

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

National Academy of Recording Arts & Sciences, Inc.)	
)	
Opposer,)	
)	
v.)	Opposition No. 154,092
)	
ShaReem, Inc.,)	Opposition No. 154,147
)	
Applicant.)	

**APPLICANT’S OPPOSITION TO OPPOSER’S “MOTION TO
WITHDRAW WITH RIGHT TO REFILE” AND TO “OPPOSER’S
LEAVE TO AMEND ITS NOTICES OF OPPOSITION”**

On January 5, 2005, opposer filed a “Motion To Withdraw With Right to Refile” requesting leave to (1) withdraw “Opposer’s Motion To Amend The Notices Of Opposition, Compel Production of Documents And Compel Witness Deposition” filed September 24, 2004; (2) file a new motion to amend its Notices Of Opposition; and (3) file a new motion to compel. On January 7, 2005, opposer filed its proposed new motion to amend entitled “Opposer’s Leave To Amend Its Notices Of Opposition And Memorandum Of Law In Support Thereof.” Applicant submits this memorandum in opposition to both motions.

Applicant has no objection to opposer’s request to withdraw its pending motion, but objects to opposer’s request for leave to file a new motion to amend and a new motion to compel. Applicant also opposes opposer’s motion for leave to amend.

I. FACTS

This consolidated proceeding involves oppositions to applicant’s applications to register GRAMMY SHAR and GRAMMI SHAR for various goods and services in Classes 9, 16 and 41,

featuring a grandmotherly character, whose first name is Shar. Applicant is a small company whose president is Sharon McCarthy, an entertainer based in the Midwest who is known to her grandchildren and others as "Grammy Shar." Opposer, National Academy of Recording Arts & Sciences, Inc., which conducts the annual GRAMMY awards presentations, filed oppositions to both applications on October 23, 2002, alleging a likelihood of confusion based on opposer's registration and use of eight GRAMMY marks.

On September 24, 2004, opposer filed a Motion To Amend And Compel by which it sought, *inter alia*, to amend each of its Notices Of Opposition to add a paragraph alleging dilution.¹ Pending at the same time were applicant's Motion To Compel filed September 20, 2004 and applicant's Motion To Extend filed September 27, 2004. By agreement of the parties, the briefing on the three motions was extended so the parties could attempt to narrow the discovery issues the Board had to address.²

On January 5, 2005, opposer filed its Motion To Withdraw With Right To Refile. On January 7, 2005, opposer filed "Opposer's Leave To Amend Its Notices Of Opposition," by which it seeks leave to amend its October 23, 2002 Notices Of Opposition and substitute a new Notice Of Opposition that differs from the Notices Of Opposition submitted with its prior Motion To Amend, as well as the original Notices Of Opposition. Opposer seeks leave to amend to add a dilution claim, but offers no explanation why a dilution claim should now be added to

¹ Opposer also requested an order compelling discovery without attaching copies of applicant's discovery responses or otherwise informing the Board that the reason the requested discovery had not yet been provided was because the parties had been unable to reach agreement on a protective order, with the result that neither party had provided confidential discovery and the noticed depositions of both parties had been cancelled. Rather than agree to an extension of the discovery period under these circumstances, opposer filed a baseless motion to compel.

² Applicant's counsel informed opposer's counsel from the beginning that while applicant hoped agreement could be reached on discovery issues, applicant would not agree to the proposed amendments adding dilution claims to the Notices Of Opposition.

Notices Of Opposition filed more than two years ago. Opposer also failed to mention that it seeks to combine the allegations of its two separately filed Notices Of Opposition into one Notice Of Opposition or explain why such an amendment should be permitted at this time.

II. ARGUMENT

A. Opposer's Motion For Leave To File A New Motion To Amend Should Be Denied

Applicant objects to opposer's request that it be permitted to file a new motion to amend. The Board should reject opposer's request to file a new motion to amend its Notices Of Opposition twenty-seven (27) months after the Notices were filed to add a claim based on information in opposer's possession when the oppositions were filed. *Trek Bicycle Corp. v. Star Trek Ltd.*, 64 USPQ2d 1540 (TTAB 2002).

