

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

MBA

Mailed: February 14, 2012

Cancellation No. 92053787

Everett W. James a/k/a Tad  
James

v.

Metagenics, Inc.

**Michael B. Adlin, Interlocutory Attorney:**

This case now comes up for consideration of petitioner's fully-briefed motion for leave to file an amended petition for cancellation, filed September 21, 2011.<sup>1</sup> In addition, on February 10, 2012, petitioner filed a motion to extend the discovery period, "[b]ecause Petitioner's Motion to Amend has not yet been ruled upon by the Board."

By way of background, respondent, a Delaware corporation based in California, owns a registration for the mark FIRST LINE THERAPY, in standard characters, for "Printed education materials and printed practice management materials for healthcare practitioners" and "Educational and practice management seminars for healthcare practitioners in

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<sup>1</sup> The delay in acting on the motion is regretted.

the fields of health and nutrition" (the "Registration").<sup>2</sup> In his original petition for cancellation, petitioner alleges prior use and registration<sup>3</sup> of TIME LINE THERAPY for "educational services; namely, conducting classes and seminars in the field of self-improvement," and related goods and services, and that use of respondent's mark is likely to cause confusion with, and dilute,<sup>4</sup> petitioner's mark. Some of petitioner's pleaded registrations are over five years old. Petitioner also alleges that respondent's mark is "merely descriptive." In its answer, respondent denies the salient allegations in the original petition for cancellation.

Based on his own investigation, and respondent's discovery responses (or lack thereof), petitioner originally sought leave to amend his petition to: (1) join as a party defendant Metagenics, Inc., a California corporation, the apparent original applicant for the involved Registration; and (2) add a claim that the involved Registration is void *ab initio* because the original application therefor was not filed by the mark's true owner. However, after receiving

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<sup>2</sup> Registration No. 3467675, issued July 15, 2008 under Section 2(f) from an application filed December 12, 2007, based on dates of first use of September 11, 2002.

<sup>3</sup> Registration Nos. 1818198, 1890438, 3596997, 3975310 and 4056847.

<sup>4</sup> Petitioner's dilution claim is not adequately pled, because petitioner does not allege that his mark became famous prior to respondent's date of first use. Toro Co. v. ToroHead Inc., 61 USPQ2d 1164, 1174 and n. 9 (TTAB 2001).

respondent's opposition to his motion for leave to amend, and the materials submitted therewith, petitioner modified his [proposed] amended petition, and now seeks instead merely to update the allegations about petitioner's originally-pleaded applications, and to add a claim that the involved Registration is void *ab initio* because: (1) the original applicant therefor "was not in existence" on the involved application's filing date; (2) the eventual change of the applicant's name to that of the Registration's current owner "was not a correctable defect;" and (3) neither the original applicant nor the Registration's current owner "used or controlled use" of the involved mark as of the application filing date. In any event, petitioner argues that leave to amend should be granted because the proposed new allegations were "only recently discovered," and respondent would not be prejudiced if leave is granted given that discovery remains open.

In response, respondent argues that petitioner "misinterpreted" the relevant facts, and that the proposed new claim is "factually and legally erroneous."

Under Fed. R. Civ. P. 15(a)(2), leave to amend a pleading should be freely given "when justice so requires." Accordingly, the Board is generally liberal in granting leave to amend pleadings, "unless entry of the proposed amendment would violate settled law or be prejudicial to the

rights of the adverse party or parties." International Finance Corp. v. Bravo Co., 64 USPQ2d 1597, 1604 (TTAB 2002). Indeed

[i]f the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits. In the absence of any apparent or declared reason - such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. - the leave sought should, as the rules require, be "freely given."

Foman v. Davis, 331 U.S. 178, 182 (1962) (quoted with approval in Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503, 1505 (TTAB 1993)).

Here, because petitioner filed his motion for leave to amend prior to trial and prior to the close of discovery, respondent would not be prejudiced by the proposed amendments. Hurley International LLC v. Volta, 82 USPQ2d 1339, 1341 (TTAB 2007); Commodore Electronics, 26 USPQ2d at 1506. This is especially so in this case, because respondent does not require discovery concerning its own corporate status and history. Respondent does not claim otherwise. Furthermore, it appears that petitioner sought leave to amend relatively soon after discovering the grounds for the proposed new claim. Respondent's assertion that the

proposed new claim is "factually and legally erroneous" is an argument on the merits and irrelevant to whether petitioner should be granted leave to amend. See, Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316, 1318 (TTAB 1992). Finally, there is no evidence of "bad faith or dilatory motive" on petitioner's part.

For all of these reasons, petitioner's [revised proposed] amended petition for cancellation included with his reply brief is accepted and made of record and is now petitioner's operative pleading herein. Respondent is allowed until **March 5, 2012** to answer or otherwise move with respect to the amended petition for cancellation. Petitioner's motion to extend discovery is moot because leave to amend has been granted by this order, but a brief extension of the discovery period is warranted as a result of the new claim, and therefore discovery, trial and other dates are hereby reset as follows:

Answer to Amended Notice Due	<b>March 5, 2012</b>
Discovery Closes	<b>March 26, 2012</b>
Plaintiffs' Pretrial Disclosures	<b>May 10, 2012</b>
Plaintiffs' 30-day Trial Period Ends	<b>June 24, 2012</b>
Defendant's Pretrial Disclosures	<b>July 9, 2012</b>
Defendant's 30-day Trial Period Ends	<b>August 23, 2012</b>
Plaintiffs' Rebuttal Disclosures	<b>September 7, 2012</b>

Plaintiffs' 15-day Rebuttal Period Ends

**October 7, 2012**

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.

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