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

Proceeding	91184197
Party	Defendant POWERTECH INDUSTRIAL CO., LTD.
Correspondence Address	MORTON J. ROSENBERG ROSENBERG, KLEIN AND LEE 3458 ELLICOTT CENTER DR STE 101 ELLICOTT CITY, MD 21043-4178 UNITED STATES rkl@rklpatlaw.com
Submission	Opposition/Response to Motion
Filer's Name	MORTON J. ROSENBERG
Filer's e-mail	rkl@rklpatlaw.com
Signature	/MORTON J. ROSENBERG/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

United Parcel Service of America, Inc., :

Opposer : Opposition No. 91184197

v.

Powertech Industrial Co., Ltd., :

Applicant :

APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO AMEND THE NOTICE OF OPPOSITION

Pursuant to Section 2.127(a) of the Trademark Rules of Practice and Rule 15(a)(3) of the Federal Rules of Civil Procedure, Powertech Industrial Co., Ltd. ("Applicant") respectfully responds and makes objection to the Opposer's Motion to Amend the Notice of Opposition ("Opposition"). Applicant respectfully requests that the Trademark Trial and Appeal Board (TTAB) dismiss Opposer's Motion to Amend the Notice of Opposition to include descriptiveness as a basis for this Opposition.

INTRODUCTION

In the subject proceeding before the TTAB, Applicant respectfully submits that it will be highly prejudicial to Applicant to grant the proposed Opposer's Motion to Amend the Notice of Opposition.

Applicant further respectfully submits that Opposer's delay in making a Motion to Amend the Notice of Opposition to add a further claim (of which the

Opposer was fully aware at the time of the filing of the Opposition) is unwarranted and will not serve the purposes of justice.

The Amended Notice of Opposition includes the allegation that "Applicant's designation "HYBRID GREEN UPS" describes a quality and feature of the proposed goods and therefore is merely descriptive pursuant to 15 USC Section 1052(e)(1). In fact, Applicant has a number of Registrations on the Principal Register using "HYBRID GREEN" which has been used continuously in commerce within the United States with the marks being in current use and would be prejudiced if Opposer's Motion to Amend was granted.

Opposer has had an extended period of time to analyze Applicant's Responses during and after the Discovery Period of this proceeding and has chosen on the last day of its Testimony Period to request an amendment to the originally filed Notice of Opposition.

The entire proceeding has been based on Opposer's and Applicant's use of the letters "UPS". No other issues have previously been presented and Opposer has now taken the opportunity to introduce additional issues to this proceeding subsequent to Discovery having closed.

Opposer has had full knowledge of Applicant use of the words "HYBRID GREEN" at least as early as the filing of the Notice of Opposition on 19 May 2008 wherein the Basis of Opposition was "deceptiveness, false suggestion of a connection, dilution and likelihood of confusion". No mention was made in the

Notice of Opposition as to any possible issue with respect to the words "HYBRID GREEN".

Accordingly, Applicant respectfully submits that "justice" would only be served by the TTAB in dismissing Opposer's Motion to Amend the Notice of Opposition since, in fact, Applicant will be highly prejudiced by Opposer amending the Notice of Opposition at this late date in the proceeding, and Opposer's unconscionable delay in filing the Motion to Amend the Notice of Opposition.

STATEMENT OF FACTS

Opposer filed a Notice of Opposition to registration of Applicant's U.S. Serial No. 77/176,134 for the mark "HYBRID GREEN UPS" on 19 May 2008. The basis of the Notice of Opposition was "deceptiveness, false suggestion of a connection, dilution and likelihood of confusion". Opposer pled seventeen of its Federal Registrations which all included the letters "UPS". No disclosure, reference, or mention was made of Applicant's word "HYBRID GREEN" at the time of filing of the Notice of Opposition.

Counsel for the parties agreed to accept Service of Discovery by e-mail as if served by U.S. mail. Apparently, on 26 January 2009, Opposer served Interrogatories/Request for Admissions/Document Requests on Applicant by e-mail on the last day permitted for the serving of such Discovery request.

Applicant did not receive Opposer's e-mails since the e-mails were not properly addressed to Applicant's attorneys e-mail address: rkl@rklpatlaw.com.

Opposer's counsel contacted Applicant's attorney on 5 March 2009 and was informed that Applicant's attorney did not receive the e-mails and thus, Opposer agreed to provide duplicate copies of Opposer's Discovery Request and permit Applicant additional time to respond. Both parties cooperated to reset the Testimony Period to allow this Post-Discovery Period activity.

Applicant served its Responses to Opposer's Discovery Request on 16 April 2009 which were apparently received by Opposer on 20 April 2009.

