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

Proceeding	91223497
Party	Plaintiff Jim Beam Brands Co.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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JIM BEAM BRANDS CO.,	)	
	)	
Opposer,	)	Opposition No. 91223497
	)	
v.	)	Serial No. 86/415,114
	)	
BUGLISI RECOBS GROUP LLC,	)	
	)	
Applicant.	)	

OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S REQUEST FOR LEAVE TO AMEND ITS ANSWER

Jim Beam Brands Co. ("Opposer") submits this memorandum in opposition to Buglisi Recobs Group LLC's ("Applicant") Motion for Leave to Amend its Answer ("Applicant's Motion"). Applicant requests leave to amend its Answer to add a counterclaim to cancel a registration or registrations owned by Opposer based on the grounds of deceptive misdecriptiveness, and to also add an affirmative defense of estoppel. Applicant's Motion is untimely, unwarranted, and unfounded, and granting Applicant's Motion would unduly prejudice Opposer.

I. Applicant's Motion is Untimely and Unwarranted

Applicant's Motion to Amend to add a counterclaim should be denied as it is untimely and would be prejudicial to Opposer. An applicant must plead a compulsory counterclaim to cancel an opposer's registration(s) at the time of its Answer if such grounds exist at the time when the answer is filed. 37 CFR § 2.106 (b)(2)(i); 37 CFR § 2.114 (b)(2)(i); TBMP § 313.04; *See, also,* 3 McCarthy § 20:23. The timing of the motion for leave to amend is a major factor in determining whether Opposer would be prejudiced by allowance of the proposed amendment. If grounds for the counterclaim are known to the Applicant when its answer to the complaint is

filed, the counterclaim should be pleaded with or as part of the answer. 37 CFR § 2.106 (b)(2)(i); 37 CFR § 2.114 (b)(2)(i); TBMP § 507.02(b).

Opposer filed its Notice of Opposition on August 26, 2015. In response, Applicant filed its Answer on October 2, 2015. Now, six months later, on April 6, 2016, Applicant requests leave to add a counterclaim to its Answer. However, the information upon which Applicant is basing its attempt to add a counterclaim—a response to an Office Action filed by Opposer's predecessor-in-interest on August 26, 2011—was available to Applicant at the time it originally filed its Answer on October 2, 2015. Moreover, that response was available to Applicant when this Opposition was filed on August 26, 2015.

Applicant claims it is entitled to add its counterclaim because its research, conducted after filing its Answer, revealed a response to an Office Action contained within the prosecution history of one of Opposer's pleaded registrations. (*See* Applicant's Motion to Amend, Affirmation of Patrick C. O'Reilly, Esq., p.1.) Applicant's finding is not only irrelevant to its proposed ground for its counterclaim, namely, deceptive misdescriptiveness, but Applicant has had over six months from the filing of Opposer's Notice of Opposition to access and review the Office Action response, a public record that has been available since the filing of this Opposition, and that continues to be available, on the USPTO website. Thus, Applicant was either aware of grounds for adding a counterclaim when it filed its Answer, or it did not promptly plead a counterclaim after conducting timely research of Opposer's marks pleaded in this Opposition.

This is not a case where Applicant discovered new information through discovery as Applicant has not taken any discovery. Rather, this information was available to Applicant when Applicant first filed its Answer and, as such, Applicant's Motion is untimely and should be

denied. *See ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 U.S.P.Q.2d 1298, 1301 (T.T.A.B. 2012) (denying Applicant's Motion for Leave to Amend counterclaim where parties had not taken discovery and Applicant's proposed additional claim was based on information available to Applicant when it first filed its counterclaim that was included with its Answer); *Media Online Inc. v. El Clasificado Inc.*, 88 U.S.P.Q.2d 1285, 1286-87 (T.T.A.B. 2008) (denying Petitioner's Motion for Leave to Amend because the information at issue was available to Petitioner when it filed its original Petition to Cancel and Petitioner had waited seven months to move to amend). For all of these reasons, Applicant's Motion is untimely.

II. Granting Applicant's Motion Would Be Prejudicial to Opposer

Leave to amend pleadings should only be freely given when justice requires. Federal Rules of Civil Procedure 15(a). Accordingly, leave to amend pleadings should not be given where the defendant will be prejudiced by the amendment. *See ChaCha Search Inc.*, 105 U.S.P.Q.2d 1298 at 1300. The timing of the motion for leave to amend is a major factor in determining whether Opposer would be prejudiced by allowance of the proposed amendment. *Id.*

Here, discovery is set to close May 2, 2016. Opposer will be prejudiced by Applicant's proposed amendment to add its counterclaim, as allowance of the amendment may require additional discovery, thus leading to increased time and expense, and unnecessary prolongation of this Opposition.

III. Applicant Seeks To Add An Affirmative Defense That Does Not Exist in Trademark Law

Applicant's request to include estoppel as an additional affirmative defense should be denied. Though Applicant does not specify which estoppel it seeks to add, the type of estoppel relating to applicant's rationale is known as file wrapper estoppel, an affirmative defense in

patent law based on previous statements asserted by a party during the prosecution of a patent. 6 McCarthy § 32:111 (2015). This form of estoppel does not exist in trademark law, as "a statement made by [a trademark] applicant to the [PTO] does not necessarily estop the applicant from later claiming to the contrary." 6 McCarthy § 32:111 (2015). As well established by the Board, a party's earlier contrary statement or opinion may be used to "illumin[ate] the shade and tone in the total picture confronting the decision maker . . . [but] under no circumstances may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record." *Top Tobacco LP v. North Atlantic Operating Co.,* 101 U.S.P.Q.2d 1163, 1172 (T.T.A.B. 2011) (citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151, 154, 576 F.2d 926 (C.C.P.A. 1978)); *See also Anthony's Pizza & Pasta International Inc. v. Anthony's Pizza Holding Co.*, 95 U.S.P.Q.2d 1271, 1281 (T.T.A.B. 2009).

Because the defense of file wrapper estoppel is generally unavailable in trademark opposition proceedings, allowing Applicant to amend its Answer to assert this defense would be futile. *Barbara's Bakery Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1290 (T.T.A.B. 2007); *see, e.g., National Cable Television Association v. American Cinema Editors Inc.,* 19 U.S.P.Q.2d 1424, 1432, 937 F.2d 1572 (Fed. Cir. 1991); *See, also,* TBMP § 311.02(b). Given that there is no such affirmative defense as that requested by Applicant, and that Applicant may introduce its research findings elsewhere in this opposition proceeding, Applicant's request to add its affirmative defense of estoppel should be denied.

IV. Conclusion

For the above-stated reasons and in the interests of justice and judicial economy, Applicant respectfully requests that the Board deny Applicant's Motion.

Date: April 27, 2016

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC FILING

The undersigned attorney hereby certifies that the attached **OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S REQUEST FOR LEAVE TO AMEND ITS ANSWER** was filed electronically with the Trademark Trial and Appeal Board on April 27, 2016:

Sarah E. Aagaard

CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a copy of **OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S REQUEST FOR LEAVE TO AMEND ITS ANSWER** was served by Federal Express on April 27, 2016 to the following address, such being the Applicant's correspondence address of record as of this date:

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