

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Contact Number: 571-272-8500

wbc

Mailed: August 18, 2015

Opposition No. 91215087

U.S. Marine Corps

v.

Peter J. Healy

**Wendy Boldt Cohen, Interlocutory Attorney:**

This case now comes before the Board on Opposer's motion filed, April 30 2015, to amend its notice of opposition to allege an additional claim of lack of bona fide intent to use. The motion is fully briefed.<sup>1</sup> The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion and does not recount them here, except as necessary to explain the Board's order.

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<sup>1</sup> Applicant, in its response to the motion, prematurely includes arguments on the merits of the pleaded claims. When considering a motion to amend a pleading, the Board does not consider the merits of the plaintiff's standing or its claims, but only considers whether the pleading is sufficient to state a claim to relief that is plausible on its face. *Cf. Bell Atl. Corp. v Twombly*, 550 U.S. 544, 570 (2007); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992). 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, and the nonmoving party should not argue against granting the moving party leave to amend merely because the non-moving party believes the moving party will not be able to prove the additional claim or allegations at trial. *See* TBMP § 507.02; *Cf.* TBMP § 503.03. In view thereof, the Board has not considered the multitude of arguments on the merits in considering the motion.

Pursuant to Fed. R. Civ. P. 15(a), a party to an *inter partes* proceeding before the Board may amend its pleading once as a matter of course within twenty-one days after serving it. Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; and leave must be freely given when justice so requires. *See* TBMP § 507.02 (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 Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007); *id.*

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). “[T]he Board does not grant such leave when entry of the proposed amendment would be prejudicial to the right of the adverse party.” *Black & Decker Corp.*, 84 USPQ2d at 1486. “The timing of the motion for leave to amend is a major factor in determining whether a party would be prejudiced by allowance of the proposed amendment.” *International Finance Company v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002); *Black & Decker Corp.*, 84 USPQ2d at 1486; *see* TBMP § 507.02 and cases cited therein. 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. *Id.* “Any party who delays filing a

motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion.” *Id.* (citations omitted).

In support of its motion, Opposer maintains that it learned of the basis for its proposed claim during discovery. Discovery closed January 31, 2105; however, Opposer waited until April 30, 2015 with just one day left in its trial period to file the instant motion. Opposer offers no sufficient justification as to why it failed to raise its proposed claim earlier. If Opposer believed the information it obtained through discovery provided an additional ground for opposition, it should have immediately moved, pursuant to Rule 15(a), to amend the pleadings to assert the additional ground. *See Donut Shops Management Corp. v. Mace*, 209 USPQ 615, 625 n.9 (TTAB 1981). In short, Opposer had ample time to file its motion to amend at an earlier stage in this proceeding. Additionally, allowing this claim now would require reopening of discovery (even if only for Applicant’s benefit)<sup>2</sup> which would entail further delay of trial.

In view thereof, the Board finds on the record before it that Opposer unduly delayed in filing its motion to amend. *See Foman*, 371 U.S. at 182; *Trek Bicycle Corporation v. StyleTrek Limited*, 64 USPQ2d 1540, 1541 (TTAB 2001).

Additionally, Opposer’s pleading of its claim of lack of bona fide intent to use is insufficient.<sup>3</sup> Opposer’s pleading is conclusory in nature<sup>4</sup> and does set forth any facts

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<sup>2</sup> Opposer argues that it does not seek additional discovery for itself but that it is agreeable to the Board reopening discovery for Applicant’s benefit.

<sup>3</sup> Section 1(b) of the Trademark Act provides in pertinent part that: “A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a

which would give Applicant fair notice of why Opposer believes that Applicant lacked the bona fide intent required by Section 1(b) to use the mark MARINE ONE DOWN when it filed the involved application. *See M.Z Berger & Co., Inc. v. Swatch AG*, 114 USPQ2d 1892, 1897-98 (TTAB 2015); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha Opposition*, 26 USPQ2d 1503, 1506 (TTAB 1993).

Accordingly, Opposer's motion to amend its pleading is **denied**.

Proceedings are resumed. The Board finds the filing of the motion to amend as tolling the running of the remaining dates. Dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	<b>8/25/2015</b>
Defendant's Pretrial Disclosures	<b>9/9/2015</b>
Defendant's 30-day Trial Period Ends	<b>10/24/2015</b>
Plaintiff's Rebuttal Disclosures	<b>11/8/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/8/2015</b>

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. 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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trademark in commerce may request registration of its trademark on the principal register....”

<sup>4</sup> Opposer's pleading of lack of bona fide intent to use merely recites Section 1(b) and alleges that Applicant lacks a bona fide intention to use the mark in commerce on the identified goods. *See Amended Pleading* at ¶ 9.