UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: December 20, 2017

Opposition No. 91217436
Opposition No. 91217437

Google Inc.

v.

Hanginout, Inc.

M. Catherine Faint,
Interlocutory Attorney:

This case now comes before the Board for consideration of Opposer's motion, filed September 12, 2017, to amend its notices of opposition for a second time. Opposer included a copy of its proposed amended pleading with its motion papers.[1] The motion is fully briefed.

Second Motion to Amend the Combined Pleadings

By way of its motion, Opposer seeks to amend its combined pleading to add the ground that the involved applications are void ab initio because Applicant was not

[1] The Board notes that an order of November 12, 2015 allowed Opposer to file a combined first amended notice of opposition after this proceeding had been consolidated. The better practice in consolidated cases is to file a separate notice of opposition in each proceeding. *See Nabisco Brands. Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993). However, the Board exercises its discretion to consider the filing of the combined second amended notice of opposition in the parent case at this juncture.

using its subject marks on all the identified goods and services at the time Applicant filed its use-based applications.

In support thereof, Opposer maintains that it obtained the information needed to formulate the basis of the proposed additional ground of opposition upon comprehensive review of Applicant's answers to interrogatories, responses to requests for admission and for production, as well as the deposition testimony of Applicant's designated Rule 30(b)(6) witness, when it became apparent that Applicant could not demonstrate use of the marks prior to the filing date of its applications. Opposer argues the proposed ground is based entirely on the same facts and evidence that support its existing fraud claim and there is no need for additional discovery as all facts and evidence pertinent to the nonuse claim are entirely within the possession of Applicant.

In response, Applicant contends that allowing Opposer to amend its pleadings at this juncture in the proceeding would prejudice Applicant by driving up the costs of litigation through delays. Moreover, Applicant maintains that Opposer unduly delayed in seeking to amend its pleading because it waited until three months after discovery had closed and well over three and one half months after the deposition of Applicant's Rule 30(b)(6) witness before filing its motion to further amend the pleadings.

Decision

Although Opposer argues the motion as one to amend pursuant to Fed. R. Civ. P. 15(a), it is filed after the opening of Opposer's testimony period, and is therefore one

filed pursuant to Fed. R. Civ. P. 15(b). The Board construes the motion as one based on Opposer's objection that nonuse is not within the issues raised in the pleadings. The motion is filed after the opening of Opposer's testimony period, but prior to its close, and prior to the opening of Applicant's testimony period.

The Board will freely permit an amendment when doing so will aid in presenting the merits of the case, and the objecting party fails to show that the evidence would prejudice that party's action or defense on the merits. *See* Fed. R. Civ. P. 15(b)(1). *Cf. Wright Line, Inc. v. Data Safe Servs. Corp.*, 229 USPQ 769, 770 n.4 (TTAB 1985)(motion to amend pleadings filed after opening of defendant's testimony period is "clearly untimely" under Fed. R. Civ. P. 15(a)). *See also* WRIGHT & MILLER 6A FED. PRAC. & PROC. CIV. § 1495 (3d ed. 2017) (Rule 15(b)(1) contemplates that objecting party must be put to "serious disadvantage").

The timing of the motion for leave to amend plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. For example, the Board generally will grant such motions when the proceedings are still in the pre-trial stage. *See, e.g., Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974). Whether or not the moving party can actually prove allegations sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial. *Focus 21 Int'l, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992).

Here the Board finds the timing is not unduly prejudicial as the motion is made prior to the close of Opposer's testimony period and prior to the opening of Applicant's

testimony period, and thus there is time for Applicant to respond to the evidence. The motion seeks to add a ground that the applications are void ab initio for nonuse as of the filing dates of the use-based applications to the count of fraud due to nonuse. Further, while it is preferable, a ground of nonuse need not be pled separately, and the Board has found applications to be void ab initio even when nonuse was not pleaded as a separate claim or issue. *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012). Allowing the amendment at this stage does not unduly prejudice Applicant, and provides Applicant with fuller notice of the grounds to be considered at final decision.

Accordingly, Opposer's motion to file a second amended combined notice of opposition is **granted**. Applicant's **time to answer** is set out below.

Opposer has stated it does not seek to change the schedule. However, the Board had suspended this proceeding after the close of Opposer's testimony period for consideration of the motion, and in the interests of fairness resets Applicant's disclosure and trial period, and remaining dates, as set out below.

Schedule

Proceedings are resumed. Dates are reset as set out below.

Time to Answer	1/30/2018
Plaintiff's Trial Period Ends	(CLOSED)
Defendant's Pretrial Disclosures Due	2/16/2018
Defendant's 30-day Trial Period Ends	4/2/2018
Plaintiff's Rebuttal Disclosures Due	4/17/2018
Plaintiff's 15-day Rebuttal Period Ends	5/17/2018
Plaintiff's Opening Brief Due	7/16/2018
Defendant's Brief Due	8/15/2018

Plaintiff's Reply Brief Due	8/30/2018
Request for Oral Hearing (optional) Due	9/9/2018

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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