

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

Lykos

Mailed: September 30, 2009

Opposition No. 91169226

Arcadia Group Brands Ltd.

v.

Studio Moderna SA

Cancellation No. 92049146

Arcadia Group Brands Ltd.

v.

Studio Moderna SA

(as consolidated)

Angela Lykos, Interlocutory Attorney

The case now comes before the Board for consideration of (1) defendant's motion to strike certain paragraphs of plaintiff's amended petition to cancel in Cancellation No. 92049146 (filed May 23, 2008), and (2) plaintiff's motion to amend its pleading in both Opposition No. 91169226 and Cancellation No. 92049146 (filed April 30, 2009). The motions are fully briefed.

I. Motion to Amend

The Board will consider first plaintiff's motion to amend its pleading in both Opposition No. 91169226 and Cancellation No. 92049146.

Plaintiff has moved to amend its pleadings to assert a claim of non-use. As a basis for its motion, plaintiff asserts that during discovery, it learned of new information pertaining to defendant's alleged nonuse of its applied-for and registered marks. Concurrent with its motion, plaintiff has submitted a single amended pleading entitled "Amended Consolidated Notice of Opposition and Petition to Cancel."

In Cancellation No. 92049146, an answer has not yet been filed. A party to an inter partes proceeding may amend its pleading once as a matter of course at any time before a responsive pleading is served. Insofar as plaintiff filed its amended pleading prior to defendant filing an answer, the amended petition to cancel is accepted. See Fed. R. Civ. P. 15(a).

In Opposition No. 91169226, an answer has been filed, and at the time the consolidated proceedings were suspended, discovery remained open. Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, 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. See, for example, *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); and *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993). 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. See TBMP § 507.02(b) (2d ed. rev. 2004) and cases cited therein.

In this instance, the Board finds that defendant would not suffer prejudice if plaintiff is permitted to add the new allegations at this time. Moreover, the timing of the amendment will not adversely affect defendant. Plaintiff moved to amend its pleadings during the suspension of this proceeding, and this case has not moved past the discovery stage. 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); see also TBMP § 507.02(a) (2d. ed. rev. 2004) and cases cited therein. Defendant therefore will have ample to take discovery on the new allegations when proceedings are resumed. Thus, permitting plaintiff to amend its pleading at this juncture is entirely consistent with prior Board practice.

Moreover, plaintiff's submission of a single amended pleading for both the opposition and cancellation is

permissible. See TBMP § 305 (2d. ed. rev. 2004) ("[a] party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant.").

In view of the foregoing, plaintiff's motion to amend is granted; plaintiff's single amended pleading is now the operative complaint for both the opposition and cancellation proceeding.

Insofar as plaintiff's amended pleading supersedes plaintiff's amended petition to cancel filed on May 6, 2008, defendant's motion to strike certain paragraphs of plaintiff's May 6, 2008 amended pleading is now moot.

II. Resetting of Schedule

This case involves the consolidation of an opposition proceeding commenced prior to November 1, 2007, and a cancellation proceeding commenced after November 1, 2007 pursuant to the Board's amended trademark rules. *Notice of Final Rulemaking*, 72 Fed. Reg. 42242 (August 1, 2007). For this reason, proceedings in Cancellation No. 92049146 are hereby resumed while proceedings in Opposition No. 91169226 remain suspended. Once the parties exchange initial disclosures in Cancellation No. 92049146, the suspension in the opposition proceeding will be lifted, and both cases

will proceed under the same amended trademark rules schedule. The parties are reminded that pursuant to the amended trademark rules, a summary judgment motion cannot be filed until the moving party has made its initial disclosures, except for a motion based on res judicata, collateral estoppel, or lack of jurisdiction by the Board. Trademark Rule 2.127(e)(1).

Time to Answer Amended Pleading ¹	10/30/09
Deadline for Discovery Conference in Cancellation No. 92049146	11/29/09
Discovery Opens in Cancellation No. 92049146	11/29/09
Initial Disclosures Due in Cancellation No. 92049146 and proceedings resume in Opp. No. 92049146	12/29/09
Expert Disclosures Due	4/28/10
Discovery Closes	5/28/10
Plaintiff's Pretrial Disclosures	7/12/10
Plaintiff's 30-day Trial Period Ends	8/26/10
Defendant's Pretrial Disclosures	9/10/10
Defendant's 30-day Trial Period Ends	10/25/10
Plaintiff's Rebuttal Disclosures	11/9/10
Plaintiff's 15-day Rebuttal Period Ends	12/9/10

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

¹ The answer to plaintiff's combined amended pleading should be filed separately in both proceedings.

upon request filed as provided by Trademark Rule 2.129.