


ESTTA Tracking number: **ESTTA1308536**
Filing date: **09/06/2023**

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

Proceeding no.	91281493
Party	Defendant Garan Services Corp.
Correspondence address	G. ROXANNE ELINGS DAVIS WRIGHT TREMAINE LLP 1251 AVENUE OF THE AMERICAS, 21ST FLOOR NEW YORK, NY 10020 UNITED STATES Primary email: nyc-trademark@dwt.com Secondary email(s): roxanneelings@dwt.com, orrinfalby@dwt.com, ChristineSun@dwt.com, NicoleMedeiros@dwt.com, LatoyaTyson@dwt.com, CelyraMyers@dwt.com, AlyssaOcchiboi@dwt.com 212-489-8230
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's name	G. Roxanne Elings
Filer's email	nyc-trademark@dwt.com, roxanneelings@dwt.com, orrinfalby@dwt.com, ChristineSun@dwt.com, NicoleMedeiros@dwt.com, LatoyaTyson@dwt.com, CelyraMyers@dwt.com, AlyssaOcchiboi@dwt.com
Signature	/GRE/
Date	09/06/2023
Attachments	Garan Opposition to Saucony Motion to Amend.pdf(286559 bytes)

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

In the matter of Application Serial Nos. 97027110, 97311226

Mark: 

Saucony IP Holdings LLC, Opposer, v. Garan Services Corp., Applicant.

Consolidated Opposition Nos.:
91281493 (Parent), 91281494

APPLICANT GARAN SERVICES CORP.’S OPPOSITION TO OPPOSER SAUCONY IP HOLDINGS LLC’S MOTION TO AMEND NOTICE OF OPPOSITION

Applicant, Garan Services, Corp., by and through its undersigned counsel, opposes the motion of Opposer, Saucony IP Holdings, Inc., for leave to amend its Consolidated Notice of Opposition (“Motion to Amend”).

I. INTRODUCTION

Nearly ten months after initiating these proceedings, Opposer now seeks to amend its operative pleading to include the following causes of action—all of which appear to be new, *albeit* not properly pleaded, causes of action:

1. Likelihood of confusion based on common law use of what Opposer describes as its “Original Design” mark¹;
2. Likelihood of confusion based on common law use of what Opposer describes as its “Circle Design” mark²;

¹ 14 TTABVUE, Ex. B at ¶ 5.

² *Id.* at ¶ 6.

3. Likelihood of confusion based on at least ten newly added registrations for design and composite marks;³ and
4. Likelihood of confusion based on the Family of Marks Doctrine.⁴

All of these new causes of action were known to Opposer at the time it commenced this proceeding and inject a new theory in Opposer's case which will prejudice Applicant. Additionally, Opposer has not proffered *any reason* for its failure to include them in its initial pleading nor has it explained its nearly ten month delay in doing so. Furthermore, the newly added causes of action are futile, not sufficiently plead, and fail to state a claim upon which relief could be granted. For these reasons, Applicant requests that the Board deny Opposer's Motion to Amend.

II. LEGAL ARGUMENT

While the Board's rules require application of the liberal standard for amendment set out in Federal Rule of Civil Procedure 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, Inc. v. Jive Commc'ns, Inc.*, 125 USPQ2d 1175, 1180 (TTAB 2017); *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).

The timing of a motion for leave to amend is a major factor in determining whether a respondent would be prejudiced by allowance of the proposed amendment. Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion. *See*

³ *Id.* at ¶ 8. Applicant notes that this constitutes ten (10) separate causes of action.

⁴ *Id.* at ¶ 11.

Wright, Miller and Kane, Federal Practice and Procedure: Civil 2d, Section 1488 (1990); Chapman, Tips from the TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Reporter 302, 307 (1991).

