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

| | |
|------------------------|--|
| Proceeding | 91195203 |
| Party | Plaintiff The United States Playing Card Company |
| Correspondence Address | STUART R. DUNWOODY, ESQ. DAVIS WRIGHT TREMAINE LLP 1201 THIRD AVENUE, SUITE 2200 SEATTLE, WA 98101 UNITED STATES stuardunwoody@dwt.com |
| Submission | Motion to Amend Pleading/Amended Pleading |
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| Signature | /Stuart R. Dunwoody/ |
| Date | 09/08/2010 |
| Attachments | Motion for Leave to Amend Notice of Opposition_91195203.pdf (6 pages) (138377 bytes) Exhibit A to Motion for Leave to Amend Notice of Opposition_91195203.pdf (9 pages) (57121 bytes) |

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

UNITED STATES PLAYING CARD
COMPANY,)
)
Opposer,)
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v.)
)
ANGEL PLAYING CARDS CO., LTD.,)
)
Applicant.)

Opposition No. 91195203

MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION

Pursuant to Fed. R. Civ. P. 15(a) and Trademark Rule 2.107, the Opposer, United States Playing Card Company (“USPC”), moves for leave to amend its Notice of Opposition to add USPC’s design mark associated with its ARISTOCRAT playing cards as a basis for its Opposition. The Board should grant leave to amend. Allowing the amendment will not prejudice the Applicant, Angel Playing Cards Co., Ltd. (“Angel”). This proceeding is still in its initial stages; the Discovery Period opened August 16, 2010 and will remain open until February 12, 2011, and the parties have not yet exchanged written discovery requests. The amendment does change the substantive issues of the proceeding, and allowing the amendment will promote judicial economy and the interest of justice.

I. FACTS

In this proceeding, USPC opposes Angel’s applications for design marks consisting of diamonds or similar diagonally-repeated designs, to be used in connection with playing cards. USPC bases its opposition on four U.S. Trademark Registrations that it owns, Nos. 48,763,

1 153,892, 2,694,791, and 3,049,851, each of which covers a design mark for playing cards
2 consisting in whole or in part of repeated diamonds.

3 USPC owns an additional diamond-based design mark for playing cards, the design that it
4 uses on its ARISTOCRAT brand playing cards. As stated in the proposed amended notice of
5 opposition that accompanies this motion, USPC has used this mark in commerce since long
6 before any date that Angel can rely on. Based on its long-standing and widespread use, USPC
7 has developed substantial trademark rights in this design, which identifies USPC as the source of
8 its playing cards and related goods and services.

9 Opposer has just recently served its initial disclosures, and neither party has served
10 written discovery requests yet. The proceeding is therefore in the very preliminary stages.

11 II. ARGUMENT

12 Granting USPC leave to amend its Notice of Opposition to include the ARISTOCRAT
13 design mark as an additional basis for opposition would further the interests of justice and would
14 not prejudice Angel. This motion to amend should therefore be granted.

15 Fed. R. Civ. P. 15(a), as made applicable by Trademark Rule 2.107, establishes that leave
16 to amend “shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a)(2). Under
17 Rule 15, a motion to amend should be granted unless the parties engage in procedural
18 improprieties such as “undue delay, bad faith or dilatory motive on the part of the movant,
19 repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the
20 opposing party by virtue of allowance of the amendment, futility of the amendment, etc.”

21 *Foman v. Davis*, 371 U.S. 178, 182 (1962). Similarly, the Board has held that “amendments to
22 pleadings should be allowed with great liberality at any stage of the proceeding where necessary
23 to bring a furtherance of justice unless it is shown that entry of the amendment would violate
24 settled law or be prejudicial to the rights of any opposing parties.” *American Optical Corp. v.*
25 *American Olean Tile Co., Inc.*, 168 U.S.P.Q. 471, 473 (TTAB 1971). To determine whether
26 leave to amend should be granted, the Board “must consider whether there is any undue
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1 prejudice to applicant and whether the amendment is legally sufficient.” *Commodore*
2 *Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (TTAB 1993).

3 Furthermore, when sufficient time remains in the discovery period for applicant to serve
4 additional discovery requests and opposer indicates agreement to extend the time for discovery,
5 the applicant is not prejudiced. *Id.* at 1506. *See also Marmark Ltd. v. Nutrexpa S.A.*, 12
6 U.S.P.Q.2d 1843, 1844 (TTAB 1989) (finding no prejudice even after service of written
7 discovery requests); *Anheuser-Busch, Inc. v. Martinez*, 185 U.S.P.Q. 434, 435 (TTAB 1975)
8 (granting leave to amend when proceeding at pre-trial stage and discovery period could be
9 reopened); Beth A. Chapman, *Tips from the TTAB, Amending Pleadings: The Right Stuff*, 81
10 TRADEMARK REP. 302, 305 (1991) (leave to amend generally granted during pre-trial stage
11 because discovery is still open or can be reopened without prejudice). Any resultant delay from
12 extending discovery is outweighed by the desire for full adjudication of the issues. Chapman,
13 *supra*, at 306.

