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

Proceeding	91236715
Party	Defendant Theatricality LLC
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Date	12/30/2019
Attachments	Response to Opposition to Opposer_s Motion for Leave to Amend the Complaint .pdf(188333 bytes) Declaration of Chris Bird.pdf(756155 bytes)

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

Application Serial No.:	**87/371,308**
Mark:	**WAR BOT**
International Classes:	**16 & 28**
Applicant:	**Theatricality LLC**
Published in *Official Gazette*:	**July 18, 2017**

ROBOT WARS, LLC, Opposer, vs. THEATRICALITY LLC, Applicant.	**Opposition No. 91236715**

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND THE OPPOSITION

I. INTRODUCTION

As Applicant's currently pending motion for summary judgment makes clear, Opposer's pending claims lack merit. As a result, at the 11th-hour, Opposer is attempting to add an entirely new claim, in order to extend and maintain its ill-fated Opposition. The proposed new claim is based on allegations that Applicant's application for WAR BOT for use on toys should be invalidated because it was only used in the state of California and not in "commerce".

This motion should be denied for numerous reasons, primarily because it is futile. Applicant's currently pending motion for summary judgment, once granted, will dispose of all of Opposer's original claims. It is only through these original claims (dilution, likelihood of confusion, etc…) that Opposer claims it will be damaged by Applicant's registration for WAR BOT. Accordingly, once the motion is granted, Opposer will not have standing to proceed with the Opposition on the new claim. For this reason alone, Opposer's Motion should be denied.

Additionally, Applicant's pre-filing use of the WAR BOT mark constitutes sufficient "use in commerce". There is no dispute that Applicant has continuously offered toys nationwide through its website, under the WAR BOT mark, since 2008. Additionally, Applicant (i) sold WAR BOT toys to entities located in states other than California, prior to filing the current application, (ii) received parts used to make the WAR BOT toys from outside of California, (iii) received inquiries about WAR BOT toys from entities outside of California and (iv) promoted the WAR BOT toys at trade shows outside of California. (Declaration of Chris Bird: 2-4)

The motion was also filed so late in the process (i.e., well after the close of discovery), rendering it untimely and prejudicial.

II. OPPOSER'S REQUEST TO ADD A NEW CLAIM SHOULD BE DENIED

"A court considers five factors in determining whether to grant leave to amend: '"(1) bad faith, (2) undue delay, (3) prejudice to the opposing party, (4) futility of amendment; and (5) whether plaintiff has previously amended his complaint.'" *Spitzer v. Aljoe* (N.D.Cal. Apr. 6, 2015, No. 13-cv-05442-MEJ) 2015 U.S.Dist.LEXIS 45471, at *12 (quoting *In re W. States Wholesale Nat. Gas Antitrust Litig*., 715 F.3d 716, 738 (9th Cir. 2013)). " Here, all the factors favor denying the motion for leave to amend, however, the futility of the proposed amendment alone, is more than sufficient to defeat it.

A. PROPOSED AMENDMENT IS FUTILE

1. Opposer Will Lack Standing to Bring New Claim Once Motion for Summary Judgment is Granted.

Opposer's Second Amended Complaint contends that it will be "damaged by the registration of WAR BOT" as a result of the alleged likelihood of confusion [Opposition: Claim 1 (Lanham Act 2d), Claim 2 (Lanham Act 2a)] and dilution [Claim 3 (Lanham Act 43(c)]. Unlike most cases, in light of the pending motion for summary judgment, the Board is uniquely positioned to determine whether in fact Opposer has a meaningful damage claim. If Opposer won't be damaged by the registration of the mark, it lacks standing to maintain an Opposition,

including standing to bring what would then be the lone remaining claim (proposed new Claim 4).

In other words, if the Board grants Applicant's motion for summary judgment, it will have necessarily concluded that Applicant's registration of WAR BOT for comic books and toys will not likely cause dilution, harm to or confusion with Opposer's use of ROBOT WARS. Thus, Opposer will not be damaged if Applicant's WAR BOT mark is registered. As a result, it would be futile for the parties or the Board to continue to litigate whether Applicant's use of the mark on toys was sufficiently used in "commerce" because Opposer would lack standing to bring the claim.

Section 13 of the Lanham act requires that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, to have standing, an opposer/petitioner must have (1) a real interest in the outcome of the proceeding, and (2) a reasonable basis for its belief that **it would suffer some kind of damage by the continued registration of the mark.** *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Universal Oil Prods. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). In other words, without "some kind of damage" the petitioner/opposer lacks standing.

