

ESTTA Tracking number: **ESTTA367314**

Filing date: **09/08/2010**

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

Proceeding	92052531
Party	Plaintiff The United States Playing Card Company
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	09/08/2010
Attachments	Motion for Leave to Amend Petition for Cancellation_92052531.pdf (6 pages) (137938 bytes) Exhibit A to Motion for Leave to Amend Petition for Cancellation_92052531.pdf (9 pages) (55807 bytes)

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

UNITED STATES PLAYING CARD
COMPANY,

Petitioner,

v.

ANGEL PLAYING CARDS CO., LTD.,

Registrant.

Cancellation No. 92052531

MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION

Pursuant to Fed. R. Civ. P. 15(a) and Trademark Rule 2.115, the Petitioner, United States Playing Card Company (“USPC”), moves for leave to amend its Petition for Cancellation to add USPC’s design mark associated with its ARISTOCRAT playing cards as a basis for its Petition. The Board should grant leave to amend. Allowing the amendment will not prejudice the Applicant, Angel Playing Cards Co., Ltd. (“Angel”). This proceeding is still in its initial stages; the Discovery Period opened August 17, 2010 and will remain open until February 13, 2011, and the parties have not yet exchanged written discovery requests. The amendment does change the substantive issues of the proceeding, and allowing the amendment will promote judicial economy and the interest of justice.

I. FACTS

In this proceeding, USPC seeks to cancel four registrations owned by Angel on the Supplemental Register, Registrations Nos. 3,759,470, 3,759,471, 3,759,472, and 3,791,673, all for design marks used in connection with playing cards. USPC bases its petition on four U.S.

1 Trademark Registrations that it owns, Nos. 48,763, 153,892, 2,694,791, and 3,049,851, each of
2 which covers a design mark for playing cards consisting in whole or in part of repeated
3 diamonds.

4 USPC owns an additional diamond-based design mark for playing cards, the design that it
5 uses on its ARISTOCRAT brand playing cards. As stated in the proposed amended petition for
6 cancellation that accompanies this motion, USPC has used this mark in commerce since long
7 before any date that Angel can rely on. Based on its long-standing and widespread use, USPC
8 has developed substantial trademark rights in this design, which identifies USPC as the source of
9 its playing cards and related goods and services.

10 Petitioner has just recently served its initial disclosures, and neither party has served
11 written discovery requests yet. The proceeding is therefore in the very preliminary stages.

12 II. ARGUMENT

13 Granting USPC leave to amend its Petition for Cancellation to include the
14 ARISTOCRAT design mark as an additional basis for cancellation would further the interests of
15 justice and would not prejudice Angel. This motion to amend should therefore be granted.

16 Fed. R. Civ. P. 15(a), as made applicable by Trademark Rule 2.115, establishes that leave
17 to amend “shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a)(2). Under
18 Rule 15, a motion to amend should be granted unless the parties engage in procedural
19 improprieties such as “undue delay, bad faith or dilatory motive on the part of the movant,
20 repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the
21 opposing party by virtue of allowance of the amendment, futility of the amendment, etc.”

22 *Foman v. Davis*, 371 U.S. 178, 182 (1962). Similarly, the Board has held that “amendments to
23 pleadings should be allowed with great liberality at any stage of the proceeding where necessary
24 to bring a furtherance of justice unless it is shown that entry of the amendment would violate
25 settled law or be prejudicial to the rights of any opposing parties.” *American Optical Corp. v.*
26 *American Olean Tile Co., Inc.*, 168 U.S.P.Q. 471, 473 (TTAB 1971). To determine whether

27 leave to amend should be granted, the Board “must consider whether there is any undue

MOTION FOR LEAVE TO AMEND
PETITION FOR CANCELLATION - 2

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1 prejudice to applicant and whether the amendment is legally sufficient.” *Commodore*
2 *Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (TTAB 1993).

3 Furthermore, when sufficient time remains in the discovery period to serve additional
4 discovery requests and the amending party indicates agreement to extend the time for discovery,
5 the amendment is not prejudicial. *Id.* at 1506. *See also Marmark Ltd. v. Nutrexpa S.A.*, 12
6 U.S.P.Q.2d 1843, 1844 (TTAB 1989) (finding no prejudice even after service of written
7 discovery requests); *Anheuser-Busch, Inc. v. Martinez*, 185 U.S.P.Q. 434, 435 (TTAB 1975)
8 (granting leave to amend when proceeding at pre-trial stage and discovery period could be
9 reopened); Beth A. Chapman, *Tips from the TTAB, Amending Pleadings: The Right Stuff*, 81
10 TRADEMARK REP. 302, 305 (1991) (leave to amend generally granted during pre-trial stage
11 because discovery is still open or can be reopened without prejudice). Any resultant delay from
12 extending discovery is outweighed by the desire for full adjudication of the issues. Chapman,
13 *supra*, at 306.

