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

Proceeding no.	91274910
Party	Plaintiff Brink Biologics, Inc.
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Date	02/13/2023
Attachments	BRINK-1-OPP Motion for Leave.pdf(131915 bytes)

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

In the matter of:

Application Serial No. : 90/642,875
Mark : NOVOPANEL
Application Date : April 13, 2021
Publication Date : November 9, 2021

Application Serial No. : Agilent Technologies, Inc.
Serial No. : 90/842,567
Mark : NOVOPANEL
Applicant Date : July 22, 2021
Publication Date : November 9, 2021

BRINK BIOLOGICS, INC.)
)
 Opposer,)
)
 v.) Opposition No. 91274910
)
AGILENT TECHNOLOGIES, INC.)
)
 Applicant.)
_____)

**OPPOSER’S MOTION FOR LEAVE TO AMEND THE FIRST AMENDED COMBINED
NOTICE OF OPPOSITION**

Pursuant to Rule 15(a)(2) of the Federal Rules of Civil Procedure, Opposer Brink Biologics, Inc. (“Opposer”) hereby moves for an order granting Opposer leave to file the Second Amended Combined Notice of Opposition (“Second Amended Notice”).

I. PROCEDURAL BACKGROUND

Opposer filed a Notice of Opposition (Dkt. 1) opposing registration of Agilent Technologies Inc.’s (“Application”) U.S. Application Serial Nos. 90/642,875 and 90/842,567 for the mark NOVOPANEL (“Applicant’s Mark”). Opposer owns U.S. Registration No. 4,187,822 (“Opposer’s Registration”) for the mark NEUKOPANEL (“Opposer’s Mark”). In the Notice of Opposition, Opposer set forth that it would be damaged by the issuance of a registration of

Applicant's Mark due to likelihood of confusion between Opposer's Mark and Applicant's Mark, dilution by tarnishment, and dilution by blurring.

In response, Applicant filed a Motion to Dismiss and For a More Definite Statement ("Motion to Dismiss") (Dkt. 16) on December 12, 2022, in which Applicant asserted that (1) Opposer failed to plead a legally sufficient claim of dilution by tarnishment and (2) the description of the goods and services provided in the Notice of Opposition were too vague for Applicant to effectively respond.

Opposer filed a Response to Applicant's Motion to Dismiss and For a More Definite Statement ("Response") (Dkt. 19) on January 3, 2023. On the same day, Opposer also filed a First Amended Combined Notice of Opposition (Dkt. 18), which provided additional, specific facts related to the dilution by tarnishment claim and rectified any alleged ambiguity in the original Notice of Opposition ("First Amended Notice") so that Applicant would be able to "fully answer the allegation in good faith" (Motion to Dismiss, p. 4). On the same day, the Board issued an order suspending all proceedings upon disposition of Applicant's Motion to Dismiss.

Prior to the Board's decision on the Motion to Dismiss, Applicant filed a Second Motion to Dismiss and to Strike Opposer's First Amended Combined Notice of Opposition ("Second Motion to Dismiss") (Dkt. 20) on January 23, 2023. In the Second Motion to Dismiss, Applicant asserted that (1) Opposer failed to plead a legally sufficient claim of dilution by tarnishment and (2) portions of the First Amended Notice failed to comply with Fed. R. Civ. P. 10(b) and TBMP § 309.03. In response, Opposer files contemporaneously herewith a Second Amended Combined Notice of Opposition ("Second Amended Notice"), and the present Motion for Leave to Amend the First Amended Combined Notice of Opposition.

II. ARGUMENT

Trademark Rule 2.115, 37 C.F.R. § 2.107, and Fed. R. Civ. P. 15(2) encourage the Board to look favorably on motions to amend pleadings, stating that "leave shall be freely given when justice so requires." *See Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 U.S.P.Q.2d 1518, 1523 (TTAB 2016). In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 U.S.P.Q.2d 1298, 1300 (TTAB 2012).

A. No Undue Delay or Prejudice to Applicant.

There has been no undue delay by Opposer in amending the First Amended Notice because all deadlines in the opposition have been suspended pending outcome of Applicant's Motions. In lieu of filing a response to the Second Motion to Dismiss, Opposer is filing the present motion and the Second Amended Combined Notice of Opposition within the period in which Opposer is required to respond to the Second Motion to Dismiss. Furthermore, this amendment is being filed early in the proceedings. The Board routinely grants such motions for leave to amend the Notice in the "pre-trial phase" of the opposition proceedings. *See, e.g., United States Olympic Comm. V. O-M Bread Inc.*, 26 U.S.P.Q. 1221, 1223 (TTAB 1993) (granting opposer's motion to amend and explaining that applicant would not be prejudiced). Therefore, providing leave to amend the First Amended Notice would not create any delay at all and certainly not undue delay.