In *NSM Resources Corp. v. Microsoft Corp.* 113 USPQ2d 1029, 1033 (TTAB 2013) the Board found that Petitioner lacked standing **at the motion to dismiss stage**, in light of the difference between the mark asserted by the Petitioner and the cited registration. (The Board concluded that the 12 trademarks containing the term "HUCK" bore no resemblance to XBOX 360, the mark sought to be cancelled and therefore Petitioner would not be damaged by its registration and therefore dismissed the case for lack of standing.) See also, *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006) ("The purpose of the standing requirement, which is directed solely to

the interest of the plaintiff, is to prevent litigation when there is **no real controversy between the parties.**"), aff'd, 240 Fed. Appx. 865 (Fed. Cir. 2007) (emphasis added);

Where a plaintiff files a motion for leave to amend the complaint while a motion for summary judgment is pending, and if the motion for summary judgment (once granted) would render the proposed amendment futile, leave to amend should be denied. *See Patwardhan v. U.S. ex rel. HHS* (C.D.Cal. Mar. 18, 2014, No. CV 13-0076 RSWL (DTBx)) 2014 U.S.Dist.LEXIS 36226, at *19. If the Board grants Applicant's motion for summary judgment, there will be no real controversy between the parties rendering Opposer's motion for leave to amend futile.

2. Applicant Used the Mark In Commerce Prior to the 2017 Filing Date

In its Second Amended Complaint, Opposer contends that the application to register WAR BOT is invalid because Applicant did not use the mark outside of California, prior to the 2017 date on which the application was filed. This is not true! It is undisputed that Applicant has continuously offered products, under the WAR BOT mark, for sale throughout the United States, since 2008. [Opposer's Opp. Brief to MSJ, p. 5; Ex. 5 to Rollings Dec.] Since 2008, Applicant, has marketed its WAR BOT products at toy fairs including one in Great Barrington, MA in December 2009. (Bird Dec.: 3). Unfortunately in 2016, Applicant relocated and moved to a new computer system (switching from a PC to a Mac), resulting in the loss of records relating to inquiries and sales of WAR BOT products, pre-dating 2016. *Id.* at 4. Nevertheless, the undisputed declaration of Applicant's principal confirms that there were inquiries from and sales made to entities outside of California prior to 2017. *Id.* Moreover, Applicant procures the parts and products used in the WAR BOT toys from suppliers outside of California. [Declaration of Chris Bird: 2-4.]

In light of the above, Opposer's proposed amendment would be futile. "[A]n amendment is futile when 'no set of facts can be proved under the amendment to the pleadings that would constitute a valid and sufficient claim or defense.'" *Neylon v. Cnty. of Inyo* (E.D.Cal. May 1, 2017, No. 1:16-cv-00712 - AWI - JLT) 2017 U.S.Dist.LEXIS 66124, at *19 (Citations

omitted). That is, "a court may find a claim is futile if it finds 'inevitability of a claim's defeat on summary judgment.'" *Id*. (citing *Cal. v. Neville Chem. Co*., 358 F.3d 661, 673 (9th Cir. 2004); see also *Richards v. CoreCivic of Tenn., LLC* (E.D.Cal. Feb. 8, 2018) 2018 U.S.Dist.LEXIS 21161, at *8 ("[A] motion for leave to amend is futile if the claims presented can be defeated on a motion for summary judgment.") (citing *Gabrielson v. Montgomery Ward & Co*., 785 F.2d 762, 766 (9th Cir. 1986)). If a proposed amendment to a complaint would be futile, it is proper to deny leave. *Carrico v. City and Cnty. of San Francisco*, 656 F.3d 1002, 1008 (noting that plaintiff's proposed amendments to the complaint would not confer standing and plaintiff failed to propose any specific amendments).

B. OTHER FACTORS ALSO FAVOR DENIAL

Opposer already had an opportunity to amend its Complaint and is seeking leave to file its Second Amended Complaint. The filing of multiple amended complaints weighs in favor of denying a motion for leave to amend. *In re W. States Wholesale Nat. Gas Antitrust Litig*., 715 F.3d 716, 738 (9th Cir. 2013)).

Applicant will also be significantly prejudiced if leave is granted. As demonstrated by the record, compared to Applicant, Opposer is a much larger entity ($50,000,000 in revenue) with much more in terms of resources to spend on the subject Opposition. [Opposer's Opp. Brief to MSJ, pp. 3-5] Opposer is now attempting to leverage its size and resource advantage by adding a new baseless claim, with the goal of further extending its ill-conceived Opposition. As noted above, the new proposed claim is futile, given Applicant's past sales-related activity and the pending motion for summary judgment. Extending the Opposition to litigate this "use in commerce" issue will severely prejudice Applicant, which has significantly less resources. *Watson v. Ford Motor Co.* (N.D.Cal. Aug. 15, 2018, No. 18-cv-00928-SI) 2018 U.S.Dist.LEXIS 138324, at *6 (citing *Solomon v. N. Am. Life & Cas. Ins. Co*., 151 F.3d 1132, 1139 (9th Cir. 1998) [denying motion to amend on the eve of discovery deadline because it would require reopening discovery and delaying proceedings]). Also, increased litigation expenses by the

proposed amendment may be deemed prejudicial. *Id*. Here, there is no question that expanding the Opposition to include another claim will inequitably increase Applicant's litigation expenses.

