

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: October 1, 2009

Opposition No. 91188035

Guess? IP Holder L.P. and
Guess?, Inc.

v.

Advance Watch Company Ltd.

By the Trademark Trial and Appeal Board:

This case now comes up for consideration of opposers' motion (filed August 21, 2009) to amend their notice of opposition to add a recently issued registration of opposer Guess?, Inc. for the mark GC as an additional basis for opposition. Concurrently with aforementioned motion, opposers have filed a motion to extend the close of discovery thirty days from the Board's ruling on opposers' motion to amend their pleading. The motions are briefed.

In support of their motion, opposers contend that because the registration which opposers seek to add to their pleading only recently issued and because the subject mark of the newly-issued registration is the same mark as the mark at issue in these proceedings, there would be no danger of prejudice to applicant if the Board permits the amendment, especially since opposers are willing to extend discovery to

afford applicant the opportunity to take discovery on the newly-issued registration. Opposers further contend that the amendment consists only of one brief paragraph that asserts ownership of the registration and alleges that the registration is valid and subsisting on the Principal Register plus some additional minor changes consistent with this assertion. In view of the foregoing and light of the Board's liberal policy for amending pleadings, opposers request that their motion to amend be granted.

In response, applicant contends that opposers waited four months after the issuance of the registration in which to file their motion to amend. Applicant argues that this delay is unreasonable and will unduly prejudice applicant. Additionally, applicant contends that the allowance of the amendment would create a disadvantage to applicant, as applicant has already formulated a position based on the pleadings as originally filed. For the foregoing reasons, applicant requests the Board to deny opposers' motion for leave to amend the notice of opposition.

Inasmuch as applicant has filed its answer herein, opposers may amend their notice of opposition only by written consent of applicant or by leave of the Board. See Fed. Civ. P. 15(a); TBMP § 507.02(a) (2d ed. rev. 2004).

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 or parties. *See id.* *See also American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

In deciding whether to grant leave to amend, a tribunal may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *See Foman v. Davis*, 371 U.S. 178, 182 (1962).

The Board notes that opposer Guess?. Inc.'s U.S. Registration No. 3605306 issued on April 14, 2009, yet opposers waited until three days before the close discovery, i.e., August 21, 2009, to file their motion to amend. The Board, while recognizing opposers' delay in asserting the amendment, nonetheless finds that allowing the amendment at this juncture in the proceeding would not unduly delay the case and would serve the interests of justice and judicial economy by permitting all claims and bases thereof to be adjudicated at once.

Moreover, the Board finds that allowing the amendment would not prejudice applicant inasmuch as opposers have indicated that they are willing to extend the discovery period to allow applicant the opportunity to take discovery in regard to opposers' newly-pleaded registration. Further,

the Board does not find that opposers' have acted in bad faith or in a dilatory manner.

The Board, however, does find that opposers' proposed amended notice of opposition to be futile, inasmuch as the proposed amended notice of opposition does not set forth a properly pleaded claim of likelihood of confusion for the reasons set forth below.

Opposers' amended notice of opposition alleges, in relevant part, the following:

Paragraph 2 of Amended Notice of Opposition

Since long prior to Applicant's priority date, Opposers have continuously and extensively used in commerce the mark GC, alone and in combination with other terms and designs (hereinafter the "GC Marks"), in connection with the sale of a variety of fashion and consumer products, including jewelry and watches.

Paragraph 3 of the Amended Notice of Opposition

Opposer is the owner of U.S. Registration No. 3,605,306 ("the '306 Registration") on the Principal Register for the mark GC for "Bracelets; Earrings: Horological and chronometric instruments and parts thereof; Cuff links and tie clips; Lapel pins; Necklaces; Rings; Watchbands; Wrist watches; Key rings of precious metal; Jewelry; Pocket watches; Clocks" in Class 14. The '306 Registration is valid and subsisting.

Paragraph 4 of the Amended Notice of Opposition

Through the widespread use and advertising of its GC Marks over a long period of time and by virtue of the quality of goods sold in connection with the GC Marks, Opposers have built up valuable goodwill and reputation in connection with the GC Marks, which would be jeopardized by Applicant's use and registration of the mark GC (stylized).

Paragraph 5 of the Amended Notice of Opposition

Applicant's goods for which it seeks to register the mark GC (stylized) are closely related to the goods sold by Opposers under the GC Marks.

Paragraph 6 of the Amended Notice of Opposition

Applicant's Marks so resembles Opposers' GC Marks, previously used in commerce and registered by Opposers and not abandoned, as to be likely, when applied to the goods of Applicant, to cause confusion or to cause mistake or to deceive.

After a careful review of opposers' amended notice of opposition, the Board finds that opposers have not pleaded the common law marks upon which they base their opposition with sufficient specificity. In particular, opposers allege use in commerce of the GC mark alone and in combination with other terms and designs without identifying those other terms and designs. Moreover, opposers allege that they use their common law marks in connection with "the sale of a variety of fashion and consumer products, including jewelry and watches." Such an allegation is deficient in that opposers have not identified with sufficient specificity the precise fashion and consumer products (aside from jewelry and watches) used in connection with their alleged common law GC marks. Finally, opposers have not even included the GC mark which is the subject of their newly-issued registration as part of their definition of "GC Marks" identified in the amended notice of opposition. By failing

to identify with specificity the alleged common law GC marks and the goods associated therewith upon which opposers wish to rely as a basis for their likelihood of confusion claim, opposers have failed to provide applicant sufficient notice pleading so as to give applicant fair notice of opposers' claim of likelihood of confusion. Accordingly, opposers' proposed amended notice of opposition does not state a valid claim of likelihood of confusion and, therefore, opposers' proposed amendment is deemed futile.

The Board further notes that opposers' likelihood of confusion claim asserted in opposers' originally-filed notice opposition is similarly deficient for the same reasons set forth above.

Accordingly, opposers' motion for leave to amend its notice of opposition is **denied**. Opposers, however, are allowed **thirty days** from the mailing date of this order in which to file and serve a renewed amended notice of opposition which sets forth a properly pleaded claim of likelihood of confusion pursuant to the guidelines set forth above, failing which opposers' claim of likelihood of confusion will be dismissed with prejudice and this proceeding will proceed solely with respect to opposers' asserted claims identified in Paragraphs 7 and 8 of opposers' originally-filed notice of opposition.

Proceedings herein are otherwise suspended pending opposers' response to the instant order.

In the event opposers file an amended notice of opposition, as permitted herein, the Board will issue a subsequent order which will provide applicant time in which to answer or otherwise respond to opposers' amended pleading. Additionally, the Board will reset the close of discovery for applicant only to afford applicant the opportunity to conduct limited discovery regarding opposers' newly-issued Registration No. 3605306 as well as any clarification to opposers' pleading, as ordered herein. Opposers are precluded from taking any further discovery in this proceeding.

In light of the instant order, opposers' motion to extend discovery filed on August 21, 2009 is deemed moot and will be given no further consideration.