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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage in an envelope addressed to: **Assistant Commissioner for Trademarks, BOX T.T.A.B. NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3514**, on May 21, 2003, by:

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

SOLUTIA, INC.,	)	
	)	
Opposer,	)	Opposition No. 91152498
	)	
vs.	)	
	)	Mark: KEEPCLEAN
JELD-WEN, INC.,	)	
	)	
Applicant.	)	
	)	

APPLICANT'S REPLY BRIEF IN SUPPORT OF MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIMS

Because of the numerous fallacies contained in Opposer's Memorandum in Opposition to Applicant's Motion for Leave to File First Amended Answer and Counterclaims ("Opp. Mem."), Applicant JELD-WEN, INC. ("JELD-WEN"), respectfully submits this Reply in support of that Motion, and requests that the Board exercise its discretion to consider such Reply.

I. JELD-WEN'S AMENDMENT IS TIMELY

Opposer takes the position that JELD-WEN's Motion is "untimely"[1] because, Opposer contends, JELD-WEN somehow filed the Motion both too early and too late. Opp. Mem. at 1-2. Opposer's illogical contention is without merit.

A. JELD-WEN's Motion is Not Premature.

Opposer argues that JELD-WEN filed the Motion too early because "[t]hese proceedings are presently suspended and this Board has not issued an order resuming the proceeding." Id. at 1. However, Opposer also acknowledges that JELD-WEN "has filed a concurrent motion to resume proceedings," id. at 2, and ignores the plain rule that either party may unilaterally request resumption at any time. See T.B.M.P. § 510.03(b). Consequently, at the time JELD-WEN filed the instant Motion, the fact that these proceedings would be resumed was a foregone conclusion.

Given this context, JELD-WEN filed this Motion concurrently with its motion to resume in an effort to expedite the Board's ruling on the issue of leave to amend. By so doing, JELD-WEN has placed the issue of amending the pleadings squarely before the Board for ruling at the earliest possible moment after resumption. In contrast, Opposer's position would require JELD-WEN to have first filed its motion to resume, and then to have awaited a formal resumption order, before filing seeking leave to amend.

[1] Opposer's actual statement is that "Opposer's motion is untimely." Opp. Mem. at 1 (emphasis added). Presumably, Opposer meant to refer to "Applicant's" or "JELD-WEN's" motion.

Rather than incur additional delay, the timing of JELD-WEN's Motion plainly promotes the efficient prosecution of these proceedings. JELD-WEN's Motion was not filed too early.

B. JELD-WEN's Amendments Fall Within a Recognized Exception to the Compulsory Counterclaim Rule.

Alternatively, Opposer contends that JELD-WEN's proposed amendment comes too late because it "compulsory counterclaims" pursuant to 37 C.F.R. § 2.106(b) and Fed. R. Civ. P. 13(a). Opp. Mem. at 7. According to Opposer, "those counterclaims must have been pleaded 'with or as part of the answer' in September of 2002." Id. In support of this position, Opposer argues that, by alleging generally that it "is the owner of various federal trademark registrations" for the marks KEEPSAFE, KEEPSAFE MAXIMUM, and "various variations thereof," Opposer put JELD-WEN ON "'fair notice' of the registrations upon which Opposer is relying." Id. at 5. As a result, Opposer concludes that JELD-WEN somehow "knew," at the time JELD-WEN filed its original answer, of the precise registrations on which Opposer intended to rely and, therefore, of the grounds upon which cancellation could be sought. Id. at 7.

Opposer's position flies directly in the face of T.B.M.P. § 319.04 and the authorities cited therein. First, Opposer is simply incorrect that, for purposes of invoking the compulsory counterclaim rule, "[s]pecific registration number or issuance dates thereof are not required by the TBMP and are not, therefore, 'necessary information.'" Id. at 4 n.1. In discussing compulsory counterclaims, the

Board said exactly the opposite in M. Aron Corp. v. Remington Prods., Inc., 222 U.S.P.Q. 93 (T.T.A.B. 1984):

> It is expected that in the original notice of opposition or petition for cancellation, an opposer or cancellation petitioner will identify by number and date of issuance each registration upon which it expects to rely. The deliberate withholding, until the testimony period of an opposer or cancellation petitioner, of the identification of the registration or registrations intended to be introduced in evidence in support of the claim of damage causes unwarranted surprise and prejudice to an applicant or respndent. Such a practice frustrates proper discovery and preparation for trial. The burden is upon an opposer or cancellation petitioner to present initially a pleading that gives fair notice of the case that an applicant or respondent must meet. The Federal Rules of Civil Procedure reject the approach that pleading is a game of skill.
>
> . . . It therefore behooves an opposer or cancellation petitioner to plead its registration by number and date of issuance, if not in the original notice of opposition or petition for cancellation, as soon as possible after the omission (or newly issued registration) comes to the opposer's or cancellation petitioner's attention.

Id. at 96 (quoting Notice of Final Rulemaking published in the Federal Register of January 22, 1981, at 36 Fed. Reg. 6940) (emphasis added).

Opposer has plainly failed to meet this burden. The Notice of Opposition refers, in only the most general terms, to "various federal trademark registrations" for Opposer's trademark "KEEPSAFE, KEEPSAFE MAXIMUM, and various variations thereof." Not. of Opp. at ¶ 3. It does not identify with specificity those registrations upon which Opposer intends to rely, leaving JELD-WEN to guess regarding which of Opposer's "various" registrations might or might not be at issue.

