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

Proceeding	92054201
Party	Plaintiff Dan Foam ApS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DAN FOAM APS)	
)	
Petitioner,)	
)	Cancellation No. 92054201
v.)	
)	
SLEEP INNOVATIONS, INC.,)	
)	
Registrant.)	

**PETITIONER’S RESPONSE IN OPPOSITION
TO REGISTRANT’S MOTION FOR LEAVE TO FILE AN AMENDED ANSWER**

Now, nearly two years after the commencement of the above-captioned cancellation proceeding, over a year after the close of discovery and over ten months after Petitioner Dan Foam APS (“Petitioner”) submitted its pretrial disclosures, Registrant Sleep Innovations, Inc. (“Registrant”) moves to add an affirmative defense asserting that Petitioner cannot be damaged by U.S. Registration No. 3,916,902 based upon Registrant’s ownership of a prior existing and incontestable registration, namely U.S. Registration No. 3,137,309, for the word mark “BODIPEDIC”. This proposed amendment is untimely and would severely prejudice Petitioner. Accordingly, Registrant’s request for leave should be denied.

I. THE PROPOSED AMENDMENT IS UNTIMELY.

On July 1, 2011, just shy of two years ago, Petitioner filed its Petition to Cancel U.S. Registration No. 3,916,902 on the grounds that Petitioner has priority and that the mark shown in U.S. Registration No. 3,916,902 is confusingly similar to Petitioner’s TEMPUR-PEDIC (plus design) Mark, which is the subject of U.S. Registration No. 3,900,919. [D.E. #1.] Registrant filed its Answer on August 11, 2011. The deadline for expert disclosures passed on May 11,

2012, and discovery in this proceeding closed on June 10, 2012, over a year ago. [D.E. #10.] The deadline for Petitioner to serve its pretrial disclosures was on July 25, 2012. *Id.* Petitioner filed its motion for summary judgment on August 7, 2012, and Registrant filed its cross-motion for summary judgment on September 17, 2012. [D.E. #43, Declaration.] The Board denied both motions for summary judgment on May 13, 2013, and stated that the Board would not hear any additional motions for summary judgment. [D.E. #42.] In its Order denying the cross-motions for summary judgment, the Board commented in a footnote that “Respondent did not plead as an affirmative defense that petitioner cannot be damaged by registration because respondent already owns another registration for the same (or substantially similar) mark and goods or services, which has not been challenged based on its Registration No. 3137309.” *Id.* Only then, after reviewing the Board’s Order which notes that Petitioner did not plead the Morehouse defense as an affirmative defense, did Registrant move to amend its Answer. [D.E. #43.] Claiming that it “inadvertently omitted” the Morehouse defense from its Answer, Registrant now, nearly two years later, seeks to amend its Answer to asserts this defense.

It is simply too late in this proceeding for Registrant to amend its Answer and assert an additional defense. Because discovery has closed and because the Board will no longer accept any motions for summary judgment, Petitioner will be severely prejudiced if Registrant’s Motion to Amend is granted. If allowed at this stage of the game, discovery would need to be reopened, and thus the amendment would effectively delay the resolution this proceeding.

This proposed amendment is not the result of anything learned in discovery; in fact, this defense was available to Registrant at the time it filed its Answer nearly two years ago. In August of 2011, Registrant was certainly aware that it owned U.S. Registration No. 3,137,309. Registrant therefore has no excuse for not timely seeking leave to amend. “Inadvertently

omitting” the defense for nearly two years is not an acceptable excuse for this untimely and prejudicial amendment.

II. GRANTING REGISTRANT LEAVE TO AMEND ITS ANSWER WOULD UNFAIRLY PREJUDICE PETITIONER.

Petitioner acknowledges that, in accordance with Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires. TBMP § 507.02. However, the Board does not grant such leave when entry of the proposed amendment would be prejudicial to the right of the adverse party. *See* TBMP §507.02. At this late stage in the game, granting Registrant leave to amend its Answer to include the Morehouse defense would be extremely prejudicial to Petitioner; Petitioner has had no opportunity to collect discovery on this newly proposed affirmative defense and will have no opportunity to move for summary judgment on the issue since the Board will no longer accept motions for summary judgment. *See* D.E. #42. Furthermore, granting Registrant’s motion would delay the resolution of this proceeding and would increase the time, effort, and money that Petitioner would be required to expend in prosecuting this matter, particularly in light of the fact that Petitioner would face expense in both taking and responding to discovery if discovery was reopened.