A. Opposer’s Nearly *Ten Month Delay* Is Not Justified As Opposer *Already Had Knowledge of Its “Family of Marks”* When It Commenced the Proceedings

All of the purportedly new allegations were known to Opposer at the time it commenced these proceedings. Opposer failed to include them in its initial pleading and then waited nearly ten months to seek leave to amend. The allegations present a new theory of the Opposer’s case (*i.e.*, the newly added registrations form a family of marks), which alters its opposition in a significant way. *See e.g., Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008) (motion for leave to amend to add claims of descriptiveness and fraud denied; petitioner unduly delayed in adding claims which were based on facts within petitioner’s knowledge at time petition to cancel was filed). Opposer has offered no explanation for its failure to include the new causes of action in its initial pleading or a reasonable explanation for the ten month delay in seeking leave to do so.

When Opposer filed its Notices of Opposition on October 31, 2022, it was well aware of each and every registration and/or application it now seeks to bring into this case or “through *reasonable effort* could have known.” *Kellogg Co. and Kellogg N.A., Assignee Shakespeare Co., LLC*, 2005 WL 1581551, at *3 (TTAB June 30, 2005)(emphasis added). That is, all of the registrations and applications that Opposer now seeks to add to its pleading were filed and/or registered *before* Opposer filed its Notices of Opposition on October 31, 2022.⁵

Opposer’s Motion to Amend fails to explain why Opposer did not include these new allegations at the original time of filing. *See Kellogg Co. and Kellogg N.A., Assignee Shakespeare Co., LLC*, 2005 WL 1581551, at *3 (TTAB June 30, 2005) (finding “in view of the lack of any sufficient explanation by opposer, that opposer unduly delayed in filing its motion for

⁵ The only mark registered after Opposer filed its Notices of Opposition on October 31, 2022 is U.S. Trademark Registration No. 7093996, which was registered on June 27, 2023. Regardless, Opposer filed for that trademark (U.S. Application No. 90025895) on June 29, 2020.

leave to amend”). At best, Opposer states that “*during the course of the proceeding*, counsel for Saucony has determined that Saucony *owns other, related marks* that are used with the *same goods* and that are also subject to being confused with Garan’s mark—both individually and collectively, as a family of marks.”⁶

Without offering any rationale for its failure to initially plead the new allegations and theory or its ten month delay—as there is no justifiable excuse for such a belated discovery—Opposer attempts to shift blame to Applicant.⁷ Opposer complains that counsel for Applicant implied it would consent to the amendment.⁸ But Opposer omits probative facts relevant to the issue. Opposer initially reached out on July 14, 2023 asking Applicant’s counsel to review the proposed amendment. Counsel for Applicant agreed to review.⁹ On July 18, counsel for Opposer requested that Applicant “pause our [sic] consideration of the draft I sent you, since I will likely add a few more registrations.”¹⁰ Once more, counsel for Applicant agreed to review.¹¹

On July 20, counsel for Opposer circulated the updated draft, noting that this version “rounds out the universe of 3-dot design marks out client owns.”¹² Later that day, Applicant’s counsel stated that it did not “anticipate any issues,” but made clear that it would “review and circle back.”¹³ Indeed, counsel for Applicant repeatedly noted during the correspondence that counsel for Applicant would need to review any proposed amendment *before* consenting.¹⁴ To be clear: counsel never implied that it would unilaterally agree to an amendment. After reviewing the proposed amendment, on August 1 counsel for Applicant confirmed—only *eight business days after* receiving Opposer’s updated draft— it would not consent to the

⁶ 14 TTABVUE ¶ 2 (emphasis added).

⁷ 14 TTABVUE.

⁸ *Id.* at ¶7.

⁹ *Id.*, Ex. C at 3.

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.*

¹³ *Id.* (“[W]e would like to review before we provide our consent to the amendment”; “Happy to review”; “I’ll review and circle back”).

¹⁴ *Id.*

amendment. Opposer's suggestion that counsel for Applicant is somehow responsible for its nearly 10 month delay is far-reaching.

