

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

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Mailed: August 11, 2016

Opposition No. **91218001 (parent)**
Cancellation No. **92061234**

*Tod's S.p.A.*¹

v.

Mycoskie, LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on Opposer/Petitioner's (hereinafter "Opposer") motion to amend its pleadings (filed December 17, 2015) and Applicant/Respondent's ("Applicant") cross-motion (filed January 13, 2016) to take the oral deposition of Stefano Sincini, a foreign resident. The motions have been fully briefed.

The Board presumes the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted in connection with the briefing of the motions. As such, this order will not summarize the proceeding background or recount the parties' arguments except as necessary.

¹ Opposer's change of correspondence (filed March 28, 2016) has been noted and entered.

Opposer's Motion to Amend its Pleadings

In its notice of opposition and petition for cancellation, Opposer asserted claims of likelihood of confusion and dilution. By way of its motion to amend, Opposer seeks to withdraw its dilution claim from both the opposition and cancellation proceedings and to add a claim of no bona fide intent to use as against the involved application.² Applicant opposes the amendments as untimely, prejudicial and in bad faith.

Fed. R. Civ. P. 15(a)(2), made applicable to Board proceedings by Trademark Rule 2.116, directs a court to “freely give leave [to amend] when justice so requires.” Accordingly, 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.” *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board’s determination of whether the adverse party would be prejudiced by the allowance of the amendment. A long and unexplained delay in seeking to amend a pleading when there is no question

² Application Serial No. 86004044 for TOMS in standard characters for “goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals” in International Class 18.

of newly discovered evidence may render the amendment untimely. *See, e.g., Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008).

Lack of a Bona Fide Intent to Use

Turning first to the lack of a bona fide intent to use claim, Applicant contends that Opposer unduly delayed in asserting the claim which is putatively based on discovery responses made as early as ten months prior to the motion to amend. *See Applicant's Response and Cross-Motion*, 18 TTABVUE 22-23. It is Opposer's position, however, that while Applicant's failure to produce documents demonstrating a bona fide intent to use the mark on all of the goods in the involved application may have hinted at a lack of a bona fide intent to use claim, Opposer "proceeded in a reasonable fashion by only seeking to amend after it had taken depositions to confirm the claim's validity," which depositions "did not proceed until the Fall [sic] of 2015" pursuant to an agreement between the parties. *See Opposer's Reply*, 22 TTABVUE 5; *Reply Declaration of Richard S. Mandel*, 22 TTABVUE 20-21.

In considering the circumstances herein, the Board does not find undue delay or bad faith on the part of Opposer so as to preclude the newly proposed claim. Although Opposer's claim relies, in part, on Applicant's putative failure to produce, as part of its February production, documents demonstrating a bona fide intent to use the mark on all of the goods in the involved application, it was not unreasonable for Opposer to confirm the validity of the claim through discovery depositions which, by agreement of

the parties, were held later in the year. Since the deposition³ supporting the bona fide intent claim did not occur until November 20, 2015, and the transcript thereof was not received by Opposer until December 7, 2015, *see id.* at 23, the Board finds neither undue delay nor bad faith in Opposer's subsequent filing of its motion to amend on December 17, 2015.

Nor does the Board find undue prejudice to Applicant in allowing the new claim. There has been no unfair surprise to Applicant in Opposer's assertion of the claim as the issue of Applicant's bona fide intent was raised by Opposer in its first set of discovery requests, *Declaration of Richard S. Mandel* ("Mandel Declaration"), Exh. B, 14 TTABVUE 42, addressed by the parties in follow up correspondence, *Declaration of Louis S. Ederer*, Exhs. 12 & 13, 18 TTABVUE 153-58, and later listed as one of the topics in Opposer's Rule 30(b)(6) deposition notice. *Mandel Declaration*, Exh. C, 14 TTABVUE 68. Furthermore, although the motion to amend was filed two days after the close of discovery, the newly proposed claim will have little impact on Applicant's discovery needs as any evidence concerning Applicant's bona fide intent is within the possession, custody and control of Applicant.

Since Opposer's pleading of a lack of a bona fide intent to use is legally sufficient, Opposer's motion to add this claim to the notice of opposition is hereby **GRANTED**. To minimize any potential prejudice to Applicant from the addition of this claim, Applicant is allowed until **THIRTY DAYS** from

³ Deposition of Brigid Stevens.

the mailing date of this order to supplement its discovery responses and document production accordingly.

Withdrawal of Dilution Claim

As part of its motion for leave to amend, Opposer further seeks to withdraw its claim of dilution from both the notice of opposition and petition for cancellation. Applicant opposes the amendment to the extent that the withdrawal of the dilution claim will also serve “to retract [Opposer’s] allegation of fame,” which allegation Applicant asserts it relied on in “conduct[ing] a costly survey” to test for confusion and the withdrawal of which will undermine Applicant’s survey results resulting in “substantial prejudice” to Applicant. *See Applicant’s Response and Cross-Motion*, 18 TTABVUE 24. The contention is not well taken.

