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

Proceeding	91121980
Party	Defendant ROBERT NOBLE & BONGO, S.A., DE C.V.
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Date	04/13/2006
Attachments	Response to Motion for Leave to Amend Pleadings.pdf ( 5 pages )

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

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ESTEFAN ENTERPRISES, INC.

Petitioner,

Opposition No.: 91121980

Cancellation No.: 92042251

vs.

BONGO, S.A. de C.V.

Registrant.

-----X

BOX TTAB

NO FEE

Assistant Commissioner of Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

**REGISTRANT'S/APPLICANT'S RESPONSE TO PETITIONER'S/OPPOSER'S  
MOTION FOR LEAVE TO AMEND PETITION TO CANCEL**

**COMES NOW** Registrant Roberto Noble, by assignment from BONGO, S.A. de C.V. (hereinafter "Registrant") by and through the undersigned counsel and hereby respectfully request the Board to deny PETITIONER'S/OPPOSER'S MOTION FOR LEAVE TO AMEND PETITION TO CANCEL.

1. Petitioner ESTEFAN ENTERPRISES, INC. filed an Opposition proceeding on February 13, 2001.

2. Petitioner ESTEFAN ENTERPRISES, INC. filed a Cancellation proceeding on June 20, 2003.

3. Petitioner ESTEFAN ENTERPRISES, INC. filed a consolidated Petition to Cancel Registration Number 2,347,247, and Notice of Opposition of Application Serial Number 7,576,7732.

4. Registrant Roberto Noble responded to various sets of requests to produce and Interrogatories through the years.

5. The Board reset the discovery to close on May 1, 2006.

6. Pursuant TTAB Rule 315, pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

7. Leave to amend a complaint shall be freely given when justice so requires, under Fed.R.Civ.P. 15(a), but numerous grounds for denial of the plaintiffs' motion to amend exist, including undue delay, undue prejudice to the defendants, and futility of the amendment. *Foman v. Davis*, 371 U.S. 178, 182, 83 S.Ct. 227, 230, 9 L.Ed.2d 222 (1962). Other factors that can weigh against granting leave to amend complaint include: (1) prejudice to defendant; (2) bad-faith motive on part of plaintiff, e.g., use of motion to postpone trial date, impose additional expense on opposing party, or gain additional leverage in settlement negotiations; (3) undue delay or dilatory conduct by plaintiff; (4) futility of proposed amendment; and (5) impact on judicial economy, judicial resources and court's ability to manage cases and control its dockets. *Millar v. Bay Area Rapid Transit Dist.*, 236 F. Supp. 2d 1110 (N.D. Cal. 2002).

8. Petitioner/Opposer's Motion for Leave to Amend Petition to Cancel adds new grounds to which Registrant/Applicant must prepare a defense at this late a date. Amending the Petition to Cancel at this late a date, causes undue delay and undue prejudice to the Registrant/Applicant. The initial proceeding was brought in early 2001 followed by the Cancellation proceeding in 2003. It has been over five (5) years since the Opposition proceeding and nearly three (3) years since the Cancellation proceeding

began. A delay in seeking an amendment to the pleadings prejudices the nonmovant when it hinders his or her ability to present the case on the merits, or leaves him or her unprepared to respond to a new theory at trial. *Miller v. Pinnacle Door Co., Inc.*, 301 Ill. App. 3d 257, 234 Ill. Dec. 767, 703 N.E.2d 628 (4th Dist. 1998), reh'g denied, (Dec. 28, 1998).

9. Also, the Petitioner/Opposer has moved to amend based on a bad faith motive. Given the extensive docket history and the knowledge of Petitioner/Opposer since September 2, 2005 of the additional claim, Petitioner/Opposer had ample opportunity to amend, but waited until three-weeks before close of discovery period.

10. Furthermore, Petitioner/Opposer has not put forth a valid reason for the delay in amending the Petition to Cancel. When "considerable time has elapsed between the filing of the complaint and the motion to amend, the movant has the burden of showing some 'valid reason for his neglect and delay.' " *Stepanischen v. Merchants Despatch Transp. Corp.*, 722 F.2d 922, 933 (1st Cir.1983) (quoting *Hayes v. New England Millwork Distribs., Inc.*, 602 F.2d 15, 19-20 (1st Cir.1979)).

11. The Board informed the Petitioner/Opposer that "a party may not obtain summary judgment on an issue that has not been pleaded. See Fed. R. Civ. P. 56(a) and (b); and TBMP §528.07 (2d ed. rev. 2004). Thus, to the extent that plaintiff is seeking judgment in its favor as a matter of law with respect to its argument...plaintiff's motion for summary judgment is denied because such issues are unpleaded." (DK. #62). Only now, after Petitioner/Opposer did not originally follow the Federal Rules of Civil Procedure, do they, at this late date, try to amend the Petition to Cancel to include the new ground.

12. Also, the Board has stated that “in the interest of judicial economy, neither party would be at liberty to bring another motion for summary judgment. The case is going to trial or settlement.” (DK. #62).

13. The liberal allowance of amendments to pleadings is important to assure a party a fair opportunity to present claims and defenses. However, equal attention should be given to the proposition that there must be an end, finally, to a particular litigation. As a result, the longer a party delays bringing an amendment, the less prejudice the opposing party must show to justify denying leave to amend. *UNR Industries, Inc. v. Continental Ins. Co.*, 623 F. Supp. 1319 (N.D. Ill. 1985).

**WHEREFORE**, Registrant/Applicant Bongo, S.A. de C.V. respectfully requests the Board deny Petitioner/Opposer’s Motion for Leave to Amend Petition to Cancel. If the Board grants such motion, Registrant/Applicant Bongo, S.A. de C.V. respectfully requests the Board to reset all discovery and trial dates in order for Registrant/Applicant Bongo, S.A. de C.V. to prepare a defense to the new claim.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing has been served on this 13<sup>th</sup> day of April, 2006, by first class mail to Karen Stetson, Esq., PO Box 403023, Miami, Florida 33140.

Respectfully submitted,

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