All of the allegations Opposer seeks to add were well-within Opposer's ambit of knowledge at the time of filing its Notices of Opposition. Opposer's counsel's sudden discovery "during the course of the proceeding" of other trademarks is *not* an acceptable explanation, let alone justification, for the delay. Accordingly, the Board should deny the Motion to Amend due to Opposer's undue delay.

B. Opposer's Amendment is Futile

Amendments are futile if the amended pleading would not survive a motion to dismiss. *See e.g., Mitek Corp. v. Woods Indus. Inc.*, 41 U.S.P.Q.2d 1307 (TTAB 1996) ("The amended pleading would withstand a motion to dismiss and therefore, granting applicant's motion to add the counterclaim would not be futile."); *see also Dollar Tree Stores, Inc. v. Everything for A Dollar Store (Canada) Inc.*, 26, 850, 2001 WL 315045, at *2 (TTAB Mar. 30, 2001) (same).

Opposer claims that it seeks to amend the pleadings "not to add new causes of action, but simply to expand the number of registrations on which its Section 2(d) claim is based to include all of its relevant marks."¹⁵ This, however, is an attempt to minimize the impact that the proposed amendments will have on these proceedings and the prejudice Applicant will suffer if the amendment is allowed. Applicant submits that the reason Opposer seeks to include these new marks and registrations is to set forth a newly proposed theory of its case under the Family of Marks Doctrine and to tack its originally pleaded marks and registrations to early uses and registrations for clearly different marks to gain an earlier priority date, among other things.¹⁶ Opposer offers no reason why these newly pleaded marks (the Original Design and Circle Design) are legally equivalent or create the same continuing commercial impression or provide a reasonable basis these clearly different marks are being added to its likelihood of confusion

¹⁵ *Id.* at ¶ 3.

¹⁶ *Id.* at ¶ 11 (emphasis added).

claim. The originally pleaded marks (the River Designs) are, in fact, materially different from newly the pleaded marks.

In fact, Opposer's amended allegation that "Applicant's Mark is highly similar to Opposer's Marks —and *especially Opposer's River and New River Marks*—in appearance and commercial impression" is indefinite and demonstrates the futility of the newly added marks and registrations.¹⁷ Opposer's own allegations fail to state that there is a likelihood of confusion with the newly added marks. Instead, it uses indefinite language that does not provide Applicant with proper and adequate notice as to which marks and registrations its Section 2(d) cause of action is actually based. Opposer newly amended pleading reveals that it is not merely amending to "expand the number of registrations"—it is purporting to assert a new doctrinal theory of ownership regarding a "family of marks," with a priority date of 1976 as opposed to the 1995 date it stated in its initial pleading.

Importantly, Opposer's mere recitation of these marks in its pleading is not sufficient to establish the existence of a family of marks. *See e.g., Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 U.S.P.Q.2d 1511 (TTAB 2009) ("The fact that opposer has used and registered several marks incorporating SCHICK is not in itself sufficient to establish the existence of a family of marks"). To assert ownership of a family of marks, Opposer must allege: (1) prior use of marks sharing a recognizable common characteristic; (2) that the common characteristic is distinctive (*i.e.*, not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark); and (3) that prior to the Applicant's first use (or constructive first use) of its mark, Opposer's marks have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition among the purchasing public such that the common characteristic is itself indicative of a common origin of the goods or services. *See e.g., Wise F&I, LLC, et al. v. Allstate Ins. Co.*, 120 USPQ2d 1103; 2016 WL 6777774 *3 (TTAB 2016); *see also*

¹⁷ *Id.*, Ex. B at ¶16 (emphasis added).

4 *McCarthy on Trademarks and Unfair Competition* § 23:61 (5th ed.) (“The family of marks rule”).

