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

Proceeding	91240636
Party	Plaintiff Information Builders, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Information Builders, Inc.,	:	
Plaintiff,	:	Opposition No. 91240636
v.	:	consolidated with
SWMG Productions, Inc.,	:	Cancellation No. 92068353
Defendant.	:	

PLAINTIFF'S REPLY BRIEF ON
MOTION TO AMEND NOTICE OF OPPOSITION
AND PETITION FOR CANCELLATION

Plaintiff Information Builders, Inc. (IBI) submits this reply brief in support of its motion to amend the pleadings in these consolidated actions to add claims that Defendant SWMG Productions, Inc. is not entitled to register its trademarks for software in class 9.

ARGUMENT

1. There Was No Delay

As set forth in IBI's motion, it was not until June 6, 2019 that SWMG provided appropriate supplemental responses to IBI's requests for admissions. This motion was promptly made after SWMG's served its supplemental responses. SWMG does not contest that IBI did not delay between June 6 and the filing of this motion

on July 17. Instead, SWMG argues that its original, deficient discovery responses put IBI on notice of the facts relevant to IBI's new non-use claims.

SWMG's served its original responses in October 2018. However, these responses were hopelessly convoluted. For example, in response to request number 9, SWMG's complete response was:

> Denied for the reasons set forth in the general objections and also because Defendant's software products are web-based and also because the word "distributed" is vague or ambiguous. Defendant admits that its software services are web-based and only small components of each software product may be downloadable to mobile devices and/or desktop computers.

SWMG Br., Ex. A at 4. If this response itself isn't convoluted enough, it incorporates by reference the two and a half page "general objections," with three convoluted paragraphs and two images. SWMG Br., Ex. A at 1-3.

During the discovery period, IBI's counsel sought to obtain a clear response to its requests for admission. After attempting to resolve the dispute over the sufficiency of the SWMG's responses, IBI moved for an order that the responses were deficient. Papers 6, 11. Part of the deficiency was that SWMG contested the meaning of the word "distributed." This Board agreed with IBI that SWMG's responses were deficient and overruled SWMG's objections. In April SWMG was ordered to serve supplemental responses.

In view of the decision finding that SWMG's responses were deficient, SWMG should not argue that those same responses provided notice to IBI of its use of its trademarks.

Further, SWMG cites this answer as providing notice to IBI:

> Defendant admits that its software services are web-based and only small components of each software product may be downloadable to mobile devices and/or desktop computers.

SWMG Br. at 6 (emphasis in SWMG Brief). This answer describes an aspect of the ***software services*** (class 42) provided by SWMG. It does not address class 9 software. Unlike its supplemental responses, there is nothing in this answer that indicates that SWMG does not distributed its software by download.

SWMG did not provide the relevant responses until June 9, 2019, and IBI did not delay moving to amend once it received those responses.

2. SWMG Is Not Prejudiced

SWMG's first prejudice argument is just another version of its delay argument. As set forth above, IBI did not delay from the time of SWMG's supplemental responses. In contrast, the cases on which SWMG relies for its prejudice argument involve delayed motions to amend to include claims known at the time the original pleading was filed. Media Online Inc. v. El Clasificado Inc., 88 USPQ2d 1285 (TTAB 2008)("the new claims appear to be based on facts within petitioner's knowledge at the time the petition to cancel

was filed."); ChaCha Search, Inc. v. Grape Technology Group, Inc., 105 USPQ2d 1298 (TTAB 2012)("the facts upon which that ground is based presumably were within Grape's knowledge at the time the counterclaim was filed . . . .")

SWMG also argues that it would be prejudiced unless discovery was reopened. SWMG Br. at 8. Reopening discovery is appropriate to avoid prejudice; it is not a reason to deny a motion to amend. See TBMP § 507.02(a) (citing Boral Ltd. v. FMC Corp., 59 USPQ2d 1701, 1703-04 (TTAB 2000)(reopened for limited purpose of conducting discovery on new claim)).

SWMG raises two more arguments. First, having now served a second set of supplemental responses, SWMG claims that its initial supplemental responses were "never intended" to be interpreted as they were written. SWMG Br. at 8-9. It is unclear how this helps SWMG. At best, this means that there is a triable issue as to whether SWMG used its trademarks on class 9 goods. The service of contradictory discovery responses should not benefit SWMG.

Lastly, SWMG argues that it can use its trademarks on class 9 software that is distributed by means other than download. SWMG Br. at 9. IBI addressed this issue in its motion. "There is no evidence that SWMG distributes software by other means, such as on CD's, DVD's, or floppy disks. The specimens of use that SWMG has submitted do not show any physical products." IBI Motion at 2-3.

3. These Claims Are Not Futile

SWMG argues that IBI's motion should be denied because IBI's new claims are futile. To support this argument, SWMG relies on Exhibit B to its brief, specifically pages 5-7 and 21-44 of that exhibit. The gist of the argument is that these exhibits are evidence that SWMG used the trademarks on class 9 software before the applications for the trademarks were filed; and, SWMG argues, since there is evidence of use of the trademarks on class 9 software, IBI's non-use allegations will fail.

However, the exhibits on which SWMG relies does not support its argument. The document at pages 5-7 only has the trademark NFOCUS SOLUTIONS and design (application no. 87546877). This application was filed on Jul. 28, 2017, but the exhibit is dated 2019. This document does not include either of the other two trademarks at issue.

Similarly, the document at pages 21-44 only includes one of the trademarks at issue—NFOCUS SOLUTIONS BRIDGING THE GAP and design (application no. 85483662). This application was filed on November 30, 2011, but the document on which SWMG relies is dated 2012.

These exhibits submitted by SWMG do not show that it used its trademarks on class 9 software before it filed its applications. Without such evidence, IBI's non-use claims are not futile.

SWMG's most obvious futility argument would be that the specimens submitted with its applications evidence class 9 use. Significantly SWMG does not make this argument. And, it appears that the specimens do not support class 9 use.

CONCLUSION

Plaintiff respectfully requests that its motion be granted allowing it to amend its pleadings and take discovery on the new grounds for cancellation and opposition.

Dated: August 26, 2019

/IES/

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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing PLAINTIFF'S REPLY BRIEF ON MOTION TO AMEND NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION has been forwarded on August 26, 2019 by email to:

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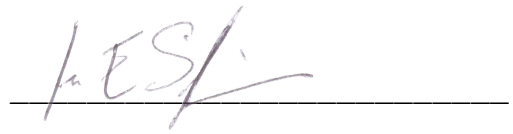

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