

ESTTA Tracking number: **ESTTA642173**

Filing date: **12/02/2014**

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

| | |
|------------------------|--|
| Proceeding | 91218846 |
| Party | Defendant Tri-Coastal Design Group, Inc. |
| Correspondence Address | TEDD S LEVINE LAW OFFICES OF TEDD S LEVINE LLC 1305 FRANKLIN AVE , STE 300 GARDEN CITY, NY 11530-1630 UNITED STATES lawofficesofteddslevine@gmail.com |
| Submission | Motion to Amend/Amended Answer or Counterclaim |
| Filer's Name | TEDD S. LEVINE |
| Filer's e-mail | lawofficesofteddslevine@gmail.com |
| Signature | /TEDD S. Levine/ |
| Date | 12/02/2014 |
| Attachments | TM-Tri-Coastal-SEASIDE-Motion to Amend.pdf(150797 bytes) |

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

-----X
Seaside Community Development Corp.,

Opposer,

Opposition No.: 91218846
Serial No. 86/188,378

-v-

MOTION TO AMEND ANSWER

Tri-Coastal Design Group, Inc.

Applicant.

-----X

MOTION TO AMEND ANSWER

Applicant, by its attorneys, hereby moves for an Order pursuant to Fed. R. Civ. P. 15(a) and Trademark Rule 2.107(a) that grants Applicant leave to amend its answer to the Notice of Opposition to add a counterclaim(s) and to modify its affirmative defenses to the extent necessary.


FACTS

On February 8, 2014, Applicant filed an intent-to-use application on the Principal Register for the mark SEASIDE in connection with bath & body products.

On May 28, 2014, the United States Patent & Trademark Office (the "PTO"), after having conducted its due diligence, approved the mark for publication not having found any reason to bar registration, including no likelihood of confusion.

On October 15, 2014, Opposer filed the present Notice of Opposition based on allegations of first use of the applied for mark that it claims to have utilized in connection with competing goods. Opposer makes this claim despite having never filed for

registration in this category. The following relevant registrations are purportedly owned by Opposer:

| Mark | Class, Goods or Services, and dates of first use | Registration Number |
|---|---|---------------------|
| SEASIDE FARMERS MARKET A RENEWED TRADITION | IC 016. US 002 005 022 023 029 037 038 050. G & S: Newsletters in the field of food, plants and crafts; posters. FIRST USE: 20090400. FIRST USE IN COMMERCE: 20090400 IC 035. US 100 101 102. G & S: Retail markets featuring food, farm products, plants, crafts and gift items. FIRST USE: 20090400. FIRST USE IN COMMERCE: 20090400 | 4313168 |
| SEASIDE FARMERS MARKET | IC 016. US 002 005 022 023 029 037 038 050. G & S: Newsletters in the field of food, plants and crafts; posters. FIRST USE: 20090400. FIRST USE IN COMMERCE: 20090400 IC 035. US 100 101 102. G & S: Retail markets featuring food, farm products, plants, crafts and gift items. FIRST USE: 20090400. FIRST USE IN COMMERCE: 20090400 | 4313167 |
| SEASIDE TRANSIT AUTHORITY | IC 012. US 019 021 023 031 035 044. G & S: Bicycles. FIRST USE: 20130301. FIRST USE IN COMMERCE: 20130301 IC 025. US 022 039. G & S: Hats; Shirts; Shorts; Sweatpants; Sweatshirts; Visors. FIRST USE: 20120524. FIRST USE IN COMMERCE: 20130524 IC 035. US 100 101 102. G & S: Retail store services featuring clothing and bicycles and parts and accessories for bicycles. FIRST USE: 20130301. FIRST USE IN COMMERCE: 20130301 IC 039. US 100 105. G & S: Rental of bicycles. FIRST USE: 20130301. FIRST USE IN COMMERCE: 20130301 | 4478723 |
|  | IC 012. US 019 021 023 031 035 044. G & S: Bicycles. FIRST USE: 20130301. FIRST USE IN COMMERCE: 20130301 IC 025. US 022 039. G & S: Hats; Shirts; Shorts; Sweatpants; Sweatshirts; Visors. | 4498852 |

