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

Proceeding	91241586
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of the Trademark Application No. 87/750,448
For the Mark: WILLAMETTER JOURNAL
Published on: May 29, 2018

WILLAMETTE VALLEY VINEYARDS, INC.,
an Oregon corporation,

Opposer,

v.

COPPER CANE LLC, a California limited
liability company,

Applicant.

Opposition No. 91241586

REDACTED FOR PUBLIC FILING

OPPOSITION TO MOTION TO AMEND COUNTERCLAIMS

Opposer, Willamette Valley Vineyards, Inc., by and through its undersigned counsel, opposes the motion of Applicant, Copper Cane LLC, for leave to amend counterclaims.

Applicant's motion should be denied as untimely, futile, and prejudicial. Applicant seeks leave to add four "new" counterclaims to cancel Opposer's pleaded registrations on top of the five existing counterclaims for cancellation Applicant has already asserted. Two of Applicant's four proposed counterclaims allege abandonment based on grounds that were available and known (or should have been known) to Applicant at the time Applicant filed its original counterclaims on July 31, 2018 (6 TTABVUE), when Applicant filed its First Amended Counterclaims on October 30, 2018 (13 TTABVUE), and when Applicant sought leave to file the current Second Amended Counterclaims on March 12, 2019 (17 TTABVUE). Because Applicant's abandonment counterclaims attack the validity of Opposer's pleaded registrations, they are compulsory under Trademark Rule 2.106(b)(3)(i). And because the basis for each of the

proposed counterclaims were known to Applicant when this proceeding was commenced in June 2018, Applicant was obligated to plead each with or as part of its original answer filed in July 2018. *See* Trademark Rule 2.106(b)(3)(i) (“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.”)

By omitting any counterclaims for abandonment from its original answer, and on the two subsequent occasions when Applicant separately filed amended counterclaims, Applicant has thrice waived its claim, and Opposer would suffer prejudice due to the inability to adequately defend and the associated undue delay in proceedings that would result. Further, allowing Applicant leave to amend would be futile, as Applicant’s claims at best purport to allege that the marks claimed in Opposer’s registrations are geographically descriptive, but lacking in secondary meaning, a ground for attack that is unavailable against Opposer’s registrations, which are both more than five years old. *See Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 195 (1985).

Applicant’s remaining two proposed new counterclaims seek cancellation of Opposer’s WILLAMETTE registration for *wine* on the grounds of deceptiveness and false geographic indication, but are, in fact, based on allegations concerning Opposer’s use of its different mark WILLAMETTE WINEWORKS for *entertainment and educational services* and *bar and restaurant services*. Both counterclaims are futile as they: (1) rely on the improper dissection of Opposer’s WILLAMETTE WINEWORKS mark; (2) constitute an impermissible collateral attack on Opposer’s separate U.S. Registration No. 6,043,024 for the WILLAMETTE WINEWORKS mark for *entertainment and educational services* and *bar and restaurant services*; (3) are duplicative of identical claims Applicant has asserted in the wholly separately

proceeding to cancel Opposer's WILLAMETTE WINEWORKS registration; (4) blur the recognized distinctions for showing deceptive use of a mark with goods as compared to services; and (5) ignores the absence of any statutory basis to apply a claim for false geographic indication under Section 2(a) to use of a mark with services.

Further, even if Applicant's proposed counterclaims based on Opposer's use of WILLAMETTE WINEWORKS with services were not futile, Applicant has subsequently acknowledged that those claims raise separate and distinct issues from the claims in this proceeding and that pursuing them here would require substantial additional discovery and cause undue delay.

A. APPLICANT CANNOT AMEND AS A MATTER OF COURSE.

Federal Rule of Civil Procedure 15 governs amendment of pleadings to add an omitted compulsory counterclaim. *Jive Software, Inc. v. Jive Commc'ns, Inc.*, 125 USPQ2d 1175, 1175-80 (TTAB 2017). It provides that a party may amend its pleading "once as a matter of course" within 21 days after service or, if the pleading is one to which a responsive pleading is required, within 21 days after service of a responsive pleading. Fed. R. Civ. P. 15(a)(1). Otherwise, pleadings may be amended only with leave or consent. Fed. R. Civ. P. 15(a)(2).

Here, Applicant amended its counterclaims "once as a matter of course" on October 30, 2018. (13 TTABVUE.) "Once a party has exhausted its one-time right to amend as a matter of course, it may make further amendments only with the opposing party's consent or with leave." *United States ex rel. D'Agostino v. EV3, Inc.*, 802 F.3d 188, 192 (1st Cir. 2015); *see also Perkins v. Silverstein*, 939 F.2d 463, 471 (7th Cir. 1991). The right does not renew simply because a responsive pleading or subsequent amendment is made. *D'Agostino*, 802 F.3d at 192-93.

Applicant asserts that because the Board recently granted Opposer leave to amend its notice of opposition to add a single claim for unlawful use, Applicant is not required to obtain leave to amend its counterclaims. Instead, Applicant asserts that it may amend its counterclaims as it sees fit “as a matter of course” and without any requirement to obtain the Board’s leave when it answers Opposer’s Third Amended Notice of Opposition.¹ Applicant provides no Board or Federal Circuit case or precedent in support. Rather, Applicant relies on the 2012 Edition of *Moore’s Federal Practice*, a treatise on federal civil procedure, for the proposition that Applicant “is allowed to amend its counterclaims in response to Opposer’s amended pleading as a matter of right.” 73 TTABVUE 5 (citing 3 James W. Moore, et al., *Moore’s Federal Practice* § 15.17[6] (3d Ed. 2012)). Applicant even parenthetically quotes the 2012 Edition as stating “when a plaintiff’s amended complaint changes the theory of the case, it would be inequitable to require leave of court before the defendant could respond with appropriate counterclaims.” *Id.*

The 2021 Edition of *Moore’s Federal Practice*, however, advocates for a different approach and omits the quoted language from the 2012 Edition that Applicant relies on. As explained in the current § 15.17[6], “[h]istorically . . . there have been three approaches to the question of when a counterclaim may be included with the answer to the amended complaint: the narrow approach, the moderate approach, and the permissive approach.” *Moore’s Federal Practice* § 15.17[6] (2021 Ed.).² Both the “narrow” and “permissive” approaches had become highly disfavored, *id.*,³ so by 2012 courts had generally coalesced around the “moderate”

¹ Applicant’s effort to link amendment of its counterclaims to the filing of its answer ignores the fact that since October 30, 2018, Applicant has broken its Answer and its Counterclaims into two separate pleadings, *see* 13, 17 TTABVUE.

² For the Board’s convenience, a copy of the 2021 Edition of § 15.17 is attached as Appendix A.

³ The narrow approach provided that an amended answer could specifically address the amendments in the complaint only; but the approach is now “largely considered irrelevant” as it was based on a provision of Fed. R. Civ. P. 13(f) abrogated in 2009. *Moore’s Federal Practice* § 15.17[6] (2021 Ed.). Under the permissive approach, any amendment of a complaint automatically causes a case “to be essentially reset,”

approach, which allowed counterclaims to be asserted without leave of court provided the counterclaims responded to new allegations in the amended complaint. *See id.* (under moderate approach, “[t]he breadth of permissible changes in the amended response is determined by the breadth of the changes in the amended complaint.”).

“More recently,” however, a fourth approach has emerged, labelled the “uniform” or *Bern* approach after the 2014 Lanham Act case that suggested it, *Bern Unlimited, Inc. v. Burton Corp.*, 25 F. Supp. 3d 170 (D. Mass. 2014). *Id.* The “uniform” approach rejects the narrow and permissive approaches and further finds the moderate approach impractical due the need for courts to “deal with the potentially difficult question of whether a counterclaim ‘responds’ to an amended complaint or not.” *Bern*, 25 F. Supp. 3d at 179.⁴ Instead, courts following the uniform approach “simply apply normal Rule 15(a) standards, in all their flexibility, to both amended complaints and amended or new counterclaims.” *Moore’s Federal Practice* § 15.17[6].

Since the post-2012 emergence of the uniform approach, the authors of *Moore’s Federal Practice* have endorsed the approach over the moderate approach:

The *Bern* approach has the advantage of eliminating a special rule for asserting counterclaims in response to amended complaints. Moreover, it is consistent with the Civil Rules Advisory Committee’s goal in 2009 of seeking to ensure that Rule 15 govern all amendments. In many cases, given the liberal amendment standard that Rule 15 embodies, the *Bern* and the moderate approaches will yield similar

triggers a right to assert any and all new counterclaims as if answering an original complaint. *Id.* The permissive approach has been heavily criticized as inconsistent with Federal Rules as amended in 2009 “and because it deprives the court of its ability to manage the litigation by rejecting amendments that do not meet the standards of Rule 15.” *Id.*; *see also Cieutat v. HPCSP Invs., LLC*, No. 20-0012, 2020 WL 4004806, at *4 (S.D. Ala. July 15, 2020) (noting that “[t]he permissive approach appears to have gained few adherents” and that “[t]he practical weaknesses of the permissive approach have been laid bare in other opinions, and the Court can find no textual support in Rule 15 for that approach.”).

⁴ The moderate approach also leads to a de facto permissive approach by allowing any counterclaim that is “responsive” in breadth without consideration of delay, prejudice or futility. *See Bern*, 25 F. Supp. 3d at 178 (“The reason that leave is required to amend a complaint is so that the court will have an opportunity to deny amendments that might cause undue delay, result in undue prejudice, result in the assertion of new claims that are futile or are asserted in bad faith, or otherwise involve abuses of the legal process.”).

results. However, courts ought to adopt the *Bern* approach to ensure analytical coherency and eliminate the possibility of further “surprisingly” inconsistent results.

Moore’s Federal Practice § 15.17[6] (emphasis added).

The Board in *Jive Software* also cited approvingly to *Bern* for its uniform approach of applying Rule 15 to leave to add a counterclaim in the same way as it would “with any amendment of the pleadings.” *Jive Software*, 125 USPQ2d at 1179. In doing so, the Board parenthetically quoting *Bern*’s conclusion that the better approach is to simply apply the Rule 15 standard “equally to amended complaints and amended (or new) counterclaims” as that approach “would prevent a party from asserting new counterclaims that are made in bad faith, cause undue delay or prejudice, are futile, or abuse the legal process in some other way, and also has the virtues of simplicity and ease of application.” *Id.* (quoting *Bern*, 25 F. Supp. 3d at 179).

Applicant attempts to downplay *Jive Software*’s reliance on *Bern* as “mere *dicta*” and “inapposite” because the counterclaim before the Board was not asserted “in response to an amended pleading.” 73 TTABVUE 6-7. What Applicant is suggesting, however, is that the Board should adopt a special, extra-textual rule applicable only to compulsory counterclaims asserted “in response to an amended pleading” that would permit a party to evade Rule 15(a)’s normal limitations on untimely, prejudicial, futile, and bad faith amendments. *Jive Software* specifically rejected such an approach, holding: “The rules require compulsory counterclaims to be pleaded in the answer, if known, but under Fed. R. Civ. P. 15(a), where justice requires, answers may be amended to add an omitted compulsory counterclaim, subject to the same rules applicable to other amendments to pleadings.” 125 USPQ2d at 1180 (emphasis added). Indeed, while *Jive Software* acknowledged the importance of taking into account the compulsory nature of a proposed counterclaim when weighing whether to grant leave to amend, it also specifically rejected the notion that certain categories of claims or counterclaims should be absolutely

exempt from application of the rules barring untimely or prejudicial claims: “it is important to emphasize that all claims, including counterclaims and defenses, should be pleaded promptly, and that an unexplained delay in filing a motion to amend a pleading may result in a finding that the amendment is untimely.” *Id.* (emphasis added).

Applicant also argues that “[a]mong decisions that actually have considered whether a party may amend its counterclaims as of right in response to an amended pleading, the overwhelming majority of courts have adopted the moderate approach.” 73 TTABVUE 7. However, of the seven opinions Applicant cites for this proposition, six were issued before *Bern* was decided in 2014 and contain no discussion or consideration of *Bern* or the uniform approach. Further, five of those six specifically cite to and rely on the now-superseded endorsement of the moderate approach in the 1997 or 2012 editions of *Moore’s Federal Practice* § 15.17[6],⁵ while three were actually decided prior to the 2009 amendments to the Federal Rules that, as the Board explained in *Jive Software*, “confirmed that leave to add a counterclaim is governed by Rule 15 . . . as with any amendment of the pleadings under this rule.” *Jive Software*, 125 USPQ2d at 1179 (citing *Bern*, 25 F. Supp. 3d at 179).

