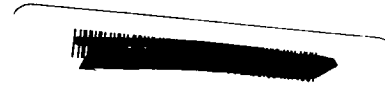


TTAB

Attorney's Docket No.: 02103-008PP2

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

In the matter of Application Serial No. 76/698,824
For the Mark WAVEFORCE
Published in the Official Gazette on March 18, 2003



10-20-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

Bose Corporation,

Opposer,

v.

Lightsurf Technologies, Inc.,

Applicant.

Opposition No. 91-157,381

Commissioner for Trademarks
BOX TTAB – NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

**OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES
AND EMBODIED MEMORANDUM IN SUPPORT THEREOF**

Motion

Opposer, Bose Corporation, ("Opposer") by and through its attorneys, hereby moves the Trademark Trial and Appeal Board (the "Board") for an order striking certain of Applicant Lightsurf Technologies, Inc.'s ("Applicant") affirmative defenses. As the

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.

October 17, 2003

Date of Deposit

Amy Armitage

Signature

Amy V. Armitage

Typed or Printed Name of Person Signing Certificate

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 2

Attorney's Docket No.: 02103-008PP2

facts below demonstrate, certain of Applicant's affirmative defenses constitute an attack on the validity of Opposer's registrations on which the opposition is based (the "Pleaded Registrations"), and cannot be maintained where Applicant has not timely asserted a counterclaim or filed a separate petition for cancellation of Opposer's Pleaded Registrations.

Statement Of The Facts

Applicant filed an application to register the mark WAVEFORCE on May 6, 1999 under Application Serial No. 76/698,824. The mark was published for opposition on March 18, 2003. Opposer filed a Notice of Opposition to the registration of WAVEFORCE on July 15, 2003. Applicant filed its Answer to the Notice of Opposition on September 26, 2003.

Applicant's Answer, a true and correct copy of which is attached hereto as Exhibit A, sets forth the following affirmative defenses:

Answer ¶3:

There is no likelihood of confusion, mistake or deception because the scope of protection, if any, afforded Opposer with respect to its claimed marks, "WAVE", "ACOUSTIC WAVE", "PROFESSIONAL WAVE" and "WAVESYNC" marks [sic] is very narrow ... because said terms are, in whole or in part, common descriptive or generic terms having direct and immediate reference to the goods set for the in the pleaded registrations, and on which use by Opposer is alleged.

Answer ¶ 5:

Upon information and belief, the trademark(s) in one or more of the alleged registrations and the common law rights pleaded by Opposer are no longer in use on or in connection with some or all of the goods set forth in the Notice of Opposition.

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 3

Attorney's Docket No.: 02103-008PP2

Answer ¶ 6:

Upon information and belief, one of more of the alleged marks pleaded by Opposer were not assigned, were not properly assigned, were not assigned with the goodwill of the business with which they were associated and were in use, and/or were not validly assigned, and consequently are no longer valid, in whole or in part, and/or are not owned by Opposer.

Applicant neither submitted payment to cover the statutory fee for a Petition for Cancellation of Opposer's Pleadings Registrations, U.S. Registration Nos. 1,633,789; 1,764,183; 1,338,571; 2,464,181; and 2,493,186, with its Answer, nor filed a separate Petition to Cancel the Pleadings Registrations prior to September 27, 2003, the deadline set by the Board for Applicant to file its Answer.

Legal Standard

Trademark Rule § 2.106(b)(1) requires that an answer to an opposition "state in short and plain terms the applicant's defenses to each claim asserted." 37 C.F.R.

§ 2.106(b)(1). An answer may contain any defense that constitutes an avoidance or affirmative defense, including a defense that an opposer's pleaded registration is weak and accordingly has a limited scope of protection. See Gould Inc. v. Sanyo Electric Co., Ltd., 179 USPQ 313, 314 (TTAB 1973); 37 C.F.R. § 2.106(b)(1). However, a defense attacking the validity of a pleaded registration will be considered a compulsory counterclaim for cancellation of the pleaded registration if grounds for asserting such a counterclaim exist at the time applicant files its answer. See 37 C.F.R. § 2.106(b)(2)(i).

For example, "allegations to the effect that opposer's [pleaded registration] has become the common descriptive name of the goods upon which it is used and that opposer has no trademark rights therein do not constitute a pleading of the 'weak mark

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 4

Attorney's Docket No.: 02103-008PP2

theory' but rather represent an attack upon the validity afforded to opposer's pleaded registration." Gould Inc. v. Sanyo Electric Co., Ltd., 179 USPQ at 314. Such an attack will not be entertained by the Board unless a counterclaim or separate petition seeking cancellation of the pleaded registration is properly and timely filed. See 37 C.F.R. § 2.106(b)(2)(ii); TBMP 318.02(b).

