

**THIS ORDER IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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September 5, 2023

Opposition No. **91281208**

Folexport, Inc.

v.

Florex USA, Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on Opposer's motion for leave to amend its pleading. The motion is fully briefed.¹

Background

On October 14, 2022, Opposer filed a notice of opposition against Application Serial No. 90616308 for FLOREX in stylized form on the ground of priority and likelihood of confusion based on pleaded Registration No. 4796931 for FOLEX in standard characters.² Applicant answered the notice of opposition on November 21, 2022, wherein Applicant denied the salient allegations of the notice of opposition.³ In accordance with the schedule in the Board's notice of institution, discovery opened on

¹ 5 TTABVUE, 8 TTABVUE and 9 TTABVUE.

² 1 TTABVUE.

³ 4 TTABVUE.

December 23, 2022, with a closing date of June 21, 2023.⁴ On May 11, 2023, Opposer filed the present motion to amend the notice of opposition.

Discussion

The pleadings in an opposition proceeding against an application filed under Section 1 of the Trademark Act may be amended in the same manner and to the same extent as in a civil action in a United States district court. *See* Trademark Rule 2.107(a). The Federal Rules of Civil Procedure, made applicable to Board proceedings by Trademark Rule 2.116, permits a party to amend a pleading 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 Rule 12(b), (e), or (f), whichever is earlier. *See* Fed. R. Civ. P. 15(a)(1). Otherwise, a party may amend its pleading only with the opposing party's written consent or leave of the court. *See* Fed. R. Civ. P. 15(a)(2). Since Opposer's motion for leave to amend comes over four months after the opening of discovery, Opposer must look to Fed. R. Civ. P. 15(a)(2) in order to amend its pleading.

Fed. R. Civ. P. 15(a)(2) directs a court to "freely give leave [to amend] when justice so requires." Accordingly, the Board is generally liberal in granting 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." *Int'l Fin. Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002). The Board's determination of whether the adverse party would be prejudiced

⁴ 2 TTABVUE 3.

by the allowance of the amendment is largely dependent on the timing of the motion for leave to amend. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007). Thus, a motion to amend a pleading should be filed as soon as the ground for amendment becomes apparent; otherwise, the party seeking leave risks denial of the motion should its delay result in prejudice to the other party. *See Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008).

Here, Opposer seeks to amend its pleading to “incorporate three additional Registrations for its FOLEX mark that was inadvertently not listed in the original pleading.”⁵ In support, Opposer contends that the registrations constitute “significant support for Opposer’s claims” and that the “amendment would not materially change the scope of this proceeding or the evidence to be adduced in discovery.”⁶ Opposer also adds that the “proceeding is at its initial stages before the parties have engaged in substantial discovery.”⁷

Applicant objects to the amendment as “made in bad faith, dilatory, and unduly prejudicial to Applicant.”⁸ Specifically, Applicant contends that Opposer had failed to take any action in this matter before filing its motion for leave to amend, having “ignored” Applicant’s communication to schedule a discovery conference⁹, in contradiction to Opposer’s claim that the “parties have completed their initial

⁵ 5 TTABVUE 5. The additional registrations are Registration Nos. 2112477, 4655774 and 5370323.

⁶ *Id.* at 3.

⁷ *Id.* at 4.

⁸ 8 TTABVUE 3.

⁹ *Id.*

discovery conference,”¹⁰ and making “no attempt to conduct any discovery,” with only six weeks remaining in the discovery period at the time Opposer filed its motion.¹¹ Applicant further contends that the registrations Opposer proposes to add “were well known to Opposer at the time that it initially filed its Notice of Opposition” and that to allow such amendment “at this time would clearly unduly prejudice the applicant as it would effectively allow the Opposers [sic] to wrongfully get a ‘second bite of the apple’ in a proceeding which it willfully chose to ignore until now.”¹²

In reply, Opposer suggests that the additional registrations were overlooked because its current counsel “has not previously represented Opposer and the Registrations referenced herein were previously obtained by another law firm” and further claims that “Applicant mischaracterizes the conditions that existed after the time Opposer filed the original notice of opposition” because “any alleged delays which have occurred in the proceeding are not due to Opposer’s disregard of this matter, but as a result of miscommunications caused by Applicant’s failure to properly identify its counsel of record and his or her contact information for correspondence related to this proceeding.”¹³

Opposer’s explanation as to why it failed to plead three of its own registrations in support of its likelihood of confusion claim, i.e., inadvertence, and the timing of its motion, i.e., filed during the late stages of the discovery period and not, as Opposer

¹⁰ 5 TTABVUE 3.

¹¹ 8 TTABVUE 7.