Clearly, Applicant will not suffer prejudice in having one less claim to defend against should Opposer be allowed to withdraw its dilution claim. Yet Applicant’s claim of prejudice is based less on the withdrawal of the dilution claim than the withdrawal of Opposer’s allegation of fame, an allegation which, the Board notes, the parties have not stipulated to and Applicant has explicitly denied in its answer. Indeed, the Board finds Applicant’s claim of prejudice vis-à-vis its expert survey overstated considering that “fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts.” *Weider Publ’ns, LLC v. D&D Beauty Care Co., LLC*, 109 USPQ2d 1347, 1354 (TTAB 2014). *See also Palm Bay Imp., Inc. v. Veuve Clicquot*

Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (“While dilution fame is an either/or proposition -- fame either does or does not exist -- likelihood of confusion fame ‘varies along a spectrum from very strong to very weak’”) quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003). Thus, notwithstanding Applicant’s contentions to the contrary, the Board sees little prejudice to Applicant in allowing Opposer to withdraw its dilution claim and its concomitant allegation of fame.

Opposer’s motion for leave to amend is hereby **GRANTED**. As the withdrawal comes after Applicant’s answer and without Applicant’s consent, Opposer’s dilution claim is **DISMISSED with prejudice**. See Trademark Rule 2.106(c).

Opposer’s Amended Combined Notice of Opposition and Consolidated Cancellation Petition is **ACCEPTED** and is now the operative pleading herein. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to serve and file its answer thereto.

Applicant’s Cross-Motion For Oral Deposition of Stefano Sincini

By its motion, Applicant seeks to take the oral deposition of Stefano Sincini, Opposer’s “co-CEO, Executive Director and General Manager” and a resident of Italy. See *Opposer’s Opposition to Cross-Motion*, 20 TTABVUE 6 and 10; *Declaration of Stefano Sincini*, 20 TTABVUE 44-45. Mr. Sincini is further identified as “Chairman of the Board of Directors of [Opposer’s] New

York based affiliate, Deva Inc.” *Id.* It is Applicant’s position that notwithstanding Mr. Sincini’s foreign residency, he should be subject to an oral discovery deposition in the United States since he “regularly travel[s] to the U.S. ... to conduct [Opposer’s] and Deva [sic] business, and to attend Deva Board meetings.” *Applicant’s Response and Cross-Motion*, 18 TTABVUE 14.

Trademark Rule 2.120(c)(1) provides as follows:

The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

Thus, the discovery deposition of a witness located in a foreign country, assuming such depositions are allowed by that country, must be taken on written questions in accordance with Trademark Rule 2.124 unless the parties stipulate or the Board orders, on motion for good cause, that the deposition be taken by oral examination. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998).

Although Applicant points to Mr. Sincini’s various connections to the United States⁴ in support of its motion to have Mr. Sincini appear in the United States for an oral deposition, the Board has stated on numerous

⁴ It is noted that the connections referenced by Applicant relate largely to Mr. Sincini’s role as Chairman of Deva Inc., a non-party to this proceeding.

occasions that it will not order a natural person residing in a foreign country to come to the United States for the taking of a discovery deposition.⁵ *See id.* However, as provided under Trademark Rule 2.120(c)(1), the Board may order the discovery deposition of a foreign party or its representative to be taken by oral examination in the country where the witness resides upon a showing of good cause.

Whether good cause exists for an oral deposition is a case-by-case determination based on the particular facts and circumstances of the matter wherein the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition was taken orally in the foreign country. *See Orion Group Inc. v. Orion Ins. Co. P.L.C.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989). Here, Applicant seeks to probe Mr. Sincini's knowledge concerning the reasons for Opposer's delay in seeking to cancel Applicant's registrations, which Applicant asserts is central to its affirmative defenses. *See Applicant's Response and Cross-Motion*, 18 TTABVUE 33. As Mr. Sincini "was the person with overall responsibility for the trademark area, including enforcement decisions relating to [Applicant's] TOMS mark," *Opposer's Opposition to Cross-Motion*, 20 TTABVUE 15, the Board finds good cause in allowing Applicant the opportunity to orally depose Mr. Sincini who has first-hand

⁵ Of course, if a foreign party or its officer, director, or managing agent, is present in the United States during the time for which the deposition is scheduled, he or she would be subject to a deposition by oral examination pursuant to Trademark Rule 2.120(c)(2).

knowledge of, and had a singular role in, the decision to proceed with the opposition and cancellation herein. This is particularly so in view of Applicant's representation that it will "pay[] the travel and accommodation costs of ensuring that [Opposer's] counsel of record is present in Italy for any such deposition." *Applicant's Response and Cross-Motion*, 18 TTABVUE 33 n.29.

In view thereof, Applicant's motion to take the oral deposition of Mr. Sincini is hereby **GRANTED** to the extent that such oral deposition will be taken in Italy. The parties are allowed until **FORTY-FIVE DAYS** from the mailing date of this order to notice, schedule and complete the oral discovery deposition of Mr. Sincini. Discovery remains closed.

Remaining dates are **RESET** as follows:

Plaintiff's Pretrial Disclosures Due	10/25/2016
Plaintiff's 30-day Trial Period Ends	12/9/2016
Defendant's Pretrial Disclosures Due	12/24/2016
Defendant's 30-day Trial Period Ends	2/7/2017
Plaintiff's Rebuttal Disclosures Due	2/22/2017
Plaintiff's 15-day Rebuttal Period Ends	3/24/2017

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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