Opposer asserts that it should be given leave to file a new motion because "the factual and legal bases . . . have changed." Dilution, however, has been a basis for opposition since 1999. There likewise has been no change in the facts relating to opposer's proposed dilution claim. A review of opposer's Leave To Amend Its Notices Of Opposition reveals that the only change is a decision by opposer that it would like to file a more elaborate brief and attempt to merge the two Notices Of Opposition into a single Notice Of Opposition, not a change of law or fact as opposer contends.

Opposer's motion for leave to file a new, untimely motion to amend should be denied.

B. Opposer's Motion For Leave To File A New Motion To Compel Should Be Denied

Applicant also objects to opposer's request that it be given leave to file a new motion to compel the deposition of applicant's Rule 30(b)(6) witness. Opposer has no basis to file a motion to compel. The depositions previously noticed by both parties voluntarily were cancelled when the parties were unable to agree on a protective order in time to proceed with the

depositions. Following the filing of a Protective Order on November 17, 2004, the parties agreed that they would exchange confidential discovery on December 10, 2004 and then work on scheduling depositions of both parties. See opposer's counsel's December 2, 2004 letter, attached hereto as Exhibit A. Despite the fact opposer still has not produced the documents it promised to provide prior to the scheduling of depositions (*see, infra at 6-7*), applicant nonetheless has provided proposed dates for both parties to proceed with depositions once opposer produces the promised documents.

Opposer's motion for leave to file a new motion to compel should be denied.

C. Opposer's Motion For Leave To Amend Its Notices Of Opposition Should Be Denied

Should the Board grant opposer's request for leave to file a new motion to amend, the motion to amend should be denied.

Opposer argues that it should be given leave to add a dilution claim. Opposer does not mention that its proposed Amended Notice Of Opposition also seeks to combine its two Notices Of Opposition into one. On October 23, 2002, when opposer filed its Notices Of Opposition, it chose to file two separate oppositions. The proceedings were subsequently consolidated, but each proceeding necessarily maintained its separate character. TBMP 511. Opposer provides no reason for its proposed amendment merging the two notices.³ Its attempt to merge the two Notices Of Opposition is improper and should be denied.

Opposer also seeks leave to amend its Notices Of Opposition to add a claim of dilution, citing *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2001). This request comes more than two years after the filing of its Notices Of Opposition on October 23, 2002 and more

³ Opposer necessarily knew that it had modified the notices, but chose not to reveal it in its motion or explain the reason for doing so. Opposer should not be permitted to address this for the first time in its reply brief to which applicant cannot respond.

than five years after dilution became available as a ground for opposition on August 5, 1999. Under these circumstances, opposer's reliance on *Boral* is misplaced. In *Boral*, the Board in granting the motion to amend, specifically noted that opposer had not delayed and instead promptly sought leave to add a dilution claim as soon as it became available by statute. Similarly, in other cases cited by opposer in which motions to amend were granted, the Board specifically noted that the moving party had not delayed in seeking leave to amend upon becoming aware of the facts supporting the amendment.⁴

Here, in contrast to *Boral*, opposer's action mirrors that of the opposer in *Trek Bicycle Corp. v. Star Trek Ltd.*, 64 USPQ2d 1540 (TTAB 2002). In *Trek*, the Board denied opposer's motion to amend to add a dilution count despite the fact that discovery was still open. The Board found that opposer unduly delayed where it sought leave to amend to add a dilution claim eight months after filing the notice of opposition. *See also Foman v. David*, 371 U.S. 178, 182 (1962) (Identifying undue delay as a reason for denying a motion to amend). Opposer's attempt to add claims two years after the opposition was filed is similarly untimely and should be denied.⁵

In addition, here, as in *Trek*, the motion to amend is wholly silent as to why the dilution claim was not raised earlier. Moreover, applicant, a small company, will be prejudiced by the further delay a newly added dilution claim will cause. Opposer's argument that there will be no

⁴ *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (Opposer sought leave to amend shortly after becoming aware of a possible claim through discovery); *Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1216 n. 1 (TTAB 1990) (Opposer sought leave shortly after a new registration issued); *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 USPQ 471, 472 (TTAB 1971) (Applicant's motion for leave to file amended answer filed immediately upon discovery of basis); *Marmark Ltd v. Nutrexa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989) (Opposer moved to amend upon learning additional facts regarding the application).

