

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

RK

Mailed: August 4, 2014

Opposition No. **91215038**

Marshall Amplification plc

v.

Kiaico, Inc.

By the Board:

This matter comes up on opposer's motion (filed June 9, 2014) to dismiss applicant's counterclaim. The motion is contested.

Background

By the Board's institution order of February 21, 2014, applicant was allowed until April 2, 2014, to serve and file its answer. On March 25, 2014, applicant served and filed its answer to the notice of opposition. On April 7, 2014, applicant served and filed a counterclaim to cancel opposer's pleaded Registration No. 3940239. On June 9, 2014, opposer filed a motion to dismiss the counterclaim as untimely.

Decision

Trademark Rule 2.106(b)(2)(i) provides as follows:

A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are

known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

Based on the nature of the claims applicant seeks to assert against opposer's pleaded registration, i.e., likelihood of confusion, non-use and abandonment, and as applicant has not argued that the grounds for the claims were discovered after service of its answer, the counterclaims are compulsory. However, Trademark Rule 2.107(a) provides that "[p]leadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court"

Fed. R. Civ. P. 13 relate to counterclaims and crossclaims. Under the 2009 amendments, Fed. R. Civ. P. 13(f), relating to omitted counterclaims, was abrogated so as to establish Fed. R. Civ. P. 15 "as the sole rule governing amendment of a pleading to add a counterclaim." *Committee Notes on Rule 15* (2009 Amendment). Fed. R. Civ. P. 15(a)(1)(A) provides that a party may amend its pleading once as a matter of course within 21 days after serving it. Here, applicant served its original answer on March 25, 2014, and served its counterclaim 13 days later on April 7, 2014. As the counterclaim was served within 21 days of the original answer, applicant's counterclaim is timely.

In view thereof, opposer's motion to dismiss is hereby **DENIED**.

Proceedings herein are **RESUMED** in accordance with the following schedule:¹

Answer to Counterclaim Due	9/5/2014
Deadline for Discovery Conference	10/5/2014
Discovery Opens	10/5/2014
Initial Disclosures Due	11/4/2014
Expert Disclosures Due	3/4/2015
Discovery Closes	4/3/2015
Plaintiff's Pretrial Disclosures	5/18/2015
30-day testimony period for plaintiff's testimony to close	7/2/2015
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	7/17/2015
30-day testimony period for defendant and plaintiff in the counterclaim to close	8/31/2015
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	9/15/2015
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	10/30/2015
Counterclaim Plaintiff's Rebuttal Disclosures Due	11/14/2015
15-day rebuttal period for plaintiff in the counterclaim to close	12/14/2015
Brief for plaintiff due	2/12/2016
Brief for defendant and plaintiff in the counterclaim due	3/13/2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	4/12/2016
Reply brief, if any, for plaintiff in the counterclaim due	4/27/2016

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 taking of testimony. Trademark Rule 2.125.

¹ Notwithstanding applicant's prior request for Board participation in the parties' discovery conference, should applicant still desire the Board's involvement, applicant is advised to formally renew the request at least 10 days prior to the deadline for conducting the discovery conference, as reset.

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Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b).
An oral hearing will be set only upon request filed as provided by Trademark
Rule 2.129.

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