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

Atofina Chemicals, Inc. (by change of name)
from Elf Atochem North America, Inc.),)

Attorney Ref.: 3809-3

Petitioner,)

v.)

Cancellation No. 92030640

GE Betz, Inc. (by change of name from)
BetzDearborn, Inc.),)

Respondent.)



03-18-2004

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

**MEMORANDUM IN SUPPORT OF RESPONDENT'S
MOTION FOR LEAVE TO AMEND ANSWER TO
ADD A COUNTERCLAIM FOR CANCELLATION**

I. INTRODUCTION

This matter is before the Board on the request of Respondent, GE Betz, Inc. (hereafter "BETZ"), pursuant to Rule 2.107 of the Rules of Practice in Trademark Cases and Rule 15(a), Fed. R. Civ. P., to amend its Answer to the Petition for Cancellation to add a counterclaim for cancellation of Petitioner's pleaded Registration No. 786,983 of the mark "bioMεT" on abandonment grounds. BETZ became aware of grounds for this counterclaim during discovery and recently from Petitioner's testimony. For the reasons outlined in BETZ's Motion and discussed further below, it is submitted that the amendment to add a counterclaim for cancellation will serve the ends of justice and will not be prejudicial to Petitioner. Accordingly, it is requested that the Motion be granted.

II. STATEMENT OF MATERIAL FACTS

In response to BETZ's request for the production of copies of all advertisements and promotional materials currently distributed by Petitioner Atofina Chemicals, Inc.

(hereafter "ATOFINA") referring to products sold under the mark "bioMεT" shown in pleaded Registration No. 786,983,¹ ATOFINA produced a number of documents, none of which bear the mark "bioMεT" shown in Registration No. 786,983. Annexed hereto as Exhibit A are representative examples of the material safety data sheets and product labels produced in response to BETZ's requests.

In response to BETZ's request that ATOFINA admit that it does not use the mark "bioMεT" in the manner shown in Registration No. 786,983, ATOFINA's response indicated that use of the mark "bioMεT" shown in the pleaded registration had been discontinued, as set forth below:

Request No. 3: Petitioner does not use the mark bioMεT in the manner shown in Registration No. 786,983.

Response: Denied--Petitioner considers bioMeT to be within the scope of its registration and as used by Petitioner. However, Petitioner admits that since 1993, Petitioner has not printed its mark with the ε for the letter "e" (emphasis added).

On February 20, 2004, ATOFINA took the testimony of Rick Hill, ATOFINA's Product Manager--Coatings. Mr. Hill's sworn testimony was that use of the mark "bioMεT" shown in pleaded Registration No. 786,983 had ceased in the mid-90's and

¹ BETZ's Request Nos. 4 and 12 requested copies of advertisements and promotional materials bearing the mark "bioMεT" shown in Registration No. 786,983, as follows:

4. Copies of all advertisements and promotional materials currently distributed by Petitioner relating or referring to its products sold under the mark bioMεT shown in Registration No. 786,983.

12. Representative examples of advertisements, promotional materials or the like bearing the mark shown in Registration No. 786,983 distributed by Petitioner during the years from 1985 to date (excluding those produced in response to Request No. 4).

that Petitioner had no intent to resume use of that mark.² This statement recently made during ATOFINA's testimony deposition, together with documents produced by ATOFINA and other responses to discovery requests, indicate that ATOFINA has effectively abandoned the mark "bioMεT" shown in its pleaded Registration No. 786,983. Accordingly, BETZ should be permitted to amend its Answer to add a counterclaim seeking cancellation of Registration No. 786,983.

