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

Proceeding	91221569
Party	Plaintiff Snapchat, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. **86/358,450**
For the mark: **SCRAP CHAT**
Filed: August 6, 2014
Published: January 20, 2015

SNAPCHAT, INC.,	:	
	:	Opposition No. 91221569
Opposer,	:	
	:	
v.	:	
	:	
JUSTIN SCHWARTZ,	:	
	:	
Applicant.	:	

OPPOSER SNAPCHAT, INC.'S MOTION AND BRIEF IN SUPPORT FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND TO SUSPEND PROCEEDING

Pursuant to Rule 2.107 of the Trademark Rules of Practice, 37 C.F.R. § 2.107, Trademark Board Manual of Procedure ("TBMP") §§ 315 and 507, and Rule 15(a) of the Federal Rules of Civil Procedure, and on the basis of information recently obtained through discovery, Opposer Snapchat, Inc. ("Opposer" or "Snapchat") respectfully moves the Board for leave to amend its Notice of Opposition against Applicant Justin Schwartz ("Applicant" or "Schwartz") to add a claim that application Serial No. 86/358,450 to register the mark SCRAP CHAT is void *ab initio* because the Applicant currently does not own the SCRAP CHAT mark and did not own that mark as of the filing date of the application, as required by 15 U.S.C. § 1051(a) and 37 C.F.R. § 2.71(d).

In accordance with TBMP § 507.01, a signed copy of the proposed Amended Notice of Opposition is attached as **Exhibit A**, and a redlined copy of the Amended Notice of Opposition, showing the proposed changes from the original Notice of Opposition, is attached as **Exhibit B**.

Additionally, pursuant to 37 C.F.R. § 2.117(c) and TBMP § 510.03, Snapchat requests

that the Board suspend this proceeding pending disposition of Snapchat's Motion for Leave to Amend its Notice of Opposition (the "Motion").

Snapchat's counsel requested Applicant's consent to this amendment on February 26, but as of the filing of this Motion has not yet received a substantive response, despite several attempts to follow up with Applicant's counsel regarding this issue. *See* Declaration of Robert Potter ("Potter Decl.") ¶ 2, Ex. 1. Given the passage of two weeks since Snapchat initially requested Applicant's consent, Snapchat had no choice but to file the present Motion to avoid any further delay.

I. FACTS AND PROCEDURAL HISTORY

On August 6, 2014, Applicant filed a use-based application to register the mark SCRAP CHAT for "computer application software for mobile phones, tablets, and handheld computers, namely, software for allowing users to share pictures, videos, links, and other content and lets them post them to their own pages if they enjoy the content" in Class 9, claiming a date of first use in commerce of January 2, 2014 (Serial No. 86/358,450) (the "Application"). Snapchat timely filed a Notice of Opposition against the Application on April 20, 2015, objecting on likelihood of confusion grounds. *See* Dkt. No. 1.

As part of ongoing discovery between the parties, counsel for Snapchat took Applicant's deposition on January 6, 2016. *See* Potter Decl. ¶ 3, Ex. 2.[1] Applicant's deposition testimony revealed that Applicant was not the current owner of the SCRAP CHAT mark, that Applicant was not the owner of the SCRAP CHAT mark on the filing date of the Application, and that,

[1] Although discovery in this proceeding closed on December 26, 2015, the parties stipulated – and the Board granted – a thirty (30) day extension of this deadline for the limited purpose of taking Applicant's deposition, which had been properly noticed within the discovery period, but which ultimately was scheduled for January 2016 to accommodate Applicant's schedule. *See* Dkt. Nos. 5-6.

instead, the mark is and always has been owned by Keatman Inc. ("Keatman"), an active New York corporation.[2]

Specifically, among other related statements, Applicant testified that Keatman is the owner of the SCRAP CHAT mark and the application to register that mark with the USPTO:

> Q: Does Keatman own the SCRAP CHAT application?
>
> A: Yes.
>
> Q: Does Keatman own the mark you've applied for to register SCRAP CHAT?
>
> A: Yes.
>
> Q: Does Keatman own that mark 100 percent?
>
> A: I believe so.

Potter Decl. ¶ 3, Ex. 2 at 17:11-18.

Consequently, and based on this, it appears that Applicant is not, and has never been, the owner of the SCRAP CHAT mark. Under these circumstances, Snapchat respectfully requests that the Board grant Snapchat leave to amend its Notice of Opposition to include a claim that the Application is void *ab initio* because Applicant did not own the SCRAP CHAT mark as of the filing date of the Application.

II. ARGUMENT AND CITATION OF AUTHORITY

Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action. *See* 37 C.F.R. § 2.107; TBMP §§ 315 and 507. Rule 15(a) of the Federal Rules of Civil Procedure provides that a party may amend its pleading by leave of court, which should be freely given when justice so requires. Fed. R. Civ. P. 15(a). The Trademark

[2] Documents filed with the Department of State for the State of New York on June 3, 2013 confirm that Keatman was an active New York corporation on the filing date of the Application and that it remains an active New York corporation as of the filing date of this Motion. *See* Potter Decl. ¶ 4, Ex. 3.

Trial and Appeal Board Manual of Procedure provides that "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." TBMP § 507.02; *see also, e.g.*, *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (T.T.A.B. 1993) (granting leave to include a claim that applicant lacked a *bona fide* intent to use the mark in commerce); *Combs v. Pac. Rim Mktg. Inc.*, Opp. No. 91187342, 2010 WL 5522991, at *2 (T.T.A.B. Dec. 16, 2010); *Am. Univ. v. Van Niekerk*, Can. No. 92040938, 2003 WL 22970623, at *1-2 (T.T.A.B. Dec. 15, 2003). Here, entry of the proposed Amended Notice of Opposition would neither violate settled law nor be prejudicial to Applicant's rights.

A. Justice Requires that Snapchat's Motion for Leave to Amend Its Notice of Opposition Be Granted

Numerous Board decisions have granted motions for leave to amend an opposer's notice of opposition to add various claims based on facts developed during or after the discovery period, including the claim that the application at issue was void *ab initio*. *See, e.g.*, *PB Brands, LLC v. KRBL Ltd.*, Opp. No. 91197238, 2013 WL 11247071, at *1 (T.T.A.B. Dec. 5, 2013) (granting motion for leave to amend answer to add several counterclaims, including counterclaim that "the application underlying opposer's pleaded registration was filed by the wrong applicant and therefore is void *ab initio*"); *McCauley v. Jillybeans Shoes Corp.*, Can. No. 92056192, 2013 WL 11248342 (T.T.A.B. Dec. 13, 2013) (granting motion to amend petition for cancellation to add claim that registration was void because respondent was not using its mark in commerce as of the filing date of the application); *Combs*, 2010 WL 5522991 (granting opposer's motion for leave to amend to add claim that application was void *ab initio* because applicant did not use mark in commerce prior to filing date of application); *Universal City Studios, LLP v. Valen Brost*, Opp. No. 91153683, 2004 WL 1957207 (T.T.A.B. Aug. 18, 2004) (granting opposer's

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