14 For example, in *Huffy Corp. v. Geoffrey Inc.*, 18 U.S.P.Q.2d 1240, 1242 (Comm’r Pat.
15 1990), the opposer moved to amend the notice of opposition to include an additional trademark
16 registration as a basis for opposition. The Board held that amendment would improve judicial
17 economy by eliminating the need for additional proceedings and that the applicant would not be
18 unduly prejudiced because the opposition proceeding was in the pre-trial stage. *Id.* The
19 Commissioner of Patent and Trademarks upheld the Board’s decision, stating that the decision
20 promoted judicial economy and would avoid the possibility of a subsequent cancellation
21 proceeding. *Id.*

22 As in these cases, USPC’s proposed amended Notice of Opposition (i) does not prejudice
23 Angel because it is made before the close of discovery; (ii) does not add any new claims but
24 merely includes an additional basis for opposition; and (iii) promotes judicial economy and the
25 interest of justice.

26 First, Angel is not prejudiced because the discovery period is still open. In fact, the
27 discovery period opened just three weeks ago and will remain open through February 12, 2011.

MOTION FOR LEAVE TO AMEND
NOTICE OF OPPOSITION - 3

DWT 15330803v1 0091284-000040

Davis Wright Tremaine LLP
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1 Moreover, Opposer has only recently served initial disclosures and neither party has, as of yet,
2 served written discovery requests. This proceeding is clearly in the very preliminary stages
3 whereby amendment would not be prejudicial.

4 Second, the proposed amended Notice of Opposition does not prejudice Angel because it
5 does not add any new claims. The substantive legal claims remain unchanged, and the addition
6 of the ARISTOCRAT design mark merely augments the basis for USPC's previously-pleaded
7 claims.

8 Finally, granting leave to amend the Notice of Opposition would promote judicial
9 economy and the interests of justice by providing a full adjudication of the issues. Denial of the
10 motion to amend and exclusion of the ARISTOCRAT design mark as a basis for opposition
11 would open the door to a petition to cancel should registrations issue on Angel's applications.
12 To prevent such a redundancy and strain on judicial resources, this issue should be adjudicated
13 with the present proceeding.

14 III. CONCLUSION

15 USPC therefore respectfully requests that the Board grant leave to amend its Notice of
16 Opposition in this proceeding to include the ARISTOCRAT design mark as a basis for
17 opposition. Should Applicant request an extension of the discovery deadline to accommodate
18 this addition, USPC respectfully requests that the Board permit an extension and reset the
19 schedule for this proceeding accordingly. The proposed amended Notice of Opposition is being
20 filed at the same time as this motion. *See* TBMP 507.01 ("A signed copy of the proposed
21 amended pleading should accompany a motion for leave to amend a pleading.") In addition,
22 attached as Exhibit A is a copy of the proposed amended Notice of Opposition marked to show
23 the changes from the original Notice of Opposition.

1 RESPECTFULLY SUBMITTED this 8th day of September, 2010.

2 Davis Wright Tremaine LLP
3 Attorneys for Opposer The United States Playing
4 Card Company

5 By s/Stuart R. Dunwoody

6 Stuart R. Dunwoody

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CERTIFICATE OF SERVICE

I hereby certify that on the 8th day of September, 2010, a true and correct copy of Motion for Leave to Amend Notice of Opposition for Opposition No. 91195203 was duly served upon the Applicant by mailing a copy thereof via the U.S. Postal Service, first-class mail to:

Neil M. Zipkin
Amster, Rothstein & Ebenstein LLP
90 Park Avenue
New York, NY 10016-1301

Attorneys for Applicant

s/Lesley Smith

Lesley Smith

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CERTIFICATE OF FILING

I hereby certify that on September 8, 2010, I filed this Motion for Leave to Amend Notice of Opposition via the ESTTA Filing System of the U.S. Patent and Trademark Office.

DATED this 8th day of September, 2010.

s/Maureen Larican

Maureen Larican

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EXHIBIT A

Opposition No. 91195203

Exhibit A to MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION

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

3 THE UNITED STATES PLAYING CARD)
4 COMPANY, a Delaware corporation,)
5) Opposition No. [91195203](#)
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THE UNITED STATES PLAYING CARD)
COMPANY, a Delaware corporation,)
Opposer,)
v.)
ANGEL PLAYING CARDS CO., LTD., a)
corporation of Japan,)
Applicant.)