As for the one post-*Bern* opinion Applicant cites, the court acknowledged the existence of the *Bern* approach but did not engage in any analysis finding it deficient or inferior to the moderate approach; instead, the court simply opted to go with the moderate approach because that is what other courts in the same circuit had previously done. *Ramsay-Nobles v. Keyser*, No. 16 Civ. 5778, 2018 WL 6985228, at *4 (S.D.N.Y. Dec. 18, 2018) (“Consistent with other courts

⁵ *Va. Innovation Scis., Inc. v. Samsung Elecs. Co.*, 11 F. Supp. 3d 622, 632 (E.D. Va. 2014); *Hydro Eng’g, Inc. v. Petter Invs., Inc.*, No. 2:11-cv-00139, 2013 WL 1194732, at *3 (D. Utah Mar. 22, 2013); *Panoceanis Maritime, Inc. v. M/V EULA B. DEVALL*, No. 11-2739, 2013 WL 264616, at *3 (E.D. La. Jan. 23, 2013); *Elite Entm’t, Inc. v. Khela Bros. Entm’t*, 227 F.R.D. 444, 447 (E.D. Va. 2005); *Uniroyal Chem. Co. v. Syngenta Crop Prot., Inc.*, No. 3:02CV02253, 2005 WL 677806, at *2 (D. Conn. Mar. 23, 2005)

in this Circuit, this Court will adopt the ‘moderate’ approach.”). As this decision illustrates, arguing that the “majority” of courts have adopted the moderate approach does not mean that the approach is either the best approach, the correct approach or the most equitable approach; rather, it means only that, given the recent emergence of the *Bern* approach, most courts previously addressing the issue either did not consider the uniform approach at all or chose to go with the moderate approach for other reasons, such as to maintain intra-circuit consistency. Here, following the uniform approach ensures both the equitable application of the rules, as well as consistency with the Board’s prior decision in *Jive Software*.

Finally, even if the moderate approach were applied to Applicant’s counterclaims, Applicant is still required to seek leave to amend as the “breadth” of Applicant’s four new counterclaims far exceeds the minimal “breath” of the single additional claim for illegal use that was added via Opposer’s Third Amended Notice of Opposition.

Opposer’s Third Amended Notice added a single additional claim that Applicant’s use of its WILLAMETTER JOURNAL mark is illegal in view of the fact that [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]. 50 TTABVUE at 3-4. Opposer’s additional claim requires no additional discovery, no expert testimony, and no expansion of the scope of the case or extension of the applicable deadline. Indeed, the illegal use claim [REDACTED]
[REDACTED]

[REDACTED].⁶

⁶ Applicant also attempts to suggest that Opposer “significantly” expanded the theory and scope of the proceeding by including in the Third Amended Notice of Opposition additional, specific factual support

In contrast, Applicant’s four proposed new counterclaims if allowed will add entire new theories, grounded on a whole new set of underlying facts, that would greatly expand the scope of the dispute and require additional discovery—including potential expert testimony—and delay the final disposition of this long running dispute.

For example, Applicant’s proposed Fifth and Sixth Counterclaims for “Abandonment,” is based on an entirely new theory that at some point in the past ten to twenty years Opposer’s WILLAMETTE VALLEY VINEYARDS and WILLAMETTE marks were somehow stripped of the secondary meaning they possessed at the time of registration through Opposer’s alleged failure to take unspecified “necessary action” to prevent the marks from allegedly “losing” their significance as indicators of source due to incrementally increasing third party use of “Willamette Valley” as a geographically descriptive term for wine. 74 TTABVue Ex. A at ¶¶ 60-108. Likewise, Applicant’s proposed Seventh and Eight Counterclaims for “deceptiveness” and “false geographical indication” are based on a whole new theory and set of allegations regarding Opposer’s use of a different mark that is not the subject of this proceeding—WILLAMETTE WINEWORKS—as a *service* mark in connection with services that are not recited in the registrations/application that are the subject of this proceeding—*Entertainment and educational services and Bar and restaurant services*—that Applicant’s counsel acknowledges involves issues that are “separate and distinct” from the claims and issues in the current proceeding and will require additional discovery. Because each of these theories is unrelated to Opposer’s new claim for illegal use and introduces multiple new theories and issues

for its already existing claims. But merely buttressing already existing claims with additional factual support obtained through discovery does not expand the “breadth” of the case. See *Bib Cnty. School Dist. v. Dallemund*, No. 5:16-Cv-549, 2019 WL 1519299, at *4 (M.D. Ga. Apr. 8, 2019) (under the moderate approach, “[b]uttressing allegations and adding new Defendants does not by itself allow the Pinnacle Defendants to assert an omitted counterclaim as of right.”); *Ramsay-Nobles*, 2018 WL 6985228, at *4-5 (Amending complaint to conform allegations to new evidence acquired during case “did not significantly change the theory or scope of the case”).

into this long-running dispute, they far exceed the “breadth” of Opposer’s limited amendment. *Ramsay-Nobles*, 2018 WL 6985228, at *4 (under moderate approach, defendants could not be amended as a matter of right where “new counterclaims are entirely unrelated to the new allegations [of the complaint], and add a whole new issue for litigation”).

B. APPLICANT HAS NOT SHOWN THAT JUSTICE REQUIRES GRANTING LEAVE TO ADD FOUR PROPOSED NEW COUNTERCLAIMS.

While the Board’s rules require application of the liberal standard for amendment set out in Rule 15(a), “it is important to emphasize that all claims, including counterclaims and defenses, should be pleaded promptly, and that an unexplained delay in filing a motion to amend a pleading may result in a finding that the amendment is untimely.” *Jive Software*, 125 USPQ2d at 1180; *see id.* (“Neither our cases nor those from federal courts favor dilatory practice, particularly that which results in substantial prejudice, undue delay, or the disruption of proceedings.”). Likewise, “if allowance of the amendment would unduly prejudice opposer or be futile, amendment will be denied.” *Mitek Corp. v. Woods Indus.*, 41 USPQ2d 1307, 1309 (TTAB 1996).

1. Applicant Has Not Shown that Justice Requires Leave to Assert Its Fifth and Sixth Proposed New Counterclaims for Abandonment.

a. Applicant’s Fifth and Sixth Counterclaims are Futile.

Applicant’s proposed abandonment counterclaims relies on allegations that “[s]ince the WVV Registration Date, wine consumers have come to understand the designation ‘Willamette Valley,’ used in connection with wine, as merely conveying information about the subject wine, namely, that it originates in the Willamette Valley,” *i.e.*, that consumers perceive the term Willamette Valley to be merely geographically descriptive for wine (not generic), and that this

perception is pervasive “to such an extent that the term no longer functions to distinguish wine producers or their goods,” *i.e.*, that the marks lack secondary meaning. 74 TTABVue 11-16.

A claim that Opposer’s marks are either merely descriptive but lacking in secondary meaning or “fail to function” as trademarks is not a valid basis to challenge Opposer’s registrations as they are each more than five years old. *See Park ‘N Fly*, 469 U.S. at 195 (“Whatever the precise boundaries of the courts’ equitable power, we do not believe that it encompasses a substantive challenge to the validity of an incontestable mark on the grounds that it lacks secondary meaning.”); *Philanthropist.com, Inc. v. The General Conference Corp. of Seventh-Day Adventists*, Canc. No. 92065178, 2017 WL 3726500, at *8 n.3 (TTAB May 1, 2017) (“Respondent’s motion to dismiss is granted with respect to the pleadings of descriptiveness, and failure to function as a mark. The claims are time-barred pursuant to Trademark Act Section 14(3).”); *see also* 2 McCarthy on Trademarks and Unfair Competition § 11:44 (5th ed.) (“If a mark has become ‘incontestable’ through five years use after federal registration and compliance with statutory formalities, then lack of distinctiveness of such a mark cannot be raised in litigation. That is, it is conclusively presumed either that the mark is nondescriptive, or if descriptive, has acquired secondary meaning. Defendant faced with an incontestable registered mark cannot defend by claiming that the mark is invalid because it is descriptive and lacks secondary meaning.”).

Applicant provides no authority for the proposition that Applicant can somehow circumvent the conclusive presumption of secondary meaning to which Opposer’s registrations are entitled by alleging that secondary meaning has somehow dissipated since the time of registration. Because Applicant cannot assert a challenge to the validity of Opposer’s marks

based on a theory that they are merely descriptive and lack secondary meaning, granting Applicant leave to add its proposed Fifth and Sixth Counterclaims would be futile.

b. Applicant's Fifth and Sixth Counterclaims are Untimely.

Even if Applicant's Fifth and Sixth Counterclaims were not futile, they are manifestly untimely. Both claims are grounded on the allegations that in the past ten to twenty years there has been a purported increase in third party use of "Willamette Valley" as a geographically descriptive term for wine, including on wine labels, and that "[s]ince 2015" the Willamette Valley Wineries Association has used the compound phrase "WILLAMETTE: THE PINOT NOIR AUCTION" in connection with an annual wine auction. 74 TTABVUE 11-16.⁷ All these alleged facts would have been known to Applicant when it filed its initial Counterclaims on July 31, 2018 (6 TTABVUE), as well as when it filed its First Amended Counterclaims on October 30, 2018 (13 TTABVUE), and sought leave to file the current Second Amended Counterclaims on March 12, 2019 (17 TTABVUE).

Applicant makes no genuine effort to show that it was not aware of these facts on the three previous occasions that it plead or amended its counterclaims. Instead, it contends that its counterclaims purportedly "arise from" Opposer's responses to discovery; specifically, that in response to some unspecified discovery request Opposer purportedly "advised Applicant, on September 15, 2020, that prominent third-party use of Opposer's alleged WILLAMETTE mark had been neither challenged nor licensed by Opposer." 73 TTABVUE 9. Applicant's motion provides no citation or record support for this claim.⁸

⁷ Applicant omits to mention, among other things, that the WVWA's auction occurs only once a year, is closed to the public, and is open only to members of the trade by invitation.

⁸ Applicant's motion also asserts that "Opposer to date has failed to confirm that its production and responses to Applicant's discovery requests are complete" without citation, record support, or any explanation for why any such alleged "failure" justified Applicant's delay. 73 TTABVUE 9.

However, based on Applicant's prior reply brief, 69 TTABVUE 6-7, it appears that Applicant is referring to the following discrete series of events:

- On May 27, 2020, Applicant served a Second Set of Requests for Production on Opposer that included Request No. 55, which sought “[a]ll documents concerning use of ‘Willamette’ on wine labels in connection with the Willamette Valley Wineries Association’s (‘WVWA’) Annual Auction.” 69 TTABVUE 6-7, 23.
- On June 26, 2020, Opposer served written responses and objections to Applicant’s Second Set of Requests for Production, which stated in response to Request No. 55 that Opposer, subject to its objections, “will produce non-privileged communications between Opposer and the Willamette Valley Wineries Association regarding the Association’s limited license to use “Willamette” on wine labels in connection with the periodically held, industry-only *Willamette: The Pinot Noir Auction*.” *Id.* at 7, 45.
- After some back and forth between counsel, Opposer’s counsel confirmed on September 15, 2020, that Opposer had produced with its June 26 responses Opposer’s communications with the WVWA regarding the limited license, including a draft of a written license agreement, and that Opposer was not aware of any executed copy of the draft agreement. *Id.* at 7, 84.

Notably, there is nothing in this series of events that includes any instance where “Opposer advised Applicant” that WVWA’s use “had been neither challenged nor licensed by Opposer,” as Applicant now claims. All that the events show is that Opposer stated on June 26, 2020 that it would produce the non-privileged “communications between Opposer and [WVWA] regarding the Association’s limited license to use ‘Willamette’ on wine labels in connection with the auction”; that Opposer produced those communications, which included a draft written license agreement; and that Opposer subsequently confirmed on September 15, 2020 that there it was not aware of any executed copy of the draft agreement.

Of course, Applicant’s Fifth and Sixth proposed counterclaims are not grounded on an allegation that WVWA’s use has been “neither challenged nor licensed by Opposer.” Rather, Opposer alleges only that WVWA’s use “is not licensed by Opposer in writing.” 74 TTABVUE Ex. A at ¶¶ 69, 97 (emphasis added). Likewise, Applicant’s prior reply brief claims that what

Applicant first became aware of on September 15, 2020, was not that Opposer had never challenge nor licensed” WVWA’s use, but that “the WVWA never had an executed license agreement to use such mark” and that “Applicant could not have brought its abandonment claims until it uncovered this information.” 69 TTABVUE 6 (emphasis added).

Applicant’s claim fails to hold up on multiple grounds. First, it is well-established that there is no requirement that a trademark license be in writing, let alone in a formal, executed written agreement. *See, e.g., Woodstock’s Enters. Inc. (Cal.) v. Woodstock’s Enters. Inc. (Or.)*, 43 USPQ2d 1440, 1447 (TTAB 1997) (“Both parties here agree that there is no formal, written agreement between them covering use of the WOODSTOCK’S marks. It is settled, however, that a license can be implied.”); *see also In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983) (“it is also clear that controlled licensing agreements may be recognized whether oral or written in form”); *Basic, Inc. v. Rex*, 167 USPQ 696, 697 (TTAB 1970) (“An oral license is sufficient to show a related company condition and there are elements of control between applicant and the licensee.”). Thus, Applicant claim that the crucial piece of missing information that prevented Applicant from previously asserting its claims was the knowledge of whether or not WVWA’s use was covered by a written “executed license agreement,” makes no sense since there is no requirement that a license be in a formal, executed written agreement.

