

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: October 3, 2014

Opposition No. 91215512

BODY VIBE INTERNATIONAL, LLC

v.

DAVID COX

Cheryl S. Goodman, Interlocutory Attorney:

On April 28, 2014, Applicant filed an amended answer, and on July 25, 2014, Opposer filed a motion for leave to amend the notice of opposition. Opposer's motion for leave to amend has been opposed by applicant.

Applicant's amended answer is accepted. Fed. R. Civ. P. 15(a).

The Board now turns to Opposer's motion for leave to amend.

Opposer seeks to amend the notice of opposition to add a claim of "not in lawful use in commerce." Opposer asserts that the parties were discussing settlement since the filing of the opposition, but now that settlement discussions have "broken down" the parties are preparing to commence discovery. Opposer states that neither party has served discovery as of the filing of the motion for leave to amend. Opposer indicates that it learned of the new claim in July 2014 while preparing its discovery requests after viewing a YouTube video and Facebook related to Applicant. Opposer

submits that this case is still in its early stages as discovery has not yet closed and allowing amendment will cause no prejudice to Applicant as the parties were involved in settlement and have not commenced discovery.

In response, Applicant argues that the addition of the “not in lawful use in commerce” claim “is unnecessary to facilitate a decision on the merits” as to priority and that permitting the allegation would “impose undue prejudice” by creating delay, “increas[ing] the scope of discovery, contribut[ing] to additional and protracted litigation expense” and increasing attorneys’ fees. Applicant also argues that the “not in lawful use in commerce” claim is futile. Lastly, Applicant contends that allowing the amendment “will not serve judicial economy.”

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *See e.g., Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); and *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993). In deciding Opposer's motion for leave to amend, the Board must consider whether there is any undue prejudice to Applicant and whether the amendment is legally sufficient. *See, e.g., Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974).

The timing of the motion for leave to amend is a major factor in determining whether applicant would be prejudiced by allowance of the proposed amendment. See TBMP § 507.02 (2014) and cases cited therein. A motion for leave to amend should be filed as soon as the basis for amendment becomes apparent. A long and unexplained delay in filing a motion for leave to amend may render the amendment untimely. See TBMP § 507.02(a); *International Finance Company v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). Any party who delays in 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 Fed. R. Civ. P. 15(a) and risks denial of that motion. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286-87 (TTAB 2008), citing Wright, Miller and Kane, *Federal Practice and Procedure: Civil* 2d, Section 1488.

Futility of amendment

On a motion for leave to amend, the Board need not determine the merits of the proposed claim, but merely satisfy itself that the plaintiff has alleged sufficient facts to state a claim upon which, if proved, relief can be granted. *Polaris Industries Inc. v. D.C. Comics*, 59 USPQ2d 1798, 1799 n.4 (TTAB 2000).

To the extent that Applicant has argued the merits of the “not in lawful use in commerce” claim, these arguments have not been considered.

The Board finds that Opposer has sufficiently alleged “not in lawful use in commerce” to state a claim. Therefore the proposed amendment is not futile.

Prejudice

An adverse party’s burden of undertaking discovery, standing alone, is not sufficient to warrant denial of a motion to amend the pleading. *United States v. Continental Illinois Nat’l Bank and Trust Co. of Chicago*, 889 F.2d 1248, 1255 (2d Cir. 1989). On the other hand, the time and expense of continued litigation, with the possibility of additional discovery, can be a basis for finding prejudice in connection with a motion to amend. *See Media Online Inc.*, 88 USPQ2d at 1286-87 (finding undue delay in opposer seeking leave to amend seven months after filing of notice of opposition; leave to amend prejudicial to applicant, as “allowing piecemeal prosecution of this case [by granting leave to amend] 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 its registration”); *Ascon Properties, Inc. v. Mobil Oil Co.*, 866 F.2d 1149, 1161 (9th Cir.1989) (same). *See also Phelps v. McClellan*, 30 F.3d 658, 663 (1994) (leave to amend may be prejudicial if it requires opponent to expend significant additional resources to conduct discovery and prepare for trial or if it significantly delays resolution of the dispute). However, such prejudice generally occurs after the parties have conducted a significant amount of discovery or the case is ready for trial (or summary judgment has been granted or is pending). *See e.g.*

Williamsburg Wax Museum, Inc. v. Historic Figures, Inc., 810 F.2d 243, 247 (D.C.Cir.1987) (leave to amend prejudicial when moving party offered no explanation for its delay and attempted to raise an entirely new issue by amendment after the parties had conducted extensive discovery, and after the district court had granted a summary judgment motion); *Gonzalez v. St. Margaret's House Dev. Fund Corp.*, 613 F.Supp. 60, 62 (S.D.N.Y.1985) (leave to amend denied where additional discovery would delay trial).

The Board does not find that Opposer unduly delayed in seeking leave to amend. Opposer learned of information relating to the “not in lawful use in commerce claim” in July 2014, and the motion for leave to amend was filed on July 25, 2014. Additionally, discovery remains open in this proceeding, and neither side has commenced discovery because the parties were discussing settlement.¹ This is not a case where the parties have already conducted extensive discovery such that allowing amendment would constitute piecemeal litigation nor is this a case where the claims are altered and it is close to trial. The Board finds that amending the complaint will not require the expenditure of significant additional resources in conducting discovery as discovery has not yet begun nor will allowance of the amendment significantly delay the resolution of the case.

¹ Four months remained for discovery at the time of filing the motion for leave to amend.

Accordingly, the Board finds no prejudice to Applicant in allowing amendment of the notice of opposition. In view of the foregoing, the motion to amend is granted and the first amended notice of opposition is accepted.

Applicant is allowed until TWENTY DAYS from the mailing date of this order to file its answer.

Opposer's request to extend is granted to the extent that discovery is extended by sixty days.

Dates are reset as follows:

Expert Disclosures Due	12/24/2014
Discovery Closes	1/23/2015
Plaintiff's Pretrial Disclosures	3/9/2015
Plaintiff's 30-day Trial Period Ends	4/23/2015
Defendant's Pretrial Disclosures	5/8/2015
Defendant's 30-day Trial Period Ends	6/22/2015
Plaintiff's Rebuttal Disclosures Due	7/7/2015
Plaintiff's 15-day Rebuttal Period Ends	8/6/2015

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.