Following the ATOFINA testimony deposition on February 20, 2004, BETZ's attorney advised ATOFINA's counsel of its position that ATOFINA's testimony, together with its discovery responses, indicate that ATOFINA has abandoned the mark "bioMεT," and that BETZ was considering filing a motion to amend its Answer to the petition to assert a counterclaim for cancellation of Registration No. 786,983.³

During a telephone discussion with ATOFINA's attorney on Friday, March 5, 2004, counsel for BETZ confirmed that a settlement proposal was being prepared and would be sent to him for his client's consideration, but that, in light of the information disclosed during ATOFINA's testimony deposition and BETZ's duty to promptly plead a counterclaim for cancellation of a pleaded registration, it had no reasonable choice but to file a Motion for Leave to Amend its Answer to assert that counterclaim in order to protect BETZ's interests in the event that a settlement was not reached.⁴

ATOFINA's testimony period closed on February 27, 2004. BETZ's testimony period was scheduled to open on March 25, 2004. However, in the spirit of pursuing

² Mr. Hill's sworn testimony has not yet been transcribed, but will be submitted as Exhibit B to the accompanying Motion as soon as it has been transcribed.

³ BETZ's attorney also confirmed to ATOFINA's counsel that it was amenable to further settlement discussions.

⁴ A proposed agreement was forwarded to ATOFINA's attorney by facsimile and mail on March 11, 2004.

settlement discussions further, ATOFINA's attorney consented to a two-month extension of the remaining testimony periods.

III. ARGUMENT

Rule 15(a) of the Federal Rules of Civil Procedure, made applicable to cancellation proceedings through Rule 2.115 of the Rules of Practice in Trademark Cases, permits amendments to pleadings after a responsive pleading has been served only by leave of the Board or by written consent of the adverse party, but specifically provides that leave to amend "shall be freely given when justice so requires." Amendments to pleadings at any stage of a proceeding have been liberally granted by the Board when justice so requires and the proposed amendment would not be prejudicial to the rights of the adverse party. *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217, n. 1 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 430 (TTAB 1985). It is submitted that the granting of BETZ's Motion will not prejudice ATOFINA and that justice requires entry of the proposed amendment.

The abandonment claim was brought into the controversy during discovery and ATOFINA's testimony relating to this potential claim. Thus, the requested amendment in essence simply conforms the pleadings to the issues which have already been raised in this cancellation and should be permitted for this reason. See *Johnson & Johnson v. Cenco Medical/Health Supply Corp.*, 177 USPQ 586, 587 (Com. Pat. 1973).

BETZ's purpose in seeking this amendment is not for delay, but, rather, is to permit all claims between the parties to be considered in the same proceeding. BETZ submits that the interests of justice and judicial economy would best be served by

permitting all claims between the parties to be adjudicated in one proceeding. See *Space Base Inc.*, 17 USPQ at 1217, n. 1.

The granting of BETZ's Motion will not prejudice ATOFINA since it has provided discovery and taken testimony on the issue relating to abandonment of the mark shown in the pleaded registration. Further, ATOFINA will have the opportunity to take further testimony, if desired, during its rebuttal testimony period, which will mitigate any possible prejudice to ATOFINA as a result of the amendment. See *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

Under the circumstances, it is believed that BETZ's Motion to amend its Answer should be granted since it is in the interest of justice and no prejudice will result to ATOFINA by granting the Motion.

IV. CONCLUSION

For the foregoing reasons, BETZ requests that its Motion for Leave to Amend its Answer to assert a counterclaim for cancellation of ATOFINA's pleaded registration be granted. Such action is respectfully requested.

GE BETZ, INC.

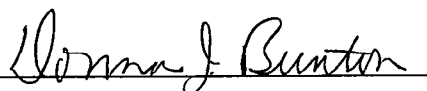
Dated: March 18, 2004

By: Donna J. Burton
Donna J. Burton
Attorney for Respondent
Nixon & Vanderhye P.C.
1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201-4714
703-816-4000

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Memorandum in Support of Respondent's Motion for Leave to Amend Answer to Add a Counterclaim for Cancellation was served upon the following attorney of record for Petitioner by depositing same in the United States mail, first class, postage prepaid, this 18th day of March, 2004:

Martin P. Hoffman, Esq.
HOFFMAN, WASSON & GITLER, P.C.
Suite 522
2361 Jefferson Davis Highway
Arlington, VA 22202

A handwritten signature in cursive script, reading "Donna J. Bunton", is written over a horizontal line.



