

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: January 3, 2016

Opposition No. 91213744

Yuko Fujita

v.

Pearl Enterprises, LLC

**Robert H. Coggins,  
Interlocutory Attorney:**

Now before the Board is Opposer's motion (filed August 19, 2015) to amend the notice of opposition.<sup>1</sup> The motion is fully briefed.

Motion to Amend

Opposer moves to amend the notice of opposition to add a ground that the subject application is void *ab initio* (Count II).

Leave to amend pleadings must be freely given 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* Trademark Rule 2.107(a); Fed. R. Civ. P. 15(a)(2). The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be

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<sup>1</sup> Applicant's change of correspondence address (filed September 10, 2015) is noted and entered.

prejudiced by allowance of the proposed amendment. *See ChaCha Search Inc. v. Grape Tech. Grp. Inc.*, 105 USPQ2d 1298, 1300 (TTAB 2012); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007). A motion for leave to amend should be filed as soon as any ground for such amendment, e.g., newly discovered evidence, becomes apparent. A long delay in filing a motion for leave to amend may render the amendment untimely. *See ChaCha Search*, 105 USPQ2d at 1300 (citing *Int'l Fin. Co. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002)).

The original Notice of Opposition was filed on November 27, 2013, almost two years before the motion to amend was filed.

The following proposed, new allegations are relevant to Count II:

5. On May 31, 2013, Applicant filed a Voluntary Amendment to its application for KINOKI for the purpose of amending the identification of goods to “aromatic body care products, namely, non-medicated body and foot scrubs in the form of cleansing foot pads for cosmetic purposes.”

6. Per a check of TSDR on August 19, 2015, Applicant’s Voluntary Amendment to its identification of products was never entered by the trademark examining attorney. Therefore, the operative identification of goods remains “aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream.”

14. The specimen submitted with Applicant’s application for KINOKI consists of a photograph of Applicant’s product packaging.

15. The specimen describes Applicant’s KINOKI products as “cleansing detox foot pads.”

16. The specimen does not show use of Applicant’s KINOKI mark in connection with any of the products recited in Applicant’s application, namely “aromatic body care products, namely, body lotion, shower gel,

cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream.”

Proposed First Amended Notice of Opposition (24 TTABVUE 5 and 6-7).

In her main brief on the motion to amend, Opposer states that she was unaware at the time she filed her original Notice of Opposition of the facts supporting the proposed new ground; however, Opposer provides no facts in her main brief to support this conclusory statement of being “unaware.” In her reply brief, Opposer states that she also believes Applicant’s specimen to be the packaging of either one of Opposer’s licensees or a private label customer of a licensee. Opposer then explains that:

The fact that the specimen appeared to be a copy of Opposer’s packaging was brought to Opposer’s attorney’s attention when working on discovery responses served by Applicant. At that point, a closer view of the identification was reviewed and compared to the specimen. Based on that review, Opposer filed its motion to amend the complaint.

Reply brief, pp 1-2 (28 TTABVUE 2-3). Opposer fails to identify the date on which she discovered that the specimen might be from a licensee or a private label customer thereof, or the date on which this belief was brought to her counsel’s attention. The lack of specificity is glaring. However, the licensee/private label customer issue is a red herring. It does not matter that Opposer eventually mentioned to her counsel that Applicant’s specimen may be packaging from one of her licensees or a private label customer of a licensee because the specimen has not changed – it existed and was readily accessible to Opposer on the date she filed her original Notice of Opposition. The real issue is when Opposer could or should have discovered that the specimen of record allegedly fails to support use of the

identification of goods in the underlying application. The identification of goods, the pre-examination amendment, and specimen of use were all present in the application file when Opposer filed her original Notice of Opposition. The alleged facts underlying Count II in paragraphs 5, 6, 14, 15, and 16 (except for the allegation that Opposer checked TSDR on August 19, 2015) existed long before the opposition was filed on November 27, 2013.<sup>2</sup> Apparently, Opposer failed to review the complete record for the subject application until some unspecified date (when she was “working on discovery responses served by Applicant”). Moreover, Opposer does not allege that the specimen which triggered her eventual review of the case file was only (or first) made available to her during discovery. Indeed, Exhibit B to the reply brief reveals that Opposer relies on the very specimen that is part of the subject application file.

The prospective ground that the subject application is void *ab initio* (Count II) was apparent, though not recognized, by Opposer when the original Notice of Opposition was filed. Opposer has failed to provide a sufficient explanation as to why the proposed ground was not apparent or could not have been known to her then. The Board can only surmise that she did not review the complete application file history (including specimen) to ascertain the alleged facts which form the basis of proposed Count II.

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<sup>2</sup> Moreover, it is noted that Opposer filed a 90-day request for an extension of time to oppose on September 17, 2013, in which Opposer stated that she needed additional time to investigate her claim and confer with counsel. Opposer is also silent as to why she did not review the application file (its history, identification, and specimen) during this period.

The Board finds that Applicant would suffer prejudice if Opposer is permitted to add the claims at this juncture. In this particular instance, Opposer did not claim that she learned of Count II through discovery or was otherwise unable to learn about the ground prior to or shortly after filing her original Notice of Opposition. Opposer therefore had ample time to file a motion for leave to amend her pleading at an earlier stage in the proceeding. It was 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 the subject application. *See Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286-87 (TTAB 2008) (motion for leave to amend denied where proposed new claims were based on facts within petitioner's knowledge or easily ascertainable at the time petition to cancel was filed; petitioner could have easily undertaken review of material prior to filing of the petition to cancel or by prompt investigation conducted immediately thereafter).

Accordingly, Petitioner's motion to amend is **denied**.

Schedule

Proceedings are **resumed**. Dates are **reset** on the following schedule:

Plaintiff's Pretrial Disclosures	January 25, 2016
30-day testimony period for plaintiff's testimony to close	March 10, 2016
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	March 25, 2016
30-day testimony period for defendant and plaintiff in the counterclaim to close	May 9, 2016

Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	May 24, 2016
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	July 8, 2016
Counterclaim Plaintiff's Rebuttal Disclosures Due	July 23, 2016
15-day rebuttal period for plaintiff in the counterclaim to close	August 22, 2016
Brief for plaintiff due	October 21, 2016
Brief for defendant and plaintiff in the counterclaim due	November 20, 2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	December 20, 2016
Reply brief, if any, for plaintiff in the counterclaim due	January 4, 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 Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.