

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: March 29, 2016

Opposition No. 91222434 (Parent Case)
Opposition No. 91224325

Invicta Watch Company of America Inc.

v.

Invicta S.p.A.

Jennifer Krisp, Interlocutory Attorney:

These proceedings are before the Board for consideration of three fully briefed motions filed in the captioned opposition proceedings by Applicant on December 21, 2015, namely:

- 1) motion to consolidate;
- 2) motion to amend answer; and
- 3) motion to amend application Serial No. 79146181 and 86301552.

The Board has reviewed all of the arguments that the parties have made in briefing the motions, but for efficiency does not set forth and discuss each such argument herein. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Motion to consolidate

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. Fed. R. Civ. P. 42(a). TBMP

Opposition No. 91222434 (parent case)

§ 511 (2015); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

Inasmuch as the parties to Opposition Nos. 91222434 and 91224325 are the same, and the claims, defenses and issues are similar or related, the Board finds that consolidation is appropriate. Applicant's motion to consolidate is granted. Opposition Nos. 91222434 and 91224325 are hereby consolidated and may be presented on the same record and briefs. *Hilson Research Inc. v. Society for Human Resource Management*, *supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. **91222434** as the “**parent case**.” From this point forward, the parties are directed to file only a single copy of all motions, briefs and papers, and each such filing should be filed in the parent

case only, and caption the consolidated proceeding numbers, identifying the “parent case” first, as in the caption to the instant order.¹

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Motion to amend answer

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 under Fed. R. Civ. P. 15(a)(2),

...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 Sys. Inc. v. Houston Computer Svs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990);

¹ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

Giersch v. Scripps Networks Inc., 85 USPQ2d 1306, 1309 (TTAB 2007); *Hurley Int'l 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 delay in filing a motion for leave to amend may render the amendment untimely. *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002).

Applicant requests leave to amend its answer so as to change, in part, its admission of the allegations in ¶ 9 of the notice of opposition, and to correct certain typographical or grammatical errors in its answer to ¶ 4, 5, 11, 12 and 14. Applicant appropriately included a red-lined copy of the amended pleading showing the proposed changes. TBMP § 507.01 (2015).

The proposed amendments to ¶ 4, 5, 11, 12 and 14 are clearly intended to correct inadvertent typographical errors, and do not substantively alter notice provided to Opposer with respect to any of Applicant's admissions or denials. In particular regard to the amendment to ¶ 9, Applicant asserts that it incorrectly admitted, in part, the allegations in that paragraph of the notice of opposition, due to inadvertence, mistake or oversight. The record does not reflect that Applicant unduly delayed in moving to amend. Moreover, when Applicant moved for leave to amend, over four months of discovery remained, as reset by the Board on July 21, 2015; based on this, as well as Applicant's statement that the parties have

exchanged initial disclosures but have not served discovery requests, no apparent prejudice to Opposer is evident from the record. Moreover, Opposer does not cite any specific litigation-related prejudice that it will suffer from allowing the amendments. Opposer's concern that Applicant sought to amend without an explanation can be fully addressed by the parties through discovery.

Based on these findings of record, Applicant's motion for leave to file an amended answer is granted. Applicant's first amended answer filed December 21, 2015 is now its operative pleading in Opposition No. 91222434.

Motion to amend application Serial No. 79146181 and 86301552

In general, an application which is the subject of a Board *inter partes* proceeding may not be amended in substance except with the consent of the other party or parties and with the approval of the Board, or except upon motion granted by the Board. Trademark Rule 2.133(a). Moreover, it is well-settled that an unconsented motion to amend in substance is to be deferred until final decision or until the case is decided upon summary judgment. TBMP § 514.01 (2015), and cases cited therein.

Opposer has not provided its consent to Applicant's proposed amendment to its application.² In view thereof, and consistent with the Board's procedure, consideration of Applicant's unconsented motion to amend its application is

² A proposed amendment to any application or registration which is the subject of an *inter partes* proceeding must also comply with all other applicable rules and statutory provisions, including, in the case of application Serial No. 79146181, various provisions applicable to § 66(a) applications. TBMP § 514.01 (2015).

Applicant cites to various cases which are inapposite, including *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077 (TTAB 2013), the strict requirements of which Applicant's motion to amend does not satisfy, one of which is unconditional consent to the entry of judgment with respect to the broader identification of goods.

deferred until such time as the Board considers these proceedings at final decision or until the proceedings are decided upon summary judgment.

Schedule

Proceedings are resumed. Discovery and trial dates are reset as indicated below:

Expert Disclosures Due	7/2/2016
Discovery Closes	8/1/2016
Plaintiff's Pretrial Disclosures due	9/15/2016
Plaintiff's 30-day Trial Period Ends	10/30/2016
Defendant's Pretrial Disclosures due	11/14/2016
Defendant's 30-day Trial Period Ends	12/29/2016
Plaintiff's Rebuttal Disclosures due	1/13/2017
Plaintiff's 15-day Rebuttal Period Ends	2/12/2017

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.