

ESTTA Tracking number: **ESTTA741076**

Filing date: **04/19/2016**

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

Proceeding	92060353
Party	Plaintiff Bentley Motors Limited
Correspondence Address	ROD S BERMAN JEFFER MANGELS BUTLER & MITCHELL LLP 1900 AVENUE OF THE STARS, SEVENTH FLOOR LOS ANGELES, CA 90067 UNITED STATES trademarkdocket@jmbm.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	JESSICA BROMALL SPARKMAN
Filer's e-mail	JZB@JMBM.COM, DOCKETING@JMBM.COM, RBERMAN@JMBM.COM, KP2@JMBM.COM
Signature	/s/ JESSICA BROMALL SPARKMAN
Date	04/19/2016
Attachments	2016-04-19 Mtn to Amend - Bentley v. Aucera.pdf(389647 bytes)

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

BENTLEY MOTORS LIMITED,

Petitioner,

v.

AUCERA SA,

Respondent.

Cancellation No. 92060353

Registration Nos.: 2007286, 2096184,
2096186

Mark: BENTLEY

Atty. Ref. No.: 58389-9026

PETITIONER’S MOTION FOR LEAVE TO FILE FIRST AMENDED PETITION
FOR CANCELLATION

Petitioner Bentley Motors Limited (“Bentley” or “Petitioner”) hereby moves, pursuant to 37 C.F.R. § 2.1115 and Fed. R. Civ. P. 15, for an order granting Petitioner leave to file a First Amended Petition for Cancellation, and an order deeming the First Amended Petition for Cancellation filed and served. A copy of the proposed First Amended Petition for Cancellation is attached hereto as Exhibit A.

The essence of Bentley’s claim is, and always has been, that respondent Aucera SA (“Aucera” or “Respondent”) is not using the BENTLEY mark in commerce for watches, pens, or jewelry. In the original Petition for Cancellation, based on that underlying allegation, Petitioner sought cancellation of Aucera’s U.S. Trademark Reg. Nos. 2,007,286 for watches, 2,096,184 for jewelry, and 2,096,186 for pens and related items (collectively, the “Registrations”).

During the course of discovery, Bentley has learned that not only is Aucera not currently making use of the BENTLEY mark, but that it did not use the mark prior to issuance of the Registrations, that it has never made any *bona fide* commercial use of the BENTLEY mark, and

that its declarations regarding its use of the mark to the Trademark Office in connection with the registrations were false.

Leave to amend should be freely given when justice so requires, and leave should be liberally granted unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. Fed. R. Civ. P. 15(a); *Zanella Ltd. v. Nordstrom Inc.*, 90 U.S.P.Q.2d 1758, 1759 (T.T.A.B. 2008). Here, there is no danger of prejudice to Aucera, and the proposed amendment does not violate settled law. The evidence relevant to the new claims is entirely within Aucera's control, and is similar, if not identical, to the evidence relevant to the original claim. Further, the relevant evidence has already been the subject of discovery requests. If necessary, Aucera may supplement its discovery responses and document product to take these new claims into account. Further, because as noted above the new claims depend on largely the same evidence and legal determinations as the originally asserted claims, the proposed amendment will increase judicial efficiency.

For the reasons stated herein, Bentley respectfully requests that Board deem the First Amended Petition for Cancellation attached hereto as Exhibit A filed and served.

Dated: April 19, 2016

/s/ Jessica Bromall Sparkman

Rod S. Berman, Esq.
Jessica Bromall Sparkman, Esq.
JEFFER MANGELS BUTLER & MITCHELL LLP
1900 Avenue of the Stars, Seventh Floor
Los Angeles, CA 90067
Telephone: (310) 203-8080
Facsimile: (310) 203-0567
E-mail: trademarkdocket@jmbm.com
Attorneys for Petitioner BENTLEY MOTORS
LIMITED

EXHIBIT A

(Proposed Second Amended Petition for Cancellation)

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

BENTLEY MOTORS LIMITED,

Petitioner,

v.

AUCERA SA,

Respondent.

Cancellation No. 92060353

Registration Nos.: 2007286, 2096184,
2096186

Mark: BENTLEY

Atty. Ref. No.: 58389-9026

PETITIONER'S FIRST AMENDED PETITION FOR CANCELLATION

Bentley Motors Limited (“Bentley”), a United Kingdom corporation having a mailing address located at Pym's Lane, Crewe, Cheshire CW13PL, United Kingdom, believes that it is and will be damaged by the continued registration of Registration Nos. 2,007,286, 2,096,184, and 2,096,186 (the “Registrations”) owned of record by Aucera SA (“Respondent”), for the mark BENTLEY in connection with goods watches, jewelry, and pens and related items, as identified in the Registrations, and hereby submits this First Amended Petition For Cancellation of said Registrations.

