**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
**P.O. Box 1451**
**Alexandria, VA 22313-1451**
General Contact No.: 571-272-8500
General Email: TTABInfo@uspto.gov

wbc

Mailed: February 25, 2022

Opposition No. 91270193

*TF Intellectual Property Pty Ltd*

*v.*

*Kenneth Thomas*

**Wendy Boldt Cohen, Interlocutory Attorney:**

This case comes before the Board on Applicant's motion to amend its answer. *See* 5 TTABVUE. The motion is contested by Opposer.[1]

**Motion to Amend**

Applicant's motion is predicated on allegations that Applicant seeks to amend its answer "[a]t the request of opposing counsel." 5 TTABVUE 2. Opposer asserts that it "wrote to Applicant regarding the Answer's deficiencies, including the unnecessary general denials, improper request for costs and expenses, and improper affirmative defenses"; and now seeks to have Applicant's affirmative defense and general denial stricken from the answer

[1] The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and does not recount the facts or arguments here, except as necessary to explain the Board's order. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015).

arguing that the matter is either improper or duplicative and unnecessary.[2] 6 TTABVUE 2-3.

Leave to amend pleadings must be freely given when justice so requires, unless entry of the proposed amendment would violate settled law, would be prejudicial to the rights of the adverse party, or would be futile. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02 (2021). The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See, e.g., Commodore Elec. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993); *United States Olympic Comm. v. 0-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993). The timing of the motion for leave to amend plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. *See, e.g., United States Olympic Comm.,* 26 USPQ2d at 1222 (applicant not prejudiced because proceeding still in pre-trial phase)*; Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had yet taken testimony); *Mack Trucks,*

[2] Applicant has not responded to Opposer's motion to strike. Nonetheless, the Board, in its discretion, does not treat the motion as conceded and considers the motion on its merits. *See, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003); *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1599 (TTAB 2002).

*Inc. v. Monroe Auto Equip. Co.*, 182 USPQ 511, 512 (TTAB 1974) (applicant would not be unduly prejudiced since no testimony has yet been taken); TBMP § 507.02(a).

The Board finds no evidence of undue delay by Applicant in filing its motion to amend its pleading. The concept of "undue delay" is inextricably linked with the concept of prejudice to the non-moving party. *See Marshall Field & Co. v. Mrs. Field Cookies,* 11 USPQ2d 1355, 1359 (TTAB 1989). It appears unlikely that Opposer will be prejudiced by allowance of the amendment. Discovery is ongoing and trial has not yet begun. *See Focus 21 Int'l Inc.*, 22 USPQ2d at 1318; TBMP § 507.02(a). Further, the Board is not persuaded that there is bad faith or dilatory motive on the part of Applicant and this is the first time Applicant has sought to amend its pleading. *See American Exp. Mktg. & Dev. Corp. v. Gilad,* 94 USPQ2d 1294, 1297 (TTAB 2010) (finding no abuse of amendment privileges where applicant sought to amend its pleading for the first time).

In view thereof, Applicant's motion to amend its answer is **granted**. The amended answer found at 5 TTABVUE is hereby considered Applicant's operative pleading.

**Motion to Strike**

Opposer argues that Applicant's affirmative defense and general denial should be stricken. In view thereof, the Board now considers the sufficiency of Applicant's affirmative defense and general denial.

Affirmative Defense

Applicant's "affirmative defense" asserts that the parties' marks and services are dissimilar and unrelated. 5 TTABVUE 2. These assertions go to the merits of Opposer's likelihood of confusion claim rather than raising an affirmative defense. A defendant should not argue the merits of the allegations in a complaint in its answer. *See* Trademark Rule 2.106(b)(1); TBMP § 311.02(a). Notwithstanding the foregoing, because these assertions give Opposer a more complete picture of Applicant's position, the Board considers these assertions as amplifications of Applicant's denials. *See* 5 TTABVUE 2; *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); *Harsco Corp. v. Elec. Sciences, Inc.*, 9 USPQ2d 1570 (TTAB 1988).

In view thereof, Opposer's motion to strike this matter is **denied**.

General Denial

Applicant's section entitled "General Denial," asserts that "Applicant denies each and every allegation and claim set forth in Opposer's Notice of Opposition that otherwise is not specifically admitted in this Answer"; and that Applicant reserves the right to amend its answer. 5 TTABVUE 4.

With respect to Applicant's general denial, such a denial is unnecessary inasmuch as Applicant has already submitted specific admissions and denials in its answer. Further, to the extent Applicant seeks to reserve the right to amend it answer, this merely paraphrases Fed. R. Civ. P. 15. Should Applicant

seek to assert any other affirmative defenses, it must do so according to the rules.[3]

Notwithstanding, motions to strike are not favored, and matter usually will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Elec. Sci. Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). Here, the Board is not persuaded that the general denial clearly have no bearing upon the issues in this case.

In view thereof, the motion to strike this matter from the answer is **denied**.

**Dates**

Proceedings are resumed and dates are reset as follows:[4]

| | |
|---|---|
| Expert Disclosures Due | May 26, 2022 |
| Discovery Closes | June 25, 2022 |
| Plaintiff's Pretrial Disclosures Due | August 9, 2022 |
| Plaintiff's 30-day Trial Period Ends | September 23, 2022 |
| Defendant's Pretrial Disclosures Due | October 8, 2022 |
| Defendant's 30-day Trial Period Ends | November 22, 2022 |
| Plaintiff's Rebuttal Disclosures Due | December 7, 2022 |
| Plaintiff's 15-day Rebuttal Period Ends | January 6, 2023 |
| | |
| BRIEFS SHALL BE DUE AS FOLLOWS: | |
| Plaintiff's Main Brief Due | March 7, 2023 |

[3] "The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02 and cases cited therein.

[4] To the extent discovery requests were served prior to suspension of this proceeding and remain outstanding, the responding party shall have **thirty days** from the date of this order to serve its responses thereto. This allowance of time to respond to outstanding discovery is not an order from the Board compelling responses but is merely an allowance of time to respond because this proceeding was suspended pending disposition of the motion to amend.

| | |
|---|---|
| Defendant's Main Brief Due | April 6, 2023 |
| Plaintiff's Reply Brief Due | April 21, 2023 |

**General Information**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).