

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451

coggins

Mailed: June 26, 2009

Cancellation No. 92048454

Fred Beverages, Inc.

v.

Fred's Capital Management
Company

Before Kuhlke, Walsh and Bergsman,
Administrative Trademark Judges

By the Board:

This case now comes up on petitioner's motions to amend the petition (filed August 26, 2008), and to compel discovery and enter discovery sanctions (filed September 22, 2008), and respondent's motion (filed October 14, 2008) to voluntarily surrender Class 32 of its registration.

By way of background, respondent's Registration No. 3051906 is a twelve-class registration. The original petition for cancellation asserts only a ground of abandonment against respondent's Class 32 goods. The original petition was filed on November 13, 2007, and was

accompanied by the appropriate filing fee under Trademark Rules 2.6(a)(16), 2.111(c)(1), and 2.112(b) for cancelling a single class. This proceeding was instituted shortly thereafter, and respondent filed a timely answer. After two motions (one contested and one consented) filed by respondent for extensions of the discovery period, petitioner filed its motion to amend the petition which began the most recent dispute between the parties and now brings this case up for consideration of the motions to amend, to compel, for sanctions, and to surrender.

Voluntary Surrender of Class 32

On October 14, 2008, respondent filed a notice of its voluntary surrender of Class 32 for Registration No. 3051906, without petitioner's written consent. Respondent specifically states that its surrender is for "partial cancellation" of the registration "in Class 32 only." Pursuant to Trademark Rule 2.172:

Upon application by the registrant, the Director may permit any registration to be surrendered for cancellation. ... When there is more than one class in a registration, one or more entire class(es) but less than the total number of classes may be surrendered.

Respondent's surrender of a single class is, therefore, permissible. However, the Board notes that Trademark Rule 2.134(a) provides that if the respondent in a cancellation

proceeding applies to cancel its involved registration under Section 7(e) of the Trademark Act without the written consent of every adverse party to the proceeding, judgment shall be entered against respondent. In view thereof, and because petitioner's written consent to the voluntary surrender is not of record, judgment is hereby entered against respondent as to Class 32, the petition to cancel Class 32 is granted, and Class 32 of Registration No. 3051906 will be cancelled in due course.

Motion to Amend the Petition

By way of its motion to amend the petition for cancellation, petitioner seeks to assert fraud as an additional ground for cancellation against Class 32, and seeks to assert abandonment as a new ground for cancellation against Classes 2, 25, 28, and 29.

Trademark Rule 2.111(c)(1) provides that a petition "must be accompanied by the required fee ... for each class in the registration for which cancellation is sought." Similarly, Trademark Rule 2.112(b) provides that "[t]he required fee must be included ... for each class sought to be cancelled." The Board notes that neither the motion to amend nor the reply in support of that motion was accompanied by any payment or an authorization to charge respondent's deposit account for any of the additional

classes sought to be cancelled. As such, petitioner has failed to perfect the proposed amendment. Accordingly, petitioner's motion to amend the petition for cancellation is denied.¹

Motions to Compel and for Sanctions

Because the discovery requests at issue were served and the Board's prior order on petitioner's earlier motion to compel was granted while the petition related only to Class 32, the motions to compel and for discovery sanctions can relate only to discovery for Class 32. In view of the voluntary surrender of and resulting judgment against Class 32, the motions to compel and for sanctions are denied as moot.

Summary

Respondent's voluntary surrender of Class 32 is noted, judgment is entered against respondent as to Class 32, the petition for cancellation of Class 32 is granted, and Class 32 of Registration No. 3051906 will be cancelled in due course.²

Petitioner's motion to amend the petition for cancellation is denied.

¹ In view of the denial of this motion for petitioner's failure to file the proper fee, the issues of alleged standing and legal sufficiency of the amended pleading are moot.

² Judgment against respondent herein is limited to Class 32.

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Petitioner's motions to compel and for discovery sanctions are denied as moot.

This proceeding will be terminated pending expiration of the time to appeal.