Given the foregoing, JELD-WEN's supposed "knowledge," at the time of its original answer, of the grounds for seeking cancellation is irrelevant. "Even if the grounds for cancellation of a plaintiff's unpleaded registration are known to the

defendant when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration unless and until the registration is pleaded by the plaintiff." T.B.M.P. § 319.04 (emphasis added). As such, the compulsory counterclaim rule is inapplicable here, and JELD-WEN's proposed amendment is timely.[2]

II. JELD-WEN'S AMENDMENT DOES NOT PREJUDICE OPPOSER

Besides its spurious "timeliness" objection, refuted above, the only prejudice to which Opposer points is that the original and extended date for the closing of discovery have passed, and that Opposer's "timely served discovery remains unanswered." Opp. Mem. at 11. Opposer admits, however, that it has freely consented to the various extensions of time for JELD-WEN to respond to such discovery, and to the close of the discovery period. Opp. Mem. at 2-3.[3] Such consented extensions were timely made, and the extended time for discovery has not lapsed. Therefore, Opposer can hardly be heard to complain of prejudice arising out of extensions to which it expressly agreed.

Notwithstanding Opposer's contrary assertions, this opposition is, indeed, in the early stages of discovery. The only discovery that has been conducted is

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[2] With regard to JELD-WEN's proposed affirmative defenses, Opposer recognizes that they are to be treated in the same manner as compulsory counterclaims. See Opp. Mem. at 9. The foregoing analysis is therefore equally applicable to the timeliness of JELD-WEN's affirmative defenses. As to the remaining alleged "changes in prior pleadings," the only material amendment to the substance of such pleadings comes in JELD-WEN's proposed amendment its answer to Paragraph 11 of the Notice of Opposition. Paragraph 11 alleged that "Applicant's Mark is not currently in use in connection with Applicant's Goods." Not. of Opp. ¶ 11. JELD-WEN's initial answer denied this allegation, but the proposed amended answer admits the allegation because JELD-WEN has since commenced use of its KEEPCLEAN mark.

[3] Opposer refers to having agreed, at one point, to a discovery closure date of "May 2, 2002," and to having granted an additional extension of time on "March 14, 2002." Given the context and other dates mentioned in those references, such activities clearly occurred in 2003, and JELD-WEN presumes that Opposer's references to those dates in 2002 was merely a typographical error.

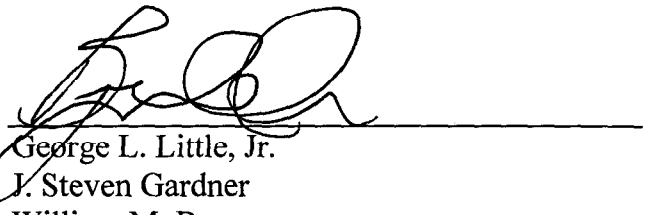
Opposer's service of a single set of interrogatories, and a single set of requests for production of documents. JELD-WEN's responses to such discovery requests are not yet due as a result of the aforementioned extensions of time, to which Opposer consented. JELD-WEN intends timely to respond to such discovery requests upon resumption of this proceeding. Moreover, sufficient time will remain in the discovery period for Opposer to serve additional discovery requests, if necessary, directed to JELD-WEN's counterclaims. In short, Opposer has not, and cannot, point to any specific detriment it has suffered, or will suffer, if JELD-WEN's Motion is granted.

The effect of denying JELD-WEN's Motion "would be to foreclose [JELD-WEN] from asserting any claim it may have against [Opposer's] registration[s]." See's Candy Shops Inc. v. Campbell Soup Co., 12 U.S.P.Q.2d 1395, 1397 (T.T.A.B. 1989). Because Opposer has not established that it will be prejudiced, "the liberal policy concerning amendments to pleadings dictates allowance" of JELD-WEN's Motion. Id. JELD-WEN respectfully submits that justice requires permitting JELD-WEN to amend its pleading as proposed.

CONCLUSION

For the reasons stated herein, and in JELD-WEN's initial Motion for Leave to File Amended Answer and Counterclaims, and Brief in Support Thereof, JELD-WEN respectfully requests that the instant Motion be granted.

This the 21st day of May, 2003.



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CERTIFICATE OF SERVICE

I, William M. Bryner, hereby certify that on this date I served the foregoing **APPLICANT'S REPLY BRIEF IN SUPPORT OF MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIMS** upon counsel for Opposer by depositing a copy thereof in the United States mail, postage prepaid and addressed as follows

John E. McKie
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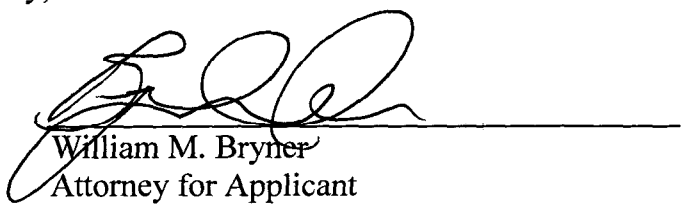
This the 21st day of May, 2003.



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