

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

Mailed: July 26, 2012

Opposition No. 91199986

Opposition No. 91202947

Opposition No. 91205388

USA Nutraceuticals Group,
Inc. and Ultra-Lab Nutrition,
Inc., d/b/a Beast Sports

v.

Monster Energy Company

**George C. Pologeorgis,
Interlocutory Attorney:**

This case now comes before the Board for consideration of opposers' motions (filed June 27, 2012) in Opposition No. 91199986 to (1) amend opposers' notice of opposition and (2) extend discovery and subsequent trial dates. Applicant filed timely responses to each of the motions on July 12, 2012.¹

The Board, in its discretion, suggested that the issues raised in opposers' motions should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. rev. 2012). The Board contacted the parties to discuss the date and time for holding the phone conference

¹Opposers' counsel's change of correspondence address filed on July 20, 2012 in each of the above-captioned cases is noted. Board records have been updated accordingly to reflect this change in correspondence address.

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The parties agreed to hold a telephone conference on Wednesday, July 25, 2012 at 4:00 p.m. EDT. The conference was held as scheduled among Ryan M. Kaiser, as counsel for opposers, Matthew S. Bellinger, as counsel for applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

Consolidation

Prior to discussing the merits of opposers' motions, the Board noted that Opposition Nos. 91199986, 91202947, and 91205388 involve the same parties and common questions of law and fact. It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, for example, Wright & Miller, Federal Practice and Procedure: Civil § 2383 (2004); Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) (Board's initiative).*

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Accordingly, Opposition Nos. 91199986, 91202947, and 91205388 are hereby consolidated and may be presented on the same record and briefs.

The Board file will be maintained in Opposition No. 91199986 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties and each paper should bear the case captions as set forth above.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

Opposers' Motion for Leave to Amend the Notice of Opposition in Opposition No. 91199986

We now turn to opposers' motion for leave to amend its notice of opposition in Opposition No. 91199986.

By way of their proposed amendment, opposers now seek to assert their prior common law rights in the mark UNLEASH THE BEAST, and to update the factual allegations concerning opposers' pleaded application for the mark BEAST MODE (which has since matured into a registration). In support of their motion to amend the pleadings, opposers argue that allowing the amendment will not prejudice applicant since applicant

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has requested and has been provided ample discovery regarding opposers' use of the mark UNLEASH THE BEAST. Even if this discovery is deemed insufficient, opposers argue that extending the close of discovery to allow applicant to take even further discovery would alleviate any prejudice to applicant. Moreover, while opposers recognize the fact that Opposition No. 91199986 was instituted over a year ago, they nonetheless maintain that the record shows that much of the delay in this proceeding was due to applicant's repeated extensions of time to file its answer, as well as change in opposers' counsel which caused further unforeseen but necessary delay.

In response, applicant maintains that undue delay alone is sufficient reason to deny opposers' motion to amend. Applicant further argues that, while opposers claim that they have been using the UNLEASH THE BEAST mark since at least as early as 2001 and inasmuch as their BEAST MODE registration issued on June 14, 2011, opposers nonetheless waited until two days before the close of discovery and a year after they filed their notice of opposition to file their motion to amend without any reason for their delay. Finally, applicant maintains that while it has sought some limited discovery on opposers' alleged use of the UNLEASH THE BEAST mark, applicant would be denied the opportunity to

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conduct full discovery regarding the mark and opposers' BEAST MODE mark since discovery is now closed.

Inasmuch as applicant has filed its answer more than twenty one days ago, opposers may amend their notice of opposition only by written consent of applicant or by leave of the Board. See Fed. Civ. P. 15(a); TBMP § 507.02(a) (3d ed. rev. 2012).

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 *id.* See also *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

In deciding whether to grant leave to amend, a tribunal 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).

