

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



07-22-2004

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #78

Bose Corporation *

Opposer *

v. *

Opposition No. 91157315

Hexawave, Inc. *

Applicant *

* * * * *

Honorable Commissioner for Trademarks
Box TTAB
2900 Crystal Drive
Arlington, VA 22202-3513

**RESPONSE TO OPPOSER’S OPPOSITION TO APPLICANT’S MOTION
FOR LEAVE TO AMEND ANSWER TO ADD COUNTER-CLAIM**

Applicant, Hexawave, Inc., (“Applicant”) by the undersigned attorneys hereby responds to Opposer’s, Bose Corporation (“Opposer”), Opposition to Applicant’s Motion for Leave to Amend Answer and to Add Counter-Claim for the reasons set forth below:

Opposer seeks to oppose Applicant’s Motion for Leave to Amend Answer to Add Counter-Claim for cancellation of Registration Number 1,633,789. In Opposer’s opposition to Applicant’s Motion for Leave to Amend Answer to Add Counter-Claim, Opposer states that “this Motion is simply made too late, is highly prejudicial to Bose, and should be denied.”

Opposer's specious allegation is incorrect and both a distortion as well as a misrepresentation of the facts.

The facts of the matter are that Applicant provided Interrogatories to Opposer having a Certificate of Service date of 26 January 2004 where an Interrogatory Number 3 was provided as follows:

“Interrogatory #3: Identify 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, and/or that Opposer intends to manufacture, license, sell, market, have sold, or have marketed that bear or are associated with one or more of Opposer's marks. Include in the identification the model number or other identifying designation, if any, for the product.”

On or about 1 March 2004, Opposer provided an Opposer's Response to Applicant's Interrogatories. In answer to Interrogatory #3, Opposer stated:

“Opposer objects to this request to the extent it is irrelevant, overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects to this request to the extent it requests information consisting

of confidential business information and/or information protected by the attorney-client and/or attorney work product privileges. Notwithstanding the foregoing objections, Opposer refers to its Notice of Opposition. Notwithstanding the foregoing objections, relevant, representative, responsive, non-privilege information, to the extent it exists, will be provided upon entry of a suitable Protective Order.”

In fact, the Answer to Interrogatory #3 provided no substantive data to the Applicant in this case.

Further, the Protective Order referred to in Opposer’s Response to Applicant’s Interrogatories was in fact sent to the Opposer on or about 7 November 2003. No response was forthcoming from Opposer. A further letter was sent to Opposer on 18 November 2003 indicating Applicant was awaiting Opposer’s signing or comments to the Protective Order. No response was forthcoming from the Opposer. A still further letter was sent to Opposer on 11 March 2004 indicating that there still was no response to the Protective Order sent to Opposer. Finally, on 20 April 2004, Opposer provided comments to the Protective Order which were incorporated by Applicant and sent for signature to Opposer on 27 April 2004. Due to Opposer’s dilatory actions, and non-response to the Protective Order sent to Opposer, the Protective Order was not signed by the Opposer until 13 May 2004.

The signed "Stipulated Protective Order" was sent to Applicant by Opposer's Attorney on 13 May 2004. A total of over six (6) months elapsed (during the Discovery period) before the Opposer signed the Protective Order.

On or about 14 May 2004 Opposer provided "Bose's Supplemental 5/14/04 Responses to Applicant's Interrogatories". In this response the Answer to Applicant's Interrogatory #3 was as follows:

"Bose objects to this request to the extent it is irrelevant, overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Bose further objects to this request to the extent it requests information protected by the attorney-client and/or attorney work product privileges. Notwithstanding the foregoing objections, Bose refers to its Notice of Opposition and to relevant, representative, responsive, non-privilege information in the form of documents and things, to the extent that exists and is in Bose's custody and control, that Bose will make available to Applicant for inspection at Fish & Richardson's Boston Office at a mutually agreeable date and time."

Once again, no substantive information was provided to Applicant as of 14 May 2004.

The Agreement between Opposer's Attorney and Hexawave's Attorney was that the documents would be provided at the Deposition of John Mar (an employee of Opposer). Opposer then indicated to Applicant's Attorney that the Deposition would be held on 21 May 2004. Agreement was made that Applicant's Attorney would review documents on 20 May 2004.

At the Deposition of John Mar on 21 May 2004, documents were provided by Opposer's Attorneys. Further, on 20 May 2004, Applicant for the first time was permitted to see documents which were requested in the original Interrogatory #3.

During the Deposition, Mr. Mar was questioned by Applicant's Attorneys with regard to the identification of the goods sold by Opposer and in particular with relation to the goods identified in Trademark Registration 1,633,789 relied upon by Opposer.

Mr. Mar's testimony on 21 May 2004 along with the documents provided by Opposer's Attorney on 20 May 2004 and at the Deposition, served as the basis for Applicant's "Motion for Leave to Amend Answer to Add Counter-Claim, and Memorandum in Support".

In fact, Applicant received the transcript of the Deposition on or about 8 June 2004. Upon review of the transcript and documents, the Applicant's Motion for Leave to Amend Answer to Add Counter-Claim and Memorandum in Support Thereof was filed within a two week period and a Certificate of Service was provided dated 23 June 2004. Thus, Opposer's statement that "this Motion is

simply made too late ...” is simply incorrect and even ludicrous in view of the aforementioned factual history.

