

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
General Email: TTABInfo@uspto.gov

Baxley

August 15, 2022

Cancellation No. 92078502

Flamel Ireland Limited

v.

Rethink Creative Group LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Petitioner's motion (filed July 25, 2022, 13 TTABVUE) for leave to file an amended petition to cancel. Respondent has filed a brief in response thereto. Although Petitioner's time to file a reply brief has not lapsed, the Board, having heard from both parties, elects to decide the motion now. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto").

At this stage of the proceeding, Petitioner may amend the petition to cancel only by written consent of Respondent or by leave of the Board; leave must be freely given when justice so requires. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02 (2022). As a general policy, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would

violate settled law or be prejudicial to the rights of the adverse party. See TBMP § 507.02. Where a movant seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, the Board normally will deny the motion for leave to amend. *See Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000); TBMP § 507.02.

Petitioner, through its motion and based on information it received in discovery, seeks to add a claim of nonuse on September 20, 2019 when Respondent filed its statement of use in the application for the involved registration. Because Petitioner filed its motion with three months left in discovery, the Board finds that Petitioner did not unduly delay in seeking to amend the petition to cancel.

However, a nonuse claim based on a statement of use must be based on nonuse prior to the expiration of time to file a statement of use, rather than nonuse when the statement of use was filed.¹ *See Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1524-26 (TTAB 2016). *See also Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1064 (TTAB 2017) (nonuse as of the statement of use deadline provides an “independent basis to cancel Respondent's registration.”). The notice of allowance issued in the application for the involved registration on March 26, 2019. Thus, a nonuse claim in this instance must be based on nonuse in commerce by September 26, 2019, not September 20, 2019, as alleged in the proposed

¹ Respondent, in its brief in opposition, argues the merits of the proposed additional claim. 14 TTABVue 3. Whether Petitioner can prove the proposed additional claim would be a matter for resolution on the merits at trial or upon timely filed motion for summary judgment. *See Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992).

amended petition. 13 TTABVUE 19. *See* Trademark Rule 2.88(a). In view of the foregoing, the motion for leave to amend is denied without prejudice.

Dates herein are reset to place the parties roughly where they stood on July 25, 2022, when Petitioner filed its motion for leave to amend.

Expert Disclosures Due	10/14/2022
Discovery Closes	11/13/2022
Plaintiff's Pretrial Disclosures Due	12/28/2022
Plaintiff's 30-day Trial Period Ends	2/11/2023
Defendant's Pretrial Disclosures Due	2/26/2023
Defendant's 30-day Trial Period Ends	4/12/2023
Plaintiff's Rebuttal Disclosures Due	4/27/2023
Plaintiff's 15-day Rebuttal Period Ends	5/27/2023
Plaintiff's Opening Brief Due	7/26/2023
Defendant's Brief Due	8/25/2023
Plaintiff's Reply Brief Due	9/9/2023
Request for Oral Hearing (optional) Due	9/19/2023

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at

final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing.

Note: Parties are strongly encouraged to check the entire document before filing.² The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

² To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.