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

Proceeding	91170258
Party	Defendant VODAFONE GROUP PLC VODAFONE GROUP PLC THE COURTYARD 2 - 4 LONDON ROAD, NEWBURY GBX BERKSHIRE RG14 1JX,
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Signature	/Nicole B Emmons/
Date	02/02/2007
Attachments	Motion for Leave to File Amended Answer.pdf ( 17 pages )(2004510 bytes )

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

.....  
DANIEL A. MENDOZA,

Opposer,

vs.

VODAFONE GROUP PLC,

Applicant.  
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Opposition Nos.: 91169419, 91169697,  
91170049, and 91170258

Application Nos.: 76/226,646; 76/226,645;  
76/462,142; and 76/375,495

**APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER**

Pursuant to 37 C.F.R. § 2.107 and Federal Rule of Civil Procedure 15, Applicant, Vodafone Group PLC ("Vodafone" or "Applicant"), hereby files this Motion for Leave to Amend Answer. In recent discussions with Opposer, Daniel Mendoza ("Mendoza" or "Opposer"), Opposer revealed facts that provide grounds for a counterclaim for cancellation. As the discovery period remains open, both parties will have the opportunity to conduct additional discovery relating to the proposed counterclaim. The Board should grant Applicant's Motion for Leave to Amend Answer because the recently-discovered grounds for cancellation can be efficiently added and the proposed amendment will not prejudice Opposer.

**BACKGROUND**

Opposer filed opposition proceedings against Vodafone's Application Nos. 76/375,495, 76/226,646; 76/226,645; and 76/462,142. Opposer based its Oppositions on Registration No. 2,389,214 for the word mark "< >" in International Class 35 for "dissemination of advertising for others via telephones and an on-line electronic communications network" and for "entertainment in the nature of prerecorded messages in the field of arts and humanities by telephone and a global computer network" in International Class 41 (the "Registered Mark").

On November 9, 2006, counsel for Vodafone conducted a telephone conference with Mendoza. Among other things, the parties discussed the status of the proceeding, discovery and extension of the discovery deadline. Emmons Decl., ¶¶ 3-5. During the telephone conference, Mendoza requested an extension of the discovery deadline and also provided informal discovery to Vodafone. *Id.*, ¶¶ 4-5. Among other things, Vodafone learned that Mendoza has abandoned any trademark use of the Registered Mark and that the Registered Mark is used in a purely generic way and does not function as a trademark. *Id.*, ¶ 5.

On January 11, 2007, counsel for Vodafone conducted another telephone conference with Mendoza. Mendoza again requested an extension of the discovery, stating that he had been busy prosecuting other Board proceedings and had not had time to attend to this proceeding. *Id.*, ¶ 6. Vodafone agreed to the extension and filed unopposed extension requests in each of the opposition proceedings.

In each of the telephone conferences, Mendoza indicated that he would provide evidence of his alleged use. *Id.*, ¶ 5-6. As of the date of this Motion, Mendoza has not produced any such evidence. *Id.*, ¶ 7. With the recent extension of the discovery dates, the parties have time to conduct any necessary discovery relating to Opposer's use. Accordingly, each party will have an opportunity to investigate the proposed new counterclaim and Opposer will not be prejudiced by the amendment.

## ARGUMENT

### A. Leave to Amend Should Be Freely Granted

Federal Rule of Civil Procedure 15 governs amendments of the pleadings in opposition proceedings (37 CFR § 2.107), and Rule 15(a) requires that parties obtain leave of Court to file an amended pleading after the defendants' initial answer. Rule 15(a) provides that such leave shall be "freely given" barring any improper purpose or prejudice. *Foman v. Davis*, 83 S.Ct.

227, 230 (1962). In fact, the Supreme Court, federal circuit courts, and the Board apply Rule 15(a) to routinely grant leave to amend and will deny a motion for leave *only* when the nonmovant demonstrates undue delay, undue prejudice, bad faith or dilatory motive, failure to cure deficiencies by amendments previously allowed, or futility of the proposed amendment. *State of Neb. v. State of Wyo.*, 115 S.Ct. 1933, 1938 (1995); *Foman*, 83 S.Ct. at 230; *Regents of the Univ. of N.M. v. Knight*, 66 USPQ2d 1001, 1010 (Fed. Cir. 2003); *Commodore Electronics Ltd v. Cbm Kabushiki Kaisha Opposition*, 26 USPQ2d 1503, 1504-05 (TTAB 1993) (consistent with *Foman*, the Board has recognized that amendments to the pleadings should be allowed with “great liberality at any stage of the proceedings”). Further, delay alone is not grounds to deny leave to amend, the nonmovant must demonstrate actual prejudice from the delay. *Bediako v. Stein Mart, Inc.*, 354 F.3d 835, 841 (8th Cir. 2004) (“Delay alone is not enough to deny a motion to amend; prejudice to the nonmovant must also be shown.”) (internal quotations omitted). And prejudice is not generally found where the discovery period remains open. *United States Olympic Committee v. O-M Broad, Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993) (“applicant would not be prejudiced because the proceeding is still in the pre-trial phase and, indeed, discovery has been extended”).

