UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CME

Mailed: March 11, 2015

Cancellation No. 92057631

X/Open Company Limited

v.

Chong Teck Choy

Cancellation No. 92060287
Cancellation No. 92060293

Chong Teck Choy

v.

X/Open Company Limited[1]

Before Cataldo, Greenbaum, and Gorowitz, Administrative Trademark Judges.

By the Board:

Chong Teck Choy ("Mr. Choy") owns Registration No. 4098948 for the mark XIUNIX, in standard characters, for a broad range of computer, website and technical services in International Class 42.[2] On August 1, 2013, X/Open

[1] For administrative ease, we issue a single order addressing all of the captioned cancellation proceedings. A copy of this order has been placed in the file for each proceeding.

[2] Filed July 4, 2011; issued February 14, 2012; claiming a date of first use of August 29, 2004 and first use in commerce of July 4, 2011.

Company Limited ("X/Open") filed a petition for cancellation of Registration No. 4098948, Cancellation No. 92057631 (the "'631 Cancellation"), alleging prior use and registration of the mark UNIX, in typed format,[3] for computers[4] and computer programs,[5] and prior common law use of the mark UNIX for "computer software, computer operating systems, and computer software certification and validation programs," as well as "adaption and integration of a standard operating system interface and environment and common utility programs to support applications programs offered by developers," and "a single stable specification to be used to develop portable computer applications of third parties." Petition, ¶¶ 2-3. As grounds for cancellation, X/Open alleges: (1) that use of Mr. Choy's mark is likely to cause confusion with X/Open's previously used and registered mark UNIX; (2) fraud; and (3) that the involved registration is void *ab initio* on the ground that the involved mark was not in use in commerce in connection with the identified services as of the filing date of the underlying use-based application.[6]

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[3] A mark in typed format is the equivalent of a standard character mark.

[4] Registration No. 1390593, issued April 22, 1986; Section 8 affidavit accepted; renewed.

[5] Registration No. 1392203, issued May 6, 1986; Section 8 affidavit accepted and Section 15 affidavit acknowledged; renewed.

[6] The petition for cancellation also references a claim for false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C § 1052(a), but such a claim has not been adequately pleaded. To state a claim for false suggestion of a connection, a plaintiff must plead that: (1) defendant's mark is the same as or a close approximation of plaintiff's previously used name or identity; (2) defendant's mark would be recognized as such by purchasers, in that defendant's mark points uniquely and unmistakably to plaintiff; (3) plaintiff is not connected with the goods

In his answer, Mr. Choy denies the salient allegations in the petition for cancellation. In addition, on November 3, 2014 – nearly fifteen months after he filed his answer in the '631 Cancellation – Mr. Choy filed separate petitions to cancel X/Open's pleaded registrations on grounds of fraud and abandonment. These petitions for cancellation have been assigned Cancellation Nos. 92060287 and 92060293 (the "'287 and '293 Cancellations").

Also on November 3, 2014, Mr. Choy filed in the '631 Cancellation a motion to consolidate the '631 Cancellation with the '287 and '293 Cancellations and then to suspend the '631 Cancellation pending disposition of the '287 and '293 Cancellations. On December 12, 2014, X/Open filed motions in the '287 and '293 Cancellations seeking to suspend these cancellation actions pending disposition of the '631 Cancellation. X/Open

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that are sold or will be sold by defendant under his mark; and (4) plaintiff's name or identity is of sufficient fame or reputation that when defendant's mark is used on his goods or services, a connection with plaintiff would be presumed. *See Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010) (*citing Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508-10 (Fed. Cir. 1983)); *see also Time Warner Ent. Co. v. Jones*, 65 USPQ2d 1650, 1664 n.26 (TTAB 2002) (noting that an allegation that defendant's mark "so closely resembles" plaintiff's marks is insufficient to state a claim of false suggestion of a connection). In addition, the ESTTA cover sheet accompanying the petition for cancellation indicates that X/Open may have intended to allege a claim for deceptiveness pursuant to Section 2(a) of the Trademark Act, 15 U.S.C § 1052(a), but the complaint is devoid of any such allegations. To adequately plead a claim that a mark is deceptive, a plaintiff must allege that: (1) the involved mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods and/or services; (2) prospective purchasers are likely to believe that the misdescription actually describes the goods and/or services; and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods and/or services. *See, e.g. In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009 (TTAB 2006).

opposes Mr. Choy's motion,[7] but Mr. Choy has not responded to X/Open's motions to suspend.[8]

The '287 and '293 Cancellations are compulsory counterclaims in the '631 Cancellation within the meaning of Trademark Rule 2.114(b)(2)(i). Although Trademark Rule 2.114(b)(2)(ii) provides that an attack against a pleaded registration may be brought as a separate petition for cancellation, the better practice would have been for Mr. Choy to file a motion for leave to amend his answer in the '631 Cancellation to assert the counterclaims. *See* TBMP § 313.01 (2014). Notwithstanding the procedural manner in which the counterclaims were asserted, the central issue remains the same, namely, whether the compulsory counterclaims were timely filed such that Mr. Choy should be able to pursue them at trial. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (asserting claim as separate petition to cancel rather than counterclaim does not obviate timeliness requirements of 37 CFR § 2.114(b)(2)(i)); *see also* TBMP §§ 313.01 and 313.04. Only after we have determined this issue may we consider consolidation.

"To be timely, a [compulsory] counterclaim must be brought as part of defendant's answer or promptly after grounds therefor are learned." *Turbo*

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[7] X/Open filed its opposition brief to the motion on November 24, 2014 and later that day filed a revised brief.

[8] Counsel representing X/Open in the '631 Cancellation is different from counsel representing X/Open in the '287 and '293 Cancellations.

Sportswear Inc. v. Marmot Mountain Ltd., 77 USPQ2d 1152, 1154 (TTAB 2005). Accordingly, in assessing whether to allow the counterclaims, we must consider: (1) whether grounds for the counterclaims were known to Mr. Choy when he filed his answer; and (2) if not, whether Mr. Choy acted "promptly" in petitioning to cancel the pleaded registrations after he learned of the grounds for such claims. *See id.* at 1154.

In their briefs concerning consolidation, the parties have touched on the issue of timeliness, but neither party has fully briefed the issue. For example, Mr. Choy asserts that he first learned of grounds for the counterclaims when X/Open took the testimony deposition of Steven Nunn, but Mr. Choy does not identify the specific testimony giving rise to his counterclaims. *See* Motion to Consolidate, pp. 1-2. Similarly, X/Open argues that to the extent Mr. Choy has cognizable counterclaims, it produced pertinent documents during discovery and Mr. Choy had them for months before he filed the '287 and '293 Cancellations. X/Open, however, does not point to any specific documents or identify when it produced such documents. *See* Response, pp. 2 and 4.

Because the parties have not fully briefed the issue of timeliness, we will allow them time to do so. Mr. Choy is allowed until **March 31, 2015** to file a supplemental brief concerning the timeliness of his counterclaims pursuant to Trademark Rule 2.114(b)(2)(i), and X/Open is allowed until **April 20, 2015** to file a supplemental response brief. A reply brief, if any, is due in

accordance with Trademark Rule 2.127(a). All proceedings otherwise remain suspended.

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