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Filing date: **01/30/2012**

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

Proceeding	92053066
Party	Plaintiff Road Tools Inc.
Correspondence Address	JEFFREY H GREGER LOWE HAUPTMAN HAM & BERNER LLP 1700 DIAGONAL ROAD, SUITE 310 ALEXANDRIA, VA 22314 UNITED STATES jhgreger@IPFirm.com
Submission	Opposition/Response to Motion
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Date	01/30/2012
Attachments	1-30-12 Opposition to motion.pdf ( 15 pages )(1183275 bytes )

Opposition to Motion to Amend

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

In the matter of U.S. Registration No. 3527661

Mark: **COOLPAD 酷派**

Registration Date: November 4, 2008

Road Tools LLC	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No.: 92-053066
	)	
Yulong Computer Telecommunication	)	
Scientific (Shenzhen) Co., Ltd.	)	
	)	
Registrant	)	
	)	

**PETITIONER'S OPPOSITION TO REGISTRANT'S  
MOTION FOR LEAVE TO FILE SECOND  
AMENDED ANSWER AND NEW COUNTERCLAIM**

COMES NOW Petitioner, Road Tools, LLC and opposes Registrant Yulong's Motion seeking leave to amend to file a Second Amended Answer asserting a new counterclaim. Yulong's newly asserted counterclaim for genericness is untimely, futile, and designed to delay. Yulong's delay of more than a year since filing its initial Answer and Counterclaims, since stricken, is prejudicial to Petitioner. Yulong's excuses for delay are unsupported by the record. Leave to amend should be denied.

I. Procedural Posture

Petitioner instituted this Cancellation proceeding on September 27, 2010. Respondent Yulong filed its initial Answer and Counterclaim on November 4, 2010. See Answer and Counterclaims at Docket No. 2. Yulong asserted two grounds for cancellation of Petitioner's relied-upon registration. The first basis alleged was non-use and abandonment. *Id.* at page 10. The second basis alleged for cancellation was trademark misuse. *Id.* Yulong also pled affirmative defenses with its initial Answer and Counterclaims alleging that a "myriad of adoptions and uses of the terms COOL and PAD in the field of computer stands and computer accessories" existed as of November 4, 2010 rendering the marks "highly diluted." *Id.* at page 7.

Petitioner responded to Yulong's counterclaims with a motion to dismiss on December 4, 2010. Docket No. 6. On June 6, 2011, the Board issued a decision on Petitioner's motion to dismiss Granting Petitioner's motion to dismiss Counterclaim Count II for misuse, and the Board *sua sponte* also dismissed Counterclaim I. See Docket No. 12 at pp 6-7. The Board also struck a number of Yulong's affirmative defenses but expressly declined to strike affirmative defense 13 which included Yulong's assertion that the terms COOL and PAD were highly diluted, indicating the language amplified Yulong's denials. *Id.* The Board suspended the proceeding and allowed Yulong until June 25, 2011 to file an amended counterclaim. *Id.*

On June 24, 2011, Yulong filed a timely First Amended Answer sans any counterclaims. See Docket No. 13. Yulong's First Amended Answer did however, allege

## Opposition to Motion to Amend

again amplifications that “a myriad of adoptions and uses of the terms COOL and PAD in the field of computer stands and computer accessories” existed still. *Id.* at pp 10-11. Proceedings were resumed. Months later, a mere day before the deadline for expert disclosure, an appearance of new counsel was made on behalf of Yulong on November 28, 2011.

As a courtesy to new counsel and at Yulong’s new counsel’s request, Petitioner’s counsel agreed to extend the then pending discovery and trial schedule because Yulong’s new counsel informed he had not obtained the client’s files, needed time to formally execute an engagement agreement with his client, and needed time to become familiar with the case. After a reasonable one month period to accommodate, on January 7, 2012, the undersigned served written discovery by mail, facsimile and email. See Exhibit A - opposing counsel’s confirming letter. Yulong filed the instant motion for leave to amend to Answer and assert a counterclaim for genericness on January 10, 2012, and followed shortly with Yulong’s own written discovery. *Id.*

## II. Analysis.

“A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed.” 37 C.F.R. §2.114(b)(2)(i)’ TBMP §313.04.(emphasis added). “If the defendant knows the grounds for a counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the Answer. *Id.*; citing *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987)(motion to add new counterclaim denied since ground was available at time of Answer).