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Atofina Chemicals, Inc. (by change of name)
from Elf Atochem North America, Inc.),)

Attorney Ref.: 3809-3

Petitioner,)

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Cancellation No. 92030640

GE Betz, Inc. (by change of name from)
BetzDearborn, Inc.),)



Respondent.)

03-18-2004

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

**MOTION FOR LEAVE TO AMEND
ANSWER TO PETITION FOR CANCELLATION**

Respondent, BetzDearborn, Inc. (now GE Betz, Inc.) (hereafter "BETZ"), pursuant to Rule 2.107 of the Rules of Practice in Trademark Cases and Rule 15(a), Fed. R. Civ. P., moves the Trademark Trial and Appeal Board to issue an order granting BETZ leave to amend its Answer to the Petition for Cancellation to add a counterclaim for the cancellation of Trademark Registration No. 786,983 of the mark "bioMεT" pleaded by Petitioner, Elf Atochem North America, Inc. (now Atofina Chemicals, Inc.) (hereafter "ATOFINA") in this cancellation. The proposed amended Answer and counterclaim to cancel Petitioner's pleaded Registration No. 786,983 is annexed hereto as Exhibit A. The grounds for this Motion are as follows:

(1) The Petition for Cancellation filed by ATOFINA relied upon ownership of U.S. Trademark Registration No. 786,983 for the mark "bioMεT" as conclusive proof of ATOFINA's exclusive right to use the mark BIOMET in commerce on the goods covered by the registration.

(2) A review of the documents produced by ATOFINA in response to BETZ's First Request for Production of Documents, served June 14, 2002, showed no use of the mark "bioMεT" shown in Registration No. 786,983.

(3) Information obtained in response to BETZ's First Request for Admissions, served August 26, 2002,¹ indicated that ATOFINA had discontinued use of the mark "bioMεT" covered by Registration No. 786,983 and was using a materially different mark in connection with the goods covered by that registration.

(4) On February 20, 2004, ATOFINA took the testimony deposition of Rick Hill, Petitioner's Product Manager--Coatings. Information elicited during the cross examination of Mr. Hill indicated that ATOFINA had ceased use of the mark "bioMεT" shown in Registration No. 786,983 in the mid-1990's and that ATOFINA has no intention to resume use of that mark.² Based upon documents produced by ATOFINA, its admission and Mr. Hill's sworn testimony, it was determined that the Answer to the Petition for Cancellation should be amended to add a counterclaim for cancellation of ATOFINA's registration on abandonment grounds.

(5) ATOFINA was aware that the abandonment of the mark "bioMεT" shown in Registration No. 786,983 would likely be made an issue in this proceeding and that a counterclaim for cancellation would likely be filed as a result of the testimony mentioned above. The proposed amended Answer and counterclaim simply conform the

¹ In November 2002, after an exchange of discovery responses, a proposed settlement agreement was sent to BETZ by ATOFINA's counsel for review and comment and an agreed motion to extend the time periods was filed to give the parties time to discuss settlement. A further stipulated motion for extension was filed on January 24, 2003, after which the Board suspended proceedings for six months while settlement discussions were pending. Those discussions were unsuccessful and proceedings were resumed by the Board on December 4, 2003.

² Mr. Hill's sworn testimony has not yet been transcribed, but will be submitted as Exhibit B as soon as it has been transcribed.

pleadings to include the abandonment issue. Accordingly, ATOFINA will not be unfairly surprised by the proposed amendment.