| | | |
|-------------------------------|--|---------|
| SEASIDE TRANSIT AUTHORITY | FIRST USE: 20120524. FIRST USE IN COMMERCE: 20130524 IC 035. US 100 101 102. G & S: Retail store services featuring clothing and bicycles and parts and accessories for bicycles. FIRST USE: 20130301. FIRST USE IN COMMERCE: 20130301 IC 039. US 100 105. G & S: Bicycle rental. FIRST USE: 20130301. FIRST USE IN COMMERCE: 20130301 | |
| SEASIDE COTTAGE RENTAL AGENCY | IC 036. US 100 101 102. G & S: Rental of condominiums, cottages, and homes. FIRST USE: 19830000. FIRST USE IN COMMERCE: 19830000 | 3193349 |
| THE SEASIDE TIMES | IC 016. US 002 005 022 023 029 037 038 050. G & S: Newspapers. FIRST USE: 19830000. FIRST USE IN COMMERCE: 19830000 | 3145344 |
| THE MERCHANTS OF SEASIDE | IC 035. US 100 101 102. G & S: Promoting the goods and services of others by distributing advertising materials through a variety of methods. FIRST USE: 20040000. FIRST USE IN COMMERCE: 20040000 | 3671934 |
| SEASIDE | IC 030. US 046. G & S: Coffee. FIRST USE: 20090500. FIRST USE IN COMMERCE: 20090500 | 3801151 |
| THE SEASIDE STYLE | IC 035. US 100 101 102. G & S: On-line retail store services featuring gifts, housewares, home furnishings, clothing, shoes and sundries; Promoting the goods and services of others via a global computer network. FIRST USE: 20100400. FIRST USE IN COMMERCE: 20100400 | 3846308 |
| CAMP SEASIDE | IC 041. US 100 101 107. G & S: Entertainment services, namely, providing day camp, recreational facilities for children where swimming and tennis lessons, sports tournaments, arts and crafts activities and adult-guided bicycle and kayak expeditions are provided; event and party planning services. FIRST USE: 19930000. FIRST USE IN COMMERCE: 19930000 | 4420199 |
| SEASIDE | IC 016. US 002 005 022 023 029 037 038 | 3998434 |

| | | |
|---------|--|---------|
| | 050. G & S: newsletters, and printed brochures all in the field of real estate properties, real estate rentals, community events, travel, architecture, fashion, food, and interior design. FIRST USE: 20050000. FIRST USE IN COMMERCE: 20050000 | |
| SEASIDE | <p>IC 036. US 100 101 102. G & S: real estate agency services and rental of condominiums and cottages. FIRST USE: 19800104. FIRST USE IN COMMERCE: 19800104</p> <p>IC 039. US 100 105. G & S: rental of bicycles. FIRST USE: 19800104. FIRST USE IN COMMERCE: 19800104</p> <p>IC 041. US 100 101 107. G & S: entertainment services in the nature of live stage performances featuring singing, dancing, theater; motion picture presentations and cultural activities; namely, craft shows; educational services; namely, symposiums in the field of urban growth and community planning; party planning; recreational services; namely, providing facilities for and arranging informal tennis, croquet, canoeing, golf, swimming, and shuffleboard competitions. FIRST USE: 19800104. FIRST USE IN COMMERCE: 19800104</p> <p>IC 042. US 100 101 107. G & S: architectural design services and retail gift, book, clothing and shoe store services. FIRST USE: 19800104. FIRST USE IN COMMERCE: 19800104</p> | 1877936 |

Discovery into this matter has not yet ensued.

Grounds to assert a counterclaim to cancel one or more of Opposer's registrations were recently discovered by Applicant.

ARGUMENT

I. APPLICANT SHOULD BE GRANTED THE RIGHT TO AMEND ITS ANSWER.

A. Legal Standard

Fed. R. Civ. P. 15(a) provides as follows:

(a) Amendments Before Trial.