⁵ Even if the period of suspension were excluded, there is still a gap of over a year between the filing the Notices Of Opposition and opposer's request to amend. Opposer cannot rely on the suspension of the proceedings to explain its delay in seeking to add a claim based on alleged facts of which it was aware when the opposition was filed two years earlier.

prejudice because applicant can take discovery regarding its proposed dilution claim ignores the problems applicant has experienced in obtaining the basic discovery to which a party is entitled in opposition proceedings.⁶ Opposer refused to provide discovery regarding its consideration, selection, clearance or first use of GRAMMY marks, its licensing of its marks or third party use, forcing applicant to file a motion to compel. *See*, applicant's Motion To Compel And To Extend Discovery filed September 20, 2004. Opposer's counsel also refused to have opposer sign a Protective Order agreeing to be bound by the terms of the Protective Order following the termination of the opposition proceedings, until after applicant had gone to the expense of preparing and serving a Motion For Protective Order. Following entry of the Protective Order, opposer refused to provide the discovery it had promised to provide once the protective order was in place, including sales figures, advertising expenditures, channels of trade information, information regarding the types of customers, and market research.⁷ Applicant accordingly was forced to file a supplemental motion to compel. *See*, Applicant's Supplemental Motion To Compel, filed January 27, 2005. There is no reason to believe that opposer would be more forthcoming in discovery regarding its proposed dilution claim than it has been with respect to its

⁶ Opposer also claims that applicant has known of opposer's intent to amend its notice since September 24, 2004 but has not taken discovery regarding the proposed dilution claim. Setting aside the lack of relevance of its argument, opposer ignores the fact that it refused to agree to an extension of the September 27, 2004 discovery close date and instead forced applicant to file the motion to extend presently pending before the Board. Applicant therefore had no ability to serve new discovery.

⁷ Opposer represents that opposer "collected, redacted and sent *thousands* of confidential documents to applicant." Opp. Motion, p. 3, n. 1. In fact, opposer produced a total of 547 pages of confidential production, as shown by opposer's counsel's December 9, 2004 and January 7, 2005 letters attached hereto as Exhibits B and C, consisting of 79 license agreements, 18 cease and desist letters, and a promotional piece, a far cry from the thousands of documents opposer claims it provided. Moreover, what is most notable about opposer's confidential production is the vast array of documents discussed above that it failed to provide despite previous promises to do so. (Opposer similarly misrepresents applicant's confidential production stating applicant produced a single paragraph. In fact, applicant provided both a product description and confidential interrogatory answers. Since applicant's product is still in development, other documents sought by opposer, such as advertising specimens, sales figures, advertising expenditures, and style manuals, simply do not exist).

likelihood of confusion claim. Opposer's proposed addition of a dilution claim two years after the oppositions were filed, like its stonewalling tactics with respect to providing discovery, will further delay applicant's registration and increase applicant's costs.

Applicant also disputes opposer's claims regarding the merits of its proposed dilution claim, but will not address them here since that is not the issue before the Board. *See, Trek*, 64 USPQ2d 1540 (Controlling factor is opposer's delay, not the sufficiency of its claim).

III. CONCLUSION

For the foregoing reasons, opposer's request for leave to file new motions to amend and compel and its motion for leave to amend should be denied.

Respectfully submitted,

SMART & BOSTJANCICH

By: Patricia S. Smart
Patricia S. Smart
John Bostjancich
19 S. LaSalle Street
Suite 1300
Chicago, Illinois 60603
(312) 857-2424

Attorneys for Applicant

CERTIFICATE OF SERVICE

I, Patricia S. Smart, an attorney for applicant, hereby certify that a copy of the foregoing Applicant's Opposition To "Opposer's Motion To Withdraw With Right To Refile" And To "Opposer's Leave To Amend Its Notices Of Opposition" is being served upon counsel for opposer James J. Wolfson, Greenberg Traurig, LLP, The Forum, 3290 Northside Parkway, Suite 400, Atlanta, GA 30327, this 27th day of January, 2005, by first class mail, postage prepaid.

Patricia S. Smart

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on January 27, 2005.

