

ESTTA Tracking number: **ESTTA754022**

Filing date: **06/22/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|--|
| Proceeding | 91219179 |
| Party | Defendant United Yacht Transport LLC dba United Yacht Transport |
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| Submission | Opposition/Response to Motion |
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| Date | 06/22/2016 |
| Attachments | UYT_response_to_motion_to_file_third_amended_complaint.PDF(100753 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SPLIETHOFF'S BEVRACHTINGSKANTOOR B.V.,

Opposer,

vs.

**Opposition No. 91219179
Serial No. 86031633**

UNITED YACHT TRANSPORT LLC,

Applicant.

_____ /

**RESPONSE IN OPPOSITION TO OPPOSER'S MOTION FOR
LEAVE TO FILE THIRD AMENDED NOTICE OF OPPOSITION**

Applicant, United Yacht Transport LLC ("United"), respectfully submits that Opposer Spliethoff's Bevrachtingskantoor B.V. ("Spliethoff") should not be permitted to amend its notice of opposition for a third time at this late date in the proceedings. Opposer's motion for leave to amend (Doc. 26) should be denied.

Argument

Spliethoff requests leave to add an additional claim that registration of the UNITED YACHT TRANSPORT mark should be denied based on its allegation that United did not hold a certain license prior to February 2016. Such information was well within Spliethoff's knowledge or ability to obtain prior to filing this proceeding in November 2014. But rather than including such allegations in its original notice of opposition, Spliethoff waited one year and seven months before finally attempting to inject this additional claim into these proceedings. Spliethoff has unduly delayed its request to amend, and leave should be denied.

Under the Federal Rules of Civil Procedure, leave to amend should be freely given "when justice so requires." Fed. R. Civ. P. 15(a)(2); *see* TBMP § 507.02. The Supreme Court has

interpreted the Rule to permit amendment except when there is an “apparent or declared reason—such as undue delay, bad faith or dilatory motive on the part of the movant, ... [or] undue prejudice to the opposing party by virtue of allowance of the amendment....” *Foman v. Davis*, 371 U.S. 178, 182 (1962), quoted in *Trek Bicycle Corp. v. Styletrek Ltd.*, 64 U.S.P.Q.2d 1540, 2001 WL 1869327, at *2 (TTAB 2001).

“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.” *International Fin. Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 2002 WL 1258278, at *7 (TTAB 2002). The Board thus requires motions for leave to amend to be filed “as soon as any ground for such amendment becomes apparent.” *Id.* at *8. “A long delay in filing a motion for leave to amend may render the amendment untimely.” *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361, at *2 (TTAB 2008).

In its motion (Doc. 26) and supporting declaration (Doc. 27), Spliethoff claims to have first learned that United did not previously hold a non-vessel-operating common carrier (“NVOCC”) license in March of 2016 when its counsel first saw a NVOCC license number on United’s website. Implicit in the declaration and motion is that the license number was not listed when Spliethoff’s counsel previously visited (or could have visited) the website at an earlier time, which is Spliethoff’s real claim—that United did not have a NVOCC license prior to February 2016. Such information regarding the absence of a license number on the website was thus available to Spliethoff simply upon accessing United’s website at any time between August 2013 (when United filed its application) and February 2016 (when Spliethoff alleges United obtained the license). The same information regarding the existence and status of United’s NVOCC license was likewise available to Spliethoff and the general public at all times on the

Federal Maritime Commission website. See Federal Maritime Commission, Ocean Transportation Intermediaries (OTI) List, <http://www2.fmc.gov/oti/NVOCC.aspx> (searchable list of licensed NVOCCs) (last visited June 22, 2016), <http://www2.fmc.gov/oti/> (complete OTI list including NVOCCs available for download at upper right button) (last visited June 22, 2016). And Spliethoff could have issued its Freedom of Information Act request to the Federal Maritime Commission at any time, even before it commenced this proceeding.

Spliethoff claims to have learned that United did not have a license before February 2016 through discovery. But the only discovery Spliethoff served with respect to the license consisted of various requests to United. And as Spliethoff concedes, United objected on relevancy grounds and did not provide information in response to the requests. In short, Spliethoff learned of the claim it now seeks to add through visiting United's website and making FOIA requests, not through discovery in this case.

An undue delay will generally be found when the "new claims appear to be based on facts within petitioner's knowledge at the time the petition ... was filed." *Media Online*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361, at *2. Thus, leave to amend will be denied for undue delay where, as here, support for the amendment comes from "access[ing] respondent's web site" and other "actions which could quite easily have been undertaken prior to filing of the petition ..., or by any prompt investigation conducted immediately thereafter." *Id.* Instead of accomplishing such actions before filing this proceeding, Spliethoff waited more than a year and seven months to attempt to add a claim that could have been part of its initial pleading.

Like the respondent in *Media Online*, United would suffer prejudice if Spliethoff is permitted to add its new claims. See 88 U.S.P.Q.2d 1285, 2008 WL 4419361, at *3. Spliethoff did not learn of its new claims through discovery but through information that could have been

obtained well in advance of filing this case. And despite describing when it first learned that United had obtained a license, Spliethoff has never addressed the real issue surrounding the untimeliness of its proposed amendment—why it was unable to learn that United did not have a NVOCC license between August 2013 and February 2016. Under the circumstances, Spliethoff had ample time to seek leave to amend at an earlier stage of the proceedings. *Id.* As the Board held in *Media Online*:

It is incumbent upon petitioner to identify all claims promptly in order to provide respondent with proper notice. Otherwise, allowing piecemeal prosecution of this case would unfairly prejudice respondent by increasing the time, effort, and money that respondent would be required to expend to defend against petitioner's challenge to its registration.

Id. at *3. So it is in this case.

Conclusion

Spliethoff has unduly delayed in seeking leave to amend, and its motion (Doc. 26) should be denied. *See Media Online*, 88 U.S.P.Q.2d 1285 (denying motion for leave to amend filed seven months after commencing case where the supporting facts were known or could have been obtained before the case was filed); *International Fin. Corp.*, 64 U.S.P.Q.2d 1597 (denying leave to amend where opposer waited two years to raise new claim and could not explain why it failed to raise the claim earlier); *Trek Bicycle Corp. v. Styletrek Ltd.*, 64 U.S.P.Q.2d 1540 (denying motion for leave to amend filed eight months after notice of opposition and prior to close of discovery because it was based on facts known to opposer before filing the case and opposer was unable to explain the delay).

Respectfully submitted,

BUSH ROSS, P.A.

Dated: June 22, 2015

By: /s/ Bryan D. Hull

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing has been served on J. Michael Pennekamp and Sandra I. Tart on June 22, 2016 by email to: jpennekamp@fowler-white.com and start@fowler-white.com, and by First Class Mail, postage prepaid to: J. Michael Pennekamp and Sandra I. Tart, FOWLER WHITE BURNETT, P.A., Espirito Santo Plaza, Fourteenth Floor, 1395 Brickell Avenue, Miami, Florida 33131.

Signature: /s/ Bryan D. Hull

Date: June 22, 2016