Second, Applicant claim that it only first learned that the WVWA’s license was not set forth in an executed license agreement on September 15, 2020 is premised on the argument that Opposer’s June 26, 2020 response to Request No. 55 somehow “suggested” that Opposer “had a fully executed license [agreement] with the WVWA.” 69 TTABVUE at 7. Opposer’s response, however, merely stated that it had “non-privileged communications . . . regarding the Association’s limited license,” *id.*, not that it had a fully executed agreement.

Third, even if one accepts on its face Applicant’s claim that it somehow construed Opposer’s June 26, 2020 response to Request No. 55 as suggesting that Opposer “had a fully executed license [agreement] with the WVWA” and that Applicant did not become disabused of this notion until September 15, 2020, Applicant’s argument completely fails to explain why Applicant could not have—and did not—assert its “abandonment” claims on the three prior occasions Applicant filed or amended its counterclaims, which all occurred more than a year prior to Opposer’s serving its June 26, 2020 response to Request No. 55. Indeed, Applicant does not dispute that it has long been aware of the WVWA’s “prominent” use of WILLAMETTE: THE PINOT NOIR AUCTION in connection with an annual auction.⁹ Applicant, however, does not provide any reason for why it would have assumed prior to June 26, 2020 that WVWA’s use was subject to any license, let alone a “a fully executed license [agreement].”

The answer, of course, is that Applicant has had all the information it needed to assert its purported new claims for abandonment since Applicant first answered and asserted counterclaims on July 31, 2018, and has no good faith explanation or excuse for its failure at that time—or on the two subsequent occasions thereafter that Applicant amended its counterclaims—to assert what it concedes are compulsory counterclaims. Applicant’s undue delay merits denial of leave to amend. *See Ramsey-Nobles*, 2018 WL 6985228, at *10 (“When a motion ‘is made after an inordinate delay, no satisfactory explanation is offered for the delay, and the amendment would prejudice’ the non-movant, such ‘undue delay’ should weigh against granting leave to amend.”) (quoting *United States ex rel. Raffington v. Bon Secours Health Sys., Inc.*, 285 F. Supp. 3d 759, 766 (S.D.N.Y. 2018)).

⁹ Applicant’s October 30, 2018 Amended Counterclaims previously attached as Exhibit 7 a screen capture from the WVWA’s website at www.willamettewines.com taken on October 28, 2018. 13 TTABVUE 80-82. At the time the screenshot was taken, the website also included a page detailing WVWA’s auction showing a photo of the alleged “prominent” use on labels. 65 TTABVUE 22-22 (screenshot of page from the WVWA website archived via The Internet Wayback Machine on August 26, 2018).

c. Opposer Would Be Prejudiced by Amendment.

Even if Applicant could show that it has timely sought leave to amend to add its abandonment counterclaims, leave should still be denied as amendment would result in unfair prejudice. Applicant's proposed Fifth and Sixth Counterclaims are based on allegations that at some point during the past 10 to 20 years, Opposer's marks ceased to possess secondary meaning and that this occurred due to some combination of a shift in consumer understanding of the terms "Willamette" and "Willamette Valley" and "Opposer's conduct," including its purported failure "to take necessary action to prevent the words 'Willamette Valley' from losing their significance as an indicator of source," and that as a result of this "conduct" Opposer's marks have been "abandoned. 74 TTABVUE Ex. A at ¶¶ 78, 85. Applicant does not allege when in this time frame of 10 to 20 years the purported abandonment occurred (or for that matter, whether the abandonment occurred at separate times for Opposer's respective marks); or identify what "conduct" by Opposer allegedly constitutes a failure "to take necessary action to prevent" abandonment beyond the single allegation that the limited license for the one-a-year WVWA trade action is not contained in a "fully executed license [agreement]," let alone the relationship between Opposer's alleged conduct and the change in third party uses.

Opposer requires discovery on these issues to adequately defend against Applicant's new claims at trial and Applicant's argument that no discovery is required because Applicant's new claims "will hinge upon the same issue presented by Applicant's previously asserted genericness claims, namely, consumer perception of Opposer's alleged marks" 73 TTABVUE 9-10, is wrong on multiple grounds. First, Applicant's genericness claims are grounded on the argument that "Willamette" and "Willamette Valley" have always been generic terms for wine, and have never been descriptive or capable of acquiring secondary meaning. Accordingly, to the extent that

Applicant now wants to assert that not only have the terms always been descriptive, but there has been a material increase in third party descriptive use of the terms since Opposer's registrations issued, Opposer is entitled to secure discovery regarding the facts and evidence that Applicant contends supports those claims.

For example, Opposer is entitled to discovery regarding the supporting basis not only for Applicant's claim that in 2004 "there were less than 200 wineries in the Willamette Valley," but today "there are approximately 700 wineries in the Willamette Valley," 74 TTABVUE Ex. A at ¶ 64, but given Applicant's assertion that this increase in use has materially impacted consumer perception, Opposer is also entitled to discovery regarding what portion of wineries during the relevant time frame, actually made use of "Willamette" or "Willamette Valley" in a consumer facing manner and the nature and extent of those uses.

Opposer is likewise entitled to discovery regarding the basis for Applicant's claim that the number of COLAs issued by the TTB for wine labels displaying the term "'Willamette' has increased 60-fold" since Opposer's first registration issued, *id.* at ¶ 68, as well as regarding Applicant's evidence regarding which, if any, of those labels were actually applied to bottles that went to market (and where, when and in what volume) and how the terms were used or displayed on those labels.

Further, Applicant comes forward with not support for the claim that the issue of whether consumers perceive a mark as descriptive but lacking in secondary meaning is the same as whether consumers perceive a mark as generic. They're not. The inquiry into whether consumers perceive a term as descriptive or generic goes to the *primary* significance of the term—*i.e.*, it's level of inherent distinctiveness—while the inquiry into whether secondary meaning has attached goes to whether acquired distinctiveness has attached through use.

“Acquired distinctiveness is known as ‘secondary meaning’ not because it is second in importance or in impact, but because it is a meaning acquired second in time. It is a new meaning added second in time to the original primary meaning of the designation.” 2 *McCarthy on Trademarks and Unfair Competition* § 15:1 (5th ed.); see also *In re McDonald’s Corp.*, 230 USPQ 304, 307 (TTAB 1986) (“[T]he word ‘primarily’ refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term’s strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services,” thus, “[a] term’s secondary meaning does not necessarily mean second in importance or significance but, merely, second in time.”).

Significantly, neither the existence of or volume of secondary meaning can preclude or prevent a finding that the primary meaning of a term is generic and not descriptive. See *In re Northland Aluminum Prods., Inc.*, 221 USPQ 1110, 1111 (TTAB 1984) (“Generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.”). Accordingly, Opposer in defending against Applicant’s genericness claims to date would have no reason to focus on or develop evidence specifically addressing what levels of secondary meaning in its marks existed in the past 10 to 20 years. If Applicant fails to carry its burden to show that Opposer’s marks are generic, Opposer would be entitled to continue to rely on the presumptions under its registrations that its marks are valid, including that they have acquired secondary meaning.

If Opposer is required, however, to defend against a claim that its marks should be cancelled because they lack secondary meaning, Opposer is entitled to marshal all relevant it might choose to present in defense of the claims, including commissioning an expert to conduct a survey measuring the level of secondary meaning in its marks.

To the extent Applicant is permitted to assert abandonment claims based on the allegation that WVWA's use of "Willamette" in connection with its annual trade auction was not license or controlled by Opposer, Opposer should also be entitled to secure through third party discovery from WVWA any additional evidence that might be required to defend against such a claim.

Due to Applicant's delay in seeking leave to assert its claims until after the deadlines for making expert disclosure had passed and less than a month before the discovery is set to close, Opposer has been deprived of the opportunity to retain an expert and seek any necessary additional discovery from Applicant and third parties. Given that this proceeding has been pending for nearly three years and Opposer's pretrial disclosures are due on June 28, 2020, Opposer would be severely prejudiced if Applicant were allowed leave to amend to add its claims for abandonment at this late date. *See Ramsay-Nobles*, 2018 WL 6985228, at *9 (when analyzing whether undue prejudice has occurred, courts examine, among other factors, "whether an amendment would 'require the opponent to expend significant additional resources to conduct discovery and prepare for trial' or 'significantly delay the resolution of the dispute.'"); *see also Bibb Cnty. School Dist.*, 2019 WL 1519299, at *9 (while discovery still remained open, allowing the proposed amendment would greatly expand the nature and scope of the case beyond the claims previously pleaded and "would undoubtedly require additional discovery" that would delay resolution of the case and cause undue prejudice).

Further, given that Opposer has been diligently litigating its claims in this proceeding for more than two years and Applicant cannot provide good faith explanation for its failure to timely assert its counterclaim, it would be unfair to require Opposer to undergo the significant additional delay in resolution of this proceed—and potentially significant expenditure in resources to conduct further additional fact and expert discovery—by extending the discovery

period to allow for additional discovery and expert disclosures on Applicant's claims. *See Ramsay-Nobles*, 2018 WL 6985228, at *9 (finding that providing additional discovery would result in additional costs and "force additional delay of the resolution of this dispute upon the Plaintiff").

2. Applicant Has Not Shown that Justice Requires Leave to Assert Its Seventh and Eight Proposed New Counterclaims for Deception and False Geographical Indication.

Applicant's motion initially asserts that Applicant's proposed Seventh and Eighth Amended Counterclaims seek to add claims against Opposer's pleaded registration for its alleged WILLAMETTE mark "arising from Opposer's use of the subject mark in connection with wine that does not originate in the Willamette Valley." (73 TTABVUE 3.) But a summary review of Applicant's motion and proposed pleading disclose that Applicant's proposed new claims do not "arise" from Opposer's use of its registered WILLAMETTE mark for *wine*. Rather, Applicant's claims purportedly arise out of Opposer's use of a wholly separate mark, WILLAMETTE WINEWORKS, in connection with *entertainment and educational services, namely, conducting wine tastings and classes and workshops in the field of wine blending and making and bar and restaurant services, namely, providing of food and beverages for consumption on and off the premises*.

Further, Opposer's WILLAMETTE WINEWORKS mark in connection with *entertainment and educational services and bar and restaurant services* is not only covered by a different federal registration owned by Opposer, No. 6,043,024, that is not the subject of this proceeding, Applicant has recently commenced an entirely separate proceeding, Cancellation No. 92076053, that seeks cancellation of Opposer's WILLAMETTE WINEWORKS registration based on, among other things, the same allegations and the same grounds of deception and false

geographic indication that Applicant seeks leave to amend here. (*See* Cancellation No. 92076053, 1 TTABVUE ¶¶ 38-55.)

And while Applicant asserts in its motion that granting leave to add these claims would not require additional discovery or cause delay, Applicant’s counsel has previously acknowledged that its claims and allegations relating to the WILLAMETTE WINEWORKS mark are sufficiently “separate and distinct” from the claims and issues in the WILLAMETTER JOURNAL proceeding that the two matters should not be consolidated, particularly in view of the additional discovery required to address the WILLAMETTE WINEWORKS claims, the drastic difference as to the stage of the proceedings and the distinct factual issues in each. *See* 65 TTABVUE 23 (“we think the proceedings should stay separate and distinct. The most important reason being that WVV has not provided any discovery regarding WILLAMETTE WINEWORKS to date and the original proceeding is just days away from the close of fact discovery”).¹⁰ Accordingly, there is no dispute that allowing Applicant leave to amend would result in substantial prejudice and undue delay in the resolution of this long-pending proceeding because it would require both parties to pursue discovery on entirely new claims that, among other things are the subject of a separate proceeding.¹¹

Even if Applicant were not concurrently pursuing a separate action for cancellation of Opposer’s WILLAMETTE WINEWORKS registration based on the identical allegations and theories that Applicant seeks leave to add here, and even if Applicant’s counsel did not concede that litigation of those claims involves separate and distinct issues, will require additional

¹⁰ Opposer agrees that this proceeding should not be consolidated with Applicant’s cancellation due to the advanced stage of these proceedings and material differences in the underlying facts and alleged claims.

¹¹ Applicant’s Seventh and Eight Counterclaims would not be compulsory counterclaims, as Applicant suggests, since they are currently the subject of another pending proceeding before the parties and, thus, are not required to be pled here. *See* 37 C.F.R. § 2.106(b)(3)(i) (“a counterclaim need not be filed if the claim is the subject of another proceeding between the same parties or anyone in privity therewith”).

discovery, and will unnecessarily delay these proceedings, granting Applicant leave to add its claims would still be futile.

