

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**

Lykos

Mailed: September 14, 2007

Opposition No. 92046796

eSpeed, Inc.

v.

eSpeedient Systems, LLC

Before Bucher, Rogers and Taylor, Administrative Trademark Judges.

By the Board:

This case now comes before the Board for consideration of petitioner's combined motion (filed July 31, 2007) to amend its petition for cancellation pursuant to Fed. R. Civ. P. 15(a) and to extend the close of the discovery and testimony periods in this case pursuant to Fed. R. Civ. P. 6(b). The motion is fully briefed.

By its motion to amend, petitioner seeks to add claims that respondent's mark was not in use in commerce at the time it filed its application under Section 1(a) of the Trademark Act and that respondent fraudulently procured its registration from the USPTO. Petitioner also requests an extension of time to take discovery on its newly added claims. For the reasons set forth below, petitioner's motion to amend and motion to extend are granted.

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. The timing of the motion for leave to amend is a major factor in determining whether respondent would be prejudiced by allowance of the proposed amendment. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); see also TBMP § 507.02(a) (2d. ed. rev. 2004) and cases cited therein. A motion for leave to amend should be filed as soon as any ground for such amendment becomes apparent. In instances where the moving party seeks to add a new claim or defense, the proposed pleading must be legally sufficient. See *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001).

In this case, the Board finds that respondent would not suffer prejudice if petitioner is permitted to add the new claims at this juncture. Petitioner moved to amend over one month prior to the close of discovery as reset by the Board's May 22, 2007 order granting petitioner's previously filed consented motion to extend the close of discovery and trial dates. See e.g., *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990) (proceeding still

in the discovery stage and no undue prejudice shown). Thus, petitioner moved to add its new claims during the discovery phase of this case and well prior to the commencement of trial. See *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted).

Respondent contends that petitioner "seeks further delay in this proceeding" insofar as petitioner is a "massive organization with vast resources and excellent legal representation" and that petitioner could have included its newly asserted claims in its initial pleading. Respondent also contends that petitioner's motion to amend constitutes a dilatory tactic to avoid a final determination on the merits.

We find respondent's argument that petitioner improperly delayed in bringing its motion unpersuasive. According to the record before us, petitioner only became aware of the new allegations it now seeks to add during the discovery process, and promptly sought leave to amend once it became aware of the additional grounds for canceling respondent's registration. More specifically, as set forth in the declaration of Mr. Georges Nahitchevansky, counsel for petitioner, on February 7, 2007, petitioner served respondent with its first set of interrogatories and

document production requests. Within those discovery requests, respondent was asked to provide information and documents regarding its asserted date of first use. Respondent failed to produce any documents in response thereto, and responded to the interrogatories in a conclusory manner. Following the entry of a protective order, on May 30, 2007, respondent produced supplemental responses which consisted of a "handful" of documents. Petitioner, prompted by respondent's meager document production, conducted an independent investigation regarding respondent's purported use of its mark. The investigation was complete in mid-July. Shortly thereafter, petitioner filed its motion to amend on July 31, 2007. Thus, petitioner moved in a timely manner to assert its new claims.

Lastly, we note that both the claims of non-use and fraud are adequately pleaded in the amended petition to cancel.

In view thereof, petitioner's motion to amend its pleading is granted. Petitioner's amended pleading is accepted and entered as the operative petition for cancellation in this case. Respondent is allowed until **THIRTY (30) days** from the mailing date of this order to file an answer to the amended petition for cancellation.

We turn now to petitioner's motion to extend the discovery and testimony periods in this case. Petitioner has requested additional time to take discovery on its new claims, including taking of the deposition of the attorney representing respondent during *ex parte* prosecution who signed the declaration regarding the use of respondent's substitute specimen. In its responsive brief, respondent did not expressly address any of the arguments raised in petitioner's motion to extend. In any event, we find good cause to warrant an extension of the discovery and testimony periods in this case insofar as the information to support petitioner's newly added claims is in the possession of respondent. See Fed. R. Civ. P. 6(b).

Trial dates, including the close of discovery, are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	10/30/07
30-day testimony period for party in position of plaintiff to close:	1/28/08
30-day testimony period for party in position of defendant to close:	3/28/08
15-day rebuttal testimony period for plaintiff to close:	5/12/08

In each instance, a 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.

### **Notice of Final Rulemaking**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>