

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

Baxley

Mailed: January 11, 2013

Opposition No. 91205896

Beau L. Tardy

v.

Wild Brain Entertainment, Inc.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of opposer's motion (filed October 4, 2012) for leave to file an amended notice of opposition. Applicant filed a brief in response thereto.

Opposer, appearing *pro se*, commenced this proceeding by filing a notice of opposition on July 3, 2012. After applicant filed an answer herein and five days prior to the deadline for the parties' discovery conference, opposer's attorney entered an appearance herein and filed a motion to extend the deadline for the discovery conference. The Board granted the motion to extend in a September 10, 2012 order. Prior to the reset deadline for the parties' discovery conference, opposer filed the motion for leave to amend.

In support of its motion for leave to amend, opposer contends that he wishes to rely upon a newly pending application, to amplify and clarify issues raised in

the original notice of opposition and to add a new claim of no bona fide intent to use the mark in commerce. Opposer filed a proposed amended notice of opposition with its motion for leave to amend.

In response, applicant contends that, in the proposed amended notice of opposition, opposer is basing his opposition on different trademark rights than he did in the original notice of opposition; that allowing the motion for leave to amend will require applicant to respond to a series of new allegations; and that the proposed additional claim of no bona fide intent to use is not pleaded in accordance with Fed. R. Civ. P. 9(b). Accordingly, applicant asks that the Board deny opposer's motion for leave to amend.

Because an answer is of record herein, opposer may amend the 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)(1)(A); TBMP Section 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, be prejudicial to the rights of the adverse party or parties, or be futile. See *id.*

The motion for leave to amend was filed less than a month after opposer's attorney entered an appearance herein

and prior to the opening of the discovery period. The record herein does not indicate that applicant will be prejudiced by allowing opposer to amend his pleading herein. That is, there is no indication that applicant's capacity to defend this opposition will be adversely affected by allowing the proposed amendment. See *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997).

Moreover, opposer has pleaded sufficient allegations of his standing and claims of priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), and of no bona fide intent to use at the time of the filing of the involved application.¹ See Trademark Act Section 1(b), 15 U.S.C. Section 1051(b); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Contrary to applicant's assertion, a claim of no bona fide intent to use a mark in commerce is not a fraud claim. See *SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 USPQ2d 1300 (TTAB 2010). Accordingly, Fed. R. Civ. P. 9(b) and the pleading requirements for fraud claims are inapplicable to no bona fide intent to use claims. See *id.*

¹ Whether opposer can prevail on these claims is a matter for resolution on the merits after introduction of competent evidence. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

Accordingly, the motion for leave to amend is granted. The amended notice of opposition is accepted as the operative complaint herein.

Notwithstanding the foregoing, the Board notes the following. In paragraph 1 of the amended notice of opposition, opposer states that "DIZZY is the brand name owned by Beau Tardy as an individual and as several business entities...." The electronic cover sheet of the original notice of opposition states that the sole opposer herein is Beau L. Hardy, an individual. Because the time in which to oppose has expired, opposer may not add any opposers through an amended notice of opposition. See Trademark Act Section 13(a), 15 U.S.C. Section 1063(a); Trademark Rule 2.101(c). Accordingly, Beau L. Hardy in his individual capacity remains the sole opposer herein and any reference to other business entities is to nonparty related companies. See Trademark Act Section 5, Trademark Act Section 1055.

In paragraph 4, opposer states that he claims common law rights in the DIZZY mark for goods, "many of which are in [International Class] 9 and identified in the new application [Serial No.] 85741800" and for "[p]roduction of television commercials, television programs, cartoons, animation, games, screensavers and other forms of entertainment." To the extent that opposer intends to rely on common law rights in the DIZZY mark beyond those

Opposition No. 91205896

specifically alleged in the amended notice of opposition, i.e., the goods identified in application Serial No. 85741800 and "[p]roduction of television commercials, television programs, cartoons, animation, games, screensavers and other forms of entertainment," opposer must seek leave of the Board to file a second amended notice of opposition in which he provides fair notice of any specific additional common law rights in the DIZZY mark upon which he intends to rely herein. See Fed. R. Civ. P. 15(a); TBMP Sections 506.01 and 507.02.

In paragraph 5, opposer states that his "predecessor-in-interest abandoned any rights it had in the DIZZY Marks and DIZZY trade names and that [he] is the sole owner of the rights with privity of interest dating back to 1996." Applicant's arguments regarding the meaning of this sentence are premature.

To the extent that opposer seeks to make of record a copy of his application Serial No. 85741800, filed October 2, 2012, for the mark DIZZY for goods in International Class 9 as an exhibit to the amended notice of opposition, opposer must make such copy of record during his testimony period. See Trademark Rule 2.122.

Proceedings herein are resumed. Dates herein are reset as follows.

Answer Due
Deadline for Discovery Conference

2/8/2013
3/10/2013

Discovery Opens	3/10/2013
Initial Disclosures Due	4/9/2013
Expert Disclosures Due	8/7/2013
Discovery Closes	9/6/2013
Plaintiff's Pretrial Disclosures Due	10/21/2013
Plaintiff's 30-day Trial Period Ends	12/5/2013
Defendant's Pretrial Disclosures Due	12/20/2013
Defendant's 30-day Trial Period Ends	2/3/2014
Plaintiff's Rebuttal Disclosures Due	2/18/2014
Plaintiff's 15-day Rebuttal Period Ends	3/20/2014

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.

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