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

MBA

Mailed: September 2, 2009

Opposition No. 91187342

Sean Puffy Combs

v.

Pacific Rim Marketing Inc.

Before Seeherman, Rogers and Ritchie, Administrative Trademark Judges

By the Board:

This case now comes up for consideration of opposer's combined motion, filed January 14, 2009, for: (1) leave to file an amended notice of opposition; and (2) judgment on the pleadings, i.e. on opposer's proposed amended notice of opposition and applicant's answer. The motion is fully briefed.

Background

Applicant seeks registration of IDIDDY, in standard characters, for "Headphones and cases specially adapted for MP3 players, cell phones and video disc players."[1] In his original notice of opposition, opposer alleges that he "has been known worldwide under the name P. DIDDY since at least

[1] Application Serial No. 78615932, filed April 25, 2005, based on a claimed date of first use in commerce of April 6, 2005.

as early as 2001." As grounds for opposition, opposer alleges prior use and registration of P. DIDDY for a wide variety of entertainment-related goods and services,[2] and that use of applicant's mark is likely to cause confusion with, and dilute, opposer's mark; opposer further alleges that "use of IDIDDY by Applicant will falsely suggest a connection with Opposer, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a)." In its answer, applicant denies the salient allegations in the notice of opposition, and specifically claims that

> [t]he brand name and MP3 carrying case iDiddy was conceived from the phrase 'Diddy Bag,' which was a reference to a small bag used to carry small items by U.S. Military servicemen as early as World War One. This descriptive phrase for a small bag used to carry incidental items was used in the defendant's household as a child … The 'i' in iDiddy was derived from the letter 'i' used in Apple Inc's iMac, iPod, and iTunes and the 'i' and the word Diddy (from Diddy Bag) were combined to create the product brand and product name 'iDiddy.'"

Answer ¶¶ 2-3.

Opposer's Motion and Applicant's Response

Opposer seeks leave to amend his notice of opposition to add a claim that applicant's mark "is descriptive of the

[2] Registration No. 3109611, issued June 27, 2006 based on dates of first use in commerce of 2001-2003 for musical and video recordings, live musical performances, providing a Web site featuring information on fashion and culture and related goods and services.

goods covered by the subject application" and is therefore "not registrable on the Principal Register under 15 U.S.C. § 1052(e)(1)." Proposed Amended Notice of Opposition ¶¶ 18-19. According to opposer, "in its Answer, Applicant admitted that its mark is descriptive of the goods covered by its application," that opposer moved promptly for leave to amend based on applicant's alleged "admission" and that because "nothing has happened in this proceeding since Applicant filed its Answer, there can be no prejudice to Applicant if this motion is granted." Opposer also moves for judgment on the pleadings on his proposed claim of mere descriptiveness, based on applicant's alleged "admission."

Applicant failed to timely respond to opposer's combined motion. Nevertheless, the Board did not grant opposer's motion as conceded, even though it was within the Board's discretion to do so under Trademark Rule 2.127(a). Instead, in its order of April 21, 2009, the Board, "[t]o assure that applicant did not misapprehend" the suspension order of January 23, 2009, allowed applicant twenty additional days, i.e., until May 11, 2009, to respond to opposer's motion. Once again applicant failed to respond within the time provided. However, applicant filed an untimely response to opposer's motion on May 12, 2009.

In his reply brief, opposer argues that applicant's response to his motion is untimely and "therefore should be

ignored by the Board." According to opposer, "[i]f the Board accepts and reviews applicant's response to opposer's motion, rather than treating opposer's motion as conceded, it will be tacitly acknowledging that a *pro se* party is free to ignore a deadline set by the Board, even when the Board has gone out of its way to make sure that party understands what the deadline is."

Decision

Before addressing the merits of opposer's combined motion, we must first determine whether to grant opposer's motion as conceded, based on applicant's failure to timely respond. In this case, applicant's late response indicates that opposer's motion is not conceded, and therefore opposer's motion will not be treated as such. However, because applicant failed to timely respond to the motion, even after being given a second opportunity to do so, we have not considered applicant's late response.

Turning now to opposer's motion for leave to amend, under Fed. R. Civ. P. 15(a), leave to amend a pleading "shall be freely given when justice so requires." Accordingly, the Board is generally liberal in granting leave to amend pleadings, "unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." International

Finance Corp. v. Bravo Co., 64 USPQ2d 1597, 1604 (TTAB 2002). Indeed

> [i]f the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits. In the absence of any apparent or declared reason – such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. – the leave sought should, as the rules require, be "freely given."