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays an important role in the Board’s determination of whether the adverse party would be prejudiced by the proposed amendment. TBMP § 507.02(a). A motion for leave to amend should be filed as soon as the ground for such amendment becomes apparent. *Int’l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). “Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion.” *Id.* (citing Wright, Miller and Kane, Federal Practice and Procedure: Civil 2d, Section 1488 (1990); Chapman, Tips from the TTAB:

Amending Pleadings: The Right Stuff, 81 Trademark Reporter 302, 307 (1991)). As noted, in this case, Registrant waited over two years before filing its motion for leave to amend its Answer to add the Morehouse defense as an affirmative defense. Only after the Board issued an Order noting that Registrant did not include this defense in its Answer did Registrant move to add this defense.

Registrant offers no suitable explanation as to why it failed to raise its affirmative defense earlier; a claim of an inadvertent omission at this late stage of the game is an insufficient reason to unduly prejudice Petitioner. A long and unexplained delay, such as the near two-year delay in this proceeding, tends to render proposed amendments untimely. TBMP § 507.02(a). This is particularly likely when there is no question of newly discovered evidence, as is the case here. TBMP § 502.02(a). *See Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) (opposer unduly delayed in filing motion for leave to amend during testimony period); *Int'l Finance Corp.*, 64 USPQ2d at 1604 (motion to amend denied where movant provided no explanation for two year delay in seeking to add a new claim).

Generally, when proposed amendments are based on facts within movant's knowledge at the time the original pleading was filed, the Board will deny the motion to amend. *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001) ("Trek Bicycle") (motion for leave to amend filed prior to close of discovery but based on facts known to opposer prior to institution of the case denied due to unexplained delay). In this particular instance, Registrant did not claim that the assertion of the Morehouse defense arose out of facts learned through discovery, nor did Registrant claim that the Morehouse defense was unavailable to it prior to or shortly after filing its Answer. To the contrary, Registrant claimed that it was simply "inadvertently omitted," and Registrant seemingly coincidentally realized this as a result of the

Board's Order on the cross-motions for summary judgment. There is simply no denying that Registrant had ample time to file a motion for leave to amend its pleading at an earlier stage in the proceeding – in fact, it had nearly two years. It is incumbent upon Registrant to identify all of its claims and defenses promptly in order to provide Petitioner with proper notice of its defenses and a proper opportunity to investigate such defenses. See *Media Online, Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008). Otherwise, permitting “the piecemeal prosecution of this case would unfairly prejudice [Petitioner] by increasing the time, effort, and money that [Petitioner] would be required to expend” in its investigation of Registrant's affirmative defenses. *Id.*

The two cases relied upon by Registrant to support its assertion that its Motion to Amend should be granted are inapposite. Unlike in the present matter, in *Jimmy Buffet v. Chi-Chi's, Inc.*, the facts upon which the opposer's proposed amended claims were based were either not discovered or did not occur until well after the filing of the answer. 226 U.S.P.Q. 428, 430 (TTAB 1985). Furthermore, the pleadings were still in a “fairly early stage.” *Id.* at 431. In the other case relied upon by Registrant, *The Toro Co. v. ToroHead Inc.*, the applicant did not object to the opposer's motion to amend to add a claim of dilution. 61 U.S.P.Q. 1164, 1172 (TTAB 2001). Here, Petitioner quite obviously objects to Registrant's Motion to Amend and finds the proposed amendment to be extremely prejudicial and untimely.

Registrant delayed filing its Motion to Amend its Answer to add the Morehouse defense for nearly two years. Registrant waited until after the close of discovery, after Petitioner filed its Pretrial Disclosures, and after cross-motions for summary judgment were submitted and decided. Only after the Board issued an Order noting that Registrant did not include the Morehouse defense in its Answer did Registrant move to add this new affirmative defense. It's simply too

late. Registrant's claim of "inadvertent omission" is not a sufficient reason to excuse the delay in moving to amend the pleading. Amending Registrant's Answer in the ninth inning is unfairly prejudicial to Petitioner.

III. CONCLUSION

Permitting Registrant's proposed amendment to its Answer, which was filed nearly two years ago, would only unfairly prejudice Petitioner and delay the resolution of this proceeding. Accordingly, Petitioner respectfully requests that the Board exercise its discretion and deny Registrant's Motion to Amend.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served on counsel for Registrant, this 14th day of June, 2013, by sending same via First Class Mail, postage prepaid, to:

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