

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

UNITED STATES PATENT AND TRADEMARK OFFICE  
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CH/RK

December 23, 2023

Opposition Nos. **91281493 (parent)**  
**91281494**

*Saucony IP Holdings LLC*

*v.*

*Garan Services Corp.*

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

This matter comes up on Saucony IP Holdings LLC's ("Opposer's") motion for leave to amend its pleading.<sup>1</sup> The motion is contested.<sup>2</sup>

**Background**

On October 31, 2022, notices of opposition were filed against Application Serial



Nos. 97027110 and 97311226, both for the mark on the ground

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<sup>1</sup> 14 TTABVUE. References to the TTABVUE record will be to that of the parent proceeding unless otherwise stated.

<sup>2</sup> 15 TTABVUE.

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of priority and likelihood of confusion.<sup>3</sup> As the basis for the claim, Opposer pleaded Registration Nos. 2064602, 3824275, 3824276, 3095051, 4739691, and 4724176, as well as Application Serial No. 97258879, all for marks comprised, either in whole or in part, of one of the following designs:



Opposition Nos. 91281493 and 91281494 were instituted on October 31, 2022. On December 12, 2022, Garan Services Corp. (“Applicant”) answered each of the notices of opposition denying the salient allegations therein.<sup>4</sup>

Discovery opened on January 9, 2023<sup>5</sup>, and the two proceedings were consolidated on January 31, 2023, with Opposition No. 91281493 designated as the

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<sup>3</sup> 1 TTABVUE (Opposition No. 91281493) and 1 TTABVUE (Opposition No. 91281494). The ESTTA cover sheet to both pleadings identify dilution by blurring and dilution by tarnishment as additional grounds for opposition. However, neither ground has been pleaded in either of the notices of opposition. The oppositions, therefore, are read as asserting a sole claim of priority and likelihood of confusion.

<sup>4</sup> 4 TTABVUE (Opposition No. 91281493) and 4 TTABVUE (Opposition No. 91281494).

<sup>5</sup> 2 TTABVUE 3 (Opposition No. 91281493) and 2 TTABVUE 3 (Opposition No. 91281494).

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parent proceeding and Opposition No. 91281494 designated as the child proceeding.<sup>6</sup> As originally set, discovery was scheduled to close on July 8, 2023.<sup>7</sup>

On May 26 and July 18, 2023, Opposer filed consented motions to extend discovery by 60 days for, in part, settlement purposes.<sup>8</sup> The motions were granted and, consequently, the close of discovery was extended to November 5, 2023.<sup>9</sup>

On August 17, 2023, Opposer filed the subject motion seeking leave to amend each of the notices 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), 37 C.F.R. § 2.107(a). The Federal Rules of Civil Procedure, made applicable to Board proceedings by Trademark Rule 2.116, 37 C.F.R. § 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

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<sup>6</sup> 6 TTABVUE (Opposition No. 91281493) and 6 TTABVUE (Opposition No. 91281494).

<sup>7</sup> 2 TTABVUE 3 (Opposition No. 91281493) and 2 TTABVUE 3 (Opposition No. 91281494).

<sup>8</sup> 10 TTABVUE and 12 TTABVUE.

<sup>9</sup> 10 – 13 TTABVUE.

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amend comes over eight 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 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 pleadings to plead additional registrations and applications, as well as “related common law rights,”<sup>10</sup> for marks that “represent[] a variation on the same theme of three dots within a curved shape ....”<sup>11</sup> Although it stands to reason that Opposer should have known of these marks and included

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<sup>10</sup> *First Amended Notice of Opposition*, ¶¶ 5-6, 8-9. 14 TTABVUE 9-13. Opposer seeks to additionally plead Registration Nos. 0876423, 1170334, 1124321, 1318234, 1350728, 1356744, 2910565 and 7093996, and Application Serial Nos. 90025895 and 90665014. It is noted that Application Serial No. 90025895 matured to registration and is already accounted for as Registration No. 7093996.

<sup>11</sup> 14 TTABVUE 3.

