UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mail date: February 5, 2004

Opposition No. 91/121980

Estefan Enterprises, Inc.

v.

Bongo, S.A., de C.V.

Cheryl Butler, Interlocutory Attorney

Proceedings were last suspended to accommodate settlement discussions by order of the Board dated April 29, 2003. Consideration of opposer's fully-briefed pending motion for leave to file an amended notice of opposition was, thus, deferred. On September 12, 2003, opposer filed a motion to resume proceedings. On January 23, 2004, opposer filed a revocation and substitute power of attorney.

Opposer's revocation and substitute power of attorney has been entered into the electronic database.

Opposer's motion to resume proceedings is granted. When the Board suspends proceedings to facilitate settlement, such suspension is ordinarily made with the right of either party to request resumption at any time.

By its motion for leave to file an amended notice of opposition, opposer seeks to assert additional bases for

likelihood of confusion between applicant's mark and opposer's pleaded marks and for "non-use of applicant's mark in interstate commerce in the United States." Opposer argues that applicant will not be prejudiced because proceedings have been suspended for settlement, and discovery has not occurred. A copy of opposer's amended notice of opposition accompanies its motion.

In response, applicant argues that opposer's footnote to amended paragraph no. 12 is irrelevant and incorrect. Specifically, applicant argues that Trademark Act Section 44(e), the basis for applicant's application, does not discuss the priority date accorded for filing a U.S. application within six months of a foreign application. Said priority date is discussed in Section 44(d). Applicant argues that opposers amended paragraph no. 19 is presumptive with respect to applicant's bona fide intention to use the mark in commerce because applicant, seeking registration, is not required to use the mark in commerce before registration. Applicant argues that opposer's amended pleading does not comport with Fed. R. Civ. P. 10(b) because it does not delineate the distinctions between the two counts: likelihood of confusion and non-use. Finally, applicant argues that opposer impermissibly brought its motion during a period of suspension.

Inasmuch as proceedings were suspended for settlement with the right of either party to request resumption at any time, opposer's motion for leave to file an amended notice of

opposition may be construed as a request for resumption and was not filed improperly.[1]

The Board has reviewed the proposed pleading with respect to applicant's contention that opposer has not separated its likelihood confusion count from its count that applicant does not have bona fide intention to use the mark in commerce and finds that the counts are stated separately. Opposer directly alleges priority in paragraph no. 17; likelihood of confusion in paragraph no. 18; and applicant's lack of a bona fide intent to use in paragraph no. 19. Accordingly, the Board finds the proposed pleading to comport with Fed. R. Civ. P. 10(b).

The Board reads paragraph no. 19 as an allegation that applicant lacks a bona fide intention to use the mark in commerce, not necessarily as an allegation of abandonment based on non-use.

The Board agrees with applicant that footnote 1 to paragraph no. 12 detracts from the clarity of the pleading. Defendant's application Serial No. 75/767732 is based on Trademark Act Section 44(e); that is, based on the existence of a mark duly registered in the foreign applicant's country of origin. Section 44(e) does not provide for a priority to filing date. Section

[1] This is so, even though opposer later filed a separate request for resumption. In addition, suspension for settlement differs from suspension for other reasons, such as pendency of civil action or pendency of dispositive motions, in that any resumption in the case of a suspension for settlement is not dependent on a determination by a court or by the Board.

44(d) does provide for a priority filing date where a U.S. application is filed within six months of the date on which a relied-upon application was filed in the foreign country. Applicant has not made a claim of priority under Section 44(d). Accordingly, footnote 1 to paragraph no. 12 is hereby stricken. *See* Fed. R. Civ. P. 12(f); and TBMP Section 506 (June 2003).

Once a responsive pleading is served, a party may amend its pleading only with the written consent of the adverse party or by leave of the Board. 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* Fed. R. Civ. P. 15(a); and TBMP Section 507.02 (June 2003). Any potential prejudice may be ameliorated by the resetting and extension of discovery and trial dates, particularly here where discovery has not yet taken place.

Accordingly, opposer’s motion for leave to file an amended notice of opposition is granted, and the amended notice of opposition is entered into the proceeding.

Applicant is allowed until **thirty days** from the mailing date of this order to file its answer to the amended notice of opposition

Proceedings having been resumed, discovery and trial dates are reset as indicated on the next page:

THE PERIOD FOR DISCOVERY TO CLOSE:	August 23, 2004
30-day testimony period for party in position of plaintiff to close:	November 21, 2004
30-day testimony period for party in position of defendant to close:	January 20, 2005
15-day rebuttal testimony period to close:	March 6, 2005

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. Rule 2.l25.

Briefs shall be filed in accordance with Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.l29.

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