Without taking discovery from Opposer, it is difficult to confirm whether Opposer is bringing this motion in bad faith or whether the delay was unreasonable. That being said, there is no question that discovery is now closed and Applicant is unable to procure any additional discovery. [Opposer's Opp. Brief to MSJ, p. 6] Courts, however, presume prejudice where a motion to amend is brought late in litigation: The "longer the delay, the greater the presumption against granting leave to amend." *C2 Educ. Sys. v. Lee* (N.D.Cal. Apr. 16, 2019, No. 18-cv-02920-SI) 2019 U.S.Dist.LEXIS 65201, at *7 (quoting *Johnson v. Cypress Hill*, 641 F.3d 867, 872 (7th Cir. 2011)). In *Johnson* (music copyright infringement action), the court found that introducing new claims, after discovery closed, would significantly prejudice defendant. *Id.* at 872-73 (stating "Johnson's request to change his claims on the eve of summary judgment is exactly the sort of switcheroo we have counseled against."). See also *Feldman v. Am. Memorial Life Ins. Co.*, 196 F.3d 783 (7th Cir. 1999) (finding that the prejudice that would result from amendment that would have added a new claim "well after the close of discovery and on the eve of summary judgment proceedings" was so apparent that the district court was not required to articulate the basis for its decision).

III. CONCLUSION

In light of the above, Opposer's Motion for Leave to Amend should be denied.

Respectfully submitted,

BUCHALTER, A Professional Corporation

DATED: December 30, 2019 By: 

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Attorney for Applicant

PROOF OF SERVICE

I am employed in the County ofLos Angeles , State of California. I am over the age of 18 and not a party to the within action. My business address is at BUCHALTER, A Professional Corporation, 1000 Wilshire Boulevard, Suite 1500, Los Angeles, CA 90017-1730.

On the date set forth below, I served the foregoing documents described as:

OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND THE COMPLAINT

on all other parties and/or their attorney(s) of record to this action by ☐ faxing, ☒ e-mailing, ☐ electronic transmission and/or ☐ placing a true copy thereof in a sealed envelope as follows:

Robert B. Golden
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One Chase Road
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Email: RGolden@LSLLP.com; HAronson@LSLLP.com; mdelcolle@lsllp.com; TMEFS@LSLLP.com; jrollings@LSLLP.com

☑ **BY EMAIL** On December 30, 2019, I caused the above-referenced document(s) to be sent in electronic PDF format as an attachment to an email addressed to the person(s) on whom such document(s) is/are to be served at the email address(es) shown above, as last given by that person(s) or as obtained from an internet website(s) relating to such person(s), and I did not receive an email response upon sending such email indicating that such email was not delivered.

☑ I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct to the best of my knowledge. Executed on December 30, 2019, at Los Angeles, California.

☑ I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made. Executed on December 30, 2019, at Los Angeles, California.

Janet E Gass — *Janet E. Gass*
(Signature)

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DECLARATION OF CHRIS BIRD

Chris Bird, declares and states as follows:

1. I am the President of Theatricality LLC ("Applicant"). I have personal knowledge of the facts stated herein and can testify to them under oath.

2. Applicant has continuously utilized its website (http://warbotrobots.com) offering toys for sale, throughout the United States, under the WAR BOT mark, since 2008.

3. Applicant, has marketed its WAR BOT products at toy fairs including one at Great Barrington, MA in December 2009. In addition, I procured parts used to make the WAR BOT toys from suppliers outside of California.

4. Unfortunately in 2016, I relocated Applicant's office and moved to a new computer system (switching from a PC to a Mac). This transition resulted in the loss of records relating to inquiries and sales of WAR BOT products, pre-dating 2016. Despite this lack of documentation, I can say with the utmost certainty that I made sales between 2008 and 2016, of

WAR BOT branded toys, to customers outside of California. In addition, during this time period, I received numerous inquiries for WAR BOT toys, from customers and potential customers outside of California.

I declare under the penalty of perjury that the foregoing is true and correct. Executed at Los Angeles, California on December 30, 2019.

By: _____
Chris Bird, President
Theatricality LLC