## Opposition to Motion to Amend

Leave to amend pleadings are freely given when justice so requires. Fed. R. Civ. P. 15(a). “The Board liberally grants leave to amend pleadings unless the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party.” *Media Online Inc., v. El Clasificado, Inc.*, 88 USPQ2d 1285 (TTAB 2008)(Cancellation No. 92047294 decided September 29, 2008) citing *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPOQ2d 1503(TTAB 1993). The timing of a motion for leave to amend is one major factor in determining prejudice. TBMP §507.02. Long delays in filing leave to amend “causes prejudice to [ones] adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion.” *Media Online* citing Wright, Miller and Kane, Federal Practice and Procedure; Civil 2d, Section 1488(1990). If newly asserted claims “appear based on facts within the movant’s knowledge at the time the [initial Answer and Counterclaims] was filed, the Board may find that the movant “unduly delayed in filing its motion. *Media Online* citing *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540(TTAB 2001).

In the *Media Online* case, the movant, attempted to add a claim for descriptiveness by consulting dictionary definitions and accessing web sites of the opposing party. The Board held that the seven (7) month delay was inexcusable and the information was of a nature available to the movant. The Board in *Media Online* also found that prejudice would occur from the delay as the movant “did not claim that it learned of the new claim through discovery or was otherwise unable to learn about the new claim prior to or shortly after filing its first complaint [attacking the registration].” *Id.* Movant had ample time to amend earlier in the proceeding. *Id.* “It is incumbent upon a petitioner, [counterclaimant here], to identify all claims properly in order to provide respondent [petitioner in this case] with proper

## Opposition to Motion to Amend

notice. *Id.* “Otherwise, allowing piecemeal prosecution of this case would unfairly prejudice [the non-movant] by increasing the time, effort, and money that [non-movant] would be required to expend to defend against the [movant’s] challenge to its registration.” *Id.*

The instant facts are analogous to the Board’s logic in *Media One*. The pertinent facts now relied on were available and Respondent Yulong was able to learn those facts. Yulong pled that it had knowledge of the “myriad of adoptions of uses” of the terms COOL and PAD in the pertinent industry covering Petitioner’s relied-upon registration, namely “computer stands.” Knowing the registration was incontestable and not subject to challenge by descriptiveness, Yulong did not undertake further investigation into the facts available to it and instead chose to challenge and counterclaim based on abandonment and misuse while concurrently amplifying its denials as to the “myriad of uses” rendering the term diluted and weak. After dismissing Yulong’s counterclaims a first time the Board provide ample time for Yulong to amend and add a counterclaim but Yulong next chose to refrain from any counterclaims and again reiterated its amplifications of a “myriad of uses.”

Only after Yulong terminated its first counsel and engaged new counsel, does Yulong come forward with a new claim that the trademark COOLPAD for computer stands is generic, based obviously on the myriad of uses it knew before. To excuse its obvious delay, Yulong’s counsel argues first that as a Chinese entity whose “first language is Chinese....it did not understand the generic meaning of “cool pad” as applied to Road Tools’, [the petitioner’s] goods. Yulong is a juristic entity and has no language, it can only act through

## Opposition to Motion to Amend

individuals.<sup>1</sup> There is no declaration from any individual that supports Yulong's counsel's statement as to unfamiliarity with the English language or lack of basis for knowledge of the meaning of the mark COOLPAD. These excuses should be disregarded as mere attorney argument.