14 For example, in *Huffy Corp. v. Geoffrey Inc.*, 18 U.S.P.Q.2d 1240, 1242 (Comm’r Pat.
15 1990), the opposer moved to amend the notice of opposition to include an additional trademark
16 registration as a basis for opposition. The Board held that amendment would improve judicial
17 economy by eliminating the need for additional proceedings and that the applicant would not be
18 unduly prejudiced because the opposition proceeding was in the pre-trial stage. *Id.* The
19 Commissioner of Patent and Trademarks upheld the Board’s decision, stating that the decision
20 promoted judicial economy and would avoid the possibility of a subsequent cancellation
21 proceeding. *Id.*

22 As in these cases, USPC’s proposed amended Petition for Cancellation (i) does not
23 prejudice Angel because it is made before the close of discovery; (ii) does not add any new
24 claims but merely includes an additional basis for opposition; and (iii) promotes judicial
25 economy and the interest of justice.

26 First, Angel is not prejudiced because the discovery period is still open. In fact, the
27 discovery period opened just three weeks ago and will remain open through February 13, 2011.

1 Moreover, Petitioner has only recently served initial disclosures and neither party has, as of yet,
2 served written discovery requests. This proceeding is clearly in the very preliminary stages
3 whereby amendment would not be prejudicial.

4 Second, the proposed amended Petition for Cancellation does not prejudice Angel
5 because it does not add any new claims. The substantive legal claims remain unchanged, and the
6 addition of the ARISTOCRAT design mark merely augments the basis for USPC's previously-
7 pleaded claims.

8 Finally, granting leave to amend the Petition for Cancellation would promote judicial
9 economy and the interests of justice by providing a full adjudication of the issues. Denial of the
10 motion to amend and exclusion of the ARISTOCRAT design mark as a basis for cancellation
11 would open the door to another petition to cancel based on the ARISTOCRAT design mark. To
12 prevent such a redundancy and strain on judicial resources, this issue should be adjudicated with
13 the present proceeding.

14 III. CONCLUSION

15 USPC therefore respectfully requests that the Board grant leave to amend its Petition for
16 Cancellation in this proceeding to include the ARISTOCRAT design mark as a basis for
17 cancellation. Should Applicant request an extension of the discovery deadline to accommodate
18 this addition, USPC respectfully requests that the Board permit an extension and reset the
19 schedule for this proceeding accordingly. The proposed amended Petition for Cancellation is
20 being filed at the same time as this motion. *See* TBMP 507.01 ("A signed copy of the proposed
21 amended pleading should accompany a motion for leave to amend a pleading.") In addition,
22 attached as Exhibit A is a copy of the proposed amended Petition for Cancellation marked to
23 show the changes from the original Petition for Cancellation.

1 RESPECTFULLY SUBMITTED this 8th day of September, 2010.

2 Davis Wright Tremaine LLP
3 Attorneys for Petitioner The United States Playing
4 Card Company

5 By s/ Stuart R. Dunwoody

6 Stuart R. Dunwoody

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CERTIFICATE OF SERVICE

I hereby certify that on the 8th day of September, 2010, a true and correct copy of Motion for Leave to Amend Petition for Cancellation No. 92052531 was duly served upon the Registrant by mailing a copy thereof via the U.S. Postal Service, first-class mail to:

Anthony F. Lo Cicero
Holly Pekowsky
Amster, Rothstein & Ebenstein LLP
90 Park Avenue
New York, NY 10016-1301

Attorneys for Registrant

s/Lesley Smith
Lesley Smith

CERTIFICATE OF FILING

I hereby certify that on September 8, 2010, I filed this Motion for Leave to Amend Petition for Cancellation via the ESTTA Filing System of the U.S. Patent and Trademark Office.