Patricia S. Smart

EXHIBIT A

Greenberg Traurig

James J. Wolfson
Tel. 678.553.2100
Fax. 678.553.2212
wolfsonj@gtlaw.com

December 2, 2004

VIA FACSIMILE & US MAIL

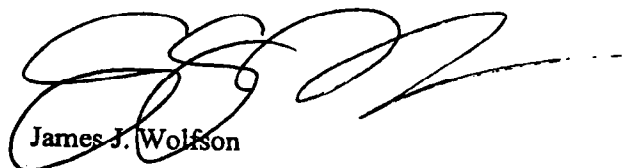
Patricia S. Smart, Esq.
Smart & Bostjancich
19 South LaSalle Street
Suite 1300
Chicago, Illinois 60603

Re: *National Academy of Recording Arts & Sciences, Inc. v. ShaReem, Inc.*;
Consolidated Opposition Nos. 91,154,092 and 91,154,147

Dear Ms. Smart:

This correspondence follows our telephone conversation on December 1, 2004. I have enclosed Opposer's Supplemental Responses to Applicant's Interrogatories and Document Requests. As agreed, counsel for both parties will Federal Express its client's documents to opposing counsel on December 9, 2004 for next day delivery. Counsel will then discuss the various pending motions as well as attempt to set deposition dates during our conference call on December 14, 2004 at 4pm (EST). We have contacted our client with regards to possible dates for depositions and the best time for them is either the first two weeks of January, 2005 or any time after February 16, 2005.

Sincerely,



James J. Wolfson

JJW:hm
495524

cc: Ms. Gail Podolsky

ALBANY
AMSTERDAM
ATLANTA
BOCA RATON
BOSTON
CHICAGO
DALLAS
DELAWARE
DENVER
FORT LAUDERDALE
LOS ANGELES
MIAMI
NEW JERSEY
NEW YORK
ORANGE COUNTY, CA
ORLANDO
SILICON VALLEY
PHILADELPHIA
PHOENIX
TALLAHASSEE
TYSONS CORNER
WASHINGTON, D.C.
WEST PALM BEACH
ZURICH

EXHIBIT B

Greenberg Traurig

Gail E. Podolsky
Tel. 678.553.2265
Fax. 678.553.2212
PodolskyG@gtlaw.com

December 9, 2004

VIA FEDERAL EXPRESS

Patricia S. Smart, Esq.
Smart & Bostjancich
19 South LaSalle Street
Suite 1300
Chicago, Illinois 60603

Re: *National Academy of Recording Arts & Sciences, Inc. v. ShaReem, Inc.*;
Consolidated Opposition Nos. 91,154,092 and 91,154,147

Dear Ms. Smart:

Enclosed please find documents produced in accordance with Opposer's Supplemental Responses to Applicant's Interrogatories and Document Requests by the National Academy of Recording Arts & Sciences, Inc. in the above-referenced Oppositions.

In accordance with the Protective Order, documents numbered NARAS 1404 through NARAS 1901 have been stamped "Trade Secret/Commercially Sensitive." Documents numbered NARAS 1902 through 1942 are stamped "Highly Confidential."

Sincerely,


Gail Podolsky

GP:hm

Enclosures

cc: Ann Meckelborg
Bobby Rosenbloum, Esq.
Kristen Fancher, Esq.
James J. Wolfson, Esq.

496551

ALBANY
AMSTERDAM
ATLANTA
BOCA RATON
BOSTON
CHICAGO
DALLAS
DELAWARE
DENVER
FORT LAUDERDALE
LOS ANGELES
MIAMI
NEW JERSEY
NEW YORK
ORANGE COUNTY, CA
ORLANDO
SILICON VALLEY
PHILADELPHIA
PHOENIX
TALLAHASSEE
TYSONS CORNER
WASHINGTON, D.C.
WEST PALM BEACH
ZURICH

EXHIBIT C

Gail E. Podolsky
Tel. 878.553.2265
Fax 878.553.2212
PodolskyG@gtlaw.com

January 7, 2005

VIA FACSIMILE

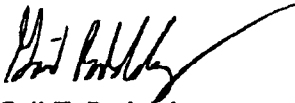
Patricia S. Smart, Esq.
Smart & Bostjancich
19 South LaSalle Street
Suite 1300
Chicago, Illinois 60603

Re: *National Academy of Recording Arts & Sciences, Inc. v. ShaReem, Inc.;*
Consolidated Opp. Nos. 91.154.092 and 91.154.147

Dear Patti:

In accordance with Jim's letter sent on January 4, 2005, enclosed please find NARAS 309-316.

Sincerely,



Gail E. Podolsky

cc: James J. Wolfson, Esq.