¹² *Id.*

¹³ 9 TTABVUE 2 n.1, 3.

claims, “the early stage of these proceedings,”¹⁴ reflects a lack of due diligence on the part of Opposer in investigating and setting forth the basis of its claim, thereby resulting in the very “piecemeal prosecution” that Opposer putatively “seeks to avoid.”¹⁵ Nevertheless, it is apparent from the briefing and the record herein that neither party has expended much, if any, effort in taking discovery in this matter and although this proceeding was in the late stages of the discovery period at the time Opposer filed its motion, proceedings herein were suspended shortly thereafter so discovery has yet to close. Indeed, proceedings were suspended while time still remained in the discovery period for propounding written discovery, contrary to Applicant’s contention that the time to serve written discovery has “effectively expired.”¹⁶ Thus, Applicant’s claim that it would be unduly prejudiced should Opposer

¹⁴ 5 TTABVUE 3.

¹⁵ 9 TTABVUE 4. Opposer’s explanation for its non-response to Applicant’s effort to schedule the discovery conference is neither well taken or supported by the record. Applicant’s lead counsel is identified as Carlos Burgos of Burgos & Associates Law Group. The signature block of Applicant’s answer identifies counsel as Rick Ruz, Esq., and the law firm as Burgos & Associates Law Group. Notwithstanding that such a filing is sufficient to serve as an appearance on behalf of Applicant, see *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB 2012) (law firm that filed motion recognized as counsel of record for the party on whose behalf the motion was filed), Opposer clearly had Mr. Ruz’s email address by way of the service email (which also copied the email addresses of record) and Opposer communicated directly with Mr. Ruz in April 2023, only then raising the question of representation. Although Opposer claims that “this apparent inaccuracy reflected in the TTAB record may have contributed, in part, to any miscommunications that have occurred between the parties,” there is no indication that Opposer attempted to contact the attorney of record for Applicant at any time following the service of Applicant’s answer or following the receipt of Mr. Ruz’s email regarding the scheduling of the discovery conference. In short, there can be no miscommunication if there was no attempt to communicate in the first instance. In any event, Mr. Ruz’s email has been added to Applicant’s correspondence information.

¹⁶ 8 TTABVUE 7.

be granted leave to amend because “it would effectively allow [Opposer] to wrongfully get a ‘second bite of the apple’ ” is not well taken or accurate.

Moreover, such a claim of prejudice has less to do with the proposed amendment of adding three of Opposer’s own registrations, which would not require any discovery from Applicant, and more to do with Applicant’s apprehension that it may now be subject to discovery requests from Opposer. This is neither prejudicial, *see Davis v. Noufal*, 142 F.R.D. 258, 259 (D.D.C. 1992) (“the burden of addressing the merits does not establish prejudice”); *Giersch v. Scripps Networks*, 85 USPQ2d 1306, 1308 (TTAB 2007) (mere inconvenience does not constitute prejudice) citing *Hadley v. U.S.*, 45 F.3d 1345 (9th Cir. 1995), nor relevant to the proposed amendment.

As a final point, the proposed amendment does not seek to add a new claim but rather to amplify the current one by pleading three additional registrations in support of Opposer’s likelihood of confusion claim. Since Applicant, who has yet to take any discovery in this matter, will be afforded the opportunity to do so, the Board sees no prejudice in allowing the amendment.

Decision

Opposer’s motion to amend its notice of opposition is hereby **GRANTED**. **Opposer’s Amended Notice of Opposition¹⁷ is ACCEPTED and will serve as Opposer’s operative pleading herein. Applicant is allowed until OCTOBER 2, 2023, to serve and file its answer thereto.**

¹⁷ 5 TTABVUE 6-35.

Proceedings remain otherwise **SUSPENDED** and will resume on **OCTOBER 3, 2023**, in accordance with the following schedule, as reset:

Expert Disclosures Due	10/31/2023
Discovery Closes	11/30/2023
Plaintiff's Pretrial Disclosures Due	1/14/2024
Plaintiff's 30-day Trial Period Ends	2/28/2024
Defendant's Pretrial Disclosures Due	3/14/2024
Defendant's 30-day Trial Period Ends	4/28/2024
Plaintiff's Rebuttal Disclosures Due	5/13/2024
Plaintiff's 15-day Rebuttal Period Ends	6/12/2024
Plaintiff's Opening Brief Due	8/11/2024
Defendant's Brief Due	9/10/2024
Plaintiff's Reply Brief Due	9/25/2024
Request for Oral Hearing (optional) Due	10/5/2024

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, matters in evidence, the manner and timing of taking testimony, 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).

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