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

PIONEER KABUSHIKI KAISHA d/b/a)
PIONEER CORPORATION,)
)
Opposer,)
)
v.)
NISSEI SANGYO AMERICA, LTD. n/k/a)
HITACHI HIGH TECHNOLOGIES AMERICA,)
INC.,)
)
Applicant.)

Opposition No. 125,458
Mark: SUPERSCAN ELITE
Serial No.: 76/208,230
Published: March 19, 2002



02-21-2003

U.S. Patent & TMOfc/TM Mail Rcpt.Dt. #72

APPLICANT'S SUR-REPLY BRIEF
CONCERNING OPPOSER'S MOTION TO COMPEL

Opposer, Pioneer, has asked the Board to accept and consider its Reply Brief filed on February 5, 2003, relating to the Opposer's Motion to Compel. Applicant, Hitachi High Technologies America, Inc. ("Applicant") likewise requests the Board to accept and consider this sur-reply if it accepts Opposer's brief. Opposer has raised new information, and Applicant requests the opportunity to respond.

The Motion to Compel is Still Moot

In its Response filed November 14, 2002, Applicant argued that the Motion to Compel was moot. Applicant's October 28, 2002 letter to Opposer stated that "... we will provide to Pioneer all requested materials and information that Hitachi High Technologies has in its possession related to the use of the mark SUPERSCAN ELITE for computer monitors." The letter also noted: "However, please be advised that some of the requested information may not be available to Hitachi High Technologies due to a recent corporate restructuring." This referred to the fact that in April,

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2000, Applicant divested the business operations of the computer monitor business to Hitachi America, Ltd., a separate entity from Applicant.

Subsequent to filing that Response, Applicant discovered it had numerous boxes of documents relating to the computer monitor operations. Applicant advised Pioneer's counsel of these documents and offered to make the documents available for inspection. Pioneer's counsel has requested to review the documents on March 5, 2003, and Applicant has agreed to make the documents available for inspection on or before that date.

In the meantime, Pioneer's counsel conducted a 30(b)(6) deposition of Hitachi America, Ltd., the entity which took over the business operations relating to the sale of Superscan Elite computer monitors. Mr. Richard Berman testified about the sales, advertising, channels of trade, etc., of Superscan Elite computer monitors both before and after the time the operations were divested to Hitachi America, Ltd. Mr. Berman also produced three large boxes of documents containing information, including sales reports relating to the computer monitor business.

Opposer's letter of January 24, 2003 (Exhibit B to Opposer's Brief), demanding supplemental responses, contained a fundamental misunderstanding. Opposer was under the impression that Applicant had used the mark Superscan Elite on 13" televisions. Applicant's counsel explained by letter dated January 27, 2003 (Exhibit C to Opposer's Brief), that Superscan Elite has not yet been used on televisions.

Applicant no longer conducts the computer monitor operations, and has no information beyond what is contained in the documents to be produced on March 5, 2003. Any documents requested by Pioneer which are in Applicant's custody or control will be in that production. Information in response to any interrogatories for which Opposer seeks supplemental responses can

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be derived from those documents by Opposer pursuant to Rule 34(d) of the Federal Rules of Civil Procedure. Thus, Opposer's Motion to Compel is still moot, since the recently discovered documents are being made available to Opposer.

Finally, it must be noted that the information concerning Superscan Elite computer monitors is of marginal relevance to the issues in this Opposition Proceeding. Although Applicant owns the registration of Superscan Elite for computer monitors, Reg. No. 1,888,264, issued April 11, 1995, that mark is not the target of this Opposition and Applicant is not claiming any priority for its pending application on the basis of that prior registration.

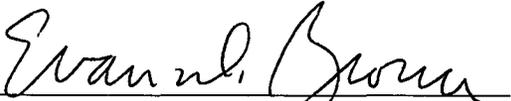
Respectfully submitted,

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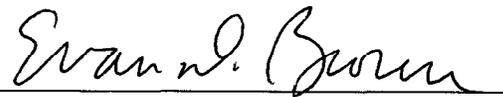
CERTIFICATE OF MAILING

I hereby certify that the foregoing Applicant's Sur-reply Brief Concerning Opposer's Motion to Compel is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to BOX TTAB NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on **February 18, 2003**.


Evan D. Brown

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Sur-reply Brief Concerning Opposer's Motion to Compel is being transmitted by facsimile to 310-782-9579, and is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to Robert J. Skousen, Esq., SKOUSEN & SKOUSEN, 12400 Wilshire Blvd., Suite 900, Los Angeles, California 90025-1060 on **February 18, 2003**.


Evan D. Brown