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

Mailed: August 21, 2009

Opposition No. 91184197

UNITED PARCEL SERVICE OF AMERICA, INC.

v.

POWERTECH INDUSTRIAL CO., LTD.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Applicant seeks to register the mark HYBRID GREEN UPS for "power supplies; mobile phone battery chargers; mobile phone battery charger stations; battery chargers; universal power supplies; power saving adapters; electric storage batteries; uninterruptible power supplies; ac/dc converters; power source stable adapters."[1] As grounds for the opposition, opposer alleges false suggestion of a connection, priority and likelihood of confusion, and dilution. Opposer pleads ownership of numerous UPS and UPS-formative marks for, *inter alia*, transportation and delivery services and for electronic equipment and components.

In accordance with the Board's order dated March 6, 2009, granting opposer's consented motion filed the same day, opposer's

[1] Application Serial No. 77176134, filed on May 9, 2007, claiming a *bona fide* intent to use the mark in commerce. A disclaimer of the term UPS is of record.

main trial period was last set to close on June 23, 2009. This case now comes up on opposer's fully briefed motions, both filed June 23, 2009, to extend its testimony period and to amend its notice of opposition to include a claim under Trademark Act §2(e)(1) that applicant's mark is merely descriptive.

In support of its motion to extend, opposer argues that this is its first request for an extension of time without applicant's consent; that the lone previous, consented extension was for the purpose of resetting applicant's time to respond to opposer's discovery requests; and that it has not abused its privilege of extensions in this case. Opposer, indicating that it has filed a timely notice of reliance, states that, due to a clerical error, it mistakenly believed additional time was available in its testimony period. Opposer indicates that it needs the additional time to complete testimony. Opposer argues that there is no prejudice to applicant as applicant will have its full testimony period to present its defense. Opposer indicates that it sought the consent of applicant's attorney who indicated he would need the client's consent and was not able to respond before opposer filed its motion.

In support of its motion to amend the notice of opposition, opposer explains that the parties agreed to email service; that applicant did not receive opposer's timely served discovery requests; that the parties cooperated such that opposer re-served the requests and applicant served responses thereto on April 16,

2009; that the responses were received by opposer on April 20, 2009; and that, based on the responses and a reasonable period to evaluate the information it received, opposer believes it has a basis for the claim of descriptiveness it now seeks to add. Opposer argues that applicant is not prejudiced by the proposed amended pleading because it has not yet used the term HYBRID GREEN UPS and, as a consequence, there is no discovery to be taken as to secondary meaning. Opposer also points out that applicant's testimony has not yet opened and applicant may develop testimony that its mark is not descriptive.

In response to opposer's motion to extend its first testimony period, applicant argues that opposer has been guilty of negligence, bad faith and has abused the privilege of extension. More particularly, applicant points out that opposer waited until the last day of the testimony period to seek an extension; that opposer knows applicant is located in Taiwan; that applicant's attorney informed opposer he could not ask for applicant's consent at that time because it was the middle of the night in Taiwan; and that opposer was aware that counsel could not obtain any instructions at such time. Applicant argues that opposer has not indicated how it would prove its case during an extended testimony period and has not provided details with respect to the clerical error which was referenced.

In response to opposer's motion to amend the pleadings, applicant argues that it is prejudiced by the proposed amendment

because it has numerous registered mark composed in all or in part of the term HYBRID GREEN and because applicant's commercial endeavors, which have been ongoing for many years, would be disadvantaged. Applicant argues that the basis for opposer's proposed amendment were known at the time opposer filed its notice of opposition; that applicant's discovery responses commenting on its "hope" that its products are beneficial to the environment do not provide a basis for a claim that its mark is merely descriptive; and that the timing of opposer's proposed amended pleading, the last day of its main testimony period, is suspect insofar as it may be related to opposer's request to extend its testimony period.