Additionally, Opposer has stated that “... this Motion ... is highly prejudicial to Bose”. It is not believed that this Motion is prejudicial in any manner to Bose since Bose certainly has had the right during its rebuttal testimony period to respond to Applicant’s Motion for Leave to Amend Answer to Add Counter-Claim, and Memorandum in Support. Additionally, if there is some “prejudice”, it is clearly the non-action taken by Bose during the appropriate period to respond to Applicant’s Interrogatories.

Further, in Opposer’s “Opposition to Applicant’s Motion for Leave to Amend Answer to Add Counter-Claim”, Opposer has stated “... 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 Counter-Claim at this late date”.

What is not stated by the Opposer is that the issue of the Counter-Claim proposed by Applicant did not come to Applicant’s attention until 20 May 2004 and questions were directed to Bose’s employee on 21 May 2004. Opposer fails to realize that the “non-use issue” relied upon by Applicant did not come to Applicant’s attention until the day before Opposer’s employee was deposed.

In the Opposition to Applicant's Motion for Leave to Amend Answer to Add Counter-Claim, the Opposer states in its reference to 37 CFR § 2.114(b)(2)(i) that: "the rule is not meant to allow a party, who, like applicant, is dilatory, refuses to properly investigate claims that may have supported a counter-claim long before, and otherwise sits on its right, to bring an 11th hour motion seeking to cancel it opponent's cited registration."

The Opposer is incorrect in this statement since Applicant was not dilatory and further could not investigate claims that were not known to the Applicant prior to 20 May 2004 and in fact 21 May 2004 where the employee of the Opposer was specifically questioned with regard to this issue. In fact Opposer's statement relating to the Applicant being "dilatory" is not only wrong but clearly a misrepresentative of the facts based upon the Opposer's non-action taken throughout the discovery period.

Opposer further states that "even if, *arguendo*, the rules of practice did not require the timely filing of a compulsory counter-claim, the fact remains that to allow Applicant leave to Amend his Answer to Add a Counter-Claim will result in severe prejudice to Bose because Bose will be denied the opportunity to obtain discovery and testimony in defense of Applicant's Counter-Claim". *Arguendo*, even if some prejudice may exist to Bose, it is precisely Bose's dilatory non-actions which have demanded this counter-claim. Bose did not actually answer Interrogatory #3 throughout its responses and its supplementary responses to the Interrogatory Request even as late as 14 May 2004. It was only at the earliest on

20 May 2004 that Applicant had an opportunity to view the documents provided by Bose.

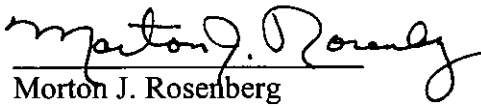
Further, it is the long-standing practice of the Board to grant amendments to pleadings and that such amendments of pleadings "... be allowed with great liberality at any stage in the proceeding where necessary to bring about a furtherance of justice." See *American Optical Corp.*, 168 USPQ 473.

The statement made by Opposer in Opposition to Applicant's Motion for Leave to Amend Answer and to Add Counter-Claim relating to: "finally, Applicant's actions appear to be nothing more than a blatant attempt to drag out the inevitable conclusion of this proceeding just a few months before it is to end", is a supposition made by the Opposer and it is believed that it is the Trademark Trial and Appeal Board which is to decide this case and not rely simply upon the Opposer's statement as to "... inevitable conclusion ...".

With reference to Opposer's statement: "it is highly suspect that Applicant's Motion was filed shortly after the time that Bose rejected Applicant's offer of settlement", this does not direct itself to a factual matter and completely fails to point out that it was Opposer who initially began settlement discussions circa January 2004 in telephone conferences with Applicant's Attorneys. Further, the statement of Opposer's suspicions are entirely speculative, are a supposition and it is not believed that a response to such blatant speculation is proper in a reply brief to the Trademark Trial and Appeal Board.

For the foregoing reasons, it is respectfully submitted that Applicant's Motion for Leave to Amend Answer and to Add Counter-Claim and Memorandum in Support be granted.

Respectfully submitted,



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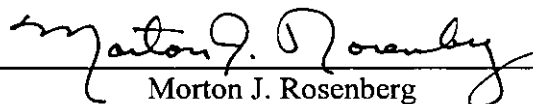
Attorneys for Applicant, Hexawave, Inc.

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.

7/20/04

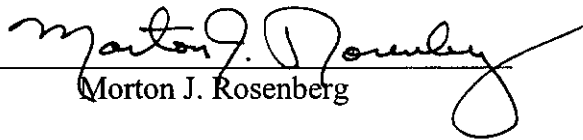
Date of Deposit



Morton J. Rosenberg

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 20th day of July 2004, a copy of the foregoing Applicant's Response to Opposer's Motion for Leave to Amend Notice of Opposition and Memorandum was mailed, first-class, postage prepaid, to Charles Hieken, Esquire and Amy L. Brosius, Esquire, Fish & Richardson P.C., 225 Franklin Street, Boston, MA 02110-2804.


Morton J. Rosenberg