Applicant's attempt to shoehorn its claims that Opposer's use of its separate WILLAMETTE WINEWORKS mark with *entertainment and educational services* and *bar and restaurant services* into claims that Opposer's WILLAMETTE mark for wine is deceptive or false use of a geographic indication constitutes an impermissible dissection of Opposer's WILLAMETTE WINEWORKS mark as well as a collateral attack on Opposer's registration for that mark.

Attempting to engraft a claim that use of a mark with *services* is akin to use of the mark with *goods* for purposes of determining whether use of the mark is deceptive also ignores the well-recognized distinction that consumers view the deceptiveness of a mark when used in connection with services differently from use of the same mark in connection with goods, particularly in the case of restaurant services. *See, e.g., In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003) (“This court recognizes that the standard under section 2(e)(3) is more difficult to satisfy for service marks than for marks on goods. In fact, for the reasons discussed above, geographic marks in connection with services are less likely to mislead the public than geographic marks on goods. Thus, a different application of the services-place association prong is appropriate, especially in the context of marks used for restaurant services – ‘some of the very most ubiquitous of all types of services.’”).

Likewise, while Section 2(a) of the Lanham Act provides a basis for cancellation of a registration for a mark on the grounds that it constitutes a false geographic indication, that basis only applies when the mark is “used on or in connection with wines or spirits.” 15 U.S.C.

§ 1052(a). Use of mark in connection with *services* is not a basis for cancellation under the statute.

In prior briefing, Applicant attempted to argue that its claims do not constitute a collateral attack on Opposer’s WILLAMETTE WINEWORKS registration and are not based on allegations that Opposer is using the WILLAMETTE WINEWORKS mark in connection with services. Rather, Applicant argues that it should be allowed to proceed because it has alleged that WILLAMETTE functions as a “separate” element from “WINEWORKS” when the terms are used in combination and that since Applicant allegations purportedly rely on Opposer’s use of the WILLAMETTE WINEWORKS mark on glassware and tasting menus, rather than its registration of the mark for services, its allegations should be construed as alleging use on or in connection with wine, rather than use with services. Neither argument has merit.

Applicant cannot plead around its own allegations regarding the mark that forms the basis of the claims. Applicant has not alleged that Opposer is using “Willamette” standing alone for wine not originating from the Willamette Valley. Rather, it alleges that:

- Opposer “owns Registration No. 6043024 for ‘Willamette Wineworks’ for services featuring wine,” that in connection its application to register the “Willamette Wineworks” mark, 74 TTABVUE Ex. A at ¶ 116 (emphasis added);
- Opposer “submitted a four-page specimen in support of registration (the ‘Specimen’)” for its Class 41 and 42 services, *id.* at ¶ 117;
- that “[p]age two of the Specimen indicates that Defendant provides its Class 41 tasting and blending services in connection ‘Natoma Wines, made in California,’ *id.* at ¶ 120 (emphasis added);
- that “the second page of the Specimen further indicates that the subject wines of the Class 41 services are not made from Willamette Valley grapes,” *id.* at ¶ 121 (emphasis added);
- That “Page four of the Specimen is a “Flights” menu bearing Defendant’s Mark that . . . includes four wines from the Willamette Valley (including one from sub-

AVA Eola-Amity Hills), and six wines from outside of the Willamette Valley,” *id.* at ¶ 124 (emphasis added)¹²;

- That Opposer stated in a press release that “Willamette Wineworks will feature food and wine pairings and a unique hands-on wine blending experience,” *id.* at ¶ 125(emphasis added).

As these allegations illustrate, Applicant claims are not based on use of “Willamette” with wine, but on Opposer’s registered “Willamette Wineworks” mark for tasting and blending services and the specimen of use with those services that Opposer filed with the USPTO in support of its application to register.

Likewise, Applicant cannot dissect Opposer’s WILLAMETTE WINEWORKS mark by alleging that “Willamette” creates its own distinct commercial impression. As a threshold matter, while Applicant does attempt to allege that “WILLAMETTE, as used by Opposer as an element of its composite ‘Willamette Wineworks’ designation, creates a separate and distinct commercial impression apart from any other matter which WILLAMETTE is used, including ‘Wineworks,’” 74 TTABVUE Ex. A at ¶ 127, Applicant’s allegation does not cause the “Wineworks” element to disappear. It still remains part of the alleged mark that cannot be disregarded. Indeed, Applicant’s allegation immediately clarifies by stating “That is, Opposer’s use of its composite ‘Willamette Wineworks’ designation constitutes use of WILLAMETTE.” *Id.* (emphasis added.)

Applicant’s allegation is also based on the assertion that WILLAMETTE WINEWORKS appears in a stylized form in one place in the specimen where “Wineworks” is shown in “larger type and in serif font” while “Wineworks” is displayed in “smaller sans-serif font.” *Id.* at ¶ 126. But the same specimen also includes multiple instances where “Willamette Wineworks” is shown all on one line in the same font, size and color. *Id.* at 320-321. That would make

¹² As shown on the copy of the Specimen itself, the “Flights” menu is a menu of tasting flights offered as part of Opposer’s tasting services. 74 TTABVUE at 323.

“Willamette Wineworks” an inseparable unitary phrase, not a composite of two separately registrable elements. See *In re Jane P. Semans*, 193 USPQ 727, 729 (TTAB 1976); see also *In re Brewster Wallcovering Co.*, 1999 WL 546863 at *2 (TTAB Jul 19, 1999) (“Although LONGWOOD, alone, suggests a surname or geographical location, we find that it takes on a different connotation when combined with the term MANOR, i.e., that of a stately home called LONGWOOD MANOR”; finding combination to be a unitary phrase and not separable elements).¹³

Accordingly, because granting Applicant leave to add its new counterclaims for deception and false geographic indication would be futile, and would result in undue delay and prejudice, leave to amend should be denied.

III. CONCLUSION

For the reasons set forth above, Opposer respectfully requests that the Board deny Applicant’s motion for leave to amend counterclaims in its entirety.

DATED this 10th day of May, 2021.

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¹³ Of course, to be considered separable elements, “Willamette” and “Wineworks” must not only create separate and distinct commercial impression from each other, but both must “in fact, per se, identify and distinguish the product from the products of others.” *In re Jane P. Semans*, supra, 193 USPQ at 729. Applicant does not allege that “Wineworks” can, per se, function as an indicator of source for wine.

Appendix A

[3 Moore's Federal Practice - Civil § 15.17](#)

Moore's Federal Practice - Civil > Volume 3: Analysis: Civil Rules 13–16 > Volume 3 Analysis: Civil Rules 13–16 > Chapter 15 Amended and Supplemental Pleadings > B. AMENDED PLEADINGS

§ 15.17 Practical Aspects of Amendments

[1] Motion for Leave to Amend

[a] Form and Content of Motion

To obtain leave of court to amend a pleading, the party's motion should attach a copy of the proposed amendment or new pleading. Failure to attach the proposed amendment is not necessarily fatal,¹ but may result in denial of leave to amend on the grounds that the court cannot evaluate the propriety of granting leave unless the court is presented with the substance of the proposed amendment.² A motion requesting

¹ Failure to attach proposed amendment not necessarily fatal.

2d Circuit [McLaughlin v. Anderson, 962 F.2d 187, 195 \(2d Cir. 1992\)](#) (lack of formal motion is not necessarily sufficient grounds for dismissal without leave to amend as long as plaintiff made clear its willingness to amend).

5th Circuit [Davis v. United States, 961 F.2d 53, 57 \(5th Cir. 1991\)](#) (district court could consider failure to attach proposed pleading as factor in determining whether to grant motion, but failure was not fatal).

² Failure to attach amendment may result in denial of leave.

1st Circuit [Aponte-Torres v. Univ. of P.R., 445 F.3d 50, 58 \(1st Cir. 2006\)](#) ("The absence of supporting information may, in and of itself, be a sufficient reason for the denial of leave to amend"; citing **Moore's**).

3d Circuit *United States ex rel. Zizic v. Q2Administrators, LLC*, [728 F.3d 228, 243 \(3d Cir. 2013\)](#) (district court did not abuse its discretion in failing to grant leave to amend when plaintiff neglected to attach draft amended complaint).

5th Circuit [Edionwe v. Bailey, 860 F.3d 287, 294 \(5th Cir. 2017\)](#) (court did not abuse discretion in implicitly denying motion to amend when entering final judgment on pleadings because motion did not indicate any new facts that might sustain plaintiff's allegations); [McKinney v. Irving Indep. Sch. Dist., 309 F.3d 308, 315 \(5th Cir. 2002\)](#) (district court did not abuse its discretion in failing to grant leave to amend, even though plaintiff was entitled to amend as of right, when plaintiffs did not furnish district court with proposed amendment and failed to alert district court and defendants to substance of proposed amendment); *see also* [Whitaker v. City of Houston, 963 F.2d 831, 837 \(5th Cir. 1992\)](#) (court denied motion to amend when plaintiff failed to submit copy of proposed amendment until one week before defendant was required to respond to motion).

6th Circuit [Roskam Baking Co. v. Lanham Mach. Co., 288 F.3d 895, 906–907 \(6th Cir. 2002\)](#) (district court did not abuse its discretion in denying leave to amend when party had not filed proper motion showing proposed amendment or substance of proposed amendment, because in absence of proposed amendment court did not have before it information necessary to determine if leave should be granted).

7th Circuit [Harris v. City of Auburn, 27 F.3d 1284, 1287 \(7th Cir. 1994\)](#) (in light of requirement that district court consider merits of request for leave to amend, failure to tender amended complaint may indicate a lack of diligence or good faith); **Otto v. Variable Annuity Life Ins. Co., 814 F.2d 1127, 1139 (7th Cir. 1986)** (citing **Moore's**, court denied plaintiff's request to amend because plaintiff failed to attach second amended complaint to motion or inform court how deficiencies would be cured); *see* [Hecker v. Deere & Co., 556 F.3d 575, 590–591 \(7th Cir. 2009\)](#) (when plaintiff does not seek leave to amend until after entry of

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only that the court grant the plaintiff the opportunity to correct deficiencies if necessary, and that fails to apprise the court of any facts that might be included in an amended complaint, will justify denial of the motion for leave to amend.^{2.1} If the district court has a local rule requiring attachment of a proposed amendment to a motion seeking leave to amend, failure to comply with that rule may be sufficient reason by itself to deny leave.^{2.2}

Every motion, including a motion for leave of court to amend a pleading, must comply with Rule 7,³ which requires the movant to specify the relief sought,^{3.1} and to state with particularity the grounds for seeking that

final judgment, failure to attach proposed amended complaint or otherwise explain how complaint's deficiencies could be cured is sufficient ground to deny leave).

8th Circuit [*In re 2007 Novastar Fin. Inc., Sec. Litig.*, 579 F.3d 878, 884–885 \(8th Cir. 2009\)](#) (district court properly denied leave to amend when movant failed to submit proposed amendment or even indicate substance of proposed amendment; district court is not required to engage in guessing game as result of movant's failure to specify proposed new allegations); see also [*O'Neil v. Simplicity, Inc.*, 574 F.3d 501, 505 \(8th Cir. 2009\)](#) (district court did not abuse its discretion by denying leave to amend when plaintiff had not submitted proposed amended pleading as required by local rule).

10th Circuit See [*Carroll v. Lawton Indep. Sch. Dist. No. 8*, 805 F.3d 1222, 1231 \(10th Cir. 2015\)](#) (plaintiffs did not make formal separate motion for leave to amend or, more significantly, identify specific factual allegations they would allege in amended complaint).

11th Circuit [*Newton v. Florida*, 895 F.3d 1270, 1277–1278 \(11th Cir. 2018\)](#) (party seeking leave to amend must either include copy of proposed pleading itself or set forth substance of proposed amendment, and mere speculation as to how pleading defects might be cured is insufficient).

D.C. Circuit [*Guam v. American Pres. Lines*, 28 F.3d 142, 150 \(D.C. Cir. 1994\)](#) (citing **Moore's**, leave to amend denied when plaintiff failed to file motion to amend complaint or to submit amended complaint).

^{2.1} **Absence of specific content may doom motion to amend.** See, e.g., [*Edionwe v. Bailey*, 860 F.3d 287, 294 \(5th Cir. 2017\)](#) (movant contended that pleadings sufficed to state due process claim throughout briefing in opposition to Rule 12(c) motion, and failed to apprise district court of any facts that would be pleaded in amended complaint).

^{2.2} **Local rule requiring attachment.** [*Castanon v. Cathey*, 969 F.3d 1125, 1133 \(10th Cir. 2020\)](#).

³ **Motion to amend must satisfy Rule 7. Fed. R. Civ. P. 7(b).**

5th Circuit [*United States ex rel. Doe v. Dow Chem. Co.*, 343 F.3d 325, 330–331 \(5th Cir. 2003\)](#) (district court properly denied motion to amend that did not set out proposed amendment or offer grounds on which amendment should be permitted).

