

ESTTA Tracking number: **ESTTA761024**

Filing date: **07/28/2016**

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

Proceeding	92062777
Party	Plaintiff Space Scooter Ltd.
Correspondence Address	HEATHER R NORTON LAW OFFICE OF HEATHER NORTON 236 WEST PORTAL AVENUE, SUITE 143 SAN FRANCISCO, CA 94127 UNITED STATES heather@heathernortonlaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Heather Norton
Filer's e-mail	heather@heathernortonlaw.com
Signature	/s Heather R Norton/
Date	07/28/2016
Attachments	Space Scooter Motion to Amend Pleadings.pdf(105752 bytes) Norton Decl. ISO Mot. for leave to amend.pdf(75431 bytes) Cancellation Exhibit A.pdf(150511 bytes) Exhibit B to Mot. to Amend.pdf(29669 bytes) Cancellation Exhibit C.pdf(156417 bytes)

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

Space Scooter, Ltd.,)	
)	
Petitioner,)	
)	Cancellation No. 92,062,777
)	Opposition No. 91,224,876
)	
v.)	
)	
Easy2.Company Besloten Vennootschap,)	
)	
Respondent.)	

PETITIONER’S MOTION FOR LEAVE TO AMEND THE PLEADING

Pursuant to Fed. R. Civ. P. 15(a) and in accordance with TBMP § 507.02, Petitioner hereby requests that the Trademark Trial and Appeal Board (the “Board”) grant it leave to amend its pleading. Petitioner requests leave to change the name of Petitioner on the pleading from Space Scooter, Ltd. to 8232326 Canada Ltd. As described herein, the change is a formality, which will not prejudice Respondent. In accordance with the Board’s liberal policy of granting leave to amend pleadings, Petitioner respectfully requests that its motion be granted and that the amended pleading attached hereto as Exhibit A be entered.

RELEVANT FACTS

Space Scooter, Ltd. and 8232326 Canada Ltd. are one and the same entity. In 2012, Petitioner registered and 8232326 Canada Ltd. as a legal entity in Canada. Since that same date, Petitioner has been doing business as Space Scooter, Ltd. (See Exh. A to

Declaration of Heather Norton (“Norton Decl.”) (Petitioner’s Verified Amended and Supplemental Responses to Respondent’s Interrogatory No. 33)).

Petitioner’s trademark application originally listed “Space Scooter, Ltd.” as the owner of the trademark. Because Petitioner’s registered business entity is 8232326 Canada Ltd., and its trade name is Space Scooter, Ltd., Petitioner has requested that the suspension of its trademark application be temporarily removed so that Petitioner can amend the inadvertent error in the owner of record. (Exhibit B to Norton Decl.). In accordance with that request, Petitioner hereby seeks leave to amend its pleadings in order to change its name on the caption from Space Scooter, Ltd. to 8232326 Canada Ltd.

LEGAL STANDARD

Consistent with Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *Zanella Ltd. v. Nordstrom, Inc.*, Opposition No. 91177858 (Oct. 23, 2008, designated as a Precedent of the TTAB on May 13, 2009) (citing *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993)). 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* TBMP § 507.02. The Board generally will grant such motions when the proceedings are still in the pre-trial stage. *See, e.g., Cool-Ray, Inc. v. Eye Care, Inc.*, 83 USPQ 618, 621 (TTAB 1974); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993)(applicant not prejudiced because proceeding still in pre-trial phase); *Focus 21*

International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976)(amendment permitted where neither party had yet taken testimony); *Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 182 USPQ 511, 512 (TTAB 1974)(applicant would not be unduly prejudiced since no testimony has yet been taken); TBMP § 507.02(a).

ARGUMENT

In the present matter, discovery has not yet closed and testimony has not yet been taken. (See Notice and Trial Dates Sent). Accordingly, Petitioner's motion is timely and will not prejudice Respondent. Moreover, the change that Petitioner is requesting is an administrative formality. Petitioner is not seeking to add claims or to amend the substance of its claims. Instead, Petitioner is simply seeking to change the name on the caption of its pleading from its trade name to the name of its registered business entity. Respondent has been made aware through discovery that Space Scooter Ltd. and 8232326 Canada Ltd. are one and the same entity. (Exh. A to Norton Decl.). For those reasons as well, Respondent would not be prejudiced by the requested amendment. Petitioner therefore respectfully requests that its motion be granted and the amended pleading be entered.

