

ESTTA Tracking number: **ESTTA901894**

Filing date: **06/07/2018**

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

Proceeding	92067247
Party	Defendant Daesang Corporation
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Date	06/07/2018
Attachments	Opposition to Motion.pdf(148778 bytes)

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

CHEF ONE CORPORATION,
Petitioner,

v.

DAESANG CORPORATION,
Respondent.

Proceeding no. 92067247

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

Respondent Daesang Corporation (“Respondent”), by its attorney, submits this Opposition to Petitioner’s Motion to Amend Petition for Cancellation.

I. STATEMENT OF FACTS

On November 1, 2017, Petitioner filed the Petition for Cancellation (“Petition”) pleading U.S. Trademark Registration Nos. 2573505, 3472727, 5146262 and 5283788 as bases of the likelihood of confusion ground in the Petition. Thereafter, on February 14, 2018, Respondent filed its Answer and Counterclaim, the Counterclaim requesting cancellation of U.S. Trademark Registration Nos. 5146262 and 5283788 (“Registrations ’262 and ’788”), based on lack of bona fide use. On May 18, 2018, more than six months after the filing of the Petition and past the due date of 21 days after filing of the Respondent’s Answer, the Petitioner filed a Motion to Amend Petition for Cancellation (“Motion to Amend”) moving the Board to allow removal of Registrations ’262 and ’788 from the pleaded registrations in the Petition and to introduce a previously unpleaded registration, U.S. Registration No. 3,303,188, into the record of the proceeding.

II. LEGAL STANDARD

A Petition for Cancellation may be amended at this stage in the proceeding only upon leave of the Board; and such leave must be freely given when justice so requires. *See* TBMP §507.01(a)(2). However, in exercising this discretion, the Board must consider such factors as undue delay, bad faith, or dilatory motive on the part of the movant, undue prejudice to the opposing party by virtue of allowance of the amendment and futility of the amendment. *See Foman v. Davis*, 371 U.S. 178, 182, 83 S. Ct. 227, 9 L. Ed. 2d 222, 6 Fed. R. Serv. 2d 1234 (1962). Any party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion. *See International Finance Corporation v. Bravo Company*, 64 U.S.P.Q.2d 1597, 1604, 2002 WL 1258278 (T.T.A.B. 2002).

III. ARGUMENT

1) Petitioner Unduly Delayed Bringing the Motion to Amend

Petitioner brings this Motion to Amend six months after filing the Petition. The Motion to Amend moves to remove Registrations ‘262 and ‘788 from the pleaded registrations in the Petition and to introduce previously unpleaded Registration ‘188 into the record. The Board should deny this motion on its face as being untimely for the following reasons.

The Motion to Amend includes no explanation of the reasons for the delay in making the request to amend the Petition. An unexplained delay in filing a motion to amend a pleading may result in a finding that the amendment is untimely. *See Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016); *Jive Software, Inc.*, 125 U.S.P.Q.2d 1175 (T.T.A.B. Dec. 20, 2017); *Trek Bicycle Corporation v. Styletrek Limited*, 64 U.S.P.Q.2d 1540, 1541, 2001 WL 1869327 (T.T.A.B. 2001) (motion based on facts known to opposer for nine months denied due to

unexplained delay). The burden to explain a delay in filing the motion to amend is on the party that seeks leave to amend. *Trek Bicycle, supra*, 64 U.S.P.Q.2d at 1541.

Petitioner had sufficient facts to conclude whether there were reasonable grounds for finding likelihood of confusion between Registrations ‘262 and ‘788 and the mark in the Respondent’s Registration no. 4787760 and whether to include Registration ‘188 into the record, at the time of filing the Petition. Petitioner filed the Petition based on the ground of likelihood of confusion and included Registrations ‘262 and ‘788 and excluded Registration ‘188, in the pleaded registrations or in the Petition. More than six (6) months after alleging this ground, Petitioner stated in the Motion to Amend that Registrations ‘262 and ‘788 are “not at all relevant to Petitioner’s basis for seeking cancellation”, or in other words, that “there is no likelihood of confusion” between the two registrations and Respondent’s registration (Motion to Amend, at 2) and introduced Registration ‘188 in the proposed First Amended Petition for Cancellation. The Motion to Amend shows that Petitioner has changed its course of action in the Petition with regards to the three registrations completely therefore. Petitioner points to no newly discovered evidence of sufficient justification to explain why Petitioner has made this change in course of action with a six-month delay.