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them as part of the original pleadings, the only explanation provided by Opposer for now seeking to include them is simply that “[d]uring the course of the proceeding, counsel for [Opposer] [] determined that [Opposer] owns other, related marks that are used with the same goods and that are also subject to being confused with [Applicant’s] mark – both individually and collectively, as a family of marks.”<sup>12</sup> While this explanation suggests a lack of due diligence on the part of Opposer in investigating and setting forth the basis of its claim, which weighs against granting Opposer leave to amend its pleadings, Applicant, aside from mere argument, has failed to demonstrate how it will be prejudiced should the amendments be allowed, particularly since nearly three months remained in the discovery period when Opposer sought leave to amend its pleadings and Applicant has yet to take any discovery from Opposer. That Applicant may be faced with a greater burden in addressing the merits is not the type of prejudice that would warrant denying Opposer’s request for leave to amend its pleading. *See Giersch v. Scripps Networks*, 85 USPQ2d 1306, 1308 (TTAB 2007) citing *Davis v. Noufal*, 142 F.R.D. 258 (D.D.C. 1992) (holding that the burden of addressing the merits does not establish “prejudice”). Thus, to the extent Opposer seeks to include additional marks to support its likelihood of confusion claim, the Board is amenable to granting Opposer leave to amend as such. However, to the extent Opposer seeks to newly assert a

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<sup>12</sup> *Id.*

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claim of likelihood of confusion based on a “family of marks” theory<sup>13</sup>, Opposer’s motion is properly denied for want of a sufficient pleading thereof.

To assert a claim of likelihood of confusion based on a family of marks, a plaintiff must plead “(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 defendant’s first use (or constructive first use) of its involved mark, plaintiff’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.” *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016). Opposer failed to do so. Moreover, where, as here, the claim of a family of marks is based on marks owned by separate legal entities<sup>14</sup>, the plaintiff must further plead that there is unity of control over the use of the marks and the nature and quality of the goods or services to which the marks apply. *See id.* No such allegations have been pleaded by Opposer.

## **Decision**

In view of the foregoing, Opposer’s motion for leave to amend its notices of opposition is hereby **GRANTED in part** to the extent it seeks to include additional marks for which it believes there to be a likelihood of confusion but **DENIED in**

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<sup>13</sup> *First Amended Notice of Opposition* at ¶ 11.

<sup>14</sup> Registration Nos. 4744176, 4739691 and 7093996 are owned by Saucony, Inc.

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**part** to the extent it seeks to assert a claim of likelihood of confusion based on ownership of a family of marks. ¶ 11 of Opposer's First Amended Notice of Opposition is accordingly **STRICKEN**.

Nevertheless, since it is the general practice of the Board to allow a party an opportunity to correct a defective pleading, *see Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993), Opposer is allowed until **JANUARY 22, 2024**, to replead its proposed claim of priority and likelihood of confusion based on a family of marks if Opposer believes it has a basis for doing so, failing which these consolidated proceedings shall proceed on the first amended notice of opposition as stricken herein. Applicant is allowed until **FEBRUARY 21, 2024**, to answer the first amended notice of opposition, as stricken, or any superseding pleading.

Proceedings remain otherwise **SUSPENDED** and will resume on **FEBRUARY 22, 2024**, in accordance with the following schedule:

Expert Disclosures Due	4/22/2024
Discovery Closes	5/22/2024
Plaintiff's Pretrial Disclosures Due	7/6/2024
Plaintiff's 30-day Trial Period Ends	8/20/2024
Defendant's Pretrial Disclosures Due	9/4/2024
Defendant's 30-day Trial Period Ends	10/19/2024
Plaintiff's Rebuttal Disclosures Due	11/3/2024
Plaintiff's 15-day Rebuttal Period Ends	12/3/2024
Plaintiff's Opening Brief Due	2/1/2025
Defendant's Brief Due	3/3/2025
Plaintiff's Reply Brief Due	3/18/2025
Request for Oral Hearing (optional) Due	3/28/2025

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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