Dated: July 27, 2016



Heather R. Norton

Attorney for Petitioner

**CERTIFICATE OF
SERVICE**

I, Heather Norton, hereby certify that a true and correct copy of the foregoing Motion to Amend the Pleading was served on Respondent's Attorney of Record, - Billie Smith, in accord with an agreement of the parties to do so.

Email for counsel for Respondent: BJSmith@michaelbest.com

Signed,
/Heather R. Norton /

July 27, 2016

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

Space Scooter, Ltd.,)	
)	
Petitioner,)	
)	Cancellation No. 92,062,777
)	
v.)	Opposition No. 91,224,876
)	
Easy2.Company Besloten Vennootschap,)	
)	
Respondent.)	

I, Heather R. Norton, declare as follows:

1. I am an attorney at law, duly admitted to practice in the State of California. I am counsel for Petitioner in this action. I make this Declaration in support of Petitioner's Motion for Leave to Amend the Pleading. The matters set forth herein are of my own personal knowledge, and if called upon to testify as to such matters, I could and would do so.
2. Attached hereto as Exhibit A are true and correct excerpts of Petitioner's Amended and Supplemental Responses to Respondent's Interrogatories, which are verified by Petitioner and were served on counsel for Respondent on June 10, 2016.
3. Attached hereto as Exhibit B is a true and correct copy of the Response to Suspension Inquiry, filed on July 20, 2016 in regard to Trademark Application, Serial Number 86303265.

4. Attached hereto as Exhibit C is a copy of the amended pleading, which Petitioner requests that the Board enter. The only amendment that has been made as compared to the original pleading is the name of Petitioner.

Executed this 27th day of July, 2016, at San Francisco, CA

A handwritten signature in black ink, appearing to read "H. R. Norton", is written over a horizontal line.

Heather R. Norton

Attorney for Petitioner

EXHIBIT A

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

Space Scooter, Ltd.,)	
)	
Petitioner,)	
)	Cancellation No. 92,062,777
v.)	
)	
Easy2.Company Besloten Vennootschap,)	
)	
Respondent.)	

**PETITIONER’S AMENDED AND SUPPLEMENTAL RESPONSES TO
APPLICANT’S FIRST SET OF INTERROGATORIES**

Pursuant to Trademark Rules of Practice 37 C.F.R. §§ 2.116 and 2.120 and Fed. R. of Civ. Proc. 33 and 26, Space Scooter Ltd. (hereinafter referred to as “Petitioner”), hereby serves their responses and objections to Easy2.Company Vesloten Vennootschap’s (hereinafter referred to as “Respondent”) First Set of Interrogatories.

PRELIMINARY STATEMENT

Petitioner has not fully completed investigation of the facts relating to this case, has not completed discovery, and has not completed preparation for trial. All of the responses contained herein are based only upon such information and documents that are presently available to and specifically known to Petitioner, and all of the responses contained herein disclose only those contentions that presently occur to Petitioner. It is anticipated that further discovery, independent investigation, legal research and analysis will supply additional facts and add meaning to known facts.

evidencing the facts stated herein, to the extent such documents exist.

INTERROGATORY NO. 32:

Provide the principal and material facts regarding Petitioner's relationship with Shanghai Changyi, including, but not limited to, the Exclusive Agency Agreement 8232326 Canada Limited entered into with Shanghai Changyi, Raphael Hui and Hui Chun Yuen's involvement in negotiation that agreement, the termination of the Exclusive Agency Agreement, and the identity of the person(s) with knowledge regarding such facts.

RESPONSE TO INTERROGATORY NO. 32

Petitioner and 8232326 Canada Limited are the same company, thus, the answer to this interrogatory is identical to the answer provided in interrogatory No. 31.

INTERROGATORY NO. 33:

Describe the relationship between 8232326 Canada Limited and Space Scooter Limited.

RESPONSE TO INTERROGATORY NO. 33

8232326 Canada Limited and Space Scooter Limited are the same company. 8232326 Canada Limited is a company registered Canada, and it does business under the name Space Scooter Limited.