DATED this 8th day of September, 2010.

s/Maureen Larican
Maureen Larican

Davis Wright Tremaine LLP
Suite 2200
1201 Third Avenue
Seattle, WA 98101-3045
Tel: (206) 757-8429
Fax: (206) 757-7700
Email: maureenlarican@dwt.com

EXHIBIT A

Cancellation No. 92052531

Exhibit A to MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION

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

3 THE UNITED STATES PLAYING CARD)
4 COMPANY, a Delaware corporation,)
5) Cancellation No. [92052531](#)
6)
7) Petitioner,)
8)
9) v.) [AMENDED](#) PETITION FOR
10) CANCELLATION
11)
12) ANGEL PLAYING CARDS CO., LTD., a)
13) corporation of Japan,)
14)
15)
16) Registrant.)
17 _____)

18 ~~Seattle, Washington 98101~~
19 ~~June 7, 2010~~

20 TO THE COMMISSIONER FOR TRADEMARKS
21 TRADEMARK TRIAL AND APPEAL BOARD

22 The United States Playing Card Company, a Delaware corporation, having a place of
23 business at 300 Gap Way, Erlanger, Kentucky 41018 (hereinafter "Petitioner"), believes that it
is being or will be damaged by Registrations Nos. 3,759,470, 3,759,471, 3,759,472 and
3,791,673 for goods in International Class 28, which to the best of Petitioner's knowledge are
owned by Angel Playing Cards Co., Ltd., and hereby petitions to cancel the same.

As grounds for the cancellation, Petitioner alleges as follows:

1. On information and belief, Angel Playing Cards Co., Ltd. is a
corporation created pursuant to the laws of Japan, having a place of business at 10-1
Kawarayamachi 2-Chome, Chuo-ku, Osaka, Japan (hereinafter "Registrant"). Registrant has
as its Attorney of Record Neil M. Zipkin, Amster Rothstein & Ebenstein LLP, 90 Park Ave
Floor 21, New York, NY 10016.

2. Petitioner is in the business of manufacturing, selling, and distributing
playing cards and related goods. Continuously, since long prior to any date upon which
Registrant can rely, Petitioner has used, in United States commerce, trademarks comprising

1 repeated parallelogram and rectangular designs and diagonal lines in association with playing
2 cards and related goods.

3 3. Continuously, since long prior to any date upon which Registrant can
4 rely, Petitioner has used trademarks comprising repetitive designs in association with playing
5 cards and related goods.

6 4. Petitioner is the owner of U.S. Trademark Registration No. 48,763 for a
7 design mark described as follows: "the trade-mark consists of a design many times repeated
8 upon a panel or parallelogram to give the effect of many parallel diagonal lines crossing
9 each other and inclosing dark diamond-shaped figures. The appearance of the light lines is
10 gained by four light parallel strokes or lines at each side of the dark diamond, and at each
11 corner of each dark diamond a smaller light diamond space appears the effect resembling a
12 plaid design." The registration claims playing cards in International Class 28, issued January
13 9, 1906, sets forth a date of first use of 1885, and is currently valid, subsisting and
14 incontestable.

15 5. Petitioner is the owner of U.S. Trademark Registration No. 153,892 for
16 the design mark shown by the drawing submitted in that registration. The registration claims
17 playing cards in International Class 16, issued March 28, 1922, sets forth a date of first use of
18 1888, and is currently valid, subsisting and incontestable.

19 6. Petitioner is the owner of U.S. Trademark Registration No. 2,694,791
20 for the design mark shown by the drawing submitted in that registration. The registration
21 claims playing cards in International Class 16, issued March 11, 2003, sets forth a date of first
22 use of October 1, 2000, and is currently valid and subsisting.

23 7. Petitioner is the owner of U.S. Trademark Registration No. 3,049,851
for the design mark shown by the drawing submitted in that registration. The registration

1 claims playing cards in International Class 28, issued January 24, 2006, sets forth a date of first
2 use of October 1, 2004, and is currently valid and subsisting.

3 8. Continuously, since long prior to any date upon which Applicant can
4 rely, Opposer and its predecessors in interest have used in commerce the design mark
5 depicted below in connection with playing cards, consisting of repeating parallelograms
6 arranged diagonally.



14 Opposer therefore owns common law trademark rights in this design in connection with
15 playing cards.

16 9. ~~8.~~ Each of Petitioner's registrations and marks identified in Paragraphs
17 4-~~7~~8 herein claims priority to Registrant's marks claimed by Registrations Nos. 3,759,470,
18 3,759,471, 3,759,472 and 3,791,673.

19 10. ~~9.~~ The marks claimed by Registrations Nos. 3,759,470, 3,759,471,
20 3,759,472 and 3,791,673, when used in association with playing cards by Registrant, so
21 resemble Petitioner's Marks described by Paragraphs 2-3 and shown by the registrations and
22 marks identified by Paragraphs 4-~~7~~8 herein as to be likely to cause confusion, or to cause
23

1 mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act 15 U.S.C. §
2 1052(d).

