amended notice of opposition comprised of sufficient claims under Sections 2(a) and 2(d) of the Trademark Act, failing which this opposition may be dismissed with prejudice.

Trial dates, including the remaining disclosure due dates, are reset as shown in the following schedule:

Time to File Amended Notice of Opposition	**4/27/2013**
Time to File Amended Answer	**5/27/2013**
Plaintiff's 30-day Trial Period Ends	**7/26/2013**
Defendant's Pretrial Disclosures Due	**8/10/2013**

Defendant's 30-day Trial Period Ends	**9/24/2013**
Plaintiff's Rebuttal Disclosures Due	**10/9/2013**
Plaintiff's 15-day Rebuttal Period Ends	**11/8/2013**

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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