Yulong next explains its delay on only recently hiring an alleged "linguistic expert" who "within the last few weeks gathered evidence to support a counterclaim for cancellation on genericness." Here again, even assuming Yulong did recently hire an expert who gathered alleged evidence as to the issue of genericness, there is no statement, declaration, or proof, that the same alleged evidence was not available at the time Yulong filed its Answer and initial counterclaim on November 4, 2010, or again when it filed first Amended Answer, back on June 24, 2011. This is particularly troublesome considering Yulong pled it was aware of a "myriad of uses" not once, but two times. Clearly there existed facts supporting a myriad of uses of the pertinent terms use in connection with computer stands and Yulong so pled.

It was incumbent upon Yulong to set forth its mandatory counterclaims in a timely manner. Instead, Yulong, waited till near the close of discovery, terminated its counsel, engaged new counsel, obtained an extension, and now attempts to assert an untimely counterclaim based on facts which were available to Yulong much earlier. Yulong should not be permitted to create and invent facts by alluding to an opinion of unnamed linguistic expert<sup>2</sup> who purports to opine on matters totally outside the pleadings, namely a dubious claim of genericness. Nowhere in its moving papers does Yulong explain or state that the

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<sup>1</sup> The record shows Yulong had United States counsel from the start of this proceeding who pled knowledge of the myriad of uses of the pertinent terms comprising the mark COOLPAD.

<sup>2</sup> No supplementation of known witnesses has been made identifying the alleged linguistic expert.

## Opposition to Motion to Amend

identical grounds it now says it discovered, was not available to it “at the time it filed its answer.” See *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224, (TTAB 1988) at f.n.6 (stating that even without deciding the merits of the denied counterclaim, the ability to ultimately prove the claim was highly questionable”). There is distinction between the availability of the facts concerning a myriad of uses, and an after-the-fact recently concocted opinion based on previously available facts.

Here, Yulong seeks to amend to assert that the mark COOLPAD for computer stands is generic. Common sense and simple dictionary definitions renders the assertion dubious.<sup>3</sup> The Board should further deny Yulong’s untimely motion to amend as futile because computer stands, as covered by the Petitioner’s relied-upon registration, are not generic, even assuming reasonable minds may disagree on descriptiveness and suggestiveness with respect to certain features of some computer stands.

The obvious reason the motion has been made at this late juncture is to prejudice the Petitioner with the burden of defending a frivolous claim, which is designed to delay and gather leverage for Yulong’s settlement efforts through new counsel. The Board should not permit an untimely amendment as presented in this case, as to do so would set a precedent that in any case, however lacking merit, a claim of genericness can be asserted to restart the clock to Answer and defend a counterclaim. If a bonafide claim existed it was incumbent upon the movant to move timely. Even absent its timeliness, movant here fails to adequately support its bald claim of genericness alluding only to last minute ditch effort of counsel to garner an opinion of a linguistic expert who will purportedly opine as to genericness. The

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<sup>3</sup> The Board is asked to take judicial notice of the dictionary definitions of terms cool, pad, computer, stand, and that the term COOLPAD as a unitary word does not appear in the dictionary. See Exhibit B.

Opposition to Motion to Amend

underlying alleged facts, namely the myriad of uses which purportedly support a genericness opinion, were available at the time of answer and/or could have been ascertained Yulong chose to but did not. Instead the decision to seek to amend with a dubious claim of genericness at this late dates, appears dilatory and designed to delay this case further for tactical advantage. Counsel's explanations on behalf of Yulong and Yulong's Motion does not meet the Board's requirement for excusable delay for leave to amend.

**CONCLUSION**

For the foregoing reasons, Petitioner respectfully requests that the Board DENY Respondent's Motion seeking Leave to Amend to add a counterclaim as untimely.

Respectfully submitted,  
LOWE HAUPTMAN HAM & BERNER, LLP



Jeffrey H. Greger  
Attorney for Petitioner

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Alexandria, Virginia 22314  
Tel: (703) 684-1111  
Fax: (703) 518-5499  
January 30, 2012

**Certificate of Service**

I hereby certify that a copy of the foregoing Motion has been forwarded to Respondent's currently listed correspondence address and contact information according to the current records as contained in the U.S. Patent and Trademark Office records as appears below, by email and facsimile pursuant to agreement between counsel and served this day, January 30, 2012 upon the following.

