

This is not a precedent
of the TTAB.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: November 5, 2016

Cancellation No. 92062923

Topiclear, Inc.

v.

K & N Distributors

By the Trademark Trial and Appeal Board:

This case now comes up for consideration of Petitioner's motion (filed October 4, 2016) for leave to amend the petition to cancel. The motion is fully briefed.

The Board has carefully reviewed the parties' respective arguments with respect to the motion, although the Board has not repeated every argument made by the parties in this order.

Petitioner seeks to amend the petition by including a claim that Respondent's underlying application and resulting registration are "void and unlawful...because there was no lawful use in commerce due to the failure of the Registrant to designate on its packaging or container as received by the ultimate purchaser, the country of origin of the products as required by federal law (19 CFR §134.11)...."

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

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to the rights of the adverse party. *See* Fed. R. Civ. P. 15(a); TBMP Section 507 and cases cited therein. Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Thus, in deciding Petitioner's motion for leave to amend, the Board must consider whether there is undue prejudice to Respondent and whether the amendment is legally sufficient. *See, e.g., Cool-Ray, Inc. v. Eye Care, Inc.* 183 USPQ 618, 621 (TTAB 1974).

Respondent has not asserted a convincing reason why it would be prejudiced by the addition of this claim and the Board is aware of none. In addition, the proposed claim is legally sufficient. In this case, Petitioner has essentially pled that use by Respondent was unlawful under a certain statute of the United States and the resulting registration is, therefore, void. As stated in *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958 (TTAB 1981) ("*Santinine*"), the Board will find use of a mark in commerce unlawful when a court or government agency having competent jurisdiction under the involved statute has previously made a finding of non-compliance or where there has been a *per se* violation of the statute at issue. *See also, General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045 (TTAB 1988).¹ Petitioner's allegations are sufficient for pleading purposes, whether or not

¹ In addition, the *Santinine* decision states that there must be some nexus between the use of the mark and the alleged violation before the unlawfulness in commerce can be said to result in the invalidity of a registration. *See Santinine, supra* at 967.

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Petitioner can actually prove this allegation is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment. See TBMP Section 507.01.

In view thereof, Petitioner's motion for leave to amend is hereby granted. Nevertheless, the Board finds that for purposes of clarity (and to allow the Board to easily review the electronic file) Petitioner must submit a signed copy of the entire amended pleading. It must do so within **ten days** of the mailing date in the caption of this order. Applicant is allowed until **thirty days** from the mailing date in the caption of this order to file an answer to the amended petition.

Proceedings herein are resumed. The remaining dates reset as follows:

Expert Disclosures Due	12/27/2016
Discovery Closes	1/26/2017
Plaintiff's Pretrial Disclosures Due	3/12/2017
Plaintiff's 30-day Trial Period Ends	4/26/2017
Defendant's Pretrial Disclosures Due	5/11/2017
Defendant's 30-day Trial Period Ends	6/25/2017
Plaintiff's Rebuttal Disclosures Due	7/10/2017
Plaintiff's 15-day Rebuttal Period Ends	8/9/2017

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.