INTERROGATORY NO. 34:

Identify Petitioner's competitors with respect to Petitioner's scooters.

RESPONSE TO INTERROGATORY 34:

Petitioner objects to this request as seeking information that is neither relevant to this proceeding, nor reasonably calculated to led to the discovery of relevant information. Respondent further objects to this request as seeking information outside the purview

EXHIBIT B

Response to Suspension Inquiry or Letter of Suspension

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86303265
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86303265/large
LITERAL ELEMENT	SPACE SCOOTER
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
OPPOSITION PROCEEDING(S)	
Opposition No(s). 91224876 is/are still pending. However, the applicant hereby requests removal of this application from suspension for the examining attorney to consider a submission, such as an amendment or consent agreement.	
COMMENT(S)/REMARK(S)	
Applicant hereby submits this response in order to amend an inadvertent error in the owner of record. Specifically, the Application was inadvertently filed in the name of Applicant's d/b/a rather than its official entity name. This submission corrects this. WHEREFORE, Applicant respectfully requests that the Examining Attorney amend the name of the owner of record, and then return the application to suspension while the related opposition proceeding moves forward. The Examining Attorney is invited to contact the undersigned attorney directly should any questions arise.	
CANCELLATION PROCEEDING(S)	
Cancellation No(s). 92062777 is/are still pending. However, the applicant hereby requests removal of this application from suspension for the examining attorney to consider a submission, such as an amendment or consent agreement.	
COMMENT(S)/REMARK(S)	
Applicant hereby submits this response in order to amend an inadvertent error in the owner of record. Specifically, the Application was inadvertently filed in the name of Applicant's d/b/a rather than its official entity name. This submission corrects this. WHEREFORE, Applicant respectfully requests that the Examining Attorney amend the name of the owner of record, and then return the application to suspension while the related cancellation proceeding moves forward. The Examining Attorney is invited to contact the undersigned attorney directly should any questions arise.	
OWNER SECTION (current)	
NAME	Space Scooter
STREET	585 Middlefield Road, Unit 22
CITY	Scarborough
ZIP/POSTAL CODE	M1V4Y5
COUNTRY	Canada
OWNER SECTION (proposed)	
NAME	8232326 Canada Ltd.

DBA/AKA/TA/Formerly	DBA Space Scooter, Ltd.
STREET	585 Middlefield Road, Unit 22
CITY	Scarborough, Ontario
ZIP/POSTAL CODE	M1V 4Y5
COUNTRY	Canada
SIGNATURE SECTION	
RESPONSE SIGNATURE	/ejo/
SIGNATORY'S NAME	Elizabeth Oliner
SIGNATORY'S POSITION	Attorney of record, California bar member
SIGNATORY'S PHONE NUMBER	650-549-5298
DATE SIGNED	07/20/2016
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Jul 20 13:49:44 EDT 2016
TEAS STAMP	USPTO/RSI-XX.XXX.XXX.XXX- 20160720134944657196-8630 3265-5503e1fdbdc571f51c8d 4fe913224d4c4543b9fdb7483 258ae9cc174cf36aaf-N/A-N/ A-20160720133549212634

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1822 (Rev 10/2011)
OMB No. 0651-0050 (Exp 07/31/2017)

Response to Suspension Inquiry or Letter of Suspension

To the Commissioner for Trademarks:

Application serial no. **86303265** SPACE SCOOTER(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86303265/large>) has been amended as follows:

OPPOSITION PROCEEDING(S)

Opposition No(s). 91224876 is/are still pending. However, the applicant hereby requests removal of this application from suspension for the examining attorney to consider a submission, such as an amendment or consent agreement.

Comment(s)/Remark(s):

Applicant hereby submits this response in order to amend an inadvertent error in the owner of record. Specifically, the Application was inadvertently filed in the name of Applicant's d/b/a rather than its official entity name. This submission corrects this. WHEREFORE, Applicant respectfully requests that the Examining Attorney amend the name of the owner of record, and then return the application to suspension while the related opposition proceeding moves forward. The Examining Attorney is invited to contact the undersigned attorney directly should any questions arise.

CANCELLATION PROCEEDING(S)

Cancellation No(s). 92062777 is/are still pending. However, the applicant hereby requests removal of this application from suspension for the examining attorney to consider a submission, such as an amendment or consent agreement.

