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

Proceeding	92051866
Party	Defendant RTTV America, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Service Mark Registration No. 3,196,183
Mark: RUSSIA TODAY
Registered: January 9, 2007

Olga Sheymov,)	
)	
Petitioner,)	
)	
v.)	Cancellation Number 92051866
)	
RTTV America, Inc.,)	
)	
Registrant.)	
)	

**RESPONDENT’S OPPOSITION TO PETITIONER’S
MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION**

Registrant, RTTV America, Inc. (“Registrant”), by and through counsel, hereby submits this Brief in Opposition to Petitioner’s Motion for Leave to Amend Petition for Cancellation.

Petitioner’s Motion for Leave to Amend Petition for Cancellation (“Motion to Amend”) should be denied because the proposed amendments would cause undue prejudice to Registrant and the claims are futile. Further, Petitioner was fully aware of the facts and claims sought to be added by amendment at the time of filing the original Petition to Cancel (“Original Petition”).

Therefore, the Motion to Amend should be denied.

I. FACTS.

Registrant is the owner of the registered mark, RUSSIA TODAY, U.S. Registration No. 3,196,183, for services in International Class 42 (the “Mark”). Registrant first used the Mark in commerce on April 10, 1996.

Petitioner has a pending trademark application for the mark, RUSSIA TODAY, Serial No. 77,802,590, for services in the same International Class 42, with an alleged first date of use in commerce of August 31, 2000 (the “Application”). The U.S. Patent and Trademark Office (“PTO”) issued an Office Action on November 13, 2009, refusing registration of Petitioner’s Application because of the likelihood of confusion with Registrant’s Mark.

The Original Petition alleged that Registrant had abandoned its use of the Mark and that therefore, the existing registration was somehow causing confusion with Petitioner’s Application for a mark in the same class of goods. Original Petition §§ 3 and 4. Registrant filed the Answer addressing the allegations of the Original Petition and setting forth several defenses to the claims. *See Answer*. Registrant’s Answer included the defense that Petitioner had committed fraud on the PTO by attempting to obtain a service mark registration by submitting the Application, because Petitioner knew of Registrant’s prior rights when she made and filed her Declaration in her Application that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true.” *Id.* at 2-3.

In addition, the Answer sets forth the defense that Petitioner had unclean hands in bringing this cancellation proceeding because Registrant’s Mark had been used in commerce since April 10, 1996, and Petitioner’s alleged first date of use in commerce for her Application was August 31, 2000. Therefore, since August 31, 2000, Petitioner has been infringing on Registrant’s Mark. *Id.* at 3.

Petitioner now seeks to amend the Original Petition to add new factual allegations to support new priority claims based on alleged common law rights and the alleged existence of a family of marks. *See* Motion to Amend.

II. ARGUMENT.

Amendment of pleadings in a cancellation proceeding is governed by Fed. R. Civ. P. 15. *See* 37 C.F.R. § 2.115. Where amendment of the pleadings is not permitted as a matter of right, or consent has not been given, as in this case, leave of the Board is required to amend the pleadings. Fed. R. Civ. P. 15(a)(2). The decision to grant or deny a motion to amend is within the discretion of the Board and amendment may be denied where there is undue prejudice to the opposing party or the amendments would be futile. *See Foman v. Davis*, 371 U.S. 178, 182 (1962).

Registrant recognizes that leave to amend will be freely given when justice requires. Fed. R. Civ. P. 15(a)(2). However, in the instant matter, leave to amend is unwarranted because Registrant would be unduly prejudiced by the amendment of the Petition because it would greatly increase the length, complexity and expense of discovery and trial in this matter. *See e.g., A. Cherney Disposal Co. v. Chicago & Suburban Refuse Disposal Corp*, 68 F.R.D. 383, 385-386 (N.D. Illinois 1975) (citing *Data Digests, Inc. v. Standard & Poor's Corp*, 57 F.R.D. 42 (S.D.N.Y. 1972); *McPhail v. Bangor Punta Corp.*, 58 F.R.D. 638 (E.D. Wis. 1973). The issues set forth in the Original Petition were fairly straightforward and focused on whether Respondent had abandoned its use of its registered Mark. The proposed amendments now seek to add common law priority claims and claims related to the existence of the family of marks, which would require extensive additional discovery and expense to Registrant.

Further, Petitioner was fully aware of the facts and claims she seeks to add at the time she filed the Original Petition. Amendment of the pleadings is frowned upon when the information was known at the time of the original filing. As noted in *Johnson v. Sales Consultants, Inc.*, 61 F.R.D., 369, 371 (N.D. Illinois 1973), “[t]he power of a court to permit amendments to a complaint should not be used to completely change the theory of the case after the case has been submitted to the Court on another theory without some showing of lack of knowledge, mistake or inadvertence or some change of conditions over which the party had no knowledge or control.” Similarly, courts have held that “[i]t is incumbent upon the movant to show that the information upon which the new claim was based was unknown or unavailable prior to the filing of the motion.” *Conroy Datsun Ltd. v. Nissan Motor Corp.*, 506 F.Supp. 1051, 1054 (N.D. Illinois 1980).

Here, Petitioner was fully aware of all of the facts and claims related to alleged priority of use and alleged family of marks at the time of her filing of the Original Petition. Clearly, Petitioner knew of the alleged existence and alleged dates of use of her own marks and was fully aware of Registrant’s registered Mark and stated date of use for which she was seeking cancellation. Despite these facts, Petitioner did not set forth these allegations in the Original Petition. It was only after Registrant presented the fraud and unclean hands defenses in the Answer that Petitioner sought to concoct these priority and family of marks claims to try to mitigate the effect of those defenses.

Amazingly, in the Motion to Amend, Petitioner asserts that these new and “additional facts were discovered during Petitioners [sic] ongoing investigation into the facts supporting its claims and defenses.” Motion to Amend p. 2. This statement strains credulity.

Also, Petitioner's claim that the marks for which she holds a registration and the Application, which is the basis of this cancellation, form a family of marks would be futile. In order to establish a family of marks, it must be shown that,

prior to the entry into the field of an opponents mark, the marks containing the claimed 'family' feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of a common origin predicated on the 'family' feature.

Marion Laboratories, Inc. v. Biochemical/Diagnostics, Inc., 6 U.S.P.Q.2d 1215, 1218 (1988)(citation omitted).

Here, even if the alleged dates of use of January 1996, of two of Petitioner's claimed marks for different goods and services were accurate, use of those marks only would have been in existence for three months prior to Registrant's entry into the field. Accordingly, it is dubious that Petitioner's alleged marks obtained any public recognition or connection as a family in that brief time period. Accordingly, the Motion to Amend should be denied.

III. CONCLUSION

For the foregoing reasons, Registrant respectfully submits that this Honorable Board should deny Petitioner's Motion to Amend.

Date: April 13, 2010

Washington, D.C.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the Answer has been served on Michael

J. Mlotkowski by mailing said copy on April 13, 2010, via First Class Mail, postage prepaid to:

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