3 11. ~~10.~~ As a result of Petitioner's long-term, substantial and widespread
4 use of the marks shown by the registrations and marks identified by Paragraphs 4-~~7~~8 herein,
5 the marks have become famous, and are thus valuable symbols that serve to identify Petitioner
6 as the source of all playing cards and related goods and services identified by or promoted with
7 the marks.

8 12. ~~11.~~ On information and belief the marks shown by the registrations and
9 marks identified by Paragraphs 4-~~7~~8 herein were previously used by Petitioner and became
10 famous prior to any date upon which Registrant can show use of any of the marks claimed by
11 Registrations Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673.

12 13. ~~12.~~ Each of Registrant's marks claimed by Registrations Nos.
13 3,759,470, 3,759,471, 3,759,472 and 3,791,673 creates a commercial impression that is so
14 similar to the commercial impressions created by Petitioner's marks shown by the registrations
15 and marks identified by Paragraphs 4-~~7~~8 herein as to be likely to cause dilution of the
16 distinctiveness of Petitioner's marks shown by those registrations and marks.

17 14. ~~13.~~ The marks claimed by Registrations Nos. 3,759,470, 3,759,471,
18 3,759,472 and 3,791,673 so resemble Petitioner's marks described by Paragraphs 2-3 herein
19 and shown by the registrations and marks identified by Paragraphs 4-~~7~~8 herein as to cause
20 dilution of the distinctive quality of Petitioner's marks in violation of 15 U.S.C. § 1125(c).

21 15. ~~14.~~ The marks claimed by Registrations Nos. 3,759,470, 3,759,471,
22 3,759,472 and 3,791,673 so resemble Petitioner's famous marks shown by the registrations
23 and marks identified by Paragraphs 4-~~7~~8 herein, which on information and belief have all been
previously used ~~and~~or registered by Petitioner, as to be likely to falsely suggest a connection

1 between Petitioner and Registrant in violation of Section 2(a) of the Lanham Act, 15 U.S.C. §
2 1052(a).

3 16. ~~15.~~ Based upon the foregoing, Registrations Nos. 3,759,470, 3,759,471,
4 3,759,472 and 3,791,673, are currently causing and will continue to cause injury and damage
5 to Petitioner's exclusive rights. Pursuant to 15 U.S.C. § 1092 and 37 CFR 2.111(b), Petitioner
6 requests cancellation of Registrations Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673.

7 WHEREFORE, Petitioner respectfully requests cancellation of the marks claimed by
8 Registrations Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673.

9 ~~Petitioner submits herewith the required fee in the amount of \$1200 and requests~~
10 ~~that any additional fees be charged to Deposit Account No. 04-0258 or any overpayment~~
11 ~~be issued as a credit to Deposit Account No. 04-0258.~~

12 Please direct all correspondence to Stuart R. Dunwoody of Davis Wright Tremaine
13 LLP at the following address:

14 Stuart R. Dunwoody, Esq.
15 Davis Wright Tremaine LLP
16 1201 Third Avenue, Suite 2200
17 Seattle, Washington 98101

18 Please direct all telephone calls to Stuart R. Dunwoody at 206-757-8034.

19 DATED this ~~7~~8th day of ~~June~~September, 2010.

20 Respectfully submitted,

21 DAVIS WRIGHT TREMAINE LLP

22 ~~By /s/ Stuart R. Dunwoody~~
23 ~~Stuart R. Dunwoody~~
~~Cindy L. Caditz~~

Attorneys for Petitioner The United States
Playing Card Company

By /s/ Stuart R. Dunwoody

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CERTIFICATE OF FILING

I hereby certify that this AMENDED PETITION FOR CANCELLATION of U.S. Trademark Registrations Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673 for the marks shown by the drawings submitted in those registrations is being filed with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office on the below date.

Date: June 7, September 8, 2010 /s/ Stuart R. Dunwoody

CERTIFICATE OF SERVICE

I hereby certify that this AMENDED PETITION FOR CANCELLATION of U.S. Trademark Registrations Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673 for the marks shown by the drawings submitted in those registrations is being duly served upon the Registrant and Registrant's Attorney of Record by mailing a copy thereof via the U.S. Postal Service in a sealed envelope as first-class mail with postage thereupon fully prepaid and addressed to:

Angel Playing Cards Co., Ltd.
10-1 Kawarayamachi 2-Chome
Chuo-ku, Osaka
JAPAN

And to:

Neil M. Zipkin
Anthony Lo Cicero
Holly Pekowsky
Amster Rothstein & Ebenstein LLP
90 Park Ave Floor 21
New York, NY 10016

Date: June 7, September 8, 2010 /s/ Stuart R. Dunwoody

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