**B. Leave Should Be Granted to Allow Addition of Newly Discovered Counterclaims**

In this case, justice requires leave to amend to add the newly discovered grounds for cancellation. As mentioned above, recent discussions during discovery revealed that Mendoza has abandoned any trademark use of the Registered Mark. Further, discovery has revealed that Mendoza is not using the Registered Mark in commerce to identify the source of any goods or services and Mendoza was not using the Registered Mark in commerce at the time he filed the trademark application, the time he filed the § 8 Declaration of Use, and the time he filed the § 15 Affidavit of Incontestability. Further still, discovery has revealed that any on-going use of the

Registered Mark in commerce is purely generic and that the Registered Mark is not functioning as a trademark. Emmons Decl., ¶ 5.

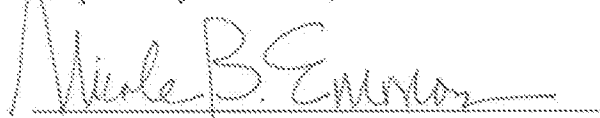
While Vodafone intends to conduct additional discovery to further investigate the above facts, the informal discovery recently obtained provides grounds for the proposed counterclaim for cancellation. See *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (any ground that could have prevented registration may be grounds for cancellation). As the discovery period remains open, the amended answer and counterclaim will not prejudice Mendoza. See *O-M Bread Inc.*, 26 USPQ2d at 1223.

#### CONCLUSION

The Federal Rules of Civil Procedure and controlling case law provide that leave to amend pleadings shall be freely given. As the discovery period remains open in this proceeding, Mendoza will not be prejudiced by the proposed amendment to add the newly-discovered counterclaim. Accordingly, Applicant respectfully requests leave to amend its Answer to assert a counterclaim for cancellation. A proposed Amended Answer and Counterclaim is attached hereto as Exhibit A.

Dated: 2-2, 2007

Respectfully submitted,



NICOLE B. EMMONS  
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ATTORNEYS FOR APPLICANT  
VODAFONE GROUP PLC

CERTIFICATE OF CONFERENCE


I hereby certify that on the 9th day of November, 2006 and the 11th day of February, 2006, I discussed the substance of the foregoing **APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER** with Opposer, Daniel Mendoza. We did not reach agreement regarding the substance of the Motion and the Motion is therefore filed as an opposed motion.

  
Nicole B. Emmons

CERTIFICATE OF SERVICE

The undersigned certifies that on the 2<sup>nd</sup> day of February, 2007, a true copy of the foregoing **APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER** was served on Opposer, via First Class mail, postage prepaid as follows:

DANIEL A. MENDOZA  
P.O. Box 193156  
San Francisco, CA 94119-3156

  
Nicole B. Emmons

# EXHIBIT A

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

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DANIEL A. MENDOZA,	§	
	§	
	§	
Opposer,	§	Opposition Nos.: 91169419, 91169697,
	§	91170049, and 91170258
vs.	§	
	§	
	§	Application Nos.: 76/226,646; 76/226,645;
VODAFONE GROUP PLC,	§	76/462,142; and 76/375,495
	§	
	§	
Applicant.	§	
.....	§	

APPLICANT'S FIRST AMENDED ANSWER AND COUNTERCLAIM

Pursuant to 37 C.F.R. § 2.706, VODAFONE GROUP PLC (hereinafter "Applicant"), a public limited company organized under the laws of the United Kingdom, with principal offices located at Vodafone House, The Connection, Newbury, Berkshire RG14 2FN, United Kingdom, hereby answers the Notice of Opposition filed by Opposer DANIEL A. MENDOZA (hereinafter "Opposer"), as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the unnumbered introductory allegation and therefore denies the same.
2. With respect to the allegations of Paragraph 1, Applicant admits it filed the application at issue. The facts contained on the application at issue speak for themselves. Further, upon information and belief, Applicant denies that the Registered Mark is used with the recited goods or services. Applicant is without knowledge or information sufficient to form a belief as to the truth of any remaining allegations in Paragraph 1 and therefore denies the same.



3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 and therefore denies the same.

4. Applicant admits that U.S. Registration No. 2,389,214 states on its face that it issued on September 26, 2000. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3 and therefore denies the same.