The same Trademark Rules that govern petitions to cancel apply to counterclaims that seek cancellation of an opposer's pleaded registrations. See 37 C.F.R. § 2.114(b)(2)(iii); TBMP § 313.01. If the grounds for a counterclaim are known to the applicant when its answer is filed, an applicant must assert the counterclaim with or as part of its answer. See 37 C.F.R. § 2.106(b)(2)(i). In addition, the statutory fee associated with a petition to cancel must accompany a counterclaim that seeks cancellation of a pleaded registration. See 37 C.F.R. § 2.111(c)(1). The Patent and Trademark Office will refuse to consider a counterclaim for cancellation where a party fails to include the statutory fee with its answer. See Sunway Fruit Products, Inc., v. Productos Caseros, S.A., 130 USPQ 33, 34 (CCPA 1960)(the Commissioner of Patents affirmed a decision by the Board striking applicant's affirmative defense that sought cancellation of opposer's pleaded registration because applicant's answer was not accompanied by the statutory fee).

Argument

Applicant's affirmative defenses ¶¶ 3, 5, and 6 which challenge the validity of Opposer's Pleded Registrations should be stricken from Applicant's Answer because 1) Applicant's defenses are more than an avoidance or an affirmative defense, but are in the

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 5

Attorney's Docket No.: 02103-008PP2

nature of a counterclaim for cancellation where they attack the validity of Opposer's Pleded Registrations; and 2) Applicant's defenses, properly viewed as a counterclaim for cancellation of Opposer's Pleded Registrations, were not timely or properly pled where Applicant failed to pay the statutory fee for cancellation, and alternatively did not file a separate petition for cancellation of opposer's Pleded Registrations by the deadline for filing its Answer.

First of all, ¶¶ 3, 5, and 6 of Applicant's affirmative defenses attack the validity of Opposer's Pleded Registrations, where they assert that Opposer's Pleded Registrations are merely descriptive and/or generic and/or have been abandoned and/or are not validly owned by Opposer. As such, they are in the nature of counterclaims for cancellation.

Specifically, Applicant, in its Answer to the Notice of Opposition, attacks the validity of Opposer's Pleded Registrations, stating "There is no likelihood of confusion, mistake or deception because the scope of protection, if any, afforded Opposer with respect to its claimed marks, "WAVE", "ACOUSTIC WAVE", "PROFESSIONAL WAVE" and "WAVESYNC" marks [sic] is very narrow ... because said terms are, in whole or in part, common descriptive or generic terms having direct and immediate reference to the goods set for the in the pleaded registrations, and on which use by Opposer is alleged." (see Exhibit A, 3¶).

Applicant further attacks the validity of Opposer's Pleded Registrations by asserting that they have been abandoned, stating "Upon information and belief, the trademark(s) in one or more of the alleged registrations and the common law rights

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 6

Attorney's Docket No.: 02103-008PP2

pleased by Opposer are no longer in use on or in connection with some or all of the goods set forth in the Notice of Opposition.” (see Exhibit A, ¶ 5).

Finally, Applicant attacks the validity of Opposer's Pleadings Registrations when it asserts “Upon information and belief, one or more of the alleged marks pleaded by Opposer were not assigned, were not properly assigned, were not assigned with the goodwill of the business with which they were associated and were in use, and/or were not validly assigned, and consequently are no longer valid, in whole or in part, and/or are not owned by Opposer.” (see Exhibit A, ¶ 6).

Clearly, Applicant's affirmative defenses cannot be interpreted but as an attack on the validity of Opposer's Pleadings Registrations. However, it is well settled that an attack upon the validity of a pleaded registration can be entertained only in the context of a petition to cancel the registration. La Fara Importing Company, Inc. v. F. Lli de Cecco di Filippo Fara S. Martino S.p.a., 8 U.S.P.Q.2d 1143, 1146 n.7 (TTAB 1998). Affirmative defenses that attack that validity of an opposer's pleaded registrations, when properly viewed as counterclaims for cancellation, can only be maintained if they are properly pled. See Gould Inc. v. Sanyo Electric Co., Ltd., 179 USPQ 313 (Board determined that applicant's affirmative defenses, which included an assertion that the pleaded registration “has become the common descriptive name of an article and has lost all trademark significance” was an attack on the validity of opposer's registration, and where applicant's separate petition for cancellation of opposer's pleaded registration had been previously dismissed, such an affirmative defenses could not be maintained).

