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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212024
Party	Plaintiff Republic Technologies (NA), LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85/551,808 for S.O.B. Published in the Official Gazette on July 23, 2013 REPUBLIC TECHNOLOGIES (NA), LLC, Opposer, v. BROOKS ENTERTAINMENT, INC., Applicant.	**Opposition No. 91212024**

REPLY IN SUPPORT OF REPUBLIC TECHNOLOGIES'
MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION

In its response, Applicant fails to show any legitimate basis for the Board to depart from the bedrock principle that motions for leave to amend pleadings should be granted freely as justice requires, so long as the proposed amendment is legally sufficient and would not unduly prejudice the other party. Republic Technologies' proposed amendment is properly and sufficiently pleaded; Republic Technologies did not unduly delay in filing its motion; and the proposed amendment would not harm Applicant in any way recognized by the Board as being relevant to this proceeding. Accordingly, Republic Technologies' motion should be granted.

I. Republic Technologies' Proposed Amendment Is Legally Sufficient

An amendment to a pleading is legally sufficient when it is properly pleaded. "[O]pposer need only allege in its amended pleading such facts as would, if proven, establish both its standing to challenge applicant's right to registration *and* a further statutory ground for opposition to the application." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d (BNA) 1503, 1506 (TTAB 1993) (emphasis in original). Republic Technologies' proposed Amended Notice of Opposition establishes its standing based on its ownership of its JOB marks. The Amended Notice also alleges that Applicant did not use the S.O.B. mark in interstate commerce at the time it filed its application, and that Applicant did not maintain a bona fide business establishment in the Dominican Republic when its Dominican trademark registration issued. These allegations, if proven, invalidate Applicant's bases for registration under § 1(a) and § 44(e), providing two new grounds for opposition in addition to Republic Technologies' original claim of likelihood of confusion. Accordingly, the Amended Notice of Opposition is properly pleaded and legally sufficient.

Applicant asserts that Republic Technologies' motion is without merit because it sets forth "impermissible, additional and different grounds" for a new claim. Resp. at 4. Applicant, however, fails to support its claim that the new claim is impermissible.[1] Instead, Applicant improperly reiterates the arguments it made in its response to Republic Technologies' motion for summary judgment, namely that it has produced sufficient evidence to defeat Republic Technologies' claims or, in the alternative, it may "cure" its defects by amending its application.[2] These arguments address whether or not Republic Technologies can prove its allegations, not the

[1] Claiming "additional and different" grounds for opposition is inherent in a motion for leave to amend and cannot coherently provide a basis for opposing the motion.

[2] Applicant, however, has not filed a motion to amend its application, and such a motion would be deferred until disposition of summary judgment, as discussed in Republic Technologies' Reply in Support of Its Motion for Summary Judgment.

sufficiency of the allegations. "Whether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment." TBMP § 507.02; *see also Karsten Mfg. Corp. v. Editoy AG*, 79 U.S.P.Q.2d (BNA) 1783, 1785 n.5 (TTAB 2006) (refusing to consider arguments that "consist merely of further arguments against opposer's motion for summary judgment" because they constitute an impermissible surreply to the summary judgment motion). Applicant's contentions regarding the merits of Republic Technologies' allegations are therefore irrelevant to the legal sufficiency of the instant motion and should not be considered.

II. Republic Technologies Did Not Unduly Delay in Filing Its Motion

Applicant asserts that Republic Technologies' motion is untimely because Republic Technologies "has known about Applicant's application for nearly nine (9) months," Resp. at 5, and now brings the motion too long after the close of discovery. Resp. at 2. These contentions are neither correct nor sufficient to show prejudice to Applicant through undue delay by Republic Technologies.