6th Circuit [*Crosby v. Twitter, Inc.*, 921 F.3d 617, 627–628 \(6th Cir. 2019\)](#) (submission of formal motion to amend required, so plaintiff's "cursory request at the end of their opposition to Defendants' motion to dismiss" was insufficient to preserve issue of whether leave should have been granted); [*CNH Am. LLC v. Int'l Union, United Auto., Aero. & Agric. Implement Workers of Am.*, 645 F.3d 785, 795 \(6th Cir. 2011\)](#) ("if a party does not file a motion to amend or a proposed amended complaint, it is not an abuse of discretion for the district court to dismiss the claims with prejudice"); see [*Tefft v. Seward*, 689 F.2d 637, 639 \(6th Cir. 1982\)](#) (while motion is most common form to seek amendment, various methods have been recognized as sufficient to amend).

7th Circuit See [*Moore v. Indiana*, 999 F.2d 1125, 1131 \(7th Cir. 1993\)](#) (plaintiff's cursory motion failed to convey plaintiff's intention to add 13 new defendants and to change nature of claim).

10th Circuit [*Calderon v. Kansas Dep't of Social & Rehab. Servs.*, 181 F.3d 1180, 1187 \(10th Cir. 1999\)](#) (motion for leave to amend must give notice to court and opposing parties of particular basis for amendment, as required by **Fed. R. Civ. P. 7(b)**).

11th Circuit [*Rosenberg v. Gould*, 554 F.3d 962, 967 \(11th Cir. 2009\)](#) (plaintiffs failed to comply with **Fed. R. Civ. P. 7** when they failed to attach copy of proposed amendment or to describe substance of proposed amendment).

D.C. Circuit [*Benoit v. United States Dep't of Agric.*, 608 F.3d 17, 21 \(D.C. Cir. 2010\)](#) (unwritten, conditional request for leave to amend made in opposition to opponent's motion to dismiss did not satisfy **Fed. R. Civ. P. 7**).

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relief.^{3.2} Although many circuits have held that a request in an opposition to a motion to dismiss does not constitute a proper motion for leave to amend, courts are sometimes willing to consider arguments raised in a form other than a formal motion for leave to amend.⁴

^{3.1} **Relief sought.** *Fed. R. Civ. P. 7(b)(1)(C)*; see, e.g., [Thomas v. Chevron, U.S.A., Inc., 832 F.3d 586, 591–592 \(5th Cir. 2016\)](#) (although motion was not particularly well organized, it gave notice of substance of proposed amendments); [Moore v. Indiana, 999 F.2d 1125, 1131 \(7th Cir. 1993\)](#) (plaintiff's cursory motion failed to convey plaintiff's intention to add 13 new defendants and to change nature of claim).

^{3.2} **Grounds for relief.** *Fed. R. Civ. P. 7(b)(1)(B)*.

3d Circuit [United States ex rel. Zizic v. Q2Administrators, LLC, 728 F.3d 228, 243 \(3d Cir. 2013\)](#) (district court did not abuse its discretion in failing to grant leave to amend when plaintiff had requested leave in his opposition to motion to dismiss without any indication of particular grounds on which amendment was sought).

5th Circuit [Thomas v. Chevron, U.S.A., Inc., 832 F.3d 586, 591–593 \(5th Cir. 2016\)](#) (although motion was not particularly well organized, it provided plausible basis for relief; district court erred in considering proposed amendment as futile); [United States ex rel. Doe v. Dow Chem. Co., 343 F.3d 325, 330–331 \(5th Cir. 2003\)](#) (district court properly denied motion to amend that did not offer grounds on which amendment should be permitted).

⁴ **Arguments in opposition as request to amend.**

1st Circuit [Gonzalez-Perez v. Hospital Interamericano de Medicina Avanzada, 355 F.3d 1, 5 \(1st Cir. 2004\)](#) (no abuse of discretion in treating statute of limitations defense raised in summary judgment as amendment to pleadings when there was no showing of undue delay, bad faith, or dilatory motive).

2d Circuit [Loreley Fin. \(Jersey\) No. 3, Ltd. v. Wells Fargo Sec., LLC, 797 F.3d 160, 191 \(2d Cir. 2015\)](#) (request for leave to amend raised in alternative in brief opposing motion to dismiss; "Here, both the district court and Defendants were aware of Plaintiffs' request, and at the time it was made ... there was no decision yet as to the precise defects, such that a proposed cure would have been in order as part of the request to amend. Given the posture of the case, Plaintiffs were not obliged to formulate their request differently.").

5th Circuit [Patrick v. Wal-Mart, Inc., 681 F.3d 614, 623 \(5th Cir. 2012\)](#) (district court was not required to entertain request for amendment contained in opposition to dismissal rather than in motion for leave to amend); [United States ex rel. Willard v. Humana Health Plan of Tex. Inc., 336 F.3d 375, 386–388 \(5th Cir. 2003\)](#) (response to motion to dismiss was not proper substitute for motion to amend when response did not expressly request leave to amend and did not provide any indication of grounds on which amendment should be permitted); cf. [Willis v. Collins, 989 F.2d 187, 189 \(5th Cir. 1993\)](#) (court should have considered arguments raised in opposition to motion to dismiss as amendment to petition); [Vernell v. U.S. Postal Serv., 819 F.2d 108, 110 \(5th Cir. 1987\)](#) (court should have allowed amendment when plaintiff requested right to amend in opposition to motion to dismiss, since no responsive pleading was filed before request).

6th Circuit [Evans v. Pearson Enters., Inc., 434 F.3d 839, 853–854 \(6th Cir. 2006\)](#) (district court did not err in denying leave to amend that was requested by means of single sentence in response to defendants' motion to dismiss, as this brief request did not state with particularity grounds for motion).

7th Circuit See [Perkins v. Silverstein, 939 F.2d 463, 470 n.6 \(7th Cir. 1991\)](#) (general rule is that plaintiff may not amend complaint in brief in opposition to motion to dismiss; however, district court appeared to have deemed exhibits attached to brief as part of complaint and considered exhibits in determining sufficiency of complaint).

8th Circuit [Minneapolis Firefighters' Relief Ass'n v. MEMC Elec. Materials, Inc., 641 F.3d 1023, 1030 \(8th Cir. 2011\)](#) (footnote contained in opposition papers to motion to dismiss requesting leave to amend in event of dismissal was insufficient as motion seeking leave to amend).

10th Circuit See [Calderon v. Kansas Dep't of Social & Rehab. Servs., 181 F.3d 1180, 1187 \(10th Cir. 1999\)](#) (sentence contained in opposition to motion to dismiss was not proper motion to amend; although failure to file formal motion is not always fatal, request must at least give notice to opposing parties and court of particular basis for amendment); [Glenn v. First Nat'l Bank in](#)

[b] Service and Filing of Motion; Simultaneous E-Filing and Service

Any motion seeking leave to amend a pleading under Rule 15 must be both served on the other parties to the action,^{4.1} and filed with the court.^{4.2} under Rule 5. If the movant is represented, e-filing is required, unless exempted for good cause or by local rule.^{4.3} If unrepresented, whether e-filing is available or required is governed by local rules and orders.^{4.4}

When e-filing is used, the motion is deemed to be simultaneously served on all other registered users of the court's system,^{4.5} so no separate service is required. These provisions therefore simplify the process of serving and filing a motion for leave to amend, because e-filing itself constitutes service. If, however, one of the other existing parties is both unrepresented and not a registered user of the court's e-filing system, separate service on that party is required under one of the other service methods of Rule 5(b).

Finally, it should be noted that although e-filing by represented parties is required, service through the court's system is not, so a pleader can separately serve a motion for leave to amend before it is e-filed with the court. Because the opposing party's written consent also permits amended pleadings (see [§ 15.14](#)), the pleader can serve the motion for leave and proposed pleading on the opposing party and request consent. If that request is granted, the amended pleading can be filed without court intervention. If it is denied, the pleader can e-file the motion with the court to formally seek leave.

[2] Court May Conditionally Grant Amendment

[Grand Junction, 868 F.2d 368, 371 \(10th Cir. 1989\)](#) (court refused to grant leave to amend based on plaintiff's "request to amend" after court had already ruled on motion to dismiss).

11th Circuit [Newton v. Florida, 895 F.3d 1270, 1277 \(11th Cir. 2018\)](#) (though requesting leave to amend in response to motion to dismiss is insufficient, if motion is granted and dismissal is ordered, request for leave to amend in **Fed. R. Civ. P. 59** or **Fed. R. Civ. P. 60** motion is sufficient, and plaintiff need not file separate motion devoted solely to leave to amend); [Dukes v. Deaton, 852 F.3d 1035, 1046 \(11th Cir. 2017\)](#) (plaintiff offered alternative argument too late, in improper attempt to use brief in opposition to summary judgment motion as method for amending complaint); [Rosenberg v. Gould, 554 F.3d 962, 967 \(11th Cir. 2009\)](#) (when plaintiffs requested leave to amend complaint in footnote to their brief in opposition to motion to dismiss, it was within discretion of district court to deny that request sub silentio); [Long v. Satz, 181 F.3d 1275, 1279–1280 \(11th Cir. 1999\)](#) (plaintiff did not file proper motion for leave to amend when request was included in her memorandum in opposition to motion to dismiss, and she failed to attach proposed amendment or set forth its substance); see also [AFSCME Council 79 v. Scott, 717 F.3d 851, 863 \(11th Cir. 2013\)](#) (at summary judgment stage, proper procedure for plaintiffs to assert new claim is to amend complaint in accordance with **Fed. R. Civ. P. 15(a)**; plaintiff may not amend complaint through argument in brief opposing summary judgment or advocating summary judgment).

D.C. Circuit [Hancock v. Urban Outfitters, Inc., 830 F.3d 511, 515 \(D.C. Cir. 2016\)](#) ("passing reference to amendment in a footnote in their opposition to the motion to dismiss" insufficient as a request to amend); [Whiting v. AARP, 637 F.3d 355, 365 \(D.C. Cir. 2011\)](#) (district court properly denied leave to amend that was requested in footnote in opposition to motion to dismiss, when footnote did not satisfy requirement that motion to amend must provide particular grounds on which amendment was sought); [Guam v. American Pres. Lines, 28 F.3d 142, 150–151 \(D.C. Cir. 1994\)](#) (presentation of issues during opposition to motion to dismiss inadequate to satisfy requirements of **Fed. R. Civ. P. 15(a)**); [Confederate Memorial Ass'n Inc. v. Hines, 995 F.2d 295, 299 \(D.C. Cir. 1993\)](#) (court should deny leave when bare request is made in opposition to motion to dismiss without any indication of grounds for amendment).

^{4.1} **Fed. R. Civ. P. 5(a)(1)(D)** (each "written motion" must be served on every party).

^{4.2} **Fed. R. Civ. P. 5(d)(1)(A)** ("Any paper after the complaint that is required to be served must be filed no later than a reasonable time after service.").

^{4.3} **Fed. R. Civ. P. 5(d)(3)(A)**.

^{4.4} **Fed. R. Civ. P. 5(d)(3)(B)**.

^{4.5} **Fed. R. Civ. P. 5(b)(2)(E)** (paper is served by "sending it to a registered user by filing it with the court's electronic-filing system").

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A court may conditionally grant an amendment when prejudice might otherwise result from granting leave. A court, at its discretion, may impose reasonable conditions when granting leave to amend.⁵ Granting conditional leave allows a court to prevent prejudice, and at the same time, to freely allow amendments in accordance with the spirit of Rule 15. In determining whether to impose any conditions, a court should consider the factors that affect a court's decision to grant leave (see [§ 15.15](#)).⁶

Rule 15 does not specify the types of conditions a court may impose. Costs are the most commonly imposed condition.⁷ A court may impose costs as a condition of granting leave to amend in order to compensate an opposing party for costs it incurred because of a faulty claim that was amended.⁸

⁵ Court may impose conditions.

2d Circuit [Van Buskirk v. United Grp. of Cos.](#), 935 F.3d 49, 56 (2d Cir. 2019) (district court may impose conditions for granting leave to amend, including compensating opposing party for expenses incurred because pleading was defective; remanding for district court to determine whether defect in diversity allegations could be cured by amendment, and whether to award costs or attorney's fees); [Polycast Tech. Corp. v. Uniroyal, Inc.](#), 728 F. Supp. 926, 939 (S.D.N.Y. 1989) (**Fed. R. Civ. P. 15** gives court authority to impose conditions when granting leave).

5th Circuit [Dussouy v. Gulf Coast Inv. Corp.](#), 660 F.2d 594, 599 (5th Cir. 1981) (court, at its discretion, may avoid any prejudice to defendant from additional discovery by imposing cost of additional discovery on plaintiff).

7th Circuit [Bibbs v. Newman](#), 997 F. Supp. 1174, 1177 (S.D. Ind. 1998) (plaintiff's motion to withdraw single count of complaint was deemed motion to amend and was granted on condition that count be dismissed with prejudice; condition imposed because plaintiff brought motion after defendants had moved for summary judgment).