AMENDED NOTICE OF
OPPOSITION

Seattle, Washington 98101
June 7, 2010

TO THE COMMISSIONER FOR TRADEMARKS
TRADEMARK TRIAL AND APPEAL BOARD

The United States Playing Card Company, a Delaware corporation, having a place of business at 300 Gap Way, Erlanger, Kentucky 41018 (hereinafter "Opposer"), believes that it will be damaged by registration of the marks as claimed by Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 all filed October 29, 2009, in International Class 28 and hereby opposes the same.

As grounds for the opposition, Opposer alleges as follows:

1. On information and belief, Angel Playing Cards Co., Ltd. is a corporation created pursuant to the laws of Japan, having a place of business at 10-1 Kawarayamachi 2-Chome, Chuo-ku, Osaka, Japan (hereinafter "Applicant"). Applicant has as its Attorney of Record Neil M. Zipkin, Amster Rothstein & Ebenstein LLP, 90 Park Ave Floor 21, New York, NY 10016.
2. Continuously, since long prior to any date upon which Applicant can rely, Opposer has used trademarks comprising repeated parallelogram and rectangular designs and diagonal lines in association with playing cards and related goods.

1 3. Continuously, since long prior to any date upon which Applicant can
2 rely, Opposer has used trademarks comprising repetitive designs in association with playing
3 cards and related goods.

4 4. Opposer is the owner of U.S. Trademark Registration No. 48,763 for a
5 design mark described as follows: “the trade-mark consists of a design many times repeated
6 upon a panel or parallelogram to give the effect of many parallel diagonal lines crossing
7 each other and inclosing dark diamond-shaped figures. The appearance of the light lines is
8 gained by four light parallel strokes or lines at each side of the dark diamond, and at each
9 corner of each dark diamond a smaller light diamond space appears the effect resembling a
10 plaid design.” The registration claims playing cards in International Class 28, issued January
11 9, 1906, sets forth a date of first use of 1885, and is currently valid, subsisting and
12 incontestable.

13 5. Opposer is the owner of U.S. Trademark Registration No. 153,892 for
14 the design mark shown by the drawing submitted in that registration. The registration claims
15 playing cards in International Class 16, issued March 28, 1922, sets forth a date of first use of
16 1888, and is currently valid, subsisting and incontestable.

17 6. Opposer is the owner of U.S. Trademark Registration No. 2,694,791 for
18 the design mark shown by the drawing submitted in that registration. The registration claims
19 playing cards in International Class 16, issued March 11, 2003, sets forth a date of first use of
20 October 1, 2000, and is currently valid and subsisting.

21 7. Opposer is the owner of U.S. Trademark Registration No. 3,049,851 for
22 the design mark shown by the drawing submitted in that registration. The registration claims
23 playing cards in International Class 28, issued January 24, 2006, sets forth a date of first use of
October 1, 2004, and is currently valid and subsisting.

1 8. Continuously, since long prior to any date upon which Applicant can
2 rely, Opposer and its predecessors in interest have used in commerce the design mark
3 depicted below in connection with playing cards, consisting of repeating parallelograms
4 arranged diagonally.



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12 Opposer therefore owns common law trademark rights in this design in connection with
13 playing cards.

14 9. ~~8.~~ Opposer will be damaged by the registrations sought by Applicant
15 insofar as the registrations will be *prima facie* evidence of the validity of the registrations,
16 Applicant's ownership of the marks as claimed by Applications Serial Nos. 77/860,456,
17 77/860,480, and 77/860,501, and Applicant's exclusive right to use the marks as claimed by
18 Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 when, in fact, Applicant is
19 not entitled to such rights by virtue of Opposer's prior and continuous use of the marks
20 described by Paragraphs 2-3 and shown by the registrations and marks identified by
21 Paragraphs 4-~~7~~8 herein in association with the sale of playing cards.

22 10. ~~9.~~ The marks claimed by Applications Serial Nos. 77/860,456,
23 77/860,480, and 77/860,501 when used in association with playing cards by Applicant, so

1 resemble Opposer's Marks described by Paragraphs 2-3 and shown by the registrations [and](#)
2 [marks](#) identified by Paragraphs 4-~~7~~8 herein as to be likely to cause confusion, or to cause
3 mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act 15 U.S.C. §
4 1052(d).