(2) *Other Amendments*. In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

Moreover, Trademark Rule 2.107(a)¹ [in conjunction with Fed. R. Civ. P. 15(a)] encourage the Board to look favorably on motions to amend, providing that “leave shall be freely given when justice so requires.” Only if allowance of the amendment would cause undue prejudice or be futile, amendment will be denied. *See Foman v. Davis*, 371 U.S. 178, 182 (1962); and *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (TTAB 1977).

B. No prejudice will result if leave is given to Applicant to add a counterclaim and to amend its affirmative defenses, in the event the Board (when ruling on Opposer’s Motion to Dismiss) determines that one or more of the affirmative defenses have not been properly pled.

No prejudice will result to the Opposer if Applicant is permitted to amend its answer to add a counterclaim that seeks to cancel one or more of Opposer’s existing

¹ § 2.107 Amendment of pleadings in an opposition proceeding.

(a) Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed.

registrations based upon lack of ownership, abandonment, and Opposer's misrepresentations to the United States Patent & Trademark Office. This proceeding is at its incipiency and discovery has not yet ensued. The current schedule lists the following key dates:

| | |
|-----------------------------------|------------|
| Time to Answer | 11/24/2014 |
| Deadline for Discovery Conference | 12/24/2014 |
| Discovery Opens | 12/24/2014 |

Counterclaims for cancellation of pleaded registrations in Board proceedings are governed by Trademark Rule 2.106(b)(2)(i), which provides as follows: "A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned." To that end, since grounds for its counterclaim were recently discovered by Applicant, amending its answer now would be timely under Rule 2.106(b)(2)(i).

Moreover, should the Board find any defense to be improperly pled, it would clearly have been the result of a mistake or oversight. To that end, as noted above, both Trademark Rule 2.107(a) and Federal Rule of Civil Procedure 15(a) direct the Board to "freely give leave when justice so requires." Under this standard, the Board will grant a party leave to amend unless the opposing party can establish prejudice, undue delay, bad faith on the part of the movant or futility of amendment. This same standard applies to

motions for leave to amend both complaints and answers. Fed.Rules Civ.Proc.Rule 15(a), 28 U.S.C.A. See *Arista Records, Inc. v. Flea World, Inc.*, 356 F.Supp.2d 411 (D.N.J.,2005) citing *Oneida Indian Nation of New York v. City of Sherrill, New York*, 337 F.3d 139, 168 (2d Cir.2003). Typically, an opposer will not be prejudiced by permitting an applicant to cure an insufficient defense or to amplify a defense that has been stated in the answer. See 6 Wright, Miller & Kane § 1487 at pp. 629-30.

Insofar as Applicant is now filing its motion to amend its answer merely weeks after it filed its original answer and approximately 3 weeks before discovery is scheduled to open, leave to amend should be granted to Applicant. See Fed. Civ. P. 15(a); TBMP § 507.02(a) (2d ed. rev. 2004). Consequently, since 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, this motion should be granted. See *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971); and *Foman v. Davis*, 371 U.S. 178, 182 (1962).

WHEREFORE, Since the time to answer just recently expired and discovery hasn't yet opened, it is axiomatic that no prejudice will befall upon Opposer if Applicant is permitted to amend its answer. Hence, Applicant prays that it be granted the right to amend its answer to add a counterclaim(s) and to modify its affirmative defenses to the extent necessary, and for such further relief as the TTAB finds just and equitable.

CERTIFICATE OF SERVICE

I TEDD S. LEVINE hereby certify that on the 2nd day of December 2014, I served
a copy of APPLICANT'S MOTION TO AMEND by email to the following:

Rochelle D. Alpert
Morgan, Lewis & Bockius LLP
One Market, Spear Street Tower
San Francisco, CA 94105
UNITED STATES
ralpert@morganlewis.com,
shall@morganlewis.com, sftrademarks@morganlewis.com

 /Tedd S. Levine/
Tedd S. Levine, Esq.