In its replies, opposer argues that it has not acted in bad faith or been negligent but responded to a docketing error in a professional manner. Opposer points out that it requested an extension before its time expired and, at the time it filed its motion, knew only that applicant neither provided its consent nor denied its consent to opposer's request. Opposer contends that the history of this case shows that there has been no abuse of the privilege of extension and that applicant has not shown any prejudice if the periods are extended. With respect to its motion to amend the pleadings, opposer argues that it acted in an appropriate fashion based on its receipt, review and evaluation of applicant's discovery responses; that applicant has full notice of the new claim before the opening of its testimony

period; and that applicant suffers no prejudice because its other registrations are not subject to this proceeding and, in any event, there has been no showing how opposer's amended pleading would affect such registrations.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension. *See* Fed. R. Civ. P. 6(b)(1)(A). *See also Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999). The Board will review the facts set forth in any such motions in determining whether good cause has been shown, including the diligence of the moving party, and whether the moving party is guilty of negligence or bad faith and whether the privilege of extensions has been abused. *Id. See also American Vitamin Products, Inc. v. DowBrands Inc.,* 22 USPQ2d 1316 (TTAB 1992).

There is no evidence that opposer is guilty of negligence or was acting in bad faith. Opposer states that it is seeking the extension because of a docketing error; opposer sought applicant's consent; and when the consent could not be provided, filed its motion. Implicit in a docketing error is the likelihood that a party would not know earlier that it needed additional time. While it is preferable for the parties to work together with respect to scheduling, and the Board notes the parties have done so in the past, a party may seek an enlargement

without the consent of its adversary. The Board notes here, that had opposer delayed in filing its motion for an enlargement of the testimony period to allow applicant's counsel to confer with applicant, opposer would be subject to the much stricter standard of Fed. R. Civ. P. 6(b)(1)(B), excusable neglect. Thus, opposer acted reasonably and diligently in filing its motion. Opposer has not abused the privilege of extension, particularly because the single, earlier extension was with applicant's consent. The Board notes in passing that, in the case referenced by applicant, *Procyon Pharmaceuticals, Inc. v. Procyon BioPharm, Inc.*, 61 USPQ2d 1542 (TTAB 2001), the opposer did not take any discovery or submit any other evidence in its testimony period. In this case, opposer participated in discovery and filed a notice of reliance.

In view thereof, for good cause shown, opposer's motion to extend its testimony period is granted. Dates are set later in this order.

As a general policy, leave to amend a pleading must 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. *See* TBMP §507.02 (2d ed. rev. 2004). The question of whether an adverse party would be prejudiced by allowance of the amended pleading in a

Board case is largely dependent on the timing of the motion to amend. While the Board will liberally grant such motions when the proceedings are still in the pre-trial stage, motions to amend the pleadings pursuant to Fed. R. Civ. P. 15(a) may be untimely when brought during or after the close of testimony. *Id.*

In this case, opposer seeks to amend its pleading to include a claim that is available in Board proceedings, that applicant's mark is merely descriptive. Opposer acted reasonably in evaluating applicant's discovery responses and any other information before seeking to amend the pleading. Neither party has asked for additional discovery or made a showing that the discovery period should be reopened for a limited purpose with respect to the proposed claim. Insofar as opposer's motion to extend its testimony period has been granted for other reasons, and applicant's full testimony period will also be reset, any prejudice arising from the timing of opposer's motion to amend its pleading is offset.

In view thereof, opposer's motion to amend its pleadings is granted, and opposer's amended notice of opposition is noted and entered and is the operative pleading in this case.

Applicant is allowed until **TWENTY DAYS** from the mailing date of this order in which to file its answer to the amended notice of opposition.

Discovery is closed. Trial dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	**10/2/2009**
Defendant's Pretrial Disclosures	**10/17/2009**
Defendant's 30-day Trial Period Ends	**12/1/2009**
Plaintiff's Rebuttal Disclosures	**12/16/2009**
Plaintiff's 15-day Rebuttal Period Ends	**1/15/2010**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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