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

Proceeding	92052327
Party	Defendant King of Rock 'N' Roll Music, Inc.
Correspondence Address	JEFFREY E JACOBSON JACOBSON & COLFIN PC 60 MADISON AVENUE, SUITE 1026 NEW YORK, NY 10010 UNITED STATES JEJESQ@aol.com
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	12/21/2010
Attachments	Amend Pleading Motion.pdf (4 pages)(249687 bytes)

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

In the Matter of Trademark Registration No. 1,909,802

For the Trademark KING OF ROCK 'N' ROLL MUSIC

Registered December 8, 1995

----- X
ELVIS PRESLEY ENTERPRISES, INC.

Cancellation No.
92052327

Petitioner,

v.

KING OF ROCK 'N' ROLL MUSIC, INC.

Registrant.
----- X

REGISTRANT'S MOTION FOR LEAVE TO AMEND ITS ANSWER

PLEASE TAKE NOTICE that Registrant hereby moves for leave to amend its Answer to list 15 U.S.C. § 1068 (and 37 CFR §§ 2.133 (a) (b)) as a defense, and to include a proposed modification to the goods listed in Registration No. 1,909,802 in the event the Board's decision on the motion for summary judgment precludes Registrant from being able to maintain its registration for all of the goods listed.

As a general rule, pleadings in an inter partes cancellation proceeding before the Board may be amended in the same manner and to the same extent as in a civil action in a United States district court. See 37 CFR § 2.115. When the time to amend a pleading as of right has expired, "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." Fed. R. Civ. P. 15 (a) (2).

When a party files a timely motion for summary judgment, the Board will suspend proceedings in the case with respect to all matters not germane to the motion. See 37 CFR §§

2.127(d) and (e) (1). Examples of papers, which may be germane to a motion for summary judgment, include inter alia, a motion for leave to amend a party's pleading. See TBMP § 528.07; *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (motion to amend to amplify pleading). In respect to the registered mark in an inter partes proceeding, the Board may modify, restrict, or rectify the application or registration by limiting the goods or services specified therein. 15 U.S.C. § 1068; see also 37 CFR §§ 2.133 (a) (b). Such a request, may be made by way of an affirmative pleading in the answer or by way of motion, ruling upon which the Board will defer until final decision or summary judgment. See 37 CFR § 2.133; *Space Base, Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216 (TTAB 1990).

Here, Registrant seeks to amend the Answer to add the following numbered paragraphs:

24. Registrant is at least entitled to maintain its registration with a restriction on the goods listed in the registration pursuant to 15 U.S.C. § 1068 and 37 CFR §§ 2.133 (a) and (b).

25. Registrant's proposed modification to the registration's goods listing is, "pre-recorded music on phonorecords and compact discs."

26. In the event the T.T.A.B. determines the Registrant is not entitled to registration in the absence of a restriction, and Registrant's proposed restriction is inadequate, Registrant requests that it be given time in which to file a request that the registration be amended to conform to the findings of the T.T.A.B.

Registrant submits that this motion to amend its Answer is germane to the pending motion for summary judgment. See TBMP § 528.07; *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993). It is particularly germane considering

Registrant raised this defense in its Memorandum of Law in Opposition to *Petitioner's* Motion for Summary Judgment and In Support of Registrant's Cross-Motion for Summary Judgment.¹

Registrant also submits that leave should be freely given here because justice requires Registrant be afforded the opportunity to utilize this defense to preserve its registration in connection with the goods unquestionably still being used with its trademark. Petitioner has not disputed Registrant's use of the mark in connection with compact discs, and only disputes Registrant's use with phonorecords because of its different interpretation of the word "phonorecord." Therefore, Registrant respectfully requests leave to amend its Answer to add this defense.

Respectfully submitted,

The Jacobson Firm, P.C.

DATED: December 21, 2010
New York, N.Y.

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¹ Note, that as Petitioner did not object in its Reply Memorandum to the use of this unpleaded defense, the Board can consider the pleadings amended notwithstanding its decision on this motion for leave to amend pursuant to TMBP § 528.07. Thus, the Board has the authority to consider it when deciding the pending motion for summary judgment.

CERTIFICATE OF SERVICE

I, Jeffrey E. Jacobson, Esq., hereby certify that a copy of REGISTRANT'S MOTION FOR LEAVE TO AMEND ITS ANSWER has been served upon:

Seth A. Rose
Loeb & Loeb
321 North Clark Street, Suite 2300
Chicago, IL 60654

via first class mail, postage prepaid and via email, this 21ST day of December, 2010.

/Jeffrey E. Jacobson/
Jeffrey E. Jacobson, Esq.