

TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: July 18, 2006 75/767132

Opposition No. 91121980
Cancellation No. 92042251 75/749162

Estefan Enterprises, Inc.

v.

Bongo, S.A. de C.V. and
Roberto Noble

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Discovery was last set to close on May 1, 2006 in accordance with the Board's summary judgment order dated March 14, 2006. Numerous motions and matters are now pending. However, certain motions have been withdrawn. Consequently, the Board provides succinct determinations of such motions and matters related thereto.

In view of defendant's withdrawal, dated May 10, 2006, of its motion to compel (filed April 28, 2006) attendance at three noticed depositions, such motion is now moot. ¹

In view of defendant's withdrawal, dated May 22, 2006, of its motion (filed April 28, 2006) to compel the attendance of

¹ Plaintiff's response to defendant's motion to compel was also filed on May 10, 2006. Such response indicates that plaintiff had already tentatively agreed to two of the three noticed depositions.



07-21-2006

Emilio Estefan for deposition, such motion and plaintiff's motion, filed April 24, 2006, for an order protecting Mr. Estefan from appearing for such a deposition are deemed moot.

Consequently, defendant's motion, filed May 5, 2006, for an extension of time to respond to plaintiff's motion for entry of a protective order is also deemed moot.

On April 4, 2006, plaintiff moved for leave to amend its petition to cancel (Cancellation No. 92042251) to add a claim that defendant committed fraud in the procurement of its registration. In support of its motion, plaintiff argues that it became aware of the grounds for its proposed amendment during the discovery deposition of defendant's corporate witness on September 2, 2005; that the facts surrounding this proposed claim are entirely within defendant's knowledge; and that (at the time the motion was brought) discovery remained open. A copy of the proposed amended petition to cancel accompanies plaintiff's motion.

In response, defendant argues that plaintiff's motion seeks to add a new ground against which defendant must prepare a response at this late date, causing further delay and undue prejudice; that plaintiff knew about the potential claim since September 2005; that, because plaintiff sought summary judgment, in part, on such grounds, but was informed that the issue was unpleaded and would not be considered, plaintiff should not be allowed to amend its pleading at this late date.

As a general policy, leave to amend a pleading must be freely given when justice so requires. See Fed. R. Civ. P. 15(a). 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. See TBMP §507.02 (2d ed. rev. 2004). The question of whether an adverse party would be prejudiced by allowance of the amended pleading in a Board case is largely dependent on the timing of the motion to amend. Moreover, the Board will liberally grant such motions when the proceedings are still in the pre-trial stage. *Id.*

The Board notes that plaintiff brought its motion approximately two weeks after the mailing date on the Board's summary judgment decision. In addition, the Board notes that proceedings had been suspended since September 12, 2006, shortly after the September 5th deposition, until the issuance of the March 14, 2006 summary judgment order. Thus, plaintiff did not unduly delay in bringing the present motion. Moreover, discovery remained open at the time the motion was brought.

Accordingly, plaintiff's motion for leave to amend the petition to cancel is granted; the amended petition to cancel is noted and entered; and defendant is allowed until **twenty days** from the mailing date of this order in which to file its answer to the amended petition to cancel.

Defendant's consented motion, filed July 17, 2006, to extend testimony dates is granted. Inasmuch as time remained in discovery when plaintiff filed its motion for leave to amend its petition to cancel, discovery is reset in approximation of the remaining time.

THE PERIOD FOR DISCOVERY TO CLOSE:	September 1, 2006
30-day testimony period for party in position of plaintiff to close:	November 30, 2006
30-day testimony period for party in position of defendant to close:	January 29, 2007
15-day rebuttal testimony period to close:	March 15, 2007

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 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.
