

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

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Mailed: September 24, 2015

Opposition No. **91215512**

Body Vibe International, LLC

v.

David Cox¹

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on a series of motions filed by the parties: (1) Applicant's motion for leave to amend his answer (filed January 13, 2015); (2) Opposer's motion for sanctions (filed January 23, 2015); and (3) Opposer's motion for extension of the discovery period and for suspension pending disposition of the motions (filed January 23, 2015). Each of the motions is contested.

By way of background, Opposer filed a notice of opposition on March 19, 2014, against Application Serial No. 85966358² on a claim of likelihood of confusion. By the Board's institution order, Applicant was allowed until April

¹ Applicant's change of correspondence (filed March 18, 2015) has been noted and entered.

² For the mark DR. VAPE in standard characters for "electric vaporizers" in International Class 11. The application was filed on June 21, 2013, under Section 1(a) of the Trademark Act.

28, 2014, to file his answer. Applicant filed his answer on April 24, 2014, and an amended answer on April 28, 2014.

On July 25, 2014, Opposer moved to amend the notice of opposition to add a claim of “not in lawful use in commerce” which the Board allowed on October 3, 2014. Two weeks later on October 17, 2014, Applicant filed his answer to the amended notice of opposition.

On December 19, 2014, Opposer served Applicant with a proposed motion for sanctions under Fed. R. Civ. P. 11 based on responses made by Applicant in his answer to the amended notice of opposition. In response, Applicant sought leave to amend his answer on January 13, 2015, and filed a proposed answer with the motion. On January 23, 2015, the last day of discovery as reset, Opposer filed its opposition to the motion for leave to amend and formally filed its motion for Rule 11 sanctions. Opposer also moved to extend discovery and to suspend this proceeding pending disposition of the pending motions.

Opposer’s Motion for Sanctions under Fed. R. Civ. P. 11

Fed. R. Civ. P. 11 states, in pertinent part, as follows:

(b) **Representations to the Court.** By presenting to the court a pleading, written motion, or other paper – whether by signing, filing, submitting, or later advocating it – an attorney or unrepresented party certifies that to the best of the person’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

- (1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;

- (2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;
- (3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

(c) **Sanctions.**

...

- (2) **Motion for Sanctions.** A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates Rule 11(b). The motion must be served under Rule 5, but it must not be filed or be presented to the court if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service or within another time the court sets. If warranted, the court may award to the prevailing party the reasonable expenses, including attorney's fees, incurred for the motion.

The safe harbor provision of Fed. R. Civ. P. 11(c)(2) requires the party moving for sanctions to first serve the motion on its opponent to provide notice and to afford the other party the opportunity to withdraw or correct the challenged paper or any part thereof within twenty-one (21) days of service.³

Opposer served Applicant with its potential motion for sanctions on December 19, 2014. By correspondence dated December 30, 2014, Applicant

³ If service is made by first-class mail, Priority Mail Express®, or overnight courier, five (5) additional days are provided by operation of Trademark Rule 2.119. *See* Fed. R. Civ. P. 11(c)(2) (“within 21 days after service or within another time the court sets”); *Matrix IV, Inc. v. American Nat. Bank and Trust Co. of Chicago*, 649 F.3d 539, 552 (7th Cir. 2011) (“21-day window specified in Rule 11 is a floor, not a ceiling”).

sought Opposer's consent to file an amended answer with the Board. On January 9, 2015, twenty-one (21) days after service of its motion, Opposer responded to Applicant's request conditioning its consent on being permitted to review and ultimately determine whether Applicant's proposed pleading cured the putative deficiencies. Foregoing Opposer's consent, Applicant filed a motion for leave to amend his answer on January 13, 2015, i.e., twenty-five (25) days after service of Opposer's motion but within the five (5) additional days provided under Trademark Rule 2.119. Notwithstanding Applicant's filing, Opposer nevertheless filed its December 19 sanctions motion with the Board on January 23, 2015, arguing in a cover memorandum to the motion that "Applicant is attempting to avoid a ruling on this Rule 11 motion by filing a last minute motion to amend his answer one or two days before Opposer may file this Rule 11 motion." *Opposer's Motion for Rule 11 Sanctions*, 12 TTABVUE 3. The contention is not well taken.

