



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Legend Pictures LLC

v.

Quentin Davis

Cancellation No. 92056168
On Petition to the Director
Filed: October 4, 2013

Decision

On October 4, 2013, Quentin Davis (petitioner) petitioned the Director of the United States Patent and Trademark Office (Director) to reverse an interlocutory order issued by the Trademark Trial and Appeal Board (TTAB). The Director has the authority to review petitioner's request. *See* 37 C.F.R. §§2.146(a)(3) and (e)(2). The petition is denied.

FACTS¹

Legend Pictures LLC (Legend Pictures) filed a petition for cancellation of U.S. Registration No. 4106459 for the mark LEGENDARY. In the petition for cancellation, Legend Pictures alleged a likelihood of confusion with the mark LEGENDARY PICTURES in U.S. Registration No. 3412677 and the mark LEGENDARY and design in U.S. Registration Nos. 3621043 and 3656926² under Trademark Act Section 2(d). 15 U.S.C. §1052(d).

On September 4, 2013, the TTAB issued an interlocutory order (Order) granting Legend Pictures' motion to amend the petition to cancel and motion to compel petitioner to comply with discovery and production requests. Petitioner did not request reconsideration of this decision at the TTAB. Petitioner now seeks reversal of the Order by the Director. Petitioner asserts that the TTAB should have denied the motion to amend because it was untimely, burdensome and legally insufficient. (Petition 4). Petitioner also alleges that the TTAB did not properly address his claim that the interrogatories sent by Legend Pictures exceeded 75 (seventy-five) in number.

¹ This decision recites only the facts relevant to the issue on petition.

² Both registrations were amended in Section 7 amendments from LEGENDARY PICTURES and design to LEGENDARY and design.

(Petition 5). Finally, petitioner alleges that the interlocutory attorney has demonstrated “subjective favoritism” in favor of Legendary Pictures. (Petition 5).

On October 21, 2013, Legend Pictures filed a reply brief in response to the instant petition.³

DISCUSSION

The Director may exercise supervisory authority in appropriate circumstances. 35 U.S.C. §2; 37 C.F.R. §2.146(a)(3); TMEP §1707. In an *inter partes* proceeding, a party may petition the Director to review an order or decision of the TTAB that concerns a procedural matter and does not end the litigation before the TTAB. TBMP §§901.02(a), 905; TMEP §§1703, 1704. However, the Director will reverse an interlocutory order of the TTAB only if there is clear error or abuse of discretion. *Paolo’s Assocs. Ltd. P’ship v. Bodo*, 21 USPQ2d 1899, 1902 (Comm’r Pats. 1991); TMEP §1703; *cf. Riko Enters., Inc. v. Lindsley*, 198 USPQ 480, 482 (Comm’r Pats. 1977). For the reasons set forth below, the circumstances presented in this case do not demonstrate that the TTAB committed clear error or abused its discretion.

First, petitioner argues that Legendary Pictures did not move to amend its pleading within 21 (twenty-one) days or obtain his consent to do so, and therefore, the motion to amend should have been denied. (Petition 2). Petitioner’s arguments are without merit and demonstrate a misunderstanding of Federal Rule of Civil Procedure (FRCP) 15(a), which states in pertinent part:

(a) Amendments Before Trial

(1) *Amending as a Matter of Course*. A party may amend its pleading once as a matter of course within:

(A) 21 days after serving it, or

(B) if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier.

(2) *Other Amendments*. **In all other cases, 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). (Emphasis added). Legendary Pictures was allowed one amendment as a matter of course within 21 days after service, but *also at any time in the proceeding with the Board’s approval*. It is customary for pleadings to be amended during the pre-trial phase, as

³ Petitioner filed an additional brief on November 6, 2013, arguing that the brief submitted by Legend Pictures was untimely. In the present case, October 19, 2013 fell on a Saturday, and therefore, respondent’s reply brief was timely filed on Monday, October 21, 2013. 35 U.S.C. §21(b); 37 C.F.R. §2.196; TMEP §308. Trademark Rule 2.146(e)(2) only provides for one reply to be filed in response to a petition. Accordingly, arguments made in the November 6, 2013 filing will not be considered. 37 C.F.R. §2.146(e)(2).

long as the amendment does not violate settled law or prejudice the other party. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990); and *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

Petitioner contends that because he is without legal counsel, responding to an amended petition to cancel at this stage would be “unduly burdensome.” (Petition 3). The amended petition to cancel seeks to add allegations that U.S. Registration No. 3412677 has become incontestable and that U.S. Registration Nos. 3621043 and 3656926 were amended from the mark LEGENDARY PICTURES and design to LEGENDARY and design. The TTAB found no prejudice to petitioner in allowing the amendments, and further noted that since the discovery period has been reopened by sixty days, petitioner is able to take additional discovery on these matters if needed. (Order 9). “The Board will generally grant a motion for leave to amend when the proceedings are still in the pre-trial phase.” *See e.g., Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2001) (finding no prejudice in allowing amendment of complaint where motion was filed prior to the close of discovery and opposer stipulated to an extension of discovery).” (Order 9). Moreover, petitioner had the option to hire an attorney to represent it in this proceeding, but chose not to do so. Petitioner’s *pro se* status does not excuse petitioner from being bound by well-settled rules of practice.

Petitioner also argues that the TTAB did not accurately count Legendary Pictures’ interrogatories, which petitioner says exceed 75 in number. (Petition 5). The total number of interrogatories which a party may serve on another party in a proceeding may not exceed 75, counting subparts. 37 C.F.R. §2.120(d)(1); TBMP §405.03. In determining whether the number of interrogatories served by one party on another exceeds the limit, the TTAB will count each subpart within an interrogatory as a separate interrogatory, regardless of whether the subpart is separately designated (i.e., separately numbered or lettered). TBMP §405.03(d). In the Order, the TTAB found “that interrogatory requests nos. 1-21 do not exceed 75 in number, including subparts. (Order 4). The Director finds no error in this conclusion. Petitioner has not provided any compelling argument as to why the substance of Legendary Pictures’ twenty one (21) interrogatories exceeded the limit.

Finally, petitioner’s allegation that Legendary Pictures has received “subjective favoritism” during the course of this proceeding is not well taken. (Petition 5). The Director reviews decisions that involve rules and practices set by the Director. Consequently, this allegation is not proper subject matter for a petition to the Director under Rules 2.146(a)(3) and (e)(2). This request does not involve a review of any rules or practices set by the Director. Rather, such an allegation should be directed to the TTAB itself. Even if this matter were properly before the Director, the Director finds no merit in the allegation after reviewing the record.

DECISION

The petition is denied. This decision will be forwarded to the TTAB for resumption of the cancellation proceeding.

/Sharon R. Marsh/

Sharon R. Marsh
Deputy Commissioner
for Trademark Examination Policy

SRM:CAG

Date: December 31, 2013

Petitioner:

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