UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

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Mailed: November 9, 2009

Opposition No. 91183919

Boucheron Holding

v.

Second Wind Consulting, Inc.

**Before Walters, Zervas and Bergsman, Administrative Trademark Judges.**

**By the Board:**

Second Wind Consulting, Inc. ("applicant") seeks to register the stylized mark shown below for a wide variety of personal care, body and beauty products and preparations for cleansing, hygiene and cosmetic purposes in International Class 3.[1]

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Applicant is proceeding pro se in this opposition.

Boucheron Holding ("opposer") filed an opposition thereto, alleging the grounds of deceptiveness and false suggestion of a connection, both under Trademark Act Section 2(a), as well as priority and likelihood of confusion under Trademark Act Section 2(d). Opposer pleaded ownership and prior use of the common law mark shown below for "perfume,

body lotion, body cream, aftershave, aftershave balm, body shampoo, deodorant stick for personal use, shower gel, eau de-toilette, eau de-cologne, deodorants for personal use, essential oils, oils for cosmetics and toilet purposes, bath soaps, cosmetic soaps, perfumed soaps, hand soaps, cleansing milk for toilet purposes, cosmetics, make-up and make-up removing preparations, cosmetic preparations for skin and hair care purposes, cosmetic preparations for slimming purposes, sun-tanning preparations, cosmetic preparations for baths, beauty masks, hair lotions, cosmetic kits comprised of lipstick, lip gloss, mascara and eye liner, cosmetic creams, incense, joss sticks, aftershave lotions, shaving preparations, nail varnish and shampoos," in International Class 3.[2]

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In its answer, applicant denied the salient allegations in the notice of opposition.

This proceeding is before the Board for consideration of 1) applicant's motion (filed September 1, 2009) for leave to amend its answer; and 2) opposer's and applicant's cross-

[1] Application Serial No. 77254137, filed August 13, 2007, alleging a bona fide intent to use the mark in commerce pursuant to Trademark Act Section 1(b).

[2] Opposer also claims Trademark Application Serial No. 77420327, filed March 12, 2008, based on Trademark Act Sections 1(a) and 44(e), and alleging a date of first use of January 1, 1994, and date of first use in commerce of January 5, 2005. However, this later-filed application may not be the basis for opposer's claim of priority and likelihood of confusion. Thus, the opposition on this basis is limited to opposer's claim of a previously used common law mark.

motions (filed June 22, 2009 and July 27, 2009, respectively) for summary judgment. The motions have been fully briefed.[3]

**Motion for leave to amend answer**

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15, made applicable to Board proceedings by operation of Trademark Rule 2.116(a). Trademark Rule 2.107. After a responsive pleading has been filed, a party may amend its pleading only by written consent of every adverse party, or by leave of the Board. Leave shall be freely given when justice so requires. *See* Fed. R. Civ P. 15(a). 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 or parties. *See* TBMP § 507.01 (2d ed. rev. 2004). *See also Hurley International LLC v. Volta,* 82 USPQ2d 1339, 1341 (TTAB 2007).

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. The motion should be filed as soon as any ground for such amendment becomes apparent. *See Commodore*

[3] Applicant's brief in response to opposer's motion for summary judgment exceeds the page limit set forth in Trademark Rule 2.127(a). Furthermore, opposer objected to applicant's brief on this basis. Accordingly, we have not considered the brief. *See Saint-Gobain Corp. v. Minnesota Mining and Mfg., Co.*, 66 USPQ2d 1220 (TTAB 2003). Nevertheless, we have still reached the merits of opposer's motion based on the evidence submitted.

*Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

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, 1785 (Fed. Cir. 1990).

By its motion, applicant seeks leave to add "a new defense of fraud," "a new defense of abandonment," "a new defense that the Opposer's mark is an unregistrable primary (sic) geographically deceptive (sic) misdescriptive mark," and "a new defense, in that the Opposer does not sell JAIPUR (attributed to the specimen) submitted with the application in United States."

To the extent that applicant was dissatisfied with any discovery responses it obtained, applicant never sought Board intervention by way of, for example, a motion to compel discovery under Trademark Rule 2.120(e), or took other appropriate action designed to address discovery issues.

Turning to the timing of the motion to amend, we note that applicant filed its motion to amend after opposer filed its summary judgment motion, after applicant filed its cross-motion for summary judgment, and after opposer's testimony period commenced. Applicant did not seek to amend

its answer until over four months after discovery closed. Thus, applicant's motion is untimely.

Further, at this late date in the proceeding, allowing an amended answer raising new defenses would significantly delay this proceeding and would prejudice opposer.

In view of these circumstances, applicant's motion for leave to file an amended answer is denied. Therefore, we do not address the viability of applicant's proposed "defenses." The answer filed on June 16, 2008 remains applicant's operative answer.

**Motions for summary judgment**

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

A party seeking summary judgment bears the initial burden of demonstrating the absence of any genuine issue of material fact, and its entitlement to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to

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