B. Brett Heavner  
Finnegan Henderson et al.  
901 New York Ave. NW  
Washington, DC 20001  
Fax No. 202-408-4400  
Email: b.brett.heavner@finnegan.com

Dated: January 30, 2012

  
\_\_\_\_\_  
Jeffrey H. Greger

Ex. A

**FINNEGAN**

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
WWW.FINNEGAN.COM

**B. BRETT HEAVNER**

202-408-4073

b.brett.heavner@finnegan.com

January 17, 2012

Jeffery H. Greger, Esq.  
Lowe Hauptman Ham & Berner LLP  
1700 Diagonal Road, Suite 300  
Alexandria, Virginia 22314

**VIA E-MAIL & FIRST CLASS MAIL**

Re : Road Tools LLC v. Yulong Computer Telecomm.  
Cancellation No. 92053066  
Your Ref. No. 4743-L708

Dear Mr. Greger:

We enclose Yulong Computer Telecommunications Scientific (Shenzhen) Co. Ltd.'s First Set of Interrogatories and First Set of Requests for Production of Documents and Things. Please confirm receipt of this document.

We have received your letter of January 7, 2012 enclosing Road Tools LLC's discovery requests. Service by facsimile and e-mail are acceptable. Please always copy my associate, Whitney Cooke, and my legal assistant, Susannah Kolstad, on all e-mails.

As discussed, our client is interested in exploring options for settlement and is currently working on a formal settlement proposal. Therefore, as suggested in your letter, our client would be agreeable to a short extension (perhaps 60 days) of all current deadlines. Please telephone me and let me know whether your client would stipulate to such an extension.

Very truly yours,

*B. Brett Heavner/sek*

B. Brett Heavner

BBH/map

cc: Whitney D. Cooke, Esq.  
Susannah Kolstad

Ex. B



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coolpad

Subbr

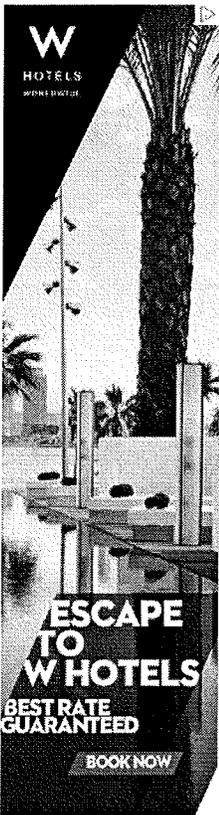


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2. clupeid
3. copyhold
4. cheliped
5. chopped
6. copilot
7. couplet
8. cobbled
9. copulate
10. cowpat
11. cop out
12. cop-out
13. clubbed
14. co-opt
15. caboodle
16. clubhead
17. cobalt



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cool

Substr

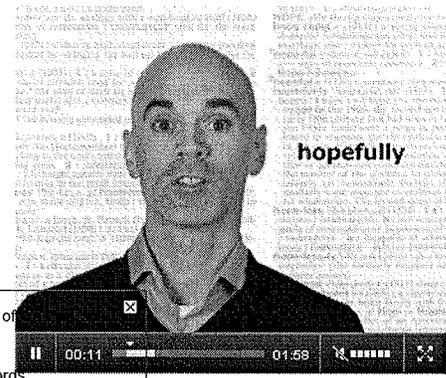
cool

Popularity

12 ENTRIES FOUND:

- 1) cool (adjective)
2) cool (verb)
3) cool (noun)

Cool is currently in the top 30% of Merriam-Webster.com. See a list of the most popular words.