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 7

Attorney's Docket No.: 02103-008PP2

Applicant's defenses cannot be maintained as counterclaims for cancellation because Applicant did not fulfill the statutory requirements necessary to sustain a compulsory counterclaim for cancellation where it did not assert a counterclaim before or with its Answer, and did not include the statutory fee.¹ Compulsory counterclaims, if the grounds for such are known at the time, must be brought with or as part of an applicant's answer. See 37 C.F.R. § 2.114(b)(2)(i); see also, Vitaline Corp. v. General Mills, Inc., 891 F.2d 273 (Fed. Cir. 1989)(The Federal Circuit asserted that Trademark Rule 2.114(b)(2)(i) "would be a nullity" if the Board allowed an applicant to pursue its claim for cancellation of an opposer's pleaded registration where applicant had failed to timely assert a counterclaim for cancellation prior to or with its answer). Furthermore, Applicant did not file a timely separate petition for cancellation of Opposer's pleaded registrations by the September 26, 2003 deadline to answer.

In addition, the Board has made clear there are no exceptions to the Trademark Rule requiring that the statutory fee be submitted at the time a party files a counterclaim for cancellation. See Sunway v. Productos Caseros, 130 USPQ at 34. Accordingly, Applicant's affirmative defenses cannot be maintained as a counterclaim for cancellation of Opposer's pleaded registrations. Applicant's affirmative defenses relating to the validity of Opposer's Pleded Registrations contained in ¶¶ 3, 5, and 6 of Applicant's Answer should be stricken.

¹ Trademark Rule 2.6 requires a petition fee of \$300 per class in respect of each registration for which cancellation is sought. Applicant should have provided a fee in the amount of \$1500 to cancel Opposer's Pleded Registrations, which are registered in a total of 5 classes.

Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 8

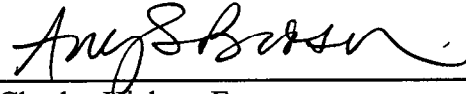
Attorney's Docket No.: 02103-008PP2

Conclusion

Opposer respectfully requests that its Motion be granted in its entirety, and Applicant's affirmative defenses in ¶¶ 3, 5, and 6 of its Answer which attack the validity of Opposer's Pleadings Registrations be stricken.

Date: _____

10/17/03



Charles Hieken, Esq.
Amy L. Brosius, Esq.
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Attorneys for Opposer,
BOSE CORPORATION

Enclosure:
Exhibit A (Copy of Applicant's Answer)

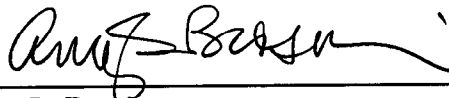
Applicant : Lightsurf Technologies, Inc.
Serial No. : 76/698,824
Filed: : May 6, 1999
Mark : WAVEFORCE
Page : 9

Attorney's Docket No.: 02103-008PP2

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES AND EMBODIED MEMORANDUM IN SUPPORT THEREOF** has this 17th day of October 2003, been mailed by prepaid first class mail to the below-identified Attorney at his/her place of business:

Martin R. Greenstein, Esq.
TechMark
55 South Market Stgreet
16th Floor
San Jose, CA 95113



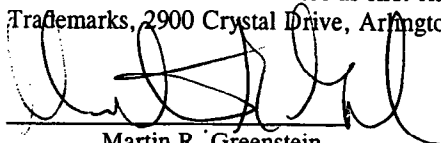
Amy L. Brosius

02103/008PP2


TRADEMARK

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on September 26, 2003.


Martin R. Greenstein

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


TRADEMARK DEPT.

BOSE CORPORATION	: Opposition No. 157,381
	: Appln. Ser. No. 76/698,824
Opposer	:
v.	: Filed: May 6, 1999
	:
LIGHTSURF TECHNOLOGIES, INC	: Published: March 18, 2003
	:
Applicant	: Mark: WAVEFORCE

ANSWER TO NOTICE OF OPPOSITION

Applicant, LightSurf Technologies, Inc. ("Applicant" or "LightSurf"), for its answer to the Notice of Opposition states:

1. Applicant is without sufficient knowledge to form a belief as to the truth or falsity of the allegations of paragraph 1 of the Notice of Opposition and consequently DENIES the same, leaving Opposer to strict proof thereof. Further answering, Applicant specifically DENIES that certified copies of any registrations were attached to materials received by Applicant, and that even the document which purports to be a photocopy of a certified copy of Reg. No. 1,633,789 bears a certification date of March 9, 1993 and is, at best, a stale certification.