5. With respect to the allegations of Paragraph 4, Applicant admits Opposer's Registration states on its face that it was filed on November 4, 1998 for the goods or services identified in said paragraph, but Applicant denies that the application was for registration of the mark shown in said paragraph and is otherwise without knowledge or information sufficient to form a belief as to the truth of the matters asserted therein and therefore denies the same.

6. Applicant denies the allegations of Paragraph 5.

7. Applicant denies the allegations of Paragraph 6.

8. Applicant denies the allegations of Paragraph 7.

9. With respect to the allegations of Paragraph 8, Applicant admits that it filed the application at issue but denies that Opposer has properly described the application. By way of further answer, Applicant states that the information provided on the application at issue speaks for itself.

10. With respect to the allegations of Paragraph 9, Applicant admits that it filed the application at issue but denies that Opposer has properly described the application. By way of further answer, Applicant states that the information provided on the application at issue speaks for itself.

11. Paragraph 10 purports to state one or more legal conclusions to which no Answer is required. To the extent that an Answer is required, Applicant denies the allegations of Paragraph 10.

12. Applicant denies the allegations of Paragraph 11.

13. To the extent that the allegations of Paragraph 12 are understood to allege that Applicant's mark is descriptive of "telephony, telephone communication services and the global communications network" and related services, Applicant denies said allegations, and Applicant otherwise is without sufficient understanding of the meaning of the allegations to form a belief as to their truth and therefore denies the same.

14. To the extent that the allegations of Paragraph 13 are understood to allege that the use of Applicant's mark is likely to cause confusion in view of Opposer's alleged earlier use of its alleged mark, Applicant denies said allegations, and Applicant otherwise is without sufficient understanding of the meaning of the allegations to form a belief as to their truth and therefore denies the same.

15. Applicant denies the allegations of Paragraph 14.

16. Applicant denies the allegations of Paragraph 15.

17. Applicant denies the allegations of Paragraph 16.

18. With respect to the allegations of Paragraph 17, Applicant admits that if the application for registration of Applicant's mark proceeds to registration, the registration would be prima facie evidence of Applicant's exclusive ownership and right to use its mark in connection with the services in the registration, but Applicant otherwise denies the allegations of said paragraph.

19. To the extent that the allegations of Paragraph 18 are understood as seeking to effectuate legally effective notice and reservation of any rights Opposer may have with respect to the use or registration of Applicant's mark anywhere in the world, Applicant denies said allegations, and Applicant otherwise is without sufficient understanding of the meaning of the allegations to form a belief as to their truth and therefore denies the same.

#### **AFFIRMATIVE DEFENSES**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. Applicant's mark is not confusingly similar to the alleged mark of Opposer in the Notice of Opposition.
3. Upon information and belief, Opposer has not made and is not currently making a bona fide trademark use of the mark as shown in Opposer's Trademark Registration.
4. Upon information and belief, Opposer has abandoned any rights in the mark shown in the Opposer's Trademark Registration without intent to resume use of the mark.
5. The doctrine of unclean hands bars Opposer from the relief requested in Opposer's Notice of Opposition.

WHEREFORE, Applicant denies that Opposer is entitled to the relief requested in its Notice of Opposition and requests that the Notice of Opposition be dismissed.

#### **COUNTERCLAIM FOR CANCELLATION**

1. Upon information and belief, Opposer is the owner of Trademark Registration No. 2,389,214 for the word mark "<"> in International Class 35 for "dissemination of advertising for others via telephones and an on-line electronic communications network" and in International Class 41 for "entertainment in the nature of prerecorded messages in the field of

arts and humanities by telephone and a global computer network” (“Opposer’s Registered Mark”).

2. Opposer has asserted Opposer’s Registered Mark against numerous trademark applications filed by Applicant.

3. Upon information and belief, Opposer is not currently making a bona fide trademark use of Opposer’s Registered Mark in interstate commerce and Opposer is not entitled to trademark protection for Opposer’s Registered Mark.

4. Upon information and belief, Opposer committed fraud in filing the trademark application that became the Registered Mark, in filing the Combined § 8 Declaration of Use and § 15 Affidavit of Incontestability by knowingly making false statements regarding material facts relating to his alleged use of the Registered Mark in commerce, when Opposer was not actually using the mark in commerce at the time of the alleged filing.

5. Upon information and belief, Opposer abandoned any legitimate trademark use of the Registered Mark without the intent to resume trademark use.

6. Upon information and belief, any current use of Opposer’s Registered Mark is purely generic and the Registered Mark does not perform a trademark function for the public.

