

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

Brown/Lykos

Mailed: September 4, 2007

Opposition Nos. 91169654  
91169655

Visual Changes Skin Care  
International, Inc.

v.

Neways, Inc.

**Before Hairston, Grendel and Cataldo, Administrative  
Trademark Judges.**

By the Board:

This case now comes before the Board for consideration of 1) opposer's motion (filed August 31, 2006) to amend its notices of opposition; 2) applicant's motion (filed October 3, 2006) for leave to file amended answers to assert a counterclaim; and 3) applicant's motion (filed September 22, 2006) to dismiss these consolidated proceedings. Opposer's motion to amend and applicant's motion to dismiss have been fully briefed.<sup>1</sup>

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<sup>1</sup> Both opposer and applicant have submitted reply briefs which the Board has exercised its discretion to consider. See Trademark Rule 2.127(e)(1).

For the reasons discussed below, opposer's motion for leave to amend its notices of opposition is granted; applicant's motion for leave to amend its answers to assert a counterclaim is moot; and applicant's motion to dismiss is denied.

**Opposer's Motion to Amend its Notice of Opposition**

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the 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, for example, Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); and *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993).

In addition, the timing of the motion for leave to amend is a major factor in determining whether applicant would be prejudiced by allowance of the proposed amendment. *See Trademark Trial and Appeal Board Manual of Procedure* § 507.02 (TBMP) (2d ed. rev. 2004) and cases cited therein. A motion for leave to amend should be filed as soon as any ground for such amendment becomes apparent.

Long and unexplained delays in filing such a motion may render it untimely. See *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984). Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion. See Wright, Miller and Kane, *Federal Practice and Procedure: Civil 2d*, Section 1488 (1990); Chapman, Tips from the TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Reporter 302, 307 (1991).

Here, opposer filed notices of opposition against Serial Nos. 78490954 and 78490974 for the marks RESURRECTION BIOMIST and NEWAYS RESURRECTION BIOMIST on March 9, 2006, asserting in both cases claims of likelihood of confusion and priority of use under Section 2(d) of the Trademark Act.<sup>2</sup> In the original notices, opposer pleaded ownership of Registration No. 3064428 for the mark RESURRECTION for use on "perfumery, essential oils, cosmetics and hair lotions." Opposer also pleaded common law rights in the mark RESURRECTION asserting that it had been using the mark since May 31, 2003 to identify the goods listed in its

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<sup>2</sup> Serial No. 78490954, identifying the mark NEWAYS RESURRECTION BIOMIST is the subject of Opposition No. 91169655 while Serial No. 78490974, identifying the mark RESURRECTION BIOMIST is the subject of Opposition No. 91169654. On July 11, 2006, the respective oppositions were consolidated and Opposition No. 91169654 is the parent file.

registration as well as in connection with "the sale of" other skin care products in each case.

By motion in both proceedings, opposer now seeks to "eliminate reliance upon its federal registration" and to "instead rely upon its common law rights..." Subsequent to the institution of these proceedings, and shortly after the filing of opposer's motion to amend its pleadings, on October 13, 2006, opposer filed a voluntary surrender of its pleaded Registration No 3064428. The registration was cancelled on April 10, 2007. Opposer's amended pleadings also contain a more detailed listing of the skin care preparations and cosmetic products that opposer has alleged to have used its mark on or in connection therewith.

Thus, it is clear that opposer has not changed its original ground for opposition nor asserted a new theory as applicant has alleged. Rather, opposer wishes to now rely solely upon the common law rights that were previously alleged in the original notices of opposition and that have evolved from ownership of its prior, though now cancelled, registration. Other than listing and in some instances clarifying the types of skin care products, the proposed amended pleadings, in all relevant aspects, remain wholly consistent with the original pleadings.

In fact, there are no material differences between the pleadings inasmuch as the amended notices of opposition rely

upon the same grounds pled in the original complaints, namely priority and likelihood of confusion, and allege the same date of first use for purpose of priority, that is May 31, 2003. The proposed amendment therefore does not constitute a colorable change to the original claims.

By eliminating the registration as a basis for asserting priority, the proposed amendment merely narrows the issue and thus serves a useful purpose. Moreover, the Board has freely granted leave even in instances where a party has attempted to plead claims that were different than those stated in the original notice of opposition. See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1877 (Fed. Cir. 1991).

The record is also absent of any significant delays in filing opposer's motion. Opposer's motion to amend was filed a short time prior to opposer's voluntary surrender of its registration. Thus, it appears that the motion to amend was filed at least around the time opposer became aware that reliance upon its prior registration was no longer practical or viable.

In addition, the motion was filed in the pre-trial stage of the proceedings. While filed less than six weeks prior to the close of discovery, such entry does not appear to have substantially prejudiced or harmed applicant. Likewise, extending discovery or reopening discovery, as the

Board has decided to do in this case, will help to mitigate any prejudice suffered by applicant. *Boral Ltd. V. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000).

In view thereof, opposer's motion to amend its notices of opposition is granted. Opposer's amended pleadings, submitted concurrently therewith, supercede the original notices and are now the operative pleadings in both cases as consolidated.

**Applicant's Motion For Leave to Amend its Answer**

We now turn to applicant's motion for leave to amend its answers. In the motion, applicant wishes to amend its answers by adding a counterclaim seeking cancellation of opposer's pleaded Registration No. 3064428. As noted above, opposer voluntarily surrendered that registration approximately ten (10) months ago and the Office canceled it on April 10, 2007. Insofar as the Board has granted opposer's motion to amend its pleadings to remove its reliance on the canceled registration, applicant's motion for leave to amend its answer to add a counterclaim is moot.

**Applicant's Motion to Dismiss**

We consider now applicant's motion to dismiss the proceedings pursuant to Fed. R. Civ. P.11(b)(3) for opposer's alleged failure to conduct a reasonable investigation of the factual and legal basis of its claims prior to filing the notices of opposition. Inasmuch as

applicant failed to comply with the "safe harbor" requirements of the rule, the motion is denied.<sup>3</sup> See Fed. R. Civ. P. 11(c)(1)(A).

Lastly, to the extent, if any, applicant is moving for dismissal for failure to state a claim under Fed. R. Civ. P. 12(b)(6), the motion is denied. Here, valid grounds exist for denying the registrations sought in this case, namely opposer's Section 2(d) claim and alleged priority pursuant to its common law rights.

In view of the foregoing, applicant is allowed until THIRTY (30) DAYS from the mailing date of this order to answer the amended notices of opposition. Insofar as the Board prefers each case to have complete pleadings, the answers should be filed as a separate submission in each case.

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<sup>3</sup> In any event, even if we were to consider the Rule 11 motion on its merits, nothing in the record supports a finding that sanctions are appropriate in this case.

Discovery and testimony dates are now reset as follows:

DISCOVERY PERIOD TO CLOSE:	10/19/07
Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	01/17/08
Testimony period for party in position of defendant to close: (opening thirty days prior thereto)	03/17/08
Rebuttal testimony period to close: (opening fifteen days prior thereto)	05/01/08

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. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**Amendment of Rules Governing Inter Partes Proceedings**

Finally, the USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are

referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>