

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: August 31, 2015

Cancellation No. 92053315

American University

v.

The American University for Science and
Technology

**Robert H. Coggins,
Interlocutory Attorney:**

Now before the Board is Petitioner's motion (filed April 8, 2015) for leave to amend the petition for cancellation. Respondent filed a brief in opposition thereto.

Motion to Amend

Petitioner moves to amend the petition to add Count IV (fraud), Count V (void *ab initio*), Count VI (failure to make lawful use of mark in commerce), and Count VII (abandonment) as grounds for cancellation.

Leave to amend pleadings must be freely given 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. *See* Fed. R. Civ. P. 15(a)(2). The Board liberally grants such leave. *See* TBMP § 507.02 (2015). In deciding Petitioner's motion for leave to amend, the Board must consider whether there is any undue

delay or prejudice to Respondent and whether the amendments are legally sufficient. *See Octocom Sys. Inc. v. Houston Computer Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990); and *Leatherwood Scopes Int'l Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702-03 (TTAB 2002). *See also, Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (allowing opposer to add the claim that applicant did not have a bona fide intention to use the mark in commerce on the specified goods and services when it filed several applications).

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a major factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. *See Commodore Electronics Ltd., supra.* For that reason, a motion for leave to amend should be filed as soon as any ground for such amendment becomes apparent. *See Wright, Miller, Kane, and Marcus*, 6 Fed. Prac. & Proc. Civ. § 1488 (3d ed., April 2015 update); Chapman, “Tips from the TTAB: Amending Pleadings: The Right Stuff,” 81 Trademark Reporter 302, 307 (1991).

Paragraph 12

Before turning to the four new grounds to be added, the Board addresses Paragraph 12 of the amended petition. Paragraph 12 alleges:

In addition to the above marks, Petitioner also owns and uses in interstate commerce other trademarks that feature the elements “American” and “University” for educational services and owns corresponding federal registrations for many of those marks.

The allegation in this paragraph was not present in the original petition. Petitioner now seeks to add the allegation of ownership of unspecified “other” marks

after discovery has closed and over four-and-a-quarter years after the commencement of this proceeding.

The allegation as to unspecified “other” marks is vague and indefinite; it does not provide fair notice of the specific marks on which Petitioner will rely in support of its grounds for cancellation. In addition, Petitioner fails to explain why it did not plead any of the unspecified “other” marks in the original petition. The vagueness of the allegation and the delay in making it without explanation each, by itself, would be reason to deny the motion to amend to add Paragraph 12, but the combination of vagueness and delay makes the denial even stronger. Respondent would be unfairly prejudiced by the inclusion of Paragraph 12 because it is indefinite and Respondent was not on notice that Petitioner would rely on any marks not specified in the original petition filed so long ago. In view thereof, the motion to amend is **denied** to the extent it seeks to add Paragraph 12. Accordingly, Paragraph 12 is **stricken** from the amended petition.

Counts IV-VII

Petitioner states that the amendments to add Counts IV-VII are based on information learned during the March 13, 2015 discovery deposition of Respondent. Inasmuch as the motion to amend was filed April 8, 2015, less than a month after the discovery deposition, the motion to amend is timely to the extent it seeks to add Counts IV-VII. Moreover, inasmuch as the new grounds are based on Respondent’s actions (or lack thereof), any information related to those grounds should be in Respondent’s own possession, custody, or control; therefore, the timing of the motion

is not prejudicial to Respondent even though discovery is now closed. Indeed, Respondent does not argue that there may be any prejudice.

Respondent does not challenge the sufficiency of the newly pleaded grounds; instead, Respondent argues the merits of each ground. A response to a motion to amend a pleading should not address the allegations on their merits. To support its motion to amend Petitioner need not prove the allegations in its pleadings; it is only necessary that Petitioner's allegations be legally sufficient (i.e., they allege facts sufficient to state a claim upon which relief may be granted). In view thereof, Respondent's arguments regarding the merits of Counts IV-VII are inappropriate for purposes of this motion to amend. Similarly, the exhibits to Respondent's brief in opposition to the motion are improper as they purport to demonstrate factual allegations or evidentiary issues relevant to the merits of Counts IV-VII. Respondent is advised that no paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

With regard to the legal sufficiency of the Counts IV-VII, the Board finds that each is legally sufficient. Indeed, as noted above, Respondent does not challenge the legal sufficiency of the new grounds. Petitioner need only allege in its amended pleading a further statutory ground for cancellation. The allegations set forth under Counts V-VI of the amended petition constitute adequate notice pleading of those new grounds, and the allegations set forth under Count IV contain the required

particularity of circumstances under Fed. R. Civ. P. 9(b). In view thereof, the motion to amend is **granted** to the extent it seeks to add Counts IV-VII.

Respondent is allowed until **September 21, 2015**, in which to file an answer to the amended petition, as stricken, failing which the cancellation will proceed in default.¹

Discovery Filings

Respondent's March 10, 2015 filing (a "response" to Petitioner's discovery inquiry) will be given no consideration. As the Board noted in the February 24, 2015 order (at 42 TTABVUE 1, n.1), responses to written discovery requests, including the production of responsive documents, should not be filed with the Board except under limited circumstances not presently at issue. *See* Trademark Rule 2.120(j)(8). Similarly, as noted above, Respondent is reminded that no paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

Pro Se Information for Respondent

Respondent is permitted to represent itself; however, it should be noted that while Patent and Trademark Rule 11.14 permits a corporation to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in a cancellation proceeding to secure the services of an attorney who is familiar with such matters. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of

¹ Respondent need not answer Paragraph 12 which has been stricken hereinabove.

Civil Procedure, is expected of all parties. In view thereof, Respondent is strongly advised to retain trademark counsel.

Schedule

Proceedings are **resumed**. Dates are **reset** on the following schedule:

Answer to Amended Petition Due	9/21/2015
Plaintiff's Pretrial Disclosures	11/5/2015
Plaintiff's 30-day Trial Period Ends	12/20/2015
Defendant's Pretrial Disclosures	1/4/2016
Defendant's 30-day Trial Period Ends	2/18/2016
Plaintiff's Rebuttal Disclosures	3/4/2016
Plaintiff's 15-day Rebuttal Period Ends	4/3/2016

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Heightened Standard Requirement

The requirement for extraordinary circumstances to obtain an extension, suspension, or reopening of time based on settlement remains in effect. *See* February 24, 2015 order (42 TTABVUE 8-9).