9th Circuit [General Signal Corp. v. MCI Telecommunications Corp.](#), 66 F.3d 1500, 1514 (9th Cir. 1995) ("district court, in its discretion, may impose costs pursuant to Rule 15 as a condition of granting leave to amend in order to compensate the opposing party for additional costs incurred because the original pleading was faulty").

⁶ Court should look to limiting factors in determining conditions.

7th Circuit [Aida Eng'g Inc. v. Red Stag, Inc.](#), 629 F. Supp. 1121, 1128 (E.D. Wis. 1986) (citing **Moore's**, important factor in determining whether to deny leave is whether court can eliminate prejudice through conditionally granting leave).

9th Circuit [Int'l Ass'n of Machinists v. Republic Airlines](#), 761 F.2d 1386, 1390–1391 (9th Cir. 1985) (since no factors limiting court's discretion to amend were present, condition that plaintiff pay attorney's fees and costs as prerequisite to filing amended complaint was not reasonable).

10th Circuit [Mountain View Pharmacy v. Abbott Labs.](#), 630 F.2d 1383, 1386 (10th Cir. 1980) (while court may impose reasonable conditions, it abused its discretion when it required certification procedure to ensure that plaintiffs pleaded sufficient facts to constitute claim, which could have been accomplished directly by relying on **Fed. R. Civ. P. 8(a)**).

⁷ Costs as condition.

2d Circuit [Van Buskirk v. United Grp. of Cos.](#), 935 F.3d 49, 56 (2d Cir. 2019) (district court may impose conditions for granting leave to amend, including compensating opposing party for expenses incurred because pleading was defective; remanding for district court to determine whether defect in diversity allegations could be cured by amendment, and whether to award costs or attorney's fees); [Polycast Tech. Corp. v. Uniroyal, Inc.](#), 728 F. Supp. 926, 939, 944 (S.D.N.Y. 1989) (in order to cure any prejudice to parties, court required plaintiff to pay costs of any duplicative discovery incurred because of amendment).

8th Circuit [Popoalii v. Correctional Med. Servs.](#), 512 F.3d 488, 498 (8th Cir. 2008) (district court had discretion to require plaintiff to compensate opposing parties for any losses caused by granting motion to amend, and did not abuse its discretion in refusing to allow amendment when plaintiff declined offer to allow amendment with this condition).

9th Circuit [General Signal Corp. v. MCI Telecommunications Corp.](#), 66 F.3d 1500, 1514 (9th Cir. 1995) ("district court, in its discretion, may impose costs pursuant to Rule 15 as a condition of granting leave to amend in order to compensate the opposing party for additional costs incurred because the original pleading was faulty").

[3] Amended Pleading Supersedes Prior Pleading

An amended pleading that is complete in itself and does not reference or adopt any portion of the prior pleading supersedes the prior pleading.⁹ Nevertheless, the Second Circuit has held that the defendants were entitled to introduce the superseded original complaint into evidence and that the jury could examine it for purposes of comparing the original claims with the claims in the amended complaint.¹⁰ The rationale behind allowing the

⁸ Examples of conditions imposed.

2d Circuit See [Hayden v. Feldman](#), 159 F.R.D. 452, 454–455 (2d Cir. 1995) (listing cases that have imposed conditions before granting leave to amend and requiring amending plaintiff to pay defendant's attorney's fees and costs).

3d Circuit [Kronfeld v. First Jersey Nat'l Bank](#), 638 F. Supp. 1454, 1460 (D.N.J. 1986) (no significant prejudice to parties that have answered, but amendment was conditioned on compensating those defendants for costs incurred in responding to original complaint).

9th Circuit [General Signal Corp. v. MCI Telecomms. Corp.](#), 66 F.3d 1500, 1514 (9th Cir. 1995) (court imposed costs because new counterclaims were broader than scope of court order granting leave to amend, resulting in prejudice).

11th Circuit [O'Rear v. American Family Life Assurance Co.](#), 139 F.R.D. 418, 421 (M.D. Fla. 1991) (plaintiff allowed to re-amend if it paid costs when admitting that second amended complaint was inadequate).

⁹ Amended pleading supersedes original.

1st Circuit [ConnectU LLC v. Zuckenberg](#), 522 F.3d 82, 91 (1st Cir. 2008) (amended complaint, once filed, supersedes previous complaint, which becomes dead letter; amended complaint rather than original complaint was, therefore, basis for determining whether federal question jurisdiction existed).

4th Circuit [Fawzy v. Wauquiez Boats SNC](#), 873 F.3d 451 (4th Cir. 2017) (“properly filed amended complaint supersedes the original one and becomes the operative complaint in the case,” so dismissal that addresses superseded complaint only is interlocutory and not subject to appeal).

5th Circuit [Boelens v. Redman Homes, Inc.](#), 759 F.2d 504, 508 (5th Cir. 1985) (court must look to amended complaint in assessing federal question jurisdiction under general rule that amended complaint supersedes original and renders it of no legal effect unless amendment specifically refers to or adopts earlier pleading); see also [King v. Dogan](#), 31 F.3d 344, 346 (5th Cir. 1994) (plaintiff failed to meet summary judgment burden because second amended complaint was in effect and superseded original complaint; original complaint of no legal effect unless amended pleading incorporates by reference portions of previous pleading).

6th Circuit [Reynolds v. Ferguson](#), 73 F. Supp. 2d 841, 843 (W.D. Mich. 1999) (amended complaint that did not somehow incorporate original complaint waived all causes of action not asserted in amended complaint).

7th Circuit [Martin v. Tyson](#), 845 F.2d 1451, 1454 (7th Cir. 1988) (court should consider pro se plaintiff's claim on merits when amended complaint said enough to incorporate count by reference, and therefore, it survived amendment of complaint).

9th Circuit [Hal Roach Studios, Inc. v. Richard Feiner & Co.](#), 896 F.2d 1542, 1546 (9th Cir. 1990) (fact that party was named in original complaint is irrelevant since amended complaint supersedes original complaint); [King v. Atiyeh](#), 814 F.2d 565, 567 (9th Cir. 1987) (claims alleged in original and not in amendment are waived); cf. [Doe v. Unocal Corp.](#), 27 F. Supp. 2d 1174, 1180 (C.D. Cal. 1998), *aff'd on other grounds*, 248 F.3d 915 (9th Cir. 2001) (defendant was properly served with original complaint even though amended complaint had been filed, since original complaint is not superseded until amended complaint is actually served).

11th Circuit [Fritz v. Standard Sec. Life Ins. Co. of N.Y.](#), 676 F.2d 1356, 1358 (11th Cir. 1982) (court correctly awarded additional insurance payments when plaintiff's amended complaint including claim for additional payments superseded original complaint).

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original complaint into evidence was that a party should not advance one set of facts, and then determine that another version is better and amend accordingly in hopes that the trier of fact will never learn about the changed story. The appellate court allowed the jury to examine the original complaint because statements in the complaint constituted admissions. This ruling resulted from the rule that inconsistent prior pleadings should be made available for the jury's comparison.¹¹ However, in the more usual scenario, a court may permit a party amending a pleading to withdraw an admission contained in the original pleading.¹²

The rule that an amended pleading supersedes the prior pleading applies even if the district court lacks notice of the amendment. In one case, for example, the plaintiff filed an original complaint and obtained a writ of attachment over a vessel. To remove that encumbrance, the defendant immediately filed a motion to vacate the writ and dismiss for lack of jurisdiction. Two days after an expedited hearing on the defendant's motion, the district court dismissed, vacated the writ, denied sanctions, and closed the case. However, approximately one hour before the district court's order, the plaintiff filed an amended complaint adding new allegations and claims for relief. The plaintiff did not seek reconsideration of the dismissal, or otherwise inform the district court of the amended complaint, and instead simply appealed. The Fourth Circuit therefore held that it lacked appellate jurisdiction, because the district court's order addressed only the superseded complaint, not the operative complaint.^{12.1} The court of appeals specifically rejected the argument that the amended complaint could be ignored due to the plaintiff's failure to provide notice to the district court, noting that the amendment was made as a matter of course (see [§ 15.10](#)), so it immediately superseded the original and became the operative complaint.^{12.2}

Pleadings, motions, and other submissions to the court by pro se parties are to be liberally construed,^{12.3} so when a pro se plaintiff submits an amended complaint, but makes it clear that its only purpose is to add additional defendants, the failure to include defendants named in the superseded complaint should not be treated as abandonment of the claims against those preexisting defendants.^{12.4}

¹⁰ **Original complaint allowed into evidence.** [Andrews v. Metro N. Commuter R.R., 882 F.2d 705, 707 \(2d Cir. 1989\)](#) (abuse of discretion when court granted leave to amend to allege failure to maintain train platform as new reason for plaintiff's fall and then refused to permit jurors to be informed of amendment and to examine original complaint).

¹¹ **Inconsistent prior pleadings.** [United States v. GAF Corp., 928 F.2d 1253, 1260 \(2d Cir. 1991\)](#) (trial court erred in providing original bill of particulars to jury).

¹² **Withdraw admission.**

3d Circuit [West Run Student Hous. Assocs., LLC v. Huntington Nat'l Bank, 712 F.3d 165, 171–173 \(3d Cir. 2013\)](#) (“Even if Plaintiffs’ allegations in the original complaint constituted judicial admissions, it does not follow that they may not amend them. This Court and several of our sister courts have recognized that judicial admissions may be withdrawn by amendment Indeed, effectively disallowing amendment by looking to the original pleading is contrary to the liberal amendment policy embodied in Rule 15.”).

5th Circuit [Hibernia Nat'l Bank v. Carner, 997 F.2d 94, 101 \(5th Cir. 1993\)](#) (plaintiff “amended away admission” because original pleading containing judicial confession was superseded).

7th Circuit [188 LLC v. Trinity Indus., Inc., 300 F.3d 730, 736 \(7th Cir. 2002\)](#) (“When a party has amended a pleading, allegations and statements in earlier pleadings are not considered judicial admissions.”).

^{12.1} **Amended pleading supersedes original regardless of notice of amendment.** [Fawzy v. Wauquiez Boats SNC, 873 F.3d 451, 455 \(4th Cir. 2017\)](#).

^{12.2} **Notice by plaintiff not required.** [Fawzy v. Wauquiez Boats SNC, 873 F.3d 451, 455–456 \(4th Cir. 2017\)](#).

^{12.3} **Liberally construed.** *E.g.*, [Erickson v. Pardus, 551 U.S. 89, 94, 127 S. Ct. 2197, 167 L. Ed. 2d 1081 \(2007\)](#) (document filed pro se is to be liberally construed).

^{12.4} **Amended complaint filed by pro se party.** [Otis v. Demarasse, 886 F.3d 639, 644–645 \(7th Cir. 2018\)](#).

Although the general rule is that pleadings need not be verified, a federal rule or statute may provide otherwise.^{12.5} If an original complaint contains a required verification, any effect of that verification survives a later amended complaint that supersedes the original, so it is not necessary to also verify the amended complaint unless the particular federal rule or statute at issue expressly so requires.^{12.6}

Once leave has been granted and an amended pleading has superseded the prior one, the district court may, under certain circumstances, rescind leave and strike the amended pleading, which has the effect of restoring the superseded pleading as the operative pleading in the case. For example, as noted in § 15.15[1], judicial economy and case management concerns may inform the decision to grant leave to file an amended complaint. If the court later determines, however, that its initial assessment of those factors was erroneous and the amended complaint has unnecessarily complicated or expanded the scope of the litigation, it may rescind leave and restore the prior complaint. But if the court chooses to do so sua sponte, it must provide notice and give the parties an opportunity to be heard on this intended action.^{12.7}

[4] Plaintiff Not Required to Replead Dismissed Claims in Order to Preserve Issue for Appeal

Although an amended pleading supersedes the prior pleading (see [3], *above*), a plaintiff does not necessarily waive the right to appeal a ruling dismissing a claim merely because the plaintiff does not replead that claim in a later complaint. When the court conclusively dismisses a claim without leave to amend, the plaintiff may continue with the action and file an amended complaint as to other claims without waiving the right to appeal the dismissal. In this situation it would be pointless to require the plaintiff to replead the dismissed claim, and plaintiff's counsel would be forced to bear the risk of sanctions to preserve the client's right to appeal.¹³ By

^{12.5} See *Fed. R. Civ. P. 11(a)*.

^{12.6} **Verification of amended complaint not required.** *Barnes v. Sea Haw. Rafting, LLC*, 889 F.3d 517, 531–532 (9th Cir. 2018) (in rem jurisdiction over vessel attached on filing of initial verified complaint under Rule C(2)(A) of Supplemental Rules for Admiralty or Maritime Claims and Asset Forfeiture Actions, so district court erred in dismissing vessel due to failure to include verification in amended complaint; rule provided only that “the complaint” must be verified, and did not expressly require verifying amended pleadings).