The concept of "undue delay" is inextricably linked with that of prejudice to the nonmoving party. *See Marshall Field & Co. v. Mrs. Field Cookies*, 11 U.S.P.Q.2d 1355, 1359 (TTAB 1989). There is no conceivable prejudice to Applicant in allowing Opposer to amend its First Amended Notice because the proposed amendments are made in direct response to Applicant's Second Motion to Dismiss.

Specifically, in its Second Motion to Dismiss, Applicant continues to allege that Opposer fails to plead a legally sufficient claim of dilution by tarnishment. While Opposer disagrees, Opposer has stricken the dilution by tarnishment claim from the Second Amended Combined Notice of Opposition in order to avoid further delays and to move the opposition proceedings forward.

Applicant also objected to Paragraphs 1, 4, and 5 of the First Amended Notice because they allegedly "assert multiple claims and multiple sets of circumstances" and therefore "it would be prejudicial for Applicant to prepare an answer to the paragraphs as written." Second Motion to Dismiss, p. 7. While Opposer disagrees with Applicant's position, Opposer has separated Paragraphs 1, 4, and 5 of the First Amended Notice into separate paragraphs in the Second Amended Notice (now Paragraphs 1 to 11), again in an effort to avoid further delays in this proceeding.

Finally, Applicant objected to Paragraph 17 of the First Amended Notice, alleging that "Paragraph 17 incorrectly asserts that Opposer's application and common law rights constitute 'prima facie evidence' of its rights." *Id.* at pp. 7-8. Again, while Applicant disagrees with

Opposer's assertions, and while Opposer continues to rely on its "continuous, extensive and exclusive use" of its NEUKOPANEL Mark in commerce to establish its senior rights (*see* Paragraphs 27 and 28 of the Second Amended Notice), Paragraph 17 of the First Amended Notice has been amended in the Second Amended Notice (now Paragraph 29) to recite that "Opposer's '822 Registration is valid and subsisting and is *prima facie* evidence of Opposer's exclusive right to its NEUKOPANEL Mark in commerce in association with the goods and services specified in such registration and application".

Opposer asserts that the Second Amended Notice sufficiently addresses all allegations set forth in Applicant's Second Motion to Dismiss. As the Second Amended Notice is intended to address the claims set forth by Applicant in the Second Motion to Dismiss, there is no prejudice to Applicant.

B. No Bad Faith or Dilatory Motive and the Amendment is Not Futile.

Additionally, there is no bad faith or dilatory motive in the amendment of the First Amended Notice. As previously stated, the Second Amended Notice is intended to address Applicant's claims in the Second Motion to Dismiss and is a good faith effort to move the opposition proceedings forward. This is quite the opposite of any dilatory motive.¹

The Second Amended Notice amends the First Amended Notice in direct response to the Second Motion to Dismiss. The amendments to the First Amended Notice sufficiently address all claims raised by Applicant in the Second Motion to Dismiss. Therefore, the amendment is not futile.

C. Previous Amendments to Pleadings.

While Opposer has previously submitted an amended Notice of Opposition, that was in direct response to the first Motion to Dismiss. The Second Amended Notice is intended to be in response to the Second Motion to Dismiss. Therefore, the fact that Opposer previously filed a First Amended Notice should not weigh against Opposer's right to file the presently submitted Second Amended Notice.

¹ However, Opposer notes that Paragraphs 1, 4 and 5 of Opposer's First Amended Notice to which Applicant objects in its Second Motion to Dismiss are identical to Paragraphs 1, 4 and 5 in Opposer's initial Notice of Opposition. Opposer wonders why Applicant did not raise all of its issues with Opposer's grounds for opposition in its First Motion to Dismiss rather than filing multiple motions to dismiss.

III. CONCLUSION

In light of the early stage of this proceeding and the Board's liberal policy in favor of granting amendments, Opposer respectfully requests that the Board grant its motion for leave to amend in order to litigate all issues relevant to this action on the merits. If this motion is granted, Opposer further requests that the Board deem the Second Amended Combined Notice of Opposition filed and served upon entry of the Board's order on this motion.

Dated: February 13, 2023

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned affirms that OPPOSER’S MOTION FOR LEAVE TO AMEND THE FIRST AMENDED COMBINED NOTICE OF OPPOSITION was served on Applicant Agilent Technologies, Inc. by emailing a copy to Applicant’s attorney of record, Craig A. Beaker of Holland & Hart LLP, at docket@hollandhart.com, agarcia@hollandhart.com, cabeaker@hollandhart.com, and aepierce@hollandhart.com, as required pursuant to 37 CFR § 2.119 and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 113.04, on the date set forth below.

Dated: February 13, 2023

/Alicia M. Passerin/_____

Alicia M. Passerin