

ESTTA Tracking number: **ESTTA546740**

Filing date: **07/03/2013**

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

Proceeding	92054201
Party	Defendant Sleep Innovations, Inc.
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Date	07/03/2013
Attachments	Registrant's Reply Brief in Support Motion for Leave to Amend Answer.pdf(201210 bytes)

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

In the Matter of Registration No. 3,916,902
For the Mark: BODIPEDIC (& Design)
Registration Date: February 8, 2011

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

**REGISTRANT’S REPLY BRIEF IN SUPPORT OF
MOTION FOR LEAVE TO AMEND ANSWER**

Registrant Sleep Innovations, Inc. (“Registrant”) submits this Reply Brief in further support of its Motion to Amend its Answer to Petition To Cancel (“Registrant’s Motion”)¹. Registrant incorporates by reference herein all arguments made and legal authority cited in its Moving Brief. As argued in Registrant’s Moving Brief, leave to amend should be freely granted unless the amendment would violate settled law or the adverse party would be prejudiced by the amendment. Neither of those grounds exist here and Registrant’s Motion should be granted.

¹ All other terms previously defined in Registrant’s papers in support of the Motion are used herein without further explanation.

ARGUMENT

I.

REGISTRANT SHOULD BE GRANTED LEAVE TO AMEND ITS NOTICE OF OPPOSITION.

A. Timeliness of Registrant's Motion

Contrary to Petitioner's assertions, Registrant has candidly explained why it did not move sooner to amend its Answer to include the Morehouse defense. Registrant inadvertently excluded the Morehouse defense from its Answer and did not realize the omission until the Board noted in its decision on the parties' cross motions for summary judgment that Registrant had not asserted its prior registration as a defense in its Answer. Hurtado Decl., ¶3, Ex. A. It is not "coincidental" that Registrant filed the Motion after the Board issued its decision in May – Registrant admittedly realized as a direct result of the Board's decision that the Answer did not include the Morehouse defense.

Petitioner misapprehends the "newly discovered" information that gave rise to the Motion. Registrant plainly knew that it owned the registration for the Word Mark and that it was relevant to the proceeding. Indeed, Registrant produced certain information concerning the Word Mark in this proceeding. Registrant filed the Motion based upon its discovery in May that the Answer inadvertently omitted the Morehouse defense. Registrant promptly moved to amend its Answer upon discovering this omission.

B. Petitioner will not be prejudiced by the proposed amendment.

As argued in Registrant's Moving Brief, Petitioner will not be prejudiced by the proposed amendment to the Answer. During discovery, Registrant produced certain information concerning the Word Mark. The application file and registration for the Word Mark are public record, and Petitioner is deemed to have constructive notice of Registrant's ownership of the

Word Mark based upon its registration. See 15 U.S.C. § 1072. The Word Mark is incontestable and may only be challenged on limited grounds such as fraud on the Patent and Trademark Office and genericness, none of which are applicable here. Petitioner's Opposition Brief is silent on this issue and does not suggest that any grounds exist to challenge the Word Mark registration.

As Registrant argued in its Moving Brief, the only issues raised by the affirmative defense are legal issues: whether the Word Mark and Registrant's Marks are substantially identical and whether the goods covered by both marks are substantially identical. See 15 U.S.C. §§ 1064 and 1065. Petitioner does not contest this in its Opposition Brief.

While Petitioner contends that it will be prejudiced if Registrant is granted leave to amend because it will not have the opportunity to take discovery concerning the Morehouse defense, Petitioner does not identify what discovery it requires that it has not already obtained. In addition, Petitioner vaguely states that it will be deprived of the opportunity to move for summary judgment on the Morehouse defense, but it is unclear what grounds Petitioner would have to move for summary judgment on this defense. In reality, Registrant is the party that would have a basis to move for summary judgment based on Morehouse.

Throughout its Opposition Brief, Petitioner makes much of Registrant's obligation to promptly identify and assert all claims and defenses, but Petitioner ignores its corresponding obligation to do the same. Petitioner was on constructive notice of the registration for the Word Mark prior to filing its Notice of Opposition, but failed to include a claim seeking cancellation of that registration. Petitioner received actual notice of the registration for the Word Mark during discovery in the proceeding when Registrant produced documents relating to the Word Mark, and never sought to amend its petition to seek cancellation of the registration for the Word Mark.

If Petitioner believed that it was harmed by the existence of the registration for the Work Mark Petitioner would have included a claim for cancellation of that registration in its Petition to Cancel, but Petitioner did not. Given its failure to challenge the Word Mark registration despite its presumed and actual awareness of that registration throughout this proceeding, Petitioner cannot plausibly claim to be prejudiced by the proposed amendment.

The testimony periods have not yet opened and most, if not all, of the information related to the Word Mark has been produced or is a matter of public record. Thus, Petitioner will suffer no prejudice as a result of Registrant's amended pleading.

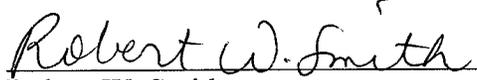
The cases cited by Petitioner in support of its Opposition to the Motion are distinguishable. Contrary to Petitioner's parenthetical at page 4 of its Opposition, the motion to amend in Black & Decker Corp. v. Emerson Electric Co. was filed four days after the close of the trial period, not during the testimony period. 84 U.S.P.Q.2d 1482, 1604 (T.T.A.B. 2007) (“[F]our days after the close of the trial period, opposer filed its motion to amend its notices of opposition . . .”). Here, the testimony periods have not even opened. The remaining cases relied upon by Petitioner are distinguishable because the moving party in each of those cases failed to provide the Board with any explanation as to why the claim it sought to add had not been included in the pleading sought to be amended. See Trek Bicycle Corp. v. StyleTrek Ltd., 64 U.S.P.Q.2D 1540 (T.T.A.B. 2001 (further denying motion to amend because proposed claim, as pleaded, was legally insufficient); see also International Finance Corp. v. Bravo Co., 64 U.S.P.Q.2d 1597 (T.T.A.B. 2002). In contrast, Registrant has explained that the Morehouse defense was inadvertently omitted from its Answer and that counsel did not realize this omission until May 2013 when the Board issued its decision on the cross-motions for summary judgment.

CONCLUSION

For the foregoing reasons, Registrant respectfully requests that its Motion for Leave to Amend be granted.

Dated: July 3, 2013

Respectfully submitted,



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CERTIFICATE OF SERVICE

The undersigned does hereby certify that on this day, I served a copy of the foregoing Registrant's Reply Brief In Support of Motion for Leave to Amend Answer on counsel for Petitioner by regular mail, as follows:

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Date: July 3, 2013


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