UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: May 31, 2016

Opposition No. 91212768

INTS It Is Not The Same, GmbH

v.

Disidual Clothing, LLC

George C. Pologeorgis,
Administrative Trademark Judge:

This case now comes before the Board for consideration of Opposer's motion (filed March 1, 2016) for leave to amend its notice of opposition. Opposer included a copy of its proposed amended pleading with its motion papers. The motion is fully briefed.

Opposer's Motion for Leave to Amend Pleadings

By way of its motion, Opposer seeks to amend its pleading to add the following three additional grounds for opposition: (1) the involved application is void *ab initio* because Applicant was not using its subject mark on all the identified goods at the time Applicant filed its use-based application; (2) Applicant is currently not using its mark on all the goods identified in its involved application and, therefore, the mark is abandoned with regard to those goods; and (3) fraud.

In support thereof, Opposer maintains that it obtained the information needed to formulate the basis of the proposed three additional claims when it received

responses to its written discovery on August 11, 2015. However, in an effort to mitigate the amount of time and resources the parties and the Board would need to dedicate to this proceeding, Opposer contends that it first filed a motion for summary judgment on November 11, 2015 on its already asserted claim of likelihood of confusion. When the motion for summary judgment was denied by the Board on February 17, 2016, Opposer states it shortly thereafter filed its motion for leave to amend its pleading. Accordingly, Opposer argues that it has not delayed in seeking to amend its pleading.

In response, Applicant contends that allowing Opposer to amend its pleading at this juncture in the proceeding would prejudice Applicant through piecemeal prosecution of this case. Moreover, Applicant maintains that Opposer unduly delayed in seeking to amend its pleading because it received Applicant's responses which formulate the basis for its new claims on August 11, 2015 but waited until two days before the opening of its testimony period, i.e., March 1, 2016, to seek leave to amend its pleading.

Decision

Inasmuch as Applicant filed its answer in this proceeding more than twenty one days ago, Opposer may amend its 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) (2015).

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).

In this instance, the Board, based upon the record, does not find any evidence of bad faith or dilatory motive on the part of Opposer in seeking to amend its pleading. Moreover, the Board notes that although it would have been a better practice to seek leave to amend its pleading shortly after Opposer received Applicant's responses to its written discovery, the Board nonetheless does not find undue delay on the part of Opposer in seeking to amend its pleading at this moment in the proceeding. Opposer moved for leave to amend its pleading shortly after the Board issued an order denying the parties' cross-motions for summary judgment on Opposer's claim of likelihood of confusion. Moreover, the concept of "undue delay" is inextricably linked with the concept of prejudice to the non-moving party, *see Marshall Field & Co. v. Mrs. Field Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) and, in this case, the Board finds no such prejudice to Applicant in allowing Opposer to add its proposed three new claims at this juncture in the proceeding, particularly since there is no need for Applicant to conduct discovery on these claims inasmuch as any evidence regarding Applicant's use of its involved mark or

any representations it made in its subject application would be in Applicant's own possession, custody and control.

Moreover, because this is the first instance where Opposer has sought to amend its notice of opposition, the Board does not find that Opposer has abused its right to amend its pleading.

With regard to the futility of Opposer's proposed claims, the Board notes that, although not futile, Opposer's proposed claim that Applicant did not use its mark on some of the goods identified in its involved application at the time it filed its involved application, if proven, will only result in the entering of judgment against Applicant solely in regard to those goods that Applicant failed to use its mark in connection therewith at the time it filed its use-based application. It would not render the entire application void *ab initio*. *See Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696 (TTAB 2006) ("The case law is clear that holding an application to be void is an appropriate remedy when the pleaded ground either is fraud, or that the applicant has not used the applied-for mark on any of the goods or services identified in the application prior to the filing of the application."); *see also* 6 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:73 (4th ed., updated March 2016) (citing "The Grand Canyon Rule").[1]

With regard to Opposer's proposed abandonment claim, the Board finds the claim deficiently pleaded. To set forth a cause of action to oppose the registration of a mark which allegedly has been abandoned, a plaintiff must allege ultimate facts

[1] The Board finds Opposer's proposed fraud claim sufficiently pleaded and that it is not a futile claim.

pertaining to the alleged abandonment that, if proved, would establish a prima facie case. *Otto International, Inc. v. Otto Kern GMBH*, 83 USPQ2d 1861, 1863 (TTAB 2007). To provide fair notice to a defendant, such a pleading must allege at least three consecutive years of non-use, or must set forth facts that show a period of nonuse less than three years, together with an intent not to resume use. *See* Trademark Act § 45, 15 U.S.C. § 1127.

Although Opposer has pleaded that (1) Applicant failed to use its mark on some of the goods identified in its application at the time it filed it use-based application, i.e., belts, gloves, dresses, and knit fact masks; (2) Applicant has been unable to produce any documentary evidence demonstrating use of the mark on these goods; and (3) Applicant is currently not using its mark on these goods, Opposer nevertheless failed to allege affirmatively that Applicant has not commenced use of its mark on "belts, gloves, dresses, and knit fact masks" and has no intention to commence such use.[2]

In view of the foregoing, Opposer's motion for leave to amend its pleading is **GRANTED** to the extent that Opposer is allowed until **June 15, 2016** in which to file and serve a revised amended pleading which properly asserts a claim of abandonment pursuant to the guidelines set forth above, failing which Paragraphs 18-22 of Opposer's amended pleading filed on March 1, 2016 will be stricken with prejudice. In turn, Applicant is allowed until **fifteen (15) days** from the date

[2] As with Opposer's proposed nonuse claim, if Opposer can prove its proposed abandonment claim (if perfected pursuant to this order), judgment will be entered against Applicant solely in connection with the goods for which Applicant has abandoned its use of its mark. It would not render Applicant's entire application void *ab initio*.

indicated on the certificate of service of Opposer's revised amended pleading in which to file and serve its answer or otherwise respond to the revised amended pleading.

In the event Opposer fails to file and serve a revised amended pleading by the deadline set forth herein, Applicant is allowed until **June 30, 2016** in which to file and serve its answer or otherwise respond to Opposer's amended pleading filed on March 1, 2016, excluding Paragraphs 18-22 of the amended pleading.

Opposer is allowed until **July 10, 2016** in which to supplement its pretrial disclosures, if necessary and appropriate, to take into consideration the additional grounds for opposition asserted in Opposer's amended pleading.

Trial Dates

Discovery is closed. Remaining trial dates are reset as follows:

30-day testimony period for plaintiff's testimony to close	**August 20, 2016**
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	**September 4, 2016**
30-day testimony period for defendant and plaintiff in the counterclaim to close	**October 19, 2016**
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	**November 3, 2016**
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	**December 18, 2016**
Counterclaim Plaintiff's Rebuttal Disclosures Due	**January 2, 2017**
15-day rebuttal period for plaintiff in the counterclaim to close	**February 1, 2017**
Brief for plaintiff due	**April 2, 2017**

Brief for defendant and plaintiff in the counterclaim due	**May 2, 2017**
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	**June 1, 2017**
Reply brief, if any, for plaintiff in the counterclaim due	**June 16, 2017**

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 Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.