

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: April 26, 2016

Opposition No. 91218800

Kimberly-Clark Worldwide, Inc.

v.

Matosantos Commercial Corp.

Jennifer Krisp, Interlocutory Attorney:

Inasmuch as the record does not include a filing subsequent to the February 22, 2016 order, this opposition proceeding is now before the Board for consideration of Opposer's October 20, 2015 motion for leave to amend notice of opposition. The motion is fully briefed.

Analysis

Amendments to pleadings in *inter partes* proceedings are governed by Fed. R. Civ. P. 15, which is applicable to Board proceedings by Trademark Rule 2.116(a). TBMP § 507.01 (2015). Fed. R. Civ. P. 15(a) governs amendments before trial. Pursuant to Fed. R. Civ. P. 15(a)(2), where, as here, a party may not amend its pleading as a matter of course,

...a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

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. TBMP § 507.02 (2015). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion to amend. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 (TTAB 2007); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

The timing of a motion to amend is a main factor in determining whether the non-movant would be prejudiced by allowance of the proposed amendment. TBMP § 507.02 (2015), and cases cited therein. The motion should be filed as soon as any ground for the amendment, *e.g.*, newly discovered evidence, becomes apparent. A long or unexplained delay in filing a motion for leave to amend may render the amendment untimely. *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002).

The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of the arguments and submissions, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Opposer requests leave to file an amended notice of opposition wherein it 1) adds a new ¶ 3 pleading ownership of Registration No. 4656343, which registered on December 16, 2014, subsequent to the institution of this proceeding, 2) amends ¶ 4 to add updated information on the status of its two pleaded registrations which expired on August 14, 2015, subsequent to the institution of this proceeding, and 3) adds to ¶ 11 a claim of common law rights.¹

The Board initially notes that the proposed amendments do not violate settled law. Regarding timing of the motion, the record indicates that Opposer informed Applicant of the proposed amendments and provided a copy of the amended pleading on September 21, 2015, in an email formally requesting Applicant's consent to the amendments.² The delay in moving to amend was not unexplained, protracted or unreasonable under these circumstances. The delay does not, in itself, constitute prejudice to Applicant, in large part due to the fact that discovery was set to close on January 4, 2016,³ more than two months after Opposer filed its motion to amend.

Regarding Opposer's amendment to plead Registration No. 4656343, Applicant argues, *inter alia*, that Opposer failed to include a claim of rights in that registered mark. However, Opposer filed the underlying application (Serial No. 86281791)

¹ 10 TTABVUE 2. Opposer's reference to "Registration Nos. 2,918,976" is construed as a typographical error only.

Opposer did not include a red-lined copy. For Opposer's future reference, the Board prefers, with the filing of a motion to amend a pleading, the submission of a red-lined copy showing the proposed changes along with a clean copy of the proposed amended pleading. TBMP § 507.01 (2015).

² 10 TTABVUE 17.

³ 7 TTABVUE 3.

prior to the institution of this proceeding, and also specifically identified this same application in a June 6, 2014 letter to counsel for Applicant, depicting in said letter the then-pending mark as being one of Opposer's trademarks for what Opposer collectively identified as "the Puppy Design" marks.⁴ Opposer's application (now registration) has, from its May 15, 2014 filing date, been a matter of public record in the USPTO database and search system; although this does not equate to a specific pleading that the registration is pleaded and relied upon in the opposition, it does discredit Applicant's arguments questioning Opposer's supposed motives in moving to amend its pleading. On this record, Opposer does not seek to amend to add matter that was covert, hidden, or known only to Opposer at all times. Also, in the original notice of opposition Opposer pointed Applicant to the now-registered mark as a basis for its claim of trademark rights by way of including it as one of the marks in the image accompanying ¶ 6; said image depicts the mark in three instances. Thus, Applicant's argument that Opposer failed to include the mark in its notice of opposition is not entirely credible.⁵

The added pleading of Registration No. 4656343, registered after the notice of opposition was instituted, coupled with the updating of the expired status of two pleaded registrations, Nos. 2918076 and 2918077, and the added allegation of specific common law rights in its puppy design mark, are not amendments that, as Applicant contends, constitute the filing of "practically ... a new case against

⁴ 12 TTABVUE 9.

⁵ 1 TTABVUE 6-7; 10 TTABVUE 6.

Applicant.”⁶ Also of note, Opposer does not seek to add any new claims. The amendments were not filed at the close of discovery, as reset; rather, time remains for Applicant to satisfy its discovery needs that are relevant to the new matters. Applicant does not articulate any specific manner in which allowing the amendments would prejudice Applicant’s ability to address them in discovery or to prepare a defense. Under all of the circumstances of record, the Board finds that the proposed amendments do not prejudice Applicant’s ability to take discovery or to defend this action.

In summary, in view of these findings, and applying the policy that the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, Opposer’s motion for leave to amend is granted.

The first amended notice of opposition is now Opposer’s operative pleading in this proceeding.

Schedule

Proceedings are hereby resumed. Opposer is allowed until ten (10) days from the mailing date of this order to serve on Applicant’s counsel an executed copy of the amended notice of opposition. Applicant is allowed until thirty (30) days from the date of service of the amended notice of opposition to file its answer thereto.

Discovery and trial dates are reset as follows:

Expert Disclosures Due	6/22/2016
Discovery Closes	7/22/2016
Plaintiff's Pretrial Disclosures Due	9/5/2016
Plaintiff's 30-day Trial Period Ends	10/20/2016
Defendant's Pretrial Disclosures Due	11/5/2016

⁶ 12 TTABVUE 5.

Defendant's 30-day Trial Period Ends	12/19/2016
Plaintiff's Rebuttal Disclosures Due	1/3/2017
Plaintiff's 15-day Rebuttal Period Ends	2/2/2017

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 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.