TTAB

Attorney's Docket No.: 02103-008PP1

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

In the matter of Application Serial No. 76-304,063
For the Mark HEXAWAVE
Published in the Official Gazette on March 18, 2003 at TM 278

Bose Corporation, Opposer, v. Hexawave, Inc., Applicant.	Opposition No. 91157315

Commissioner for Trademarks
BOX TTAB – NO FEE
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OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER TO ADD COUNTERCLAIM

Opposer Bose Corporation ("Bose"), by its undersigned attorneys, hereby opposes Applicant Hexawave, Inc.'s ("Applicant") Motion for Leave to Amend Answer to Add Counterclaim dated June 23, 2004 for the reasons set forth below.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514.

July 12, 2004
Date of Deposit

Amy S. Brooks
Signature

Amy S. Brooks
Typed or Printed Name of Person Signing Certificate

07-15-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

On July 15, 2003, Bose filed its Notice of Opposition, claiming a likelihood of confusion between Applicant's HEXAWAVE mark and Bose's family of WAVE marks[1]. Applicant answered the Notice of Opposition on September 18, 2003, asserting various affirmative defenses. Applicant subsequently sought discovery on Bose's use of the marks relied on in Bose's Notice of Opposition, but Applicant never filed a counterclaim for cancellation of those same marks. Now, almost nine months after it answered the Notice of Opposition, more than three months past the close of discovery, and after Bose's testimony period has closed, Applicant seeks leave to amend its answer to add a counterclaim for cancellation of Bose's Registration No. 1,633,789 on grounds of non-use. This motion is simply made too late, is highly prejudicial to Bose, and should be denied.

First of all, although Applicant asserts that the evidence which purports to bolster its counterclaim is newly-discovered, these purported facts were known to Applicant, or at the very least were easily discoverable, far earlier than June 23, 2004, the date Applicant filed its Motion for Leave. For example, Applicant's Interrogatory No. 3, served to Bose on January 26, 2004, requests that Bose "[i]dentify and provide a detailed description of each and every product manufactured, licensed, sold by or on behalf of Opposer, or marketed by or on behalf of Opposer since the inception of Opposer's business that bear Opposer's marks." On May 20, 2004, Applicant inspected documents provided by Bose that were responsive to this interrogatory. At no time did Applicant indicate that Bose's documents were anything less than responsive to this

[1] In its notice of opposition, Bose's relied on WAVE marks it has used and registered including Registration No. 1,633,789 for WAVE, registered on the principal register on February 5, 1991; Registration No. 1,764,183 for ACOUSTIC WAVE registered on the principal register on April 13, 1993; and Registration No.1,338,571 for ACOUSTIC WAVE, registered on the principal register on May 28, 1985.

inquiry about Bose's use of its marks. Clearly, at that time, Applicant had information in its possession that was highly relevant to the inquiry into Bose's use of its pleaded marks.

In addition, Applicant's Interrogatory No. 1, also served on Bose on January 26, 2004, requested that Bose "[i]dentify all persons with knowledge of any facts relating to the allegations set forth in the Notice of Opposition." Bose identified John Mar, the Bose employee who Bose later deposed. It is evident that Applicant began its inquiry into Bose's use of its pleaded registrations as far back as January 2004, but failed of its own accord to either complete discovery on these issues, or to bring a counterclaim for cancellation based on the information it did have at that time. Furthermore, although the parties exchanged discovery responses and documents after the close of the discovery period, Applicant never requested that the discovery period be extended in order for Applicant to notice and take the depositions of any Bose witnesses, or to obtain any follow-up discovery on the non-use issue. Bose should not have to bear the burden of Applicant's delay by responding to a counterclaim at this late date.

Also, Applicant's reliance on 37 C.F.R. § 2.114(b)(2)(i)[2] in support of its motion for leave to amend is misplaced in that it ignores the balance that must be struck between allowing parties to assert claims based on newly-discovered evidence on the one hand, and preventing prejudice to the non-movant on the other. The Rule is not meant to allow a party, who, like Applicant, is dilatory, refuses to properly investigate claims that may have supported a counterclaim long before, and otherwise sits on its rights, to bring an 11th hour motion seeking to cancel its opponent's pleaded registration.

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[2] 37 C.F.R. § 2.114(b)(2)(i) states "If the grounds for a counterclaim are learned during the course of the...proceeding, the counterclaim shall be pleaded promptly after the grounds therefore are learned."

For the foregoing reasons, it is respectfully submitted that Applicant's Motion for Leave to Amend Answer to Add Counterclaim should be denied.

Respectfully submitted,

Date: July 12, 2004

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BOSE CORPORATION

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing BOSE'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER TO ADD COUNTERCLAIM has this 13th day of July 2004, been mailed by prepaid first class mail to the below-identified Attorney at his/her place of business:

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