

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

Mailed: January 8, 2005

Opposition No. 91157315

BOSE CORPORATION

v.

HEXAWAVE INC.

Thomas W. Wellington
Interlocutory Attorney,
Trademark Trial and Appeal Board:

This proceeding now comes up on (1) opposer's motion (filed June 1, 2004) for leave to file an amended notice of opposition, and (2) applicant's motion (filed June 24, 2004) for leave to file an amended answer with counterclaim.¹ The parties have briefed the motions. The Board presumes familiarity with the issues presented and does not provide a complete recitation of the allegations and contentions of each party.

We turn first to opposer's motion for leave to file an amended notice of opposition. By way of this motion, opposer

¹ Opposer also filed (on November 8, 2004) a motion to suspend proceedings pending the Board's determination of these motions, with applicant's consent. The motion to suspend is granted to the extent that proceedings are considered suspended as of November 8, 2004. See TBMP § 510 (2d ed. rev. 2004) and authorities cited therein.

seeks to insert an additional ground for opposition in its complaint, namely, alleging that applicant had not made "bona fide use of its mark in commerce" prior to filing its [use-based] application and the application is "void *ab initio*."

Leave to amend a pleading shall be freely given when justice so requires. See Fed. R. Civ. P. 15(a). Accordingly, 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 or parties. See TBMP § 507 (2d ed. rev. 2004) and authorities cited therein.

After consideration of both parties' arguments regarding opposer's motion to amend, we find that opposer has stated a claim that, if proven, would entitle it to the relief sought. Further, applicant's rights will not be prejudiced by the amended complaint. Thus, the motion to amend is granted and opposer's amended notice of opposition (filed June 1, 2004) is the operative complaint in this case.²

² The Board's copy of opposer's amended notice of opposition is stamped "Confidential" and has not been entered into the public proceeding file or scanned for entry into the Board's online database. **Opposer is ordered to file within fifteen (15) days from the mailing date of this order a redacted copy of the amended notice of opposition with the Board which will entered into the proceeding file (and scanned into the Board's TTABVue online proceeding database).**

We now turn to applicant's motion for leave to file an amended answer that includes a counterclaim petition to cancel opposer's pleaded registration.

As stated previously in this order, a motions for leave to file amended pleadings are generally allowed when justice so requires; however, the timing of a motion for leave to amend is particularly important the party seeks leave to amend to assert a counterclaim for cancellation of the plaintiff's pleaded registration. See TBMP § 507.02(b) (2d ed. rev. 2004). Counterclaims to cancel pleaded registrations in Board proceedings are governed by Trademark Rules 2.106(b)(2)(i) and 2.114(b)(2)(i), which essentially provide that if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. Otherwise, if during the proceeding the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned.

In this case, we find that applicant filed its motion for leave to filed an amended answer with a counterclaim promptly after learning of the information which serves as the basis for its counterclaim. Specifically, applicant bases its counterclaim cancellation on information obtained through the deposition of John Mar (taken on May 21, 2004 and certified

copy thereof served on June 8, 2004) and discovery documents received from opposer a day prior to the deposition.

Applicant's motion was filed on June 23, 2004. Moreover, we find no demonstrated prejudice to opposer.

In view of the above, and after consideration of the parties' arguments regarding applicant's motion for leave to file a counterclaim, applicant's motion is granted to the extent that applicant is allowed twenty (20) days from the mailing date of this order to file an amended answer, with counterclaim, to opposer's amended notice of opposition. Fed. R. Civ. P. 15(a).

In summary, the Board holds as follows:

- 1.) Opposer's motion to amend its notice of opposition is granted and amended notice of opposition is accepted and entered;
- 2.) Applicant is allowed twenty (20) days from the mailing date of this order to file an answer to opposer's amended notice of opposition;
- 3.) Applicant's motion to amend its answer to assert a counterclaim is granted to the extent that applicant's answer to the amended notice of opposition may include the proposed counterclaim to cancel the pleaded registration;
- 4.) Should applicant file a counterclaim cancellation, opposer is allowed thirty (30) days from the date it is served with the counterclaim to file its answer thereto.

Proceedings Otherwise Suspended - Remaining Appropriate Trial Dates to be Rescheduled

Proceedings are otherwise suspended. We note that as of the filing date for opposer's motion to suspend proceedings, discovery had closed and the parties' original testimony periods had expired.³ Upon expiration of the time allowed for the parties to file their amended pleadings (as set forth above), the Board will reschedule the appropriate remaining testimony periods, including any reopening of testimony periods limited in scope to issues raised by the amended pleadings, as well as the deadlines for filing briefs.

* * *

³ Opposer's notice of reliance was filed on June 1, 2004 and applicant's notice of reliance was filed on July 28, 2004.