(6) In accordance with Trademark Rule 2.114(b)(2)(i), if the grounds for a counterclaim attacking the validity of a registration pleaded in the cancellation petition are not known at the time the Answer is filed, but are learned during the course of the cancellation proceeding, then the counterclaim can be pleaded after the grounds for the counterclaim are learned. BETZ was not aware that ATOFINA had abandoned the mark shown in its pleaded Registration No. 786,983 when BETZ filed its Answer. BETZ discovered this information from discovery responses and from the ATOFINA testimony deposition held on February 20, 2004. Thus, BETZ is promptly seeking leave to amend its Answer to conform to the evidence.

(7) The granting of BETZ's Motion for Leave to Amend its Answer to Petition for Cancellation will clearly not prejudice ATOFINA since it was aware of the potential counterclaim and has provided discovery and testimony on the abandonment issue. Further, ATOFINA will have the opportunity to take any testimony it may deem necessary to respond to the counterclaim during its rebuttal testimony period. Granting the Motion will serve the interests of justice and judicial economy by permitting all claims between the parties to be adjudicated in one proceeding.

For the above reasons and in view of the policy under Rule 15(a), Fed. R. Civ. P, of liberally granting motions to amend when justice requires, it is submitted that the Motion should be granted.

GE BETZ, INC.

Dated: March 18, 2004

By: Donna J. Buntin
Donna J. Buntin
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Registrant.)

Attorney Ref.: 3809-3

Cancellation No. 92030640



03-18-2004

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #22

**AMENDED ANSWER AND COUNTERCLAIM TO CANCEL
PETITIONER'S PLEADED REGISTRATION NO. 786,983**

Registrant, GE Betz, Inc. (formerly BetzDearborn Inc.), hereby answers the allegations of the Petition for Cancellation as follows:

1. Answering the allegations of Paragraph 1 of the Petition for Cancellation, Registrant admits that a photocopy of the certifying page of a certified copy of Registration No. 786,983 of the mark bioMεT was attached to the Petition for Cancellation as Exhibit A. Except as thus stated, Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 1 and therefore denies same.

2. Registrant denies the allegations of Paragraph 2 of the Petition for Cancellation.

3. Answering the allegations of Paragraph 3 of the Petition for Cancellation, Registrant admits that photocopies of sheets bearing the term bioMεT were attached to the Petition for Cancellation as Exhibits B, C and D. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 of

EXHIBIT A

the Petition for Cancellation relating to Petitioner's alleged use of the mark and therefore denies same. Registrant denies the remaining allegations of Paragraph 3.

4. Answering the allegations of Paragraph 4 of the Petition for Cancellation, Registrant admits that Registration No. 786,983 of the mark bioMεT issued prior to the date on which Registrant filed its application which matured into Registration No. 2,333,593. Except as thus stated, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore denies same.

5. Registrant denies the allegations of Paragraph 5 of the Petition for Cancellation.

6. Registrant denies the allegations of Paragraph 6 of the Petition for Cancellation.

7. Registrant denies the allegations of Paragraph 7 of the Petition for Cancellation.

**COUNTERCLAIM FOR CANCELLATION OF
PETITIONER'S PLEADED REGISTRATION**

8. Registrant, GE Betz, Inc. ("BETZ") hereby counterclaims to cancel Petitioner Atofina Chemicals, Inc.'s ("ATOFINA's") pleaded Registration No. 786,983 pursuant to Trademark Rule 2.114(b)(2)(i).

9. BETZ hereby incorporates paragraphs 1-7 of its Answer herein.

10. ATOFINA has asserted its ownership of Trademark Registration No. 786,983 in this cancellation as conclusive proof of its right to use the mark covered therein in commerce on the goods covered by the registration.

11. In response to BETZ's First Request for Admissions No. 3, ATOFINA admitted that since 1993, it "has not printed its mark with the ε for the letter "e" as shown in pleaded Registration No. 786,983. According to ATOFINA's sworn testimony on February 20, 2004, ATOFINA has not used the mark in the format shown in Registration No. 786,983 since the mid-1990's and has no intention to resume use of that mark.