Republic Technologies' awareness of the existence of Applicant's application is irrelevant. On its face, the application itself does not reveal the bases of Republic Technologies' challenges to the registration of Applicant's mark under § 1(a) and § 44(e). Rather, the bases for those challenges were not revealed by evidence until Applicant served its responses to Republic Technologies' final discovery requests, along with responsive documents, on May 16, 2014, 25 days after the close of discovery on April 21, 2014. Republic Technologies filed the instant motion on June 12, 2014, 27 days after Applicant completed its discovery responses and document production. A period of less than one month does not constitute a long delay. *See, e.g.,*

Karsten Mfg. Corp., 79 U.S.P.Q.2d at 1786 (accepting amended notices of opposition where opposer filed in May after learning of new grounds for opposition during discovery in February); *Commodore Electronics Ltd.*, 26 U.S.P.Q.2d at 1506 (finding motion for leave to amend timely where opposer filed approximately one month after denial of summary judgment). Moreover, pleadings in an opposition proceeding may be amended to conform to the evidence during and even after trial, 37 C.F.R. § 2.107. The trial period for this proceeding has not yet begun. Republic Technologies' motion, therefore, is timely.

III. Republic Technologies' Proposed Amendment Would Not Be Prejudicial to Applicant's Rights

Republic Technologies' proposed amendment will not prejudice Applicant in any way recognized by the Board as sufficient to deny a motion. Leave to amend pleadings "must be freely given when justice so requires, unless the entry of the proposed amendment would … be prejudicial *to the rights* of the adverse party." *Hurley Int'l LLC v. Volta*, 82 U.S.P.Q. 2d (BNA) 1339, 1341 (TTAB 2007) (emphasis added). The adverse party must be prejudiced in terms of its due process rights in conducting the proceeding; mere commercial inconvenience is insufficient. *Id* (finding no prejudice where applicants argued that amendment would further delay them in their pursuit of commercial interests, but motion for leave to amend was filed prior to trial); *cf. Black & Decker Corp. v. Emerson Electric Co.*, 84 U.S.P.Q.2d (BNA) 1482, 1486 (TTAB 2007) (finding prejudice where opposer filed motion for leave to amend after the close of the trial period because applicant "had no opportunity to present evidence on this issue to refute or explain the testimony on which opposer relies in support of this ground").

In its response, Applicant concedes that it would not suffer prejudice relative to this proceeding if Republic Technologies' motion were granted. Instead, as in *Hurley*, Applicant argues that it will be inconvenienced commercially by the proposed amendment. Resp. at 7

("Applicant anticipated that this proceeding would conclude by the end of 2014 so that it could move its business forward according to the ruling. This delay will also result in unnecessary delay and higher costs to Applicant because its ability to grow the business is limited without a ruling in this proceeding"). However, also as in *Hurley*, Republic Technologies filed its motion for leave to amend prior to the trial period and promptly after becoming aware of its new grounds for opposition. Thus, as in *Hurley*, Republic Technologies' motion for leave to amend should be granted because Applicant's claim of economic inconvenience does not constitute prejudice recognized by the Board.

Moreover, any facts or evidence that may refute Republic Technologies' allegations as to Applicant's use of the mark in interstate commerce and Applicant's business activities in the Dominican Republic relate to Applicant's business and are already in Applicant's possession, custody or control. It does not require (and has not requested) any discovery regarding these issues. Applicant has the opportunity to present such facts and evidence in response to Republic Technologies' motion for summary judgment and, if necessary, during the trial period in this matter. Therefore, Republic Technologies' proposed amendment will not prejudice Applicant as to its due process rights in conducting this proceeding.

CONCLUSION

Applicant has not offered any sustainable argument against the propriety of Republic Technologies' Motion for Leave to File an Amended Notice of Opposition. Republic Technologies' proposed amendment is legally sufficient because it establishes Republic Technologies' standing and alleges facts setting forth additional grounds for opposition. The motion is timely, having been filed less than one month after Republic Technologies became aware of the new grounds for opposition through discovery. Finally, the proposed amendment

will not prejudice Applicant in any relevant way. Accordingly, Republic Technologies respectfully requests that the Board grant its motion and allow it leave to file its Amended Notice of Opposition.

Respectfully submitted,

REPUBLIC TECHNOLOGIES (NA), LLC

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Dated: July 17, 2014

CERTIFICATE OF SERVICE

I, Andrew S. Fraker, an attorney, state that, pursuant to 37 CFR §§ 2.101, 2.111, and 2.119, I caused a true and correct copy of the foregoing **Reply in Support of Motion for Leave to File Amended Notice of Opposition** to be served upon:

Richard B. Jefferson
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via U.S. Mail, with a courtesy copy sent via email, on July 17, 2014.

/Andrew S. Fraker /
Andrew S. Fraker

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