Foman v. Davis, 331 U.S. 178, 182 (1962) (quoted with approval in Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503, 1505 (TTAB 1993)).

Here, opposer filed his motion for leave to amend promptly after applicant served its answer. Furthermore, as opposer points out, this case is in its early stages, and opposer filed his motion well before the close of discovery and well before trial. There is no evidence that applicant would be prejudiced if leave is granted, nor is there any evidence that opposer has acted in bad faith or otherwise improperly. Accordingly, opposer's motion for leave to amend is hereby **GRANTED**. Hurley International LLC v. Volta, 82 USPQ2d 1339, 1341 (TTAB 2007); Commodore Electronics, 26 USPQ2d at 1506. Opposer's proposed amended notice of opposition is accepted and is now opposer's operative

pleading herein. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to file an answer to the amended notice of opposition.

Turning next to the motion for judgment on the pleadings, "[a] motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings." Rickson Gracie LLC v. Gracie, 67 USPQ2d 1702, 1703 (TTAB 2003). Motions for judgment on the pleadings are

> designed to provide a means of disposition of a case when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings. See Fed. R. Civ. P. 12(c). For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true, and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party. … An unresolved material issue of fact may result from an express conflict on a particular point between the parties' respective pleadings or from defendant's pleading of new matter and affirmative defenses in its answer. … a plaintiff may not secure a judgment on the pleadings when the answer raises issues of fact that, if proved, would defeat a plaintiff's claim.

Leeds Technologies Ltd. v. Topaz Communications Ltd., 65 USPQ2d 1303, 1305 (TTAB 2002) (citations omitted).

Opposer requests judgment on the pleadings on his allegation that applicant's mark is merely descriptive, arguing that applicant's alleged "admissions" in its answer establish that applicant's mark is merely descriptive and,

therefore, that opposer is entitled to judgment on the pleadings. We disagree.

Even if we were to construe applicant's answer as an admission of opposer's claim of mere descriptiveness, and we do not do so, "[u]nder no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record." Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 929, 198 USPQ 151, 154 (CCPA 1978); see also, In re Hester Industries, Inc., 230 USPQ 797, 798 (TTAB 1986) ("we are not bound by the applicant's conclusions on [descriptiveness] any more than we are by the Examining Attorney's"); Harco Laboratories, Inc. v. The Decca Navigator Company Limited, 150 USPQ 813, 814 n. 2 (TTAB 1966).

Accordingly, opposer's motion for judgment on the pleadings is hereby **DENIED**. However, the Board has now twice exercised its discretion to not grant judgment on the pleadings, even though applicant twice failed to timely respond to opposer's motion. Applicant should not expect, and will not be granted, a third chance. Whether it chooses to obtain counsel, as recommended in the Board's orders of January 23 and April 21, 2009, or chooses to continue representing itself, applicant is required to comply with all Board rules and procedures, and failure to do so will be

at applicant's peril. **Failure to timely respond to a motion or comply with the Board's rules and procedures may result in judgment being entered in opposer's favor and against applicant, and applicant being refused registration.**

Conclusion

Opposer's motion for leave to amend is granted, opposer's motion for judgment on the pleadings is denied and applicant's answer to the amended notice of opposition shall be served and filed within **THIRTY DAYS** of the mailing date of this order. Disclosure, conferencing, discovery, trial and other dates are reset as follows:

Deadline for Discovery Conference	**October 19, 2009**
Discovery Opens	**October 19, 2009**
Initial Disclosures Due	**November 18, 2009**
Expert Disclosures Due	**March 18, 2010**
Discovery Closes	**April 17, 2010**
Plaintiff's Pretrial Disclosures	**June 1, 2010**
Plaintiff's 30-day Trial Period Ends	**July 16, 2010**
Defendant's Pretrial Disclosures	**July 31, 2010**
Defendant's 30-day Trial Period Ends	**September 14, 2010**
Plaintiff's Rebuttal Disclosures	**September 29, 2010**
Plaintiff's 15-day Rebuttal Period Ends	**October 29, 2010**

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. Trademark Rule 2.l25.

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.l29.

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