

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: April 15, 2014

Opposition No. 91214091
(Parent Case)
Opposition No. 91214147

Villanueva Holding Company LLC

v.

David Reynoso Urzua A/K/A David
Reynoso

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

On April 14, 2014, applicant filed a counterclaim seeking to cancel opposer's pleaded Registration No. 4495282 on the following grounds: (1) opposer is not the owner of its pleaded mark, (2) opposer has not used the mark in commerce at the time it filed its underlying application or at the time it filed its Statement of Use, (3) fraud, and (4) mere descriptiveness under Section 2(e)(1) of the Trademark Act.

A party may amend its pleading once as a matter of course within 21 after serving it. Fed. R. Civ. P. 15(a)(1). Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board. *See* TBMP § 507.02 (3d ed. rev. 2 2013). In this instance, applicant filed his counterclaim more than 21 days after he filed his answers to each notice of

Opposition No. 91214091

Opposition No. 91214147

opposition in this consolidated matter. Further, applicant failed to file an accompanying motion for leave to amend his pleadings to assert a counterclaim and brief in support thereof.¹

In view thereof, applicant's counterclaim filed on April 14, 2014 **will be given no further consideration.**²

Trial dates for this consolidated proceeding remain as set forth in the Board's February 25, 2014, order. Discovery is open.

¹ The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations, as is the case here. Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i). *See* TBMP § 507.02(b). As provided therein, if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned. *Id.*

² The fee for the counterclaim will be refunded in due course.