Comment(s)/Remark(s):

Applicant hereby submits this response in order to amend an inadvertent error in the owner of record. Specifically, the Application was inadvertently filed in the name of Applicant's d/b/a rather than its official entity name. This submission corrects this. WHEREFORE, Applicant respectfully requests that the Examining Attorney amend the name of the owner of record, and then return the application to suspension while the related cancellation proceeding moves forward. The Examining Attorney is invited to contact the undersigned attorney directly should any questions arise.

APPLICANT AND/OR ENTITY INFORMATION

Applicant proposes to amend the following:

Current: Space Scooter a(n) limited company (Ltd.), legally organized under the laws of Canada, having an address of
585 Middlefield Road, Unit 22
Scarborough, M1V4Y5
Canada

Proposed: 8232326 Canada Ltd., DBA Space Scooter, Ltd., limited company (Ltd.) legally organized under the laws of Canada, having an address of
585 Middlefield Road, Unit 22
Scarborough, Ontario, M1V 4Y5
Canada

Response Suspension Inquiry Signature

Signature: /ejo/ Date: 07/20/2016

Signatory's Name: Elizabeth Oliner

Signatory's Position: Attorney of record, California bar member

Signatory's Phone Number: 650-549-5298

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 86303265

Internet Transmission Date: Wed Jul 20 13:49:44 EDT 2016

TEAS Stamp: USPTO/RSI-XX.XXX.XXX.XXX-201607201349446

57196-86303265-5503e1fdbdc571f51c8d4fe91

3224d4c4543b9fdb7483258ae9cc174cf36aaf-N

/A-N/A-20160720133549212634

EXHIBIT C

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

8232326 Canada Ltd

PETITIONER,

And

Easy2. Company Besloten Vennootschapane
Crawford,

RESPONDENT.

In the matter of Serial Nos.
79150812, 79156928 (U.S. Registration
No. 4741450)

For the mark SPACE SCOOTER

Filing Date: April 15, 2014 and August
27, 2014 respectively

Publication Date: October 14, 2015 and
March 10, 2015 respectively

Registration Date: May 26, 2015

Cancellation No. 92062777

NOTICE OF OPPOSITION AND PETITION TO CANCEL REGISTERED MARK

Petitioner, 8232326 Canada Ltd d/b/a Space Scooter Ltd., a Canadian limited company (hereinafter "Petitioner"), believes that it will be greatly damaged by the registration of the mark SPACE SCOOTER (hereinafter "Mark") for U.S. Serial No. 79150812 (hereinafter "Application"), filed by Easy2. Company Besloten Vennootschap (hereinafter "Easy2") on April 15, 2014. The Petitioner also believes that it will be vastly damaged by continued registration of U.S. Registration No. 4741450, for the mark SPACE SCOOTER, which is also owned by Easy2.

The Petitioner's grounds for opposition and cancellation of the above identified Marks are as follows:

INTRODUCTION

1. Easy2 filed a trademark application with the USPTO assigned U.S. Serial No. 79150812 on April 15, 2014 for the mark SPACE SCOOTER, under International Class 012, “Vehicles, namely, scooters”, and International Class 028, “Games and playthings, namely, toy scooters.”
2. Easy2 filed its application under Section 66(a), based on its International Registration of the mark which was issued on April 15, 2014.
3. Easy2 also filed a trademark application with the USPTO assigned U.S. Serial No. 79156928 on August 27, 2014 for the stylized mark SPACE SCOOTER, under International Class 012, “Vehicles, namely, scooters”, and International Class 028, “Games and playthings, namely, toy scooters.”
4. Easy2 filed its application under Section 66(a), based on its International Registration No. 1227572 of the mark, SPACE SCOOTER, which was issued on August 27, 2014.
5. The USPTO issued Easy2 a registration certificate for its stylized SPACE SCOOTER mark on May 26, 2015 and assigned it U.S. Trademark Registration No. 4741450.
6. The Petitioner filed its trademark application with the USPTO assigned U.S. Serial No. 86303265 on June 7, 2014 for the mark SPACE SCOOTER under International Class 012, “Non-motorized Scooters; Structural parts and accessories for non-motorized scooters; Non-mortorziied scooters for use in sports and recreation”, and International Class 028, “Toy scooters and accessories therefor; Rideable toys and accessories therefor; Ride-on toys and accessories therefor; Toy vehicles and accessories therefor.”
7. The Petitioner filed under 1(a) filing basis, with its first use of the mark ever on August 2, 2008 and its first use of the mark in commerce on April 20, 2012.