^{12.7} **Rescinding leave sua sponte.** *Diece-Lisa Indus. v. Disney Enters.*, 943 F.3d 239, 253–254 (5th Cir. 2019) (when amended complaint added new claims and parties to action, sua sponte rescission of leave and restoration of prior complaint one year later and after conduct of discovery was abuse of discretion because it was effective dismissal of new claims and parties; when potentially dispositive motions as to new claims and parties were pending, district court erred in essentially avoiding decision of those motions by rescinding leave and striking amended complaint).

¹³ **Plaintiff does not waive right to appeal by filing amended complaint that omits claims dismissed without leave to amend.**

2d Circuit *Hancock v. Cty. of Rensselaer*, 882 F.3d 58, 63 (2d Cir. 2018) (“we do not require futile repleading of a claim that has been dismissed with prejudice,” so failure of amended complaint to reassert particular claim “does not amount to a waiver of that cause of action for purposes of appellate review”); *P. Stolz Family P’ship L.P. v. Daum*, 355 F.3d 92, 96 (2d Cir. 2004) (citing *Moore’s*, defendant was not required to replead dismissed claims in order to preserve right to appeal; formalistic requirement would serve no valid purpose, and plaintiff’s counsel would be forced to bear risk of sanctions to preserve client’s right to appeal).

4th Circuit *Young v. City of Mount Ranier*, 238 F.3d 567, 572–573 (4th Cir. 2001) (when district court dismissed claims without leave to amend, and plaintiffs then amended their complaint to delete those claims, they did not forfeit right to appeal dismissal, although they did waive any appeal of similar claims against other parties that had not been formally dismissed).

5th Circuit *Wilson v. First Houston Inv. Corp.*, 566 F.2d 1235, 1237–1238 (5th Cir. 1978), *vacated on other grounds*, 444 U.S. 959 (1979) (citing *Moore’s*, plaintiff did not waive objection to court’s dismissal without leave to amend when plaintiff filed amended complaint).

contrast, if the court dismisses a claim but allows leave to amend, and the plaintiff then voluntarily omits the claim from the amended complaint, the claim is abandoned and the plaintiff waives the right to appeal the dismissal.¹⁴

In some cases, an adverse ruling and resulting order requires some action by the plaintiff, and the district court states that dismissal will result from noncompliance, but the plaintiff then amends the complaint to drop the claim instead of complying. If the adverse ruling “struck a vital blow” to the dropped claim, the plaintiff’s decision to amend is considered involuntary; thus, amending does not waive the right to appeal the adverse ruling.^{14.1}

[5] Response to Amended Pleading Required Within Time to Respond to Original Pleading or 14 Days After Service of Amendment

Unless the court orders otherwise, a party must respond to an amended pleading within the time period remaining to respond to the original pleading, or within 14 days after service of the amended pleading, whichever is later.¹⁵ This provision is applicable, however, only if the party served with the amended pleading is required to plead in response.^{15.1} Even when a response is required in theory, courts rarely enforce the requirement for responses to amended pleadings. When an amended pleading does not add new parties, new claims, or significant new factual allegations, courts are often willing to allow the previously filed response to the original pleading to suffice.¹⁶ Even in those courts in which the failure to file a timely response to an amended pleading is considered to be at least a technical violation of Rule 15, the courts will rarely enforce a waiver as a result of this violation. Instead, so long as no other party is misled or prejudiced, courts will usually relieve a

7th Circuit [Scott v. Chuhak & Tecson, P.C., 725 F.3d 772, 782–783 \(7th Cir. 2013\)](#) (while an amended complaint supersedes original complaint, this supersession does not require party to replead in later complaints claims that court has rejected, in order to preserve those claims for appeal).

9th Circuit [Lacey v. Maricopa County, 693 F.3d 896, 928 \(9th Cir. 2012\)](#) (en banc) (“We therefore join our sister circuits and overrule in part the rule found in *Forsyth* and other cases that a plaintiff waives all claims alleged in a dismissed complaint which are not realleged in an amended complaint For claims dismissed with prejudice and without leave to amend, we will not require that they be repled in a subsequent amended complaint to preserve them for appeal. But for any claims voluntarily dismissed, we will consider those claims to be waived if not repled.”); see [Forsyth v. Humana, Inc., 114 F.3d 1467, 1474 \(9th Cir. 1997\)](#).

10th Circuit [Davis v. TXO Production Corp., 929 F.2d 1515, 1517–1518 \(10th Cir. 1991\)](#) (party is not required to reallege claim on which district court has conclusively ruled in order to preserve issue for appeal; requiring repleading would “set a trap for unsuspecting plaintiffs with no concomitant benefit to the opposing party”).

¹⁴ **When claim is dismissed with leave to amend, plaintiff waives right to appeal by failing to allege claim in amended complaint.** [Lacey v. Maricopa County, 693 F.3d 896, 928 \(9th Cir. 2012\)](#) (en banc) (“But for any claims voluntarily dismissed, we will consider those claims to be waived if not repled.”).

^{14.1} **Struck “vital blow” to claim.** [Acuity v. Rex, LLC, 929 F.3d 995, 999 \(8th Cir. 2019\)](#) (when order determined that interpleader jurisdiction required deposit of entire \$21 million dollar stake, and plaintiff amended complaint to drop interpleader claim and seek declaratory relief only, order requiring deposit was appealable; forcing plaintiff to stand on complaint and suffer dismissal to preserve issue for review simply sets “trap” for unwary, so involuntary amendment also preserves issue).

¹⁵ **Fed. R. Civ. P. 15(a)(3).**

^{15.1} See **Fed. R. Civ. P. 15(a)(3)** (“any required response to an amended pleading must be made . . .”) (emphasis added).

¹⁶ **Response to amended pleading not always required by courts.** See, e.g., [Stanley Works v. Snydergeneral Corp., 781 F. Supp. 659, 664–665 \(E.D. Cal. 1990\)](#) (court cites cases for proposition that “the option to file an Answer to a First Amended Complaint lies with the defendant”).

party of the technical waiver and permit the party to make whatever responsive pleading is required to the amended pleading at a later time.¹⁷

While courts do not always require a response to an amended pleading, a court may not deprive an affected party of the right to file a response to an amended pleading if the party so desires, particularly if the amended pleading adds a new claim or a new party. The Supreme Court has ruled that an amendment to the pleadings that somehow deprives an affected party of the right to be served with the amended pleading and to file a timely response to it does not comply with Rule 15 and amounts to a denial of due process as well.^{17.1}

The 14-day period for filing a response to an amended pleading runs from the date of service of the amended pleading.^{17.2}

[6] Standards for Allowing New or Omitted Counterclaim in Response to Amended Pleading Are Unsettled

A party served with an amended pleading has the duty and the right to “respond” to the amendment or to the changes in the amended pleading.¹⁸ Nonetheless, there has been a surprising amount of discussion among the courts concerning whether or in what circumstances a responding party must seek leave of court before including a counterclaim in that response.¹⁹ Resolution of the issue regarding whether a party may assert a compulsory counterclaim as a matter of right under the varying approaches depends on (1) whether the counterclaim is one that should have been asserted in response to the original pleading,²⁰ (2) whether the amended complaint changes the scope or theory of the case, and (3) whether the counterclaim is truly a proper response to the amended pleading, itself unduly expands the scope of litigation, or surprises or prejudices the plaintiff. Until 2009, there was an ambiguity in the rules themselves. Rule 13 formerly included a provision specifically addressing the amendment of pleadings to include counterclaims. That provision, Rule 13(f), abrogated in 2009, stated:²¹

¹⁷ **Courts regularly relieve failure to timely respond to amended pleading.** See, e.g., [Martschinske v. Olympic Styles, Inc., 628 F. Supp. 231, 242 \(D.S.D. 1984\)](#), *aff'd without published op.*, [774 F.2d 1172 \(8th Cir. 1985\)](#) (there was technical violation of **Fed. R. Civ. P. 15(a)** by failure to timely respond to amended complaint, but court granted trial motion to refile original answer and counterclaim as response to amended complaint).

^{17.1} **Affected parties must be given right to file timely response to amended pleading.** [Nelson v. Adams USA, Inc., 529 U.S. 460, 466, 120 S. Ct. 1579, 146 L. Ed. 2d 530 \(2000\)](#) (“Nelson was never served with an amended pleading. ... Nor, after the amendment naming him as a party, was Nelson accorded 10 days to state his defenses Accordingly, the proceedings did not comply with Rule 15, and neither did they comport with due process”).

^{17.2} **Response period runs from service.** **Fed. R. Civ. P. 15(a)(3)** (“any required response to an amended pleading must be made ... within 10 days after *service* of the amended pleading”) (emphasis added); see [Nelson v. Adams USA, Inc., 529 U.S. 460, 467, 120 S. Ct. 1579, 146 L. Ed. 2d 530 \(2000\)](#) (“as Rule 15 further prescribes, the clock on an added party’s time to respond does not start running until the new pleading naming that party is served”).

¹⁸ See **Fed. R. Civ. P. 15(a)(3)**.

¹⁹ **Courts take different approaches.**

1st Circuit See B2 [Opportunity Fund, LLC v. Trabelsi, 2017 U.S. Dist. LEXIS 100858, at *6 \(D. Mass. June 29, 2017\)](#) (“issue is rather surprisingly up in the air”); [Bern Unlimited, Inc. v. Burton Corp., 25 F. Supp. 3d 170, 177–179 \(D. Mass. 2014\)](#).

4th Circuit See [Va. Innovation Scis. Inc. v. Samsung Elecs. Co., 11 F. Supp. 3d 622, 629–633 \(E.D. Va. 2014\)](#).

5th Circuit See [Travelers Cas. & Sur. Co. of Am. v. Hub Mech. Contrs., Inc., 2015 U.S. Dist. LEXIS 64567, at *6–*7 \(S.D. Miss., May 18, 2015\)](#).

²⁰ See **Fed. R. Civ. P. 13(a), (b)**.

²¹ See former **Fed. R. Civ. P. 13(f)**.

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(f) OMITTED COUNTERCLAIM. The court may permit a party to amend a pleading to add a counterclaim if it was omitted through oversight, inadvertence, or excusable neglect or if justice so requires.

The Rules Advisory Committee has noted that this language was “potentially misleading” because it could be read to improperly suggest that general Rule 15 amendment standards were inapplicable to amendments adding certain counterclaims.²²

It would seem that the abrogation of Rule 13(f) would solve the problem: Rule 15 provides the standard for asserting compulsory counterclaims in response to an amended complaint. Historically, however, there have been three approaches to the question of when a counterclaim may be included with the answer to the amended complaint: the narrow approach, the moderate approach, and the permissive approach.²³ More recently, another approach that may be labeled the “*Bern*” approach after a case that suggested it, has emerged.²⁴ Though cases addressing this issue are typically district court decisions, the Second Circuit has recognized the potential applicability of each of these four approaches, but declined to decide which, if any, is correct.^{24.1}

The narrow approach, now largely considered irrelevant given its connection to abrogated Rule 13(f), provided that an amended answer had to be tailored specifically to address the amendments in the complaint. A party lacked the right it otherwise would have had to assert counterclaims in its original answer.²⁵ Under the

²² **Former rule was misleading.** See *Fed. R. Civ. P. 13*, advisory committee note of 2009 (reprinted at § 13App.07) (“Rule 13(f) is deleted as largely redundant and potentially misleading. An amendment to add a counterclaim will be governed by Rule 15. Rule 15(a)(1) permits some amendments to be made as a matter of course or with the opposing party’s written consent. When the court’s leave is required, the reasons described in Rule 13(f) for permitting amendment of a pleading to add an omitted counterclaim sound different from the general amendment standard in Rule 15(a)(2), but seem to be administered—as they should be—according to the same standard directing that leave should be freely given when justice so requires.”); see also B2 [Opportunity Fund, LLC v. Trabelsi, 2017 U.S. Dist. LEXIS 100858, at *6 \(D. Mass. June 29, 2017\)](#) (Rule 13(f) was eliminated in 2009 “because of a lack of clarity about the relationship between Rule 13(f) and Rule 15.”).

²³ **Three historical approaches.**

1st Circuit See [Bern Unlimited, Inc. v. Burton Corp., 25 F. Supp. 3d 170, 177–179 \(D. Mass. 2014\)](#) (detailing different approaches);

2d Circuit See [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 100 n.12 \(2d Cir. 2019\)](#) (citing **Moore’s**; when new counterclaims are asserted in amended answer that responds to amended complaint, several approaches have been identified, including: (1) “narrow” approach: requires counterclaim to be tailored specifically to address amendments to complaint only; (2) “permissive” approach: permits all new counterclaims; (3) “moderate” approach: excuses leave of court if amended complaint changes theory or scope of case).

4th Circuit See [Va. Innovation Scis. Inc. v. Samsung Elecs. Co., 11 F. Supp. 3d 622, 629–633 \(E.D. Va. 2014\)](#) (summarizing positions).