The Board may deny a motion to amend if the motion does not provide any explanation or sufficient justification as to why the movant failed to incorporate the amended version at the time of filing the pleading when the movant “had in its possession sufficient facts to allege such claims and/or through reasonable effort could have known of these claims.” *See Kellogg Co. & Kellogg N. Am., Assignee Shakespeare Co., LLC*, OPPOSITION 91154502, 2005 WL 1581551, at *3 (June 30, 2005); *Trek Bicycle Corp.*, 64 U.S.P.Q.2d 1540 (T.T.A.B. Dec. 19, 2001); *S&L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987); *Media Online Inc. v. El*

Clasificado Inc., 88 USPQ2d 1285, 1286 (TTAB 2008). A long and unexplained delay in filing a motion to amend a pleading when there is no question of newly discovered evidence may render the amendment untimely. See TBMP § 507.02(b); *Rlp Ventures, LLC*, 91228593, 2017 WL 4054467, at *3 (Sept. 8, 2017). The Board has held that a motion for leave to amend should be filed as soon as any grounds for such amendment becomes apparent. *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001); *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, 1286–87, 2008 WL 4419361 (T.T.A.B. 2008) (motion denied where movant waited *seven* months from learning facts and after nonmovant filed motion for judgment). Further, the Board has held that a motion to amend pleading to add a newly registered mark as a pleaded registration without sufficient explanation for the delay will be denied for undue delay. See *Kellogg Co. & Kellogg N. Am., Assignee Shakespeare Co., LLC*, OPPOSITION 91154502, 2005 WL 1581551, at *3 (June 30, 2005) (motion to amend to add a newly registered mark as a pleaded registration with no explanation for the delay denied for undue delay).

It is clear therefore that as Petitioner failed to make satisfactory showing of the reason for the delay the Motion to Amend should be denied.

2) Granting Motion to Amend Will Cause Respondent Prejudice

Granting the Motion to Amend at this stage of the proceeding will unduly prejudice Respondent.

Respondent gave careful thought to the claims made in the Petition for Cancellation and relied on the same in order to prepare and devise its answer, affirmative defenses and counterclaims and its course of action in the proceeding. It would be prejudicial to Respondent to now grant Petitioner's request to remove Registrations '262 and '788 since it would nullify Respondent's counterclaim and require Respondent to undertake a new course of defense.

Further, introduction of a previously unpleaded Registration ‘188 would be prejudicial because Respondent would have to consider a new allegation of claim of ownership of a mark and change its course of defense. Alternatively, if Petitioner is not intending to add Registration ‘188 as a pleaded registration, introducing it into the record as evidence is still prejudicial as it is relevant to the duPont factor of fame of the mark and would require Respondent to take a new course of defense.

It is fundamental to a trademark registrability proceeding that, when the plaintiff pleads registrations in the complaint, the defendant will give immediate and careful thought to whether it knows of grounds for cancellation of those pleaded registrations before filing its answer. *Jive Software, Inc.*, 125 U.S.P.Q.2d 1175 (T.T.A.B. Dec. 20, 2017). The Board has held that if the motion for leave to amend filed with delay alters the nature of the litigation and requires defendant to undertake an entirely new course of defense, there would be undue prejudice to defendant. *Morongo Band of Mission Indians v. Rose*, 893 F.2d 1074, 1079 (9th Cir.1990); *Gibson Brands, Inc. v. John Hornby Skewes & Co.*, No. CV 14-00609 DDP (SS), 2015 WL 4651250, at *6 (C.D. Cal. Aug. 4, 2015).

3) Petitioner’s Delay Not Due to Oversight, Inadvertence, or Excusable Neglect

Petitioner has made no attempt to excuse its delay due to an oversight, inadvertence, or excusable neglect. See, e.g., *Whitaker v. City of Houston, Tex.*, 963 F.2d 831, 836, 23 Fed. R. Serv. 3d 365 (5th Cir. 1992) (at some point delay becomes procedurally fatal and movant must show that delay was due to oversight, inadvertence, or excusable neglect; leave denied because lack of due diligence in moving to amend). Petitioner had at least since the time of filing the Petition, the facts sufficient to determine the bases of the grounds and pleaded registrations for the Petition. Petitioner completely ignores the fact that it waited six (6) months after it knew of the

underlying facts supporting the Motion to Amend, and after Respondent filed the Answer and Counterclaim against Registrations ‘262 and ‘788. Accordingly, Petitioner lacked the due diligence in moving to amend and the Board should deny the Motion to Amend.

4) **In the Alternative, Respondent Seeks Reasonable Time to Amend its Answer and Counterclaim**

In the alternative, Respondent moves the Board to allow reasonable time to amend its answer and counterclaim should the Board decide to grant Petitioner’s Motion to Amend.

IV. CONCLUSION

For the foregoing reasons, Respondent respectfully requests that the Motion to Amend be denied.

Dated: June 7, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 7, 2018, I served a copy of the foregoing RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO AMEND PETITION FOR CANCELLATION, upon Petitioner's attorney of record by e-mail at acarroll@mayerbrown.com and ipdocket@mayerbrown.com.

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