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'cool adj \k\u028a\u026a\



Definition of COOL

e\_en\_US

- 1 : moderately cold : lacking in warmth
2 a : marked by steady dispassionate calmness and self-control
b : lacking ardor or friendliness
c of jazz : marked by restrained emotion
d : free from tensions or violence
3 —used as an intensive
4 : marked by deliberate effrontery or lack of due respect
5 : facilitating or suggesting relief from heat
6 a of a color : producing an impression of being cool
b of a musical tone : relatively lacking in timbre
7 slang
a : very good : EXCELLENT; also : ALL RIGHT
b : FASHIONABLE, HIP

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Examples of COOL

The weather is cool today.



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pad

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pad

Popularity

37 ENTRIES FOUND:

- 1) pad (verb) 2) pad (noun) 3) pad (noun)

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pad noun



Definition of PAD

1 a : a thin flat mat or cushion; as (1) : a piece of soft stuffed material used as or under a saddle (2) : padding used to shape an article of clothing (3) : a guard worn to shield body parts against impact (4) : a piece of usually folded absorbent material (as gauze) used as a surgical dressing or protective covering (5) : a component of certain brake systems (as disc brakes) consisting of a plate covered with a frictional material

b : a piece of material saturated with ink for inking the surface of a rubber stamp

2 a : the foot of an animal

b : the cushioned thickening of the underside of the toes of an animal

3 : a floating leaf of a water plant

4 : a collection of sheets of paper glued together at one end

5 a (1) : a section of an airstrip used for warm-ups or turnarounds (2) : an area used for helicopter takeoffs and landings

b : LAUNCHPAD

c : a horizontal concrete surface (as for parking a mobile home)

6 a : BED

b : living quarters

Origin of PAD

origin unknown

First Known Use: 1570

Other Automotive Terms

articulated, block, choke, clutch, diesel, neutral, transmission

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computer

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Popularity

computer

9 ENTRIES FOUND:

- computer (noun) computer science (noun) analog computer (noun)

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com·put·er noun, often attributive \kəm-'pyü-ter\



Definition of COMPUTER

: one that computes; specifically : a programmable usually electronic device that can store, retrieve, and process data

- com·put·er·dom noun - com·put·er·less adjective - com·put·er·like adjective

See computer defined for English-language learners » See computer defined for kids »

Examples of COMPUTER

He works all day on a computer.

First Known Use of COMPUTER

1646

Other Computer-Related Terms

adware, flash, kludge, phishing, recursive, router

Rhymes with COMPUTER

accoutre, commuter, confuter, crapshooter, diluter, disputer, freebooter, hip shooter, jump shooter, peashooter, polluter, recruiter, refu... [+ ] more

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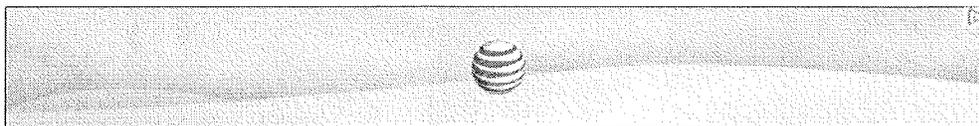
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stand

Subbr

stand

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43 ENTRIES FOUND:

- 1) stand (verb)
- 2) stand (noun)
- stood



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stand noun



Definition of STAND

- 1 a : a halt for defense or resistance
  - b : an often defensive effort of some duration or degree of success <a goal-line stand>
  - c (1) : a stop made to give a performance <a 6-game stand at home> (2) : a town where such a stop is made
- 2 : an act of stopping or staying in one place
- 3 a : a place or post where one stands
  - b : a strongly or aggressively held position especially on a debatable issue <took a stand against higher taxes>
- 4 a : the place taken by a witness for testifying in court
  - b plural (1) : a section of the tiered seats for spectators of a sport or spectacle (2) : the occupants of such seats
  - c : a raised platform (as for a speaker or hunter) serving as a point of vantage
- 5 a : a small often open-air structure for a small retail business <a vegetable stand> <a hot dog stand>
  - b : a site fit for business opportunity
- 6 : a place where a passenger vehicle stops or parks <a taxi stand>
- 7 : HIVE 2
- 8 : a frame on or in which something may be placed for support
- 9 : a group of plants growing in a continuous area
- 10: a standing posture

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