While we recognize that opposers could have asserted their common law rights in the mark UNLEASH THE BEAST in their originally-filed notice of opposition, we find that allowing them to do so at this juncture in the proceeding will not prejudice applicant. First, we note that, in their initial pleading, opposers, in addition to pleading

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ownership of various pending applications and issued registrations for BEAST formative marks, also alleged common law rights to various marks incorporating the word "BEAST." See Paragraph 10 of opposers' initially-filed notice of opposition. By this allegation, applicant was put on notice that opposers would be relying on their common law rights of various marks incorporating the term BEAST in support of their asserted claims. Applicant therefore was entitled to conduct discovery to ascertain the precise nature of these BEAST marks, as well as opposers' use of such marks. In fact, applicant has conceded that it has already taken discovery regarding opposers' use of the UNLEASH THE BEAST mark. Finally, in light of the consolidation ordered herein, applicant will be afforded additional time to take further discovery regarding opposers' common law use of the UNLEASH THE BEAST mark, if it so chooses. In view of the foregoing, we find that applicant will not be prejudiced by permitting opposers to amend their pleading to include allegations regarding their common law rights in the UNLEASH THE BEAST mark.

With regard to opposers' proposed amendment to include allegations regarding ownership of its resultant registration of the mark BEAST MODE, the Board notes that a plaintiff which pleads ownership of an application in its

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complaint, as is the case here, does not have to amend its pleading to assert the resultant registration, so long as it issues before the plaintiff's testimony period closes. See *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009). The pleading of an application is viewed as providing sufficient notice to the defendant of the plaintiff's intention to rely on any registration that issues from the pleaded application. *Id.* In view thereof, there is no need for opposers to amend their notice of opposition to claim ownership of their resultant registration. However, since we have found opposers' proposed amendment to include allegations regarding their common law rights in the mark UNLEASH THE BEAST permissible and because the registration of which opposers now seek to claim ownership issued prior to the close of opposers' testimony period, we see no harm in allowing opposers' to amend their pleading to include allegations of ownership of this resultant registration.

Moreover, based on the record herein, we do not find any bad faith or dilatory motive on the part of opposers in seeking to amend their pleading. Nor do we find opposers' proposed amendment futile. We also note that this is the first time opposers have sought to amend their pleading.

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In view of the foregoing, opposers' motion to amend their notice of opposition in Opposition No. 91199986 is **GRANTED** in its entirety. The Board notes that opposers provided a copy of their amended notice of opposition with their motion papers. The amended notice of opposition is now the operative pleading in Opposition No. 91199986.

Opposers' Motion to Extend Discovery and Trial Dates in Opposition in Opposition No. 91199986

In light of the consolidation ordered herein and the trial schedule set forth below in view of such consolidation, opposers' motion to extend discovery and trial dates in Opposition No. 91199986 is deemed moot and will be given no further consideration.

Trial Schedule

As ordered above, Opposition Nos. Opposition Nos. 91199986, 91202947, and 91205388 are hereby consolidated. In accordance with Board practice, discovery, disclosure and trial dates are reset to conform to the dates latest set in the proceedings that are being consolidated. In this instance, however, the Board notes that the deadlines for the parties' discovery conference and initial disclosures in Opposition No. 91205388 have not yet expired, while such deadlines have already passed in Opposition Nos. 91199986 and 91202947. Accordingly, Opposition Nos. 91199986 and 91202947 are hereby suspended until the deadline for initial

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disclosures in Opposition No. 91205388, as set forth below, has expired, after which all three cases consolidated herein will proceed simultaneously pursuant to the trial schedule provided below. The only exceptions to the above is that (1) applicant is allowed twenty days from the mailing date of this order in which to file and serve its answer to opposers' amended notice of opposition in Opposition No. 91199986 and (2) the parties are allowed thirty days from the mailing date of this order in which to serve responses to any outstanding discovery in Opposition Nos. 91199986 and 91202947.²

The trial schedule for these now consolidated proceedings is reset as follows:

Deadline for Discovery Conference in Opposition No. 91205388	8/9/2012
Discovery Opens in Opposition No. 91205388	8/9/2012
Initial Disclosures Due in Opposition No. 91205388	9/8/2012
Expert Disclosures Due for all three consolidated cases	1/6/2013
Discovery Closes for all three consolidated cases	2/5/2013
Plaintiff's Pretrial Disclosures Due	3/22/2013
Plaintiff's 30-day Trial Period Ends	5/6/2013
Defendant's Pretrial Disclosures Due	5/21/2013

²The allotment of time to respond to outstanding discovery in Opposition Nos. 91199986 and 91202947 does not constitute an order to compel discovery but merely serves as a scheduling order.

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Defendant's 30-day Trial Period Ends	7/5/2013
Plaintiff's Rebuttal Disclosures Due	7/20/2013
Plaintiff's 15-day Rebuttal Period Ends	8/19/2013

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. 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.