12. Documents produced by ATOFINA in response to BETZ's request for production of promotional materials distributed by ATOFINA from 1985 to date do not bear the mark "bioMεT" shown in Registration No. 786,983.

13. The symbol "ε" is commonly known and recognized as an alternate form for the symbol "&" which stands for the conjunction "and." On information and belief, the designation "MεT" in the mark "bioMεT" is derived from the name of the original Registrant, M&T Chemicals, Inc., successor in interest to Metal & Thermit Corporation. The label submitted as a specimen with the application which matured into Registration No. 786,983, a true copy of which is attached as Exhibit 1 hereto, clearly illustrates that the derivation and meaning of the mark "bioMεT" is "bioM&T" or "bio M and T."

14. Paragraph 1 of ATOFINA's petition for cancellation asserts in part that "Petitioner is the owner of U.S. Trademark Registration No. 786,983, for BIOMET." Registration No. 786,983 covers the mark "bioMεT," which differs in sound, appearance and meaning from BIOMET. The marks "bioMεT" and BIOMET create different commercial impressions and therefore constitute materially different marks.

15. In view of ATOFINA's admitted discontinuance of use of the mark "bioMεT" shown in Registration No. 786,983 more than ten years ago with intent not to resume

use, ATOFINA has abandoned "bioMεT" as a trademark for said goods within the meaning of Section 45 of the Trademark Act of 1946.

16. Registration No. 786,983 of the mark "bioMεT" accordingly is invalid as a matter of law and Petitioner is not entitled to rely on ownership thereof as a basis for its petition to cancel BETZ's Registration No. 2,333,593 of the mark BIOMATE.

17. For the reasons set forth above, BETZ is suffering irreparable damage by the continued existence of Registration No. 786,983.

The requisite filing fee for this Counterclaim for Cancellation is submitted herewith.

WHEREFORE, BETZ prays that Cancellation No. .92030640 be dismissed and that the counterclaim for cancellation be granted with Registration No. 786,983 being canceled.

Respectfully submitted,

GE BETZ, INC.

Dated: _____

By: _____

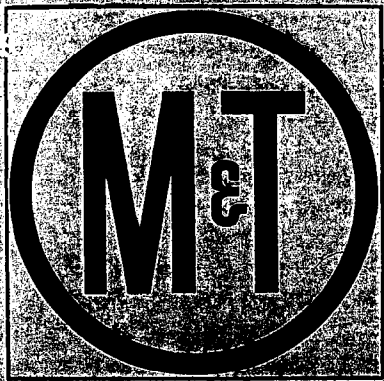
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bioM&T TB 10

BRAND OF BIS (TRI-N-BUTYL TIN) OXIDE
FOR USE IN MANUFACTURING OTHER ECONOMIC POISONS

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GENERAL OFFICES RANWAY, N. J.

ACTIVE INGREDIENTS

Bis (Tri-n-Butyltin) Oxide..... 95% Min.

INERT INGREDIENTS:

Other Butyltin Compounds..... 5% Max.
Total 100%

**WARNING! MAY BE FATAL IF SWALLOWED
MAY BE ABSORBED THROUGH SKIN
CAUSES SKIN IRRITATION**

Do not get on skin, in eyes or on clothing.
In case of contact, remove contaminated clothing and immediately wash skin with soap and water. If irritation persists get medical attention.
In case of contact with eyes, immediately flush with water and get medical attention.
Wash contaminated clothing before re-use.

Read technical data bulletin about this product prior to use.

NO. 79

MADE IN U.S.A.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Motion for Leave to Amend Answer to Petition for Cancellation was served upon the following attorney of record for Petitioner by depositing same in the United States mail, first class, postage prepaid, this 18th day of March, 2004:

Martin P. Hoffman, Esq.
HOFFMAN, WASSON & GITLER, P.C.
Suite 522
2361 Jefferson Davis Highway
Arlington, VA 22202