Moreover, Opposer’s proposed amendments do not allege sufficient facts regarding use of Opposer’s “family of marks”, their distinctive characteristics, or use of Opposer’s marks in promotional advertising or sales activities such that consumers recognize common characteristics between the marks. *See, e.g., Wise F&I, LLC, et al.*, 120 USPQ2d 1103, 1107; 2016 WL 6777774 at *7 (TTAB 2016) (Opposer failed to state a claim upon which relief can be granted because Opposer failed to allege all of the necessary elements of a family of marks). Rather, Opposer has alleged sparse, generalized allegations about “continuous use” of its “family of marks” and a list of the registrations and applications.¹⁸

To the extent that Opposer alleges that Applicant infringes *each* of its marks, Opposer’s new, proposed allegations (*see, e.g., 14 TTABVUE, Ex. B at ¶ 16*) are insufficient, as these are pled “in what amounts to a single set of *broad [and indefinite]* allegations.” *Wise F&I, LLC, et al.*, 120 USPQ2d 1103, fn. 9. Opposer “must set forth *each pleaded mark and registration* in a separate numbered paragraph so that Applicant can separately admit or deny Opposer’s allegations with respect to each one.” *Id.* (emphasis added); *see also, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 28 (CCPA 1976) (each class of good/services requires a different factual determination and different conclusion on the issue of likelihood of confusion).

For all of these reasons, the Board should deny the Motion to Amend because Opposer’s amended pleading will not withstand a motion to dismiss.

¹⁸ *Id.*, Ex. B. at ¶¶ 5-6, 8, 11.

C. Applicant Will Be Prejudiced By Opposer's Delayed Amendment.

Opposer claims there is no “potential for prejudice to Garan” because discovery has not closed and Applicant has not served discovery.¹⁹ However, the fact that the discovery period remains *open* does not mean Applicant has not suffered prejudice due to Opposer's delay.

To be clear: none of the proposed allegations are based on *new facts* that Opposer gleaned *during* the course of discovery. This opposition has been pending for nearly a year. Applicant has spent ample time investigating Opposer's pleaded registrations, preparing its defenses, responding to Opposer's discovery, and finalizing its affirmative discovery. Opposer now seeks to inject a “newly discovered” theory of its case – one which it has not defined with any clarity. It is incumbent upon Opposer to identify all claims promptly in order to provide Applicant with proper notice. Allowing piecemeal prosecution of this case unfairly prejudices Applicant by increasing the time, effort, and money that Applicant will be required to expend to defend against Opposer's challenge to its Applications.

Assuming *arguendo* the Board acknowledges that the remainder of the discovery period allows the parties to explore the new claims, the motion must still be denied. By way of example, in *Trek Bicycle Corp. v. Styletrek Limited*, the Board acknowledged that the motion to amend was filed *before* the close of discovery and there was no indication that applicant's witnesses or evidence would be unavailable due to the delay.” 64 U.S.P.Q.2d 1540, 2001 WL 1869327 (TTAB 2001). Regardless, the Board made clear that it was “troubled by opposer's delay” in raising a new claim because not only was the claim an available grounds well before filing the opposition but the Board emphasized: “[m]ore particularly, we note that opposer's motion for leave to amend its pleading was filed *eight months after opposer filed its notice of opposition* and, from the language of the proposed amendment, appears to be *based on facts within opposer's knowledge* at the time it filed its notice of opposition.” *Id.* (emphasis added). The

¹⁹ *Id.* at ¶ 6.

Board further observed that the motion was “wholly silent” as to why the claim has not been raised sooner. *Id.*

In light of Opposer’s unjustified delay and the futility of Opposer’s proposed “family of mark” ownership theory, the efficient resolution of this matter should not be impeded because of counsel’s failure to develop its legal theory at the outset of the proceeding and fully identify all marks used on Opposer’s footwear.

III. CONCLUSION

For all of the foregoing reasons, Opposer’s Motion to Amend should be denied.

Dated: New York, New York
September 6, 2023

DAVIS WRIGHT TREMAINE LLP

By: /G. Roxanne Elings

G. Roxanne Elings
Nicole Medeiros

1251 Avenue of the Americas
21st Floor
New York, New York 10020
(212) 489-8230

*Attorneys for Applicant
Garan Services Corp.*

