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

Mailed: August 16, 2013

Cancellation No. 92055269

Mango's Tropical Cafe, Inc.

v.

Tango Mango, LLC

George C. Pologeorgis,
Interlocutory Attorney:

This case now comes before the Board for consideration of petitioner's renewed motion (filed June 26, 2013) for leave to amend its petition to cancel.[1] Petitioner filed its proposed amended pleading concurrently with its motion for leave to amend. The motion is fully briefed.

By way of its motion to amend, petitioner seeks to amend its pleading (1) to plead ownership of two additional registrations, namely, Registration No. 4190731 for the mark MANGO'S and Registration No. 4224643 for the mark MANGO'S TROPICAL CAFE, both of which issued during the course of

[1] Petitioner originally filed its motion for leave to amend on January 18, 2013. However, since proceedings were suspended for settlement from January 22, 2013 until June 23, 2013, petitioner renewed its motion for leave following the conclusion of the suspension period.

this proceeding, (2) to add a claim of abandonment through non-use, and (3) to delete its claim of dilution.

In response, respondent argues that petitioner's motion should be denied because the USPTO has already determined that respondent's involved mark TANGO MANGO is not likely to cause confusion with the marks subject to petitioner's new registrations and, therefore, the addition of these two new registrations to petitioner's pleading would serve no useful purpose. Additionally, respondent maintains that petitioner unduly delayed in seeking to add these two registrations to its pleading since these registrations were in existence for months before petitioner sought to add either registration to the proceeding. Moreover, respondent contends that petitioner clearly knew of the existence of the underlying applications for the registrations well before the filing of this cancellation proceeding and should have pleaded ownership of the pending applications in its original petition to cancel. With regard to the addition of petitioner's abandonment claim, respondent argues the merits of this claim and further contends that claim is based on facts that were, or could have been, within petitioner's knowledge at the time it filed its original petition to cancel and, therefore, to allow petitioner to assert this claim at this juncture in the proceeding would prejudice respondent through piecemeal prosecution of this case.

Decision

Inasmuch as respondent filed its answer in this proceeding more than twenty one days ago, petitioner may amend its petition to cancel only by

written consent of respondent or by leave of the Board. *See* Fed. Civ. P. 15(a); TBMP § 507.02(a) (3d ed. rev. 2 2013).

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See id. See also American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

In deciding whether to grant leave to amend, a tribunal may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *See Foman v. Davis*, 371 U.S. 178, 182 (1962).

In this instance, the Board, based upon the record, does not find any evidence of bad faith or dilatory motive on the part of petitioner in seeking to amend its pleading. Moreover, the Board does not find undue delay on the part of petitioner to add allegations regarding its recently issued registrations and newly-asserted claim of abandonment since these proceedings had been suspended from January 2013 until June 23, 2013 and petitioner filed its motion to amend soon after resumption of proceedings from settlement. The concept of "undue delay" is inextricably linked with the concept of prejudice to the non-moving party, *see Marshall Field & Co. v. Mrs. Field Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) and, in this case, we find no such prejudice since, as noted below, the Board will afford respondent

time in which to take discovery limited to petitioner's new allegations regarding its claim of ownership of Registration Nos. 4190731 and 4224643.[2] We similarly find no prejudice to respondent in allowing petitioner to add a claim of abandonment at this juncture in the proceeding, particularly since there is no need for applicant to conduct discovery on this claim since any evidence regarding use or nonuse of respondent's mark would be in respondent's own possession, custody and control.

Moreover, the Board does not find the proposed amendments to be futile. We find respondent's argument that the addition of these two new registrations to petitioner's pleading would serve no useful purpose since the USPTO has already found that respondents' mark is not confusingly similar to the marks subject to the two registrations petitioner now seeks to add to its pleading unpersuasive. It is well established that the Board must determine each case on its own record and prior decisions by examining attorneys are not binding on the Board. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). With regard to the proposed abandonment claim, as stated above, respondent merely argues the merits of petitioner's abandonment claim rather than that the claim would be futile or unavailable.

[2] The Board does note, however, that the better practice would have been for petitioner to have pleaded ownership of the underlying applications at the time it filed its original petition to cancel.

Lastly, we note that this is the first instance where petitioner sought to amend its pleading.

In view of the foregoing, petitioner's motion for leave to amend its pleading is **GRANTED**.[3]

As noted above, petitioner provided a copy of its amended pleading with its motion papers filed on June 26, 2013. The amended petition to cancel is now the operative pleading in this case.

Respondent is allowed until **twenty (20) days** from the mailing date of this order in which to file and serve its answer to petitioner's amended pleading.

Respondent is also allowed until **September 16, 2013** in which to conduct **written discovery** solely limited to petitioner's new allegations regarding its ownership of Registration No. 4190731 for the mark MANGO'S and Registration No. 4224643 for the mark MANGO'S TROPICAL CAFE.

Petitioner, in turn, is allowed **thirty (30) days** from the date of service of respondents' written discovery, if propounded, in which to provide responses thereto.

As previously noted, the Board finds that there is no reason for respondent to conduct any discovery regarding petitioner's newly-asserted claim of abandonment inasmuch as any evidence regarding respondent's use

[3] In its response to petitioner's motion for leave to amend its pleading, respondent did not object to the removal of petitioner's claim of dilution. Accordingly, petitioner's claim of dilution is dismissed.

or nonuse of its subject mark would already be in respondent's possession, custody and control. Discovery is therefore closed except to the extent noted above.

Trial Schedule

Trial dates for these proceedings, beginning with the deadline for petitioner's pretrial disclosures, are reset as follows:

Plaintiff's Pretrial Disclosures Due	**10/25/2013**
Plaintiff's 30-day Trial Period Ends	**12/9/2013**
Defendant's Pretrial Disclosures Due	**12/24/2013**
Defendant's 30-day Trial Period Ends	**2/7/2014**
Plaintiff's Rebuttal Disclosures Due	**2/22/2014**
Plaintiff's 15-day Rebuttal Period Ends	**3/24/2014**

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.l25.

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.l29.