5 11. ~~10.~~ As a result of Opposer's long-term, substantial and widespread use
6 of the marks shown by the registrations [and marks](#) identified by Paragraphs 4-~~7~~8 herein, the
7 marks have become famous, and are thus valuable symbols that serve to identify Opposer as
8 the source of all playing cards and related goods and services identified by or promoted with
9 the marks.

10 12. ~~11.~~ On information and belief the marks shown by the registrations [and](#)
11 [marks](#) identified by Paragraphs 4-~~7~~8 herein were previously used by Opposer and became
12 famous prior to any date upon which Applicant can show use of any of the marks claimed by
13 Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501.

14 13. ~~12.~~ Each of Applicant's marks claimed by Applications Serial Nos.
15 77/860,456, 77/860,480, and 77/860,501 creates a commercial impression that is so similar to
16 the commercial impressions created by Opposer's marks shown by the registrations [and marks](#)
17 identified by Paragraphs 4-~~7~~8 herein as to be likely to cause dilution of the distinctiveness of
18 Opposer's marks shown by those registrations [and marks](#).

19 14. ~~13.~~ The marks claimed by Applications Serial Nos. 77/860,456,
20 77/860,480, and 77/860,501 so resemble Opposer's marks described by Paragraphs 2-3 herein
21 and shown by the registrations [and marks](#) identified by Paragraphs 4-~~7~~8 herein as to cause
22 dilution of the distinctive quality of Opposer's marks in violation of 15 U.S.C. § 1125(c).

23 15. ~~14.~~ The marks claimed by Applications Serial Nos. 77/860,456,
77/860,480, and 77/860,501 so resemble Opposer's famous marks shown by the registrations

1 and marks identified by Paragraphs 4-~~7~~8 herein, which on information and belief have all been
2 previously used and registered by Opposer, as to be likely to falsely suggest a connection
3 between Opposer and Applicant in violation of Section 2(a) of the Lanham Act, 15 U.S.C. §
4 1052(a).

5 16. ~~15.~~ Based upon the foregoing, registration of the marks claimed by
6 Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501, filed October 29, 2009, is
7 likely to cause injury and damage to Opposer.

8 WHEREFORE, Opposer respectfully requests that the registration of the mark claimed
9 by Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 be denied pursuant to
10 Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), Section 2(a) of the Lanham Act, 15
11 U.S.C. § 1052(a) and 15 U.S.C. § 1125(c), and that this opposition be sustained.

12 ~~Opposer submits herewith the required fee in the amount of \$900 and requests that~~
13 ~~any additional fees be charged to Deposit Account No. 04-0258 or any overpayment be~~
14 ~~issued as a credit to Deposit Account No. 04-0258.~~

1 Please direct all correspondence to Stuart R. Dunwoody of Davis Wright Tremaine
2 LLP at the following address:

3 Stuart R. Dunwoody, Esq.
4 Davis Wright Tremaine LLP
1201 Third Avenue, Suite 2200
Seattle, Washington 98101

5 Please direct all telephone calls to Stuart R. Dunwoody at 206-757-8034.

6 DATED this 7th day of ~~June~~September, 2010.

7 Respectfully submitted,

8 DAVIS WRIGHT TREMAINE LLP

9
10 By /s/ Stuart R. Dunwoody

11 Stuart R. Dunwoody

12 Cindy L. Caditz

13 Attorneys for Opposer The United States
14 Playing Card Company

15 By /s/ Stuart R. Dunwoody

16 Stuart R. Dunwoody

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CERTIFICATE OF FILING

I hereby certify that this AMENDED NOTICE OF OPPOSITION to U.S. Trademark Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 for the marks shown by the drawings submitted in Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 is being filed with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office on the below date.

Date: June 7, September 8, 2010 /s/ Stuart R. Dunwoody

CERTIFICATE OF SERVICE

I hereby certify that this AMENDED NOTICE OF OPPOSITION to U.S. Trademark Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 for the marks shown by the drawings submitted in Applications Serial Nos. 77/860,456, 77/860,480, and 77/860,501 is being duly served upon the Applicant and Applicant's Attorney of Record by mailing a copy thereof via the U.S. Postal Service in a sealed envelope as first-class mail with postage thereupon fully prepaid and addressed to:

~~Angel Playing Cards Co., Ltd.
10-1 Kawarayamachi 2-Chome
Chuo-ku, Osaka
JAPAN~~

~~And to:~~

~~Neil M. Zipkin
Anthony Lo Cicero
Holly Pekowsky
Amster Rothstein & Ebenstein LLP
90 Park Ave Floor 21
New York, NY 10016~~

Date: June 7, September 8, 2010 /s/ Stuart R. Dunwoody

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| Format changed | 0 |
| Total changes | 70 |