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

Proceeding	91176065
Party	Defendant H. Co. Computer Products
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Attachments	Mtn to Amend Counterclaim to Allege Fraud (HCCP).pdf (5 pages)(153241 bytes)

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

Lenovo (Singapore) PTE Ltd. Opposer, v. H. Co. Computer Products Applicant.	Opposition No. 91176065
AND RELATED COUNTERCLAIM	

MOTION TO AMEND COUNTERCLAIM TO ALLEGE FRAUD

Pursuant to Rules 13 and 15 of the Federal Rules of Civil Procedure and Rules 2.107 and 2.115 of the Trademark Rules of Practice, H. Co. Computer Products ("HCCP") moves to amend its counterclaim in the above-captioned consolidated proceedings to assert a claim for fraud on the Patent and Trademark Office. HCCP only recently became aware of evidence supporting this claim and therefore could not have brought the claim when it originally filed its counterclaim. HCCP therefore respectfully requests that the Board enter the First Amended Counterclaim filed concurrently with this motion.

This motion is based on the Points and Authorities put forth below, as well as the complete records and files of this proceeding, and any other oral or documentary evidence that may be relevant.

MEMORANDUM OF POINTS AND AUTHORITIES

I. LEGAL STANDARD FOR AMENDING COUNTERCLAIMS

Pleadings in opposition and cancellation proceedings may be amended in the same manner and in the same extent as in a civil action in a United States district court. 37 C.F.R. §§ 2.107, 2.115. Leave to amend a party's pleadings should be freely given when justice so requires. Fed. R. Civ. P. 15(a)(2); *see also* Fed. R. Civ. P. 13(f) (leave to amend pleadings to add counterclaim should be granted when justice so requires). If the grounds for a counterclaim to cancel an opposer's registration are known when the answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. 37 C.F.R. § 2.106(b)(2)(i). If, however, during the proceeding, the defendant learns of the grounds for a counterclaim to cancel a registration pleaded by opposer, the counterclaim should be pleaded promptly after the grounds for the claim have been learned. *Id.*; *see also Marshall Field & Co. v. Mrs. Field's Cookies*, 17 U.S.P.Q. 2d 1355 (T.T.A.B. 1989) (counterclaim was pleaded promptly after defendant obtained information through discovery concerning possible fraud). In this instance, leave to amend should be granted because HCCP only recently became aware of the basis for its claim for fraud.

II. THE FACTS SUPPORT GRANTING LEAVE TO AMEND

HCCP requests that it be granted leave to amend its counterclaim to add a claim for fraud on the Patent and Trademark Office. In support of this motion, HCCP submits the following:

1. HCCP owns United States Trademark Application Serial Nos. 78/636,480 (the "HCCP Application").
2. On February 21, 2007, Lenovo filed a defective notice of opposition on the basis of priority of use and likelihood of confusion. Lenovo based its opposition on a number of registrations.

3. On April 13, 2007, HCCP filed a motion to dismiss Lenovo's defective notice of opposition.

4. On May 5, 2007, Lenovo filed a motion to amend its pleadings and lodged with the Board an amended notice of opposition.

5. On May 8, 2007, the Board issued an order stating that HCCP's motion to dismiss was moot in light of Lenovo's amended notice of opposition.

6. On June 7, 2007, HCCP filed an answer and counterclaim for cancellation on the basis of priority and likelihood of confusion.

7. On September 5, 2007, Lenovo filed a motion for a more definite statement in connection with HCCP's counterclaim.

8. The Board suspended proceedings until August 21, 2008, when it issued an order granting in part Lenovo's motion for a more definite statement. In that order, the Board directed HCCP to allege certain aspects of its counterclaim with additional particularity.

9. On September 10, 2008, HCCP filed an amended counterclaim that it believed complied with the Board's August 21, 2008 order.

10. On November 6, 2008, Lenovo filed a motion to dismiss HCCP's counterclaim for failure to state a claim upon which relief could be granted. The Board granted Lenovo's motion on June 30, 2009 and gave HCCP leave to amend its counterclaim.

11. HCCP is filing concurrently with this motion its amended counterclaim for priority of use and likelihood of confusion. HCCP is also filing a counterclaim for fraud on the PTO.

12. Although proceedings have been suspended, HCCP has undertaken discovery efforts and has been investigating Lenovo's use of its asserted trademarks.

13. As is explained in HCCP's proposed amended counterclaim, HCCP has now become aware of information indicating fraud on the PTO by Lenovo during prosecution of the applications that matured into Registration Nos. 2,678,462; 2,931,692; and 2,995,709.

14. This proceeding is still in the proceedings stage. Thus, discovery is ongoing, and there is thus no danger of prejudice to the parties if the Board allows HCCP to amend its counterclaim to include this fraud claim.

15. Because the parties have not engaged in formal discovery due to the early stage of this proceeding, HCCP could not have learned of Lenovo's fraud any earlier than it did.

HCCP is seeking leave to assert its newly discovered counterclaim promptly after having discovered the basis for it. Granting HCCP leave to amend its counterclaim in these proceedings is in the interest of justice, and HCCP therefore respectfully requests leave to amend its counterclaim and requests that the Board enter HCCP's First Amended Counterclaim. If the Board denies this motion, HCCP requests that the Board accept its counterclaim for priority and likelihood of confusion and that it strike without prejudice the counterclaim for fraud.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date

7/20/09

By

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CERTIFICATE OF TRANSMISSION AND SERVICE

I certify that on July 20, 2009, the foregoing **MOTION TO AMEND COUNTERCLAIM TO ALLEGE FRAUD** is being electronically filed with:

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

It is further certified that on July 20, 2009, the foregoing **MOTION TO AMEND COUNTERCLAIM TO ALLEGE FRAUD** is being served by mailing a copy thereof by first-class mail addressed to:

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