

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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nmt/JMM

July 28, 2021

Opposition No. 91268387

Trademark Holdings SRL

v.

AiYaRa, LLC

Jill M. McCormack, Interlocutory Attorney:

On March 25, 2021, Opposer filed its notice of opposition. (1 TTABVUE). On May 5, 2021, Applicant filed a motion to dismiss for failure to state a claim upon which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6). (4 TTABVUE). On June 16, 2021, after multiple consented extensions of time to respond to the motion to dismiss, Opposer filed a proposed amended notice of opposition. (12 TTABVUE). On June 30, 2021, Applicant filed a motion to dismiss the proposed amended notice of opposition pursuant to Fed. R. Civ. P. 12(b)(6). (13 TTABVUE).

As an initial matter, Opposer's proposed amended notice of opposition does not include proof of service on Applicant. Trademark Rule 2.119(a), 37 C.F.R. § 2.119(a), states that every submission filed in an inter partes proceeding must be served upon the other party or parties, and proof of such service must be made before the submission will be considered. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 113.02 (2021). The Board informed the parties of the rules

governing service and the service requirement in the notice of institution. (2 TTABVUE 2). Trademark Rule 2.119(b), 37 C.F.R. § 2.119(b), sets forth the manner of service. *See also* TBMP § 113.04.

Because Applicant filed a response to Opposer's proposed amended pleading, and to avoid further delay in this proceeding, the Board exercises its discretion to consider the filing.¹ However, strict compliance is required in all future submissions filed with the Board. The Board may decline to read or consider any future submission filed by Opposer in this proceeding which does not include proof of service.

Pursuant to Fed. R. Civ. P. 15(a)(1), made applicable to Board proceedings by Trademark Rule 2.116(a), a party may amend its pleading once as a matter of course within 21 days after serving it, or if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Fed. R. Civ. P. 12(b), (e) or (f), whichever is earlier. *See* Trademark Rule 2.107. Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board.

Opposer's June 16, 2021 amended notice of opposition was filed more than 21 days after service of Applicant's May 5, 2021 motion to dismiss. As a result, the amended pleading was not filed as a matter of course, and the Board construes Opposer's submission to include a motion for leave to amend its notice of opposition. Nevertheless, because leave to amend is freely given when justice so requires, Opposer's construed motion for leave to amend its notice of opposition is **GRANTED**,

¹ A copy of the filing can be viewed using TTABVUE at <http://ttabvue.uspto.gov>.

and the amended notice of opposition, 12 TTABVUE, is accepted as Opposer's operative pleading.²

As noted above, on June 30, 2021, Applicant filed a motion to dismiss Opposer's amended notice of opposition. (13 TTABVUE). Opposer is allowed **TWENTY (20) DAYS** from the date of this order to file its response thereto, failing which the motion to dismiss may be granted as conceded. *See* Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a). Applicant's reply, if any, must be filed in accordance with Trademark Rule 2.127(a).

Proceedings otherwise remain **SUSPENDED** pending disposition of Applicant's motion to dismiss.³

² Fed. R. Civ. P. 15(a) encourages the Board to look favorably on motions to amend pleadings, stating that 'leave shall be freely given when justice so requires.'" *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016); *see* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.02 (2021). As a result, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amended pleading would be prejudicial to the rights of the adverse party, would violate settled law, or would serve no useful purpose. *See* Fed. R. Civ. P. 15(a)(2); *see also, e.g., Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010); *Polaris Indus. v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703 (TTAB 2000).

³ Opposer's unopposed motions to extend time to respond to Applicant's motion to dismiss, (14, 15 TTABVUE), are denied as moot.