7. Applicant believes that it has and will be damaged by Opposer’s Registered Mark.

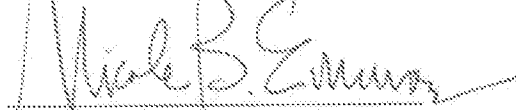
WHEREFORE, Applicant contends that this Opposition is groundless and baseless in fact; that Opposer has abandoned all rights in Opposer’s Registered Mark; that Opposer is not entitled to trademark protection for Opposer’s Registered Mark because Opposer is not making a bona fide trademark use of Opposer’s Registered Mark in interstate commerce; that Opposer committed fraud by falsely declaring use in commerce in the trademark application that became the Registered Mark, in the Combined § 8 Declaration of Use and § 15 Affidavit of

Incontestability when Opposer was not using the mark in commerce at those times; that any current use of Opposer's Registered Mark is purely generic and that the mark does not perform a trademark function for the public. Accordingly, Applicant requests:

- A. that this Opposition be dismissed and the application at issue be granted registration;
- B. that Opposer's Registered Mark be cancelled; and
- C. that Applicant be granted such other and further relief as the Board deems just and proper.

The fee required by § 2.6 will be paid simultaneously with filing.

Respectfully submitted,



Dated: February 2, 2007

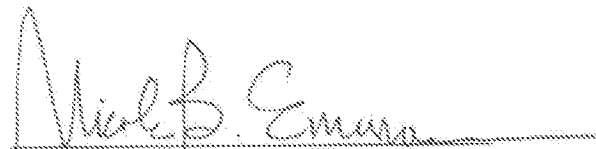
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**ATTORNEYS FOR APPLICANT**  
**VODAFONE GROUP PLC**

CERTIFICATE OF SERVICE

The undersigned certifies that on the 2nd day of February, 2007, a true copy of the foregoing **APPLICANT'S FIRST AMENDED ANSWER AND COUNTERCLAIM** was served on Opposer, via First Class mail, postage prepaid, as follows:

DANIEL A. MENDOZA  
P.O. Box 193156  
San Francisco, CA 94119-3156

  
\_\_\_\_\_  
Nicole B. Emmons



4. Among other things, Mr. Mendoza and I discussed the status of these proceedings and additional discovery that may be necessary. Mr. Mendoza asked that Applicant consent to an extension of the discovery periods and I provided Applicant's consent to the extensions.

5. Mr. Mendoza also provided a number of facts relating to his trademarks and the allegedly-related services. Among other things, Mr. Mendoza described his operations and directed me to a number of websites that allegedly identify the services relating to his trademarks. Mr. Mendoza also indicated that he would provide further documentation relating to those services during discovery. From this discussion and other evidence obtained as part of Applicant's discovery investigations, it became apparent that Applicant can plead a good-faith claim for cancellation of the trademark registration asserted against the applications-at-issue. More specifically, it now appears that Mr. Mendoza has abandoned the Registered Mark and/or does not make actual commercial trademark use of the Registered Mark. Further, my discussion with Mr. Mendoza revealed that the Registered Mark, if used at all, is used in a generic sense. Further still, my discussion with Mr. Mendoza revealed that the Registered Mark was not in use in commerce at the time Mr. Mendoza originally filed the trademark application and the Combined § 8 Declaration of Use and § 15 Affidavit of Incontestability for the Registered Mark.

6. On January 11, 2007, I again spoke with Mr. Mendoza on the telephone. We again discussed the status of the cases and Mr. Mendoza again requested an extension of the discovery deadlines because he had been busy with other Board proceedings. Mr. Mendoza indicated that he would once again send documents within a week evidencing his use of the Registered Mark in connection with legitimate goods and services.

7. Mr. Mendoza once again failed to produced any documents to indicate that he is currently using the Registered Mark.




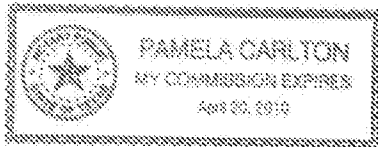
§. I declare under penalty of perjury under the laws of the United States and the State of Texas that the foregoing is true and correct."

Executed this 2<sup>nd</sup> day of February, 2007.

  
\_\_\_\_\_  
Nicole B. Emmons

SWORN TO AND SUBSCRIBED TO BEFORE ME this 2<sup>nd</sup> day of February, 2007.


  
\_\_\_\_\_  
PAMELA CARLTON  
Notary Public, in and for the State of Texas  
My Commission Expires: **APRIL 10, 2010**



CERTIFICATE OF SERVICE

The undersigned certifies that on the 2<sup>nd</sup> day of February, 2007, a true copy of the foregoing **DECLARATION OF NICOLE EMMONS IN SUPPORT OF APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER** was served on opposing counsel, via First Class mail, postage prepaid:

DANIEL A. MENDOZA  
P.O. Box 193156  
San Francisco, CA 94119-3156

  
\_\_\_\_\_  
Nicole B. Emmons