As grounds for this Petition, it is alleged that:

1. On information and belief, including based on materials produced in discovery, Respondent failed to make any use in commerce of the mark BENTLEY for any of the registered goods prior to issuance of any of the Registrations. As a result, each of the registrations is void *ab initio* in its entirety.

2. On information and belief, including based on materials produced in discovery, Respondent failed to make adequate use in commerce of the mark BENTLEY for any of the

registered goods at any time in order to establish or sustain trademark rights in the mark. As a result, each of the Registrations is subject to cancellation.

3. On information and belief, including based on materials produced in discovery, Respondent procured each of the Registrations through fraud on the Trademark Office:

a. In discovery, Respondent produced no evidence of any use of the mark BENTLEY prior to September 2001, between September 2001 and January 2008, or between April 2008 and June 2013.

b. Respondent submitted declarations to the Trademark Office in connection with the Registrations affirming its use of the mark BENTLEY in 1996, 2002, 2003, 2006, and 2007.

c. On information and belief, including based on materials produced in discovery, Respondent's declarations of use were false, and Respondent knew or should have known that the declarations were false.

d. On information and belief, including based on materials produced in discovery, in making the false declarations, Respondent intended to induce the Trademark Office to issue the Registrations.

e. Respondent's declarations of use were material, and were relied on by the Trademark Office in issuing each of the Registrations.

4. On information and belief, including based on materials produced in discovery, Respondent has ceased use in commerce of the mark BENTLEY for all of the registered goods for one or more periods of three years or more, raising a presumption of abandonment. On information and belief, including based on materials produced in discovery, Respondent has no

intent to resume use of the mark BENTLEY for any of the registered goods and will be unable to rebut the presumption of abandonment.

5. Bentley owns numerous trademark registrations and applications for the mark BENTLEY, including the following: U.S. Reg. No. 3,998,345 for BENTLEY for various goods, including, “jewelry, watches and clocks” in Int. Cl. 14, and various goods in Int. Cl. 16, including stationary and diaries; U.S. Reg. No. 4,881,746 for B BENTLEY & Design for various goods, including, “precious metals and their alloys; jewelry, watches and clocks; table clocks; desk clocks; cuff link boxes; key rings of precious metal; key trays of precious metal” in Int. Cl. 14, and “writing implements; pens; pencils; . . . stands for pens and pencils; holders for pens and pencils” in Int. Cl. 16; and U.S. Application Serial No. 86/092,070 for B BENTLEY & Design for “metal key rings; and metal key trays” and “candle holders and candlesticks” in Int. Cls. 6 and 21, respectively.

6. WHEREFORE, Petitioner respectfully requests that this Cancellation be sustained and that Respondent's Registration Nos. 2,007,286, 2,096,184, and 2,096,186 be cancelled.

Dated: April 19, 2016

/s/ Jessica Bromall Sparkman

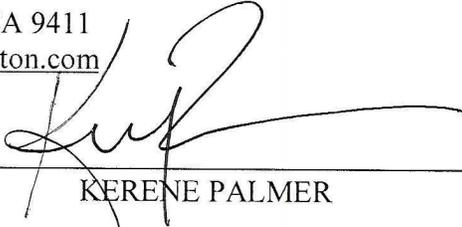
Rod S. Berman, Esq.
Jessica Bromall Sparkman, Esq.
JEFFER MANGELS BUTLER & MITCHELL LLP
1900 Avenue of the Stars, Seventh Floor
Los Angeles, CA 90067
Telephone: (310) 203-8080
Facsimile: (310) 203-0567
E-mail: trademarkdocket@jmbm.com
Attorneys for Petitioner BENTLEY MOTORS
LIMITED

CERTIFICATE OF SERVICE

It is hereby certified that one (1) copy of the foregoing **PETITIONER'S MOTION FOR LEAVE TO FILE FIRST AMENDED PETITION FOR CANCELLATION** is being sent via first class mail to Petitioner Aucera SA's attorney of record as follows:

Jennifer A. Golinveaux
Winston & Strawn LLP
101 California Street
San Francisco, CA 94111
jgolinveaux@winston.com

Dated: April 19, 2016



KERENE PALMER