It has been observed that some of the "general purposes of the safe harbor provision include protecting litigants from sanctions whenever possible in order to mitigate Rule 11's chilling effect [and] encouraging the withdrawal of papers that violate the rule" without involving the court, in this case the Board. *See* Wright, Miller, Kane, Marcus and Steinman, *5A Fed. Prac. & Proc. Civ.* § 1337.2 (3d ed.). In filing its motion, Opposer complains of the very thing that the safe harbor provision is designed to encourage. Applicant sought to withdraw the putatively offending pleading by timely filing a

motion for leave to amend his answer, yet not only did Opposer proceed with filing a motion for sanctions, it filed a motion directed to a pleading which Applicant has actively sought to withdraw. *See Dee-K Enters., Inc. v. Heveafil Sdn. Bhd.*, 177 F.R.D. 351, 355 (E.D.Va. 1998) (by filing motion for leave to file a second amended complaint, plaintiffs had “informally withdrawn” first amended complaint).

In view thereof, the Board finds that Opposer failed to comply with the safe harbor provisions of Fed. R. Civ. P. 11. As such, Opposer’s motion for sanctions is hereby **DENIED**.

Applicant’s Motion for Leave to Amend Answer

Turning then to Applicant’s motion for leave to amend his pleading, Applicant seeks to amend the seventh paragraph and third defense in his answer.

As Applicant’s amendment is outside the time allowed under Fed. R. Civ. P. 15(a)(1) for amendments made as a matter of course, Applicant may amend his pleading only with Opposer’s written consent or by leave of the Board pursuant to Fed. R. Civ. P. 15(a)(2). That rule further directs the Board to “freely give leave when justice so requires.” Thus, the Board is generally liberal in granting leave to amend pleadings “unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.” *Int’l Fin. Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). Furthermore, “[i]n the absence of any apparent or

declared reason – such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. – the leave sought should, as the rules require, be ‘freely given.’” *Foman v. Davis*, 331 U.S. 178, 182 (1962) (quoted with approval in *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993)).

Concerning the amendment to ¶ 7 of Applicant’s answer, the amendment was precipitated by Opposer’s notice of a Rule 11 motion for sanctions. As Applicant has conceded that he “inadvertently answered only two” of three allegations in ¶ 7 of Opposer’s amended notice of opposition and, by the proposed amendment, Applicant seeks to more fully respond to Opposer’s allegations, the Board does not view the amendment as violative of settled law or prejudicial to the rights of Opposer.⁴

As to Applicant’s amendment of his third defense, Applicant has merely amplified the basis of the defense. Again, the amendment is neither violative of settled law nor prejudicial to Opposer’s rights. *See, e.g., Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539, 541 (TTAB 1973) (allegations amplified).

⁴ To the extent that Opposer believes and has based its motion for Rule 11 sanctions on the notion that Applicant’s pleading contradicts evidence pleaded in its notice of opposition, Opposer is reminded that it is inappropriate to plead evidentiary matters in a complaint as such matters are for proof and not for pleading. *See McCormick & Co. v. Hygrade Food Prods. Corp.*, 124 USPQ 16, 17 (TTAB 1959).

In view thereof, Applicant's motion for leave to amend his answer is hereby **GRANTED**. Applicant's amended answer of January 13, 2015, is **ACCEPTED** and is now Applicant's operative pleading herein.

Opposer's Motion to Suspend Proceedings and to Extend Discovery

Proceedings herein were suspended by the Board on March 2, 2015. As to Opposer's request to extend discovery, it is noted that the request was made prior to the close of discovery, albeit on the last day. As such, Opposer need only demonstrate good cause for the requested extension. *See* Fed. R. Civ. P. 6(b)(1)(A).

Here, Opposer has already propounded its first set of discovery requests and has otherwise failed to demonstrate a need for discovery other than that related to Applicant's amendment to his answer. As Applicant may also require discovery relating to amendments to his third defense, Opposer's motion to extend discovery is hereby **GRANTED** and the parties are allowed until **NOVEMBER 2, 2015**, to take follow-up discovery relating to the amendments to Applicant's pleading.⁵

To be clear, Opposer should not view this extension as an opportunity to notice and renew its motion for Rule 11 sanctions. The purpose of pleadings is to give notice of a claim or defense, *see Hickman v. Taylor*, 329 U.S. 495, 67 S.Ct. 385, 388 (1947), not to substitute for proof. Applicant has met the

⁵ In view of the limited nature of the discovery allowed, the Board has allowed a period of discovery less than the ninety (90) days requested by Opposer.

pleading requirements of Fed. R. Civ. P. 8(b). As such, the parties are ordered to complete discovery and proceed to trial.

Proceedings herein are **RESUMED** and dates are **RESET** as follows:

Limited Discovery Closes	11/2/2015
Plaintiff's Pretrial Disclosures Due	12/17/2015
Plaintiff's 30-day Trial Period Ends	1/31/2016
Defendant's Pretrial Disclosures Due	2/15/2016
Defendant's 30-day Trial Period Ends	3/31/2016
Plaintiff's Rebuttal Disclosures Due	4/15/2016
Plaintiff's 15-day Rebuttal Period Ends	5/15/2016

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.

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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