Opposer's Testimony Period ended on 23 June 2009 and thus, had Applicant's Responses for over two months and did not take any action until the last day of Opposer's Testimony Period with a filing of Opposer's Motion to Amend the Notice of Opposition and a Motion to Extend Opposer's Testimony which were both filed on the last day of Opposer's Testimony Period.

ARGUMENT

Rule 15(a)(2) provides that a party may amend its pleadings by leave of court and that leave shall be freely given when justice so requires, FRCP 15(a). The TTAB may amend pleadings at any stage of the proceeding when justice so requires, unless entry of the proposed amendment would violate set of law or be prejudicial to the rights of the adverse party or parties (underline added). See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ 2d 1503.

As stated in the International Finance Corp. v. Bravo Company, 64 USPQ 2d 1597, "The timing of the motion for leave to amend is a major factor in determining whether Applicant would be prejudiced by allowance of the proposed amendment." The TTAB went on further to indicate: "A motion for leave to amend should be filed as soon as any ground for such amendment becomes apparent. Any party who delays filing a motion for leave to amend its pleading, and in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion."

In the M. Aron Corporation v. Remington Products, Inc. TTAB decision, 222 USPQ 93, the TTAB stated: "It should be remembered that a long and unexplained delay in the filing of a motion to amend a Notice of Opposition or Petition of Cancellation, when there is no question of newly discovered evidence (as there would not be when a party is pleading its own Registration), may render the amendment untimely if the Defendant is thereby prejudiced."

In the instant proceeding, Applicant will be highly prejudiced by Opposer's late claim of Applicant's designation "HYBRID GREEN UPS" describing a quality and feature of the proposed goods and in the Opposer's contention would merely be descriptive.

Applicant has a number of marks associated with the "HYBRID GREEN" designation for related goods including "HYBRID GREEN SYSTEM" for uninterruptible power supplies (among others) in Registration No. 3,550,928 having a registration date of 23 December 2008, as well "HYBRID GREEN

POWER" having among its goods "uninterruptible power supplies" (among others) in Registration No. 3,550,927 issued on 23 December 2008.

Applicant has continuously used the marks "HYBRID GREEN SYSTEM" and "HYBRID GREEN POWER" in commerce in the United States since as early as 24 May 2007 and has continuously used the words "HYBRID GREEN" to the present date.

Additionally, Applicant has used the terminology "HYBRID GREEN" in association with catalogs which have been dispersed in the commercial marketplace for advertising its "HYBRID GREEN SYSTEM" and "HYBRID GREEN POWER" products.

Opposer was well aware of Applicant's mark "HYBRID GREEN UPS" at least as early as the date of filing the Notice of Opposition, namely, 19 May 2008. However, Opposer did not elect to include its proposed newly inserted claim as to descriptiveness until the last day of testimony given to Opposer, namely, 23 June 2009, based upon some newly acquired "evidence" of which Applicant is unaware.

Applicant submits that if Opposer did not believe the words "HYBRID GREEN" to be descriptive at the time of filing the Notice of Opposition, it is not understood how Opposer now contends that the words are descriptive and Applicant does not understand how any new "basis" can be found for such an allegation.

The Opposer requests leave to add this claim based upon what the Opposer indicates is a "recently-discovered additional basis". In fact, the Opposer is possibly requesting the amendment to the Notice of Opposition based upon Applicant's responses to Discovery Requests which wer received by the Opposer on 20 April 2009. The Opposer has not made this Request for Amendment of the Notice of Opposition until the last day of Testimony given to the Opposer, namely, 23 June 2009 which is over two months subsequent to having received Applicant's Responses to the Discovery Requests.

It is not known by the Applicant what "basis" arises from the information that was uncovered through Discovery as stated in Opposer's Motion to Amend the Notice of Opposition.

The only thing that Applicant can find in Applicant's Answer to Opposer's Interrogatories concerning any question about the mark in question "HYBRID GREEN UPS" which would bear on the new claim of descriptiveness is Interrogatory No. 3 where the Opposer requested:

> "Describe in detail all facts and circumstance surrounding Applicant's decision to select, adopt and use or intend to use the proposed mark, and identify all persons who first suggested use of the proposed mark.
>
> Answer to Interrogatory No. 3: Objection to Interrogatory No. 3, see General Objections.

The person who first suggested the use of the proposed mark is Mr. Sheng-Hsen Liao, having an address at No. 2, Alley 20, Lane 199, Sajyun Street, Shulin City, Taipei County, Taiwan, R.O.C.

The term "HYBRID" was simply chosen for use as a convenient word which would apply to the various goods as selected in the allowed application, Serial No. 77/176,134. The word "GREEN" was believed to be a word which shows some type of environmental friendliness. The letters "UPS" are directed to uninterruptible power supplies which is one of the main products to be offered by Applicant."