ACTION ON OPPOSITION
STATUS
11/19/03
ENDS ON 10/1/03

2. The Notice of Opposition contains no paragraph 2, so no response is necessary or possible. If and to the extent paragraph 2 was inadvertently incorporated into paragraph 1, it is responded to above.

3. Applicant is without sufficient knowledge to form a belief as to the truth or falsity of the allegations of paragraph 3 of the Notice of Opposition and consequently DENIES the same, leaving Opposer to strict proof thereof.

4. Applicant ADMITS that it filed Application No. 75/698,824 for the mark WAVEFORCE on May 6, 1999, that during prosecution the goods were amended to those set forth in paragraph 4 of the Notice of Opposition, and that said application was published for opposition in the Official Gazette of March 18, 2003, but DENIES the remaining allegations of paragraph 4.

5. Applicant DENIES the allegations of the allegations of paragraph 5 of the Notice of Opposition, leaving Opposer to strict proof thereof..

6. Applicant DENIES the allegations of the allegations of paragraph 5 of the Notice of Opposition, leaving Opposer to strict proof thereof.

AFFIRMATIVE DEFENSES

1. There is no likelihood of confusion, mistake or deception because, inter alia, Applicant's mark and the pleaded alleged marks of Opposer are or would be used on different goods and/or services and sold through different trade channels, and simultaneous by both is not likely to cause confusion, mistake or deception.

2. The Notice of Opposition, in whole or as to specific allegations, fails to state a claim upon which relief can be granted.

3. There is no likelihood of confusion, mistake or deception because the scope of protection, if any, afforded Opposer with respect to its claimed marks "WAVE", "ACOUSTIC WAVE", PROFESSIONAL WAVE" and "WAVESYNC" marks is very narrow as a result of the doctrines of laches, estoppel and acquiescence, and also because said terms are, in whole or in part, common descriptive or generic terms having direct and immediate reference to the goods set forth in the pleaded registrations, and on which use by Opposer is alleged.

4. The rights of Opposer are limited because marks which consist of or include the common term "wave", alone and in combination with other words, symbols and/or designs have previously been used and/or registered by numerous other third party users for various goods and/or services of the type set forth in Applicant's application, for goods and/or services of the type set forth in Opposer's alleged registrations, or for closely related goods and services, many of which are the same or similar to goods or services of Opposer.. As such Opposer's rights are limited to at most a specific form of the mark, and also to specific goods or services in specific trade channels, by virtue of any valid common law rights which Opposer may be able to successfully establish.

5. Upon information and belief, the trademark(s) in one or more of the alleged registrations and the common law rights pleaded by Opposer are no longer in use on or in connection with some or all of the goods set forth in the Notice of Opposition.

6. Upon information and belief, one or more of the alleged marks pleaded by Opposer were not assigned, were not properly assigned, were not assigned with the goodwill of the business with which they were associated and in use, and/or were not validly assigned, and consequently are no longer valid, in whole or in part, and/or are not owned by Opposer.

WHEREFORE, Applicant respectfully requests that Opposition No. 157,381 be denied and that Application Serial Number 75/698,824 be allowed to proceed to registration.

Dated: September 26, 2003

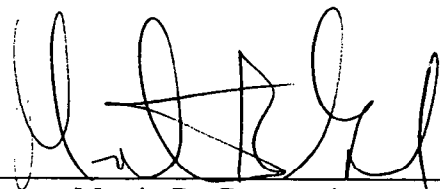
LIGHTSURF TECHNOLOGIES, INC

By 
Martin R. Greenstein
TechMark
55 South Market Street
Sixteenth Floor
San Jose, CA 95113
(408) 280-2233
MRG@TechMark.com
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing ANSWER TO NOTICE OF OPPOSITION is being served this 26th of September, 2003 upon counsel of record for Opposer by deposit of same in the United States mail, first class postage prepaid, in an envelope addressed to:

Charlies Hieken, Esq.
Amy L. Brosius, Esq.
FISH & RICHARDSON, P.C.
225 Franklin Street
Boston, MA 02110-2804
Tel: 617-542-5070; Fax: 617-542-8906
Attorneys for Opposer


Martin R. Greenstein