9th Circuit See [UDAP Indus. v. Bushwacker Backpack & Supply Co., 2017 U.S. Dist. LEXIS 66803, at *6–*7 \(D. Mont. May 2, 2017\)](#), dismissed per stipulation, [2017 U.S. Dist. LEXIS 108896 \(D. Mont. July 13, 2017\)](#).

²⁴ **Bern approach.** [Bern Unlimited, Inc. v. Burton Corp., 25 F. Supp. 3d 170, 178–179 \(D. Mass. 2014\)](#).

^{24.1} **Four approaches recognized.** [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 100 n.12 \(2d Cir. 2019\)](#) (citing **Moore’s**).

²⁵ **Former narrow approach explained.**

4th Circuit See [Va. Innovation Scis. Inc. v. Samsung Elecs. Co., 11 F. Supp. 3d 622, 630 \(E.D. Va. Mar. 31, 2014\)](#).

9th Circuit See [UDAP Indus. v. Bushwacker Backpack & Supply Co., 2017 U.S. Dist. LEXIS 66803, at *6 \(D. Mont. May 2, 2017\)](#), dismissed per stipulation, [2017 U.S. Dist. LEXIS 108896 \(D. Mont. July 13, 2017\)](#); see also [Sierra Dev. Co. v. Chartwell](#)

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permissive approach, on the other hand, once the plaintiff amends a complaint, the case is deemed to be essentially reset. The defendant may include counterclaims in the answer without leave of court, regardless of the nature of the amended complaint and the previous history of the litigation.²⁶ The permissive approach has been criticized as inconsistent with the abrogation of Rule 13(f), and because it deprives the court of its ability to manage the litigation by rejecting amendments that do not meet the standards of Rule 15.²⁷ The moderate approach allows the responding party to include counterclaims without seeking permission if the amended complaint changes the theory or scope of the case. The counterclaims that may be asserted without leave of court, however, must be those that respond to new allegations in the amended complaint. The breadth of permissible changes in the amended response is determined by the breadth of the changes in the amended complaint.²⁸

The moderate approach has represented the majority position.²⁹ There is, however, an emerging approach that rejects all the historical approaches—articulated by the Massachusetts District Court's *Bern* opinion.³⁰ The court

[Advisory Grp. Ltd., 2016 U.S. Dist. LEXIS 160308, at *11 \(D. Nev. Nov. 18, 2016\)](#) (abrogation of Rule 13(f) undermined supporting case law); [UPEK Inc. v. Authentec, Inc., 2010 U.S. Dist. LEXIS 76807, at *6–*7 \(N.D. Ca. July 6, 2010\)](#) (approach superseded by rule changes).

²⁶ **Permissive approach explained.** [UDAP Indus. v. Bushwacker Backpack & Supply Co., 2017 U.S. Dist. LEXIS 66803, at *6 \(D. Mont. May 2, 2017\)](#), dismissed per stipulation, [2017 U.S. Dist. LEXIS 108896 \(D. Mont. July 13, 2017\)](#); see also [Coppola v. Smith, 2015 U.S. Dist. LEXIS 59440, at *8–*9 \(E.D. Ca. May 6, 2015\)](#) (philosophy underlying permissive approach is that plaintiffs amend complaints “at their peril,” and essentially give responding parties a blank slate on which to respond; quoting [S. England Tel. Co. v. Global NAPS, Inc., 2007 U.S. Dist. LEXIS 10421, at *6 \(D. Conn. Feb. 14, 2007\)](#)).

²⁷ **Permissive approach criticized.**

1st Circuit See, e.g., [Bern Unlimited, Inc. v. Burton Corp., 25 F. Supp. 3d 170, 178–179 \(D. Mass. 2014\)](#) (approach violated spirit of Rule 15).

4th Circuit See, e.g., [Va. Innovation Scis, Inc. v. Samsung Elecs. Co. 11 F. Supp. 3d 622, 632 \(E.D. Va. 2014\)](#) (permissive approach is not the most appropriate one).

9th Circuit See, e.g., [Sierra Dev. Co. v. Chartwell Advisory Grp. Ltd., 2016 U.S. Dist. LEXIS 160308](#), at *12 (D. Nev. Nov. 18, 2016).

²⁸ **Moderate approach explained.**

1st Circuit [Bern Unlimited, Inc. v. Burton Corp., 25 F. Supp. 3d 170, 179 \(D. Mass. 2014\)](#).

4th Circuit [Va. Innovation Scis, Inc. v. Samsung Elecs. Co. 11 F. Supp. 3d 622, 632–633 \(E.D. Va. 2014\)](#) (citing Moore's); [Elite Entm't, Inc. v. Khela Bros. Entm't, 227 F.R.D. 444, 446–447 \(E.D. Va. 2005\)](#).

8th Circuit See, e.g., [Tralon Corp. v. Cedarapids, Inc., 966 F. Supp. 812, 832 \(N.D. Iowa 1997\)](#), *aff'd without opinion*, **205 F.3d 1347 (8th Cir. 2000)** (defendant permitted to add new counterclaim without leave of court when plaintiff filed second amended complaint that greatly expanded both factual allegations against defendant and scope of plaintiff's claims); see also [Buffalo Wild Wings, Inc. v. Buffalo Wings & Rings, LLC, 2011 U.S. Dist. LEXIS 63925, at *12 \(D. Minn. Mar. 21, 2011\)](#) (“Under this rule, there is no requirement that a defendant specifically tailor its answer to the amended complaint, rather the court considers whether the defendant's answer affects the scope of the litigation in a manner proportional with the amended complaint.”).

9th Circuit [UDAP Indus. v. Bushwacker Backpack & Supply Co., 2017 U.S. Dist. LEXIS 66803, at *6–*7 \(D. Mont. May 2, 2017\)](#), dismissed per stipulation, [2017 U.S. Dist. LEXIS 108896 \(D. Mont. July 13, 2017\)](#).

²⁹ **Moderate view favored.**

1st Circuit See [Patel v. Pandya, 2016 U.S. Dist. LEXIS 71710, at *6 \(D.N.J. June 2, 2016\)](#); [Coppola v. Smith, 2015 U.S. Dist. LEXIS 59440, at *10 \(E.D. Ca. May 6, 2015\)](#).

concluded that neither the permissive nor moderate approach was entirely satisfactory. It joined the critique of the permissive approach as violating both the spirit and purpose of Rule 15. It further found the moderate approach, on the other hand, required a court to deal with the “potentially difficult question” of whether the asserted counterclaim actually responds to the amended complaint.³¹ The *Bern* opinion did not attempt to fit the case before it into one of the traditional categories of analysis. It suggested, instead, that courts facing such issues simply apply normal Rule 15(a) standards, in all their flexibility, to both amended complaints and amended or new counterclaims. Concluding that counterclaims before it were governed by the permissive amendment standards of Rule 15(a)(2), the court determined that leave of court should have been sought before they were filed. In view of the unsettled nature of the law, however, the court treated the counterclaims as requests to amend. It ultimately allowed certain of the counterclaims, and struck others on various grounds.³² Some courts have recognized the *Bern* standard as the most appealing one.³³ Others continue to apply the moderate standard.³⁴

The *Bern* approach has the advantage of eliminating a special rule for asserting counterclaims in response to amended complaints. Moreover, it is consistent with the Civil Rules Advisory Committee’s goal in 2009 of seeking to ensure that Rule 15 govern all amendments. In many cases, given the liberal amendment standard that Rule 15 embodies, the *Bern* and the moderate approaches will yield similar results. However, courts ought to adopt the *Bern* approach to ensure analytical coherency and eliminate the possibility of further “surprisingly” inconsistent results.

In the only apparent published court of appeals case addressing this issue, the Second Circuit mentioned each of these four potential approaches, but did not expressly adopt any of them.³⁵ Instead, the court concluded that the issues of whether leave is required and whether to grant it both turn on how far into the litigation the new

4th Circuit [Va. Innovation Scis. Inc. v. Samsung Elecs. Co.](#), 11 F. Supp. 3d 622, 630, 632–633 (E.D. Va. Mar. 31, 2014); [Elite Entm’t, Inc. v. Khela Bros. Entm’t](#), 227 F.R.D. 444, 446–447 (E.D. Va. 2005) (“Not only is this moderate approach predominant in the caselaw, ... the requirement that an amended response reflect the change in theory or scope of the amended complaint is consistent with Rule 15’s requirement that an amended pleading must ‘plead in response’ to the amended pleading.”).

³⁰ **Bern citation.** [Bern Unlimited, Inc. v. Burton Corp.](#), 25 F. Supp. 3d 170 (D. Mass. 2014).

³¹ **Historical approaches not satisfactory.** [Bern Unlimited, Inc. v. Burton Corp.](#), 25 F. Supp. 3d 170, 178–179 (D. Mass. 2014)

³² **Bern approach explained.** [Bern Unlimited, Inc. v. Burton Corp.](#), 25 F. Supp. 3d 170, 178–180, 186 (D. Mass. 2014).

³³ **Courts supporting Bern approach.** See, e.g., [Lawlis v. Moore Iron & Steele](#), 2014 U.S. Dist. LEXIS 178308, at * (W.D. Okla. Dec. 30, 2014) (*Bern* approach most appropriate); [Digital Ally, Inc. v. Dragoneye Tech., LLC](#), 2014 U.S. Dist. LEXIS 85586, at *11 (D. Kan. June 24, 2014) (“The Court here finds the approach set forth in *Bern Unlimited*—applying the Rule 15 standard equally to amended complaints and amended counterclaims—superior to the other approaches. This approach, unlike the permissive, narrow or moderate approaches, provides for the consistent application of the Rule 15 standard for amendment of pleadings that assert ‘a claim for relief,’ such as a complaint and counterclaim.”).

³⁴ **Moderate approach still preferred by many courts.**

3d Circuit [Patel v. Pandya](#), 2016 U.S. Dist. LEXIS 71710, at *6 (D.N.J. June 2, 2016) (Third Circuit courts favor moderate approach).

9th Circuit See, e.g. [UDAP Indus. v. Bushwacker Backpack & Supply Co.](#), 2017 U.S. Dist. LEXIS 66803, at *7 (D. Mont. May 2, 2017), dismissed per stipulation, [2017 U.S. Dist. LEXIS 108896](#) (D. Mont. July 13, 2017) (district courts within Ninth Circuit continue to apply moderate approach).

Fed. Circuit [King v. United States](#), 2014 U.S. Claims LEXIS 656, at *5 (Fed. Cl. July 17, 2014) (adopting moderate approach rather than *Bern* approach.).

³⁵ **Four approaches recognized.** [GEOMC Co. v. Calmare Therapeutics Inc.](#), 918 F.3d 92, 100 n.12 (2d Cir. 2019) (citing Moore’s).

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counterclaim is asserted.³⁶ When a new counterclaim in an amended answer is presented at an early stage, it may normally be as broad as those filed in response to an original complaint. At a late stage, however, a new counterclaim that raises issues beyond the scope of the new claims made in the most recent amended complaint will usually (1) result in prejudice and (2) unduly expand the litigation. For these reasons, the court concluded that “a new counterclaim should normally not be permitted if it exceeds the scope of the plaintiff’s new claims.”³⁷ Although the court did not so state, its decision appears to reject the *Bern* approach because it requires the court to consider whether the new counterclaim responds to the new claims in the amended complaint, or instead addresses claims that were already made in the superseded complaint.³⁸

The Second Circuit decision had an additional complicating factor. When the district court granted leave to file the amended complaint, it also expressly preauthorized the defendant to file an amended answer, subject to the plaintiff’s opportunity to move to strike any counterclaims that went beyond the scope of the amendments. As the court of appeals noted, this was procedurally improper, because a Rule 12(f) motion to strike is confined to excising particular allegations or materials from pleadings, and is not a basis for dismissal of claims in their entirety.³⁹ Nevertheless, the disposition was affirmed because striking the counterclaims was the “functional equivalent” of denying leave to assert them in the amended answer.⁴⁰ In effect, the district court initially granted leave to amend the answer, but then retroactively revoked that leave and struck the counterclaims because they exceeded the scope of the new claims in the amended complaint.

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³⁶ **Turns on stage of litigation.** [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 100 \(2d Cir. 2019\).](#)

³⁷ **Normally not permitted.** [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 100 \(2d Cir. 2019\).](#)

³⁸ **Responds to new claims only.** [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 102 \(2d Cir. 2019\)](#) (“Because the second amended complaint, filed late in the litigation, added only a claim for breach of contract, the new counterclaims were properly tested in relation only to that claim”; district court properly rejected counterclaims that would have prejudicially expanded litigation).

³⁹ **Not to dismiss entirety of claim.** [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 101–102 \(2d Cir. 2019\)](#) (citing **Moore’s**; “use of a Rule 12(f) motion to strike ... counterclaims (as distinguished from striking matter in them) was procedurally improper”).

⁴⁰ **Functional equivalent.** [GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 102 \(2d Cir. 2019\).](#)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing was served upon by electronic mail on the 10th day of May, 2021, upon,

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