In Applicant's Response to Opposer's First Request for Admissions, the Opposer asked and Applicant answered:

"Request for Admission No. 52:

Applicant's goods to be offered under the proposed mark are intended to be energy efficient.

Answer to Request for Admission No. 52:

It is always hoped by Applicant that the goods that it produces are "energy efficient" and therefore, must admit.

Request for Admission No. 53:

Applicant's goods to be offered under the proposed mark are intended to use less energy than otherwise comparable goods.

Answer to Request for Admission No. 53:

Applicant has not made a specific investigation as to the use of less energy than otherwise comparable goods and although Applicant hopes that is uses less energy than otherwise comparable goods, Applicant to that extend admits.

Request for Admission No. 54:

Applicant's goods to be offered under the proposed mark are intended to be beneficial to the environment.

Answer to Request for Admission No. 54:

Applicant certainly hopes that its goods offered under the proposed mark will be beneficial to the environment and therefore to that extent admits.

Request for Admission No. 55:

Applicant's goods to be offered under the proposed mark are intended to appear to be beneficial to the environment.

Answer to Request for Admission No. 55:

It is intended that Applicant's goods to be offered under the proposed mark would appear to be beneficial to the environment and to this extent admits."

Applicant submits that it would be reasonable to assume that any corporation would "hope" that its products are beneficial to the environment.

Although the Opposer has not indicated any basis for its "recently-discovered additional basis", Applicant submits that such would not be a viable basis for the TTAB to grant Opposer's Motion to Amend its Notice of Opposition.

Arguendo, even if the TTAB decides that such is the basis for some unknown newly discovered evidence, all matters were provided to the Opposer and the Opposer chose not to file a Motion to Amend its Notice of Opposition until the very last day of the Testimony Period.

Opposer should not now be allowed to amend its Notice of Opposition since the Amended Notice of Opposition would highly prejudice the Applicant in its commercial endeavors which has been ongoing for many years. Applicant has issued a Family of Registrations which include "HYBRID GREEN" for a series of electronic products. Applicant has dispersed catalogs, which include the term "HYBRID GREEN", to the commercial world, and the Opposer's request for amendment of the Notice of Opposition would cause a commercial disadvantage and prejudice of Applicant's rights in its issued Trademark Registrations and its use of the term "HYBRID GREEN" in its commercial endeavors.

The TTAB should deny the Opposer's Amendment to the Notice of Opposition since the Opposer was aware of Applicant's mark "HYBRID GREEN UPS" since the inception of the current proceedings. No new basis of evidence has been provided by the Opposer as to the determination of descriptiveness of Applicant's use of the words "HYBRID GREEN" to this date (including the date of filing of the Opposer's Motion to Amend the Notice of Opposition).

Additionally, although perhaps not related to the Opposer's Motion to Amend the Notice of Opposition, Opposer has in a separate paper requested an Extension of Time to its Testimony Period on the very last day of its Testimony Period. The opposing attorney has apparently indicated that there were some procedural problems in the office of the opposing attorney, however, Applicant was only requested to stipulate to an Extension of Time on the last day of Opposer's Testimony Period which Opposer's attorneys knew could not be granted since Applicant is in Taiwan, R.O.C. and it was the middle of the night when Opposer requested such a stipulation. Thus, Applicant's attorney did not even have time to request information or authorization from the Applicant.

Thus, it appears that Opposer's Motion to Amend the Notice of Opposition is merely a facade placed into this record by the opposing attorney to allow extension of time of its Testimony Period.

Therefore, Applicant respectfully submits that the TTAB should deny Opposer's Motion to Amend the Notice of Opposition for inclusion of the proposed amendment.

CONCLUSION

For the above reasons, Applicant respectfully requests that the TTAB deny Opposer's Motion to Amend its Notice of Opposition.

Respectfully submitted,

7/6/09
Dated

Morton J. Rosenberg
Rosenberg, Klein & Lee
3458 Ellicott Center Drive, Suite 101
Ellicott City, MD 21043
Tel: 410-465-6678
Fax: 410-461-3067

Attorney for Applicant
POWERTECH INDUSTRIAL CO., LTD.

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing "Applicant's Response in Opposition to Opposer's Motion to Amend the Notice of Opposition" was served this day via electronic and 1st class mail, pursuant to agreement, addressed to:

Stephen M. Schaetzel, Esquire
KING & SPALDING LLP
1180 Peachtree Street, N.E.
Atlanta, GA 30309-3521
sschaetzel@kslaw.com

This 6TH day of July, 2009.

Morton J. Rosenberg