PRIOR USE

1. The Petitioner asks the Trademark Trial and Appeals Board to prevent registration of U.S. Serial No. 79150812 and to cancel U.S. Registration No. 4741450 based on the Petitioner’s priority of use under 15 U.S. Code § 1052 (d).

2. Petitioner and Easy2 have been using identical marks for goods that are similar and related to one another. Petitioner sells non-motorized scooters as well as accessories for these scooters. Easy2 sells only the scooters.
3. Both Petitioner and Easy2 have filed trademark applications for international classes 012 and 028. Easy2 has been issued registration for its stylized mark on May 26, 2015.
4. The Petitioner and Easy2's goods and services are very closely related to one another and would likely cause confusion amongst consumers.
5. The Petitioner sells its scooters to its customers in the U.S. and Canada through its online website. Easy2 sells to its European consumers via its online website as well. Giving Easy2 trademark registration for SPACE SCOOTERS in the U.S., will cause the North American market to fall into great confusion. Consumers will wrongly assume that Easy2's products are affiliated with those of the Petitioner's, who already has an established market share in this industry.
6. The Petitioner did not try to obtain a trademark registration for its Mark until it filed its application in 2014, however, it has common law rights in the Mark dating back to April 20, 2012 when the Mark was first used in commerce.
7. Petitioner submits shipping labels dated December 5, 2012, November 25, 2013, November 28, 2014 and January 5, 2015 as evidence that the Petitioner has been using the Mark prior to Easy2's first use in commerce, Easy2's International Registration, and its application for registration.
8. Petitioner's Mark is widely recognized throughout the U.S and Canada as a reputable brand for scooters. In fact, Petitioner's website gets over one hundred (100) new visitors per day. It also has a widely popular YouTube marketing campaign which has had over 133,458 views. *See* <https://www.youtube.com/watch?v=f-dDD-kVEGY>
9. Based on the fact that the Petitioner's Mark has a wide presence in the North American market and is a reputable brand, it seems highly unlikely that the Easy2 was not aware of the

Petitioner's prior use of the mark before it filed its applications in April and August 27 of 2014, respectively.

CONCLUSION

10. The Petitioner has shown through evidence submitted that it was using the Mark in commerce prior to the Easy2's first use in commerce and International Registration date of April 15, 2014 for U.S. Serial No. 79150812 and August 27, 2014 for U.S. Registration No. 4741450.
11. The Petitioner's first use of the Mark in commerce dates back to April 20, 2012; which is two (2) years before Easy2's first use in commerce (based on its International Registration dates from April and August, 2014).
12. The Petitioner's Mark is widely recognized as a brand of high quality scooters throughout North America. Easy2 has been selling its scooters mainly in Europe and now wants to expand to the U.S. where the Petitioner already has an established presence.
13. Allowing registration of Easy2's Mark for Serial No. 79150812 and continued registration of Registration No. 4741450 will cause great harm to the Petitioner's reputation who maintains a certain quality for the goods it carries and sells under its Mark. If people associate Easy2's scooters with those sold by the Petitioner, it could cause irreparable damage to the Petitioner's brand, which is known for selling high quality goods.
14. Therefore, the Petitioner hereby requests the Trademark Trial and Appeals Board to deny Easy2's application for registration of the Mark for U.S. Serial No. 79150812 and cancel Easy2's registration for U.S. Registration No. 4741450, based on overwhelming evidence that the Petitioner has priority rights in the Mark.

By: /Heather R. Norton/

Date: July 27, 2016

Heather R. Norton
Attorney for Petitioner

CERTIFICATE OF SERVICE/MAILING

I hereby certify that a true and complete copy of the foregoing Petition for Cancellation has been served on Registrant's attorney of record by sending said copy by email per agreement between the parties to: BJSmith@michaelbest.com

/Heather R. Norton/
Heather R. Norton