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

Mailed: July 24, 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 Bucher, Cataldo, and Greenbaum,
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 Company

[1] For administrative ease, we issue a single order concerning 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.

Limited ("X/Open") filed a petition to cancel Registration No. 4098948 on grounds of likelihood of confusion, fraud and non-use of the involved mark in connection with the identified services as of the filing date of the underlying use-based application. The proceeding was instituted on August 2, 2013 and assigned Cancellation No. 92057631 (the "'631 Cancellation").

On September 9, 2013, Mr. Choy filed a timely answer denying the salient allegations in the petition to cancel. On November 3, 2014, with three days left in his testimony period and nearly fourteen 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.[3] These proceedings have been assigned Cancellation Nos. 92060287 and 92060293 (the "'287 and '293 Cancellations").

Also on November 3, 2014, Mr. Choy filed a motion (the "Combined Motion"): (1) to consolidate the '631 Cancellation with the '287 and '293 Cancellations and to thereafter suspend the '631 Cancellation pending disposition of the '287 and '293 Cancellations, Combined Motion, pp. 2-3; and (2) requesting that he "be allowed time to conduct the deposition upon written questions of [his] lone witness in the instant matter" in the event the Board denies consolidation and suspension of the '631 Cancellation. *Id.* at p. 3. X/Open filed a brief in opposition to the Combined Motion on November 24, 2014.

[3] We treat the '631 Cancellation as suspended as of the date Mr. Choy filed the Combined Motion. Accordingly, three days remain in Mr. Choy's testimony period.

Upon review of the parties' filings, the Board issued an order on March 11, 2015 (the "Prior Order"): (1) explaining that the '287 and '293 Cancellations are compulsory counterclaims in the '631 Cancellation within the meaning of Trademark Rule 2.114(b)(2)(i), and therefore, the Board must determine whether the compulsory counterclaims are timely before we may consider possible consolidation, *see* Prior Order, p. 4; and (2) allowing the parties time to further brief the timeliness of the counterclaims. *See id.* at p. 5. Pursuant to the Prior Order, the parties filed supplemental briefs on March 31, 2015 and April 20, 2015, respectively.

Upon consideration of all the parties' filings and for the reasons discussed below, we find that the counterclaims are untimely.

As set forth in the Prior Order, "a [compulsory] counterclaim must be brought as part of defendant's answer or promptly after grounds therefor are learned." *Turbo Sportswear Inc. v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1154 (TTAB 2005); *see also* Trademark Rule 2.114(b)(2)(i). 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 Turbo Sportswear,* 77 USPQ2d at 1154. Mr. Choy has the burden of demonstrating that he has promptly asserted the counterclaims. *Cf. Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (denying motion for leave to amend notice of opposition to add dilution claim where such

claim became available as ground for opposition nine months before the opposition was filed, but opposer did not raise the claim until eight months after filing the opposition, and opposer failed to explain the reason for its delay).

The theory underlying Mr. Choy's counterclaims for fraud and abandonment is that X/Open's pleaded mark UNIX no longer functions as a trademark, but instead is used as a certification mark. Mr. Choy asserts that he first learned of the factual basis for the counterclaims when X/Open took the testimony deposition of Steven Nunn (the "Nunn Testimony Deposition"). *See* Combined Motion at pp. 1-2 and Mr. Choy's Supplemental Brief, p. 2. Specifically, Mr. Choy maintains that Mr. Nunn testified about "the history of the UNIX Mark and the UNIX specification" and that "X/Opens' [sic] Registered UNIX Marks were effectively no longer in use as a source identifier for X/Opens [sic] ... goods or as trademarks but, at best, now serve merely as certification marks beginning in the early 2000's." Combined Motion at p. 2. Mr. Choy further asserts that he "was not able to verify" Mr. Nunn's testimony until he received a copy of the deposition transcript "on or about October 15, 2014" and that he acted promptly in filing the '287 and '293 Cancellations "less than twenty (20) days" later. Combined Motion at p. 2 and Mr. Choy's Supplemental Brief at p. 2.

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. *See* Response to Combined Motion, pp. 2 and 4. Mr. Choy has not responded to this assertion. Mr. Choy also has not cited to the portion(s) of the Nunn Testimony Deposition purportedly giving rise to

the compulsory counterclaims notwithstanding that the Board allowed him time specifically to brief facts underlying the timeliness thereof. Instead, in his supplemental brief, Mr. Choy simply reiterates the unsupported conclusory allegations in his earlier Combined Motion. Such allegations fall far short of demonstrating that the counterclaims – brought at the end of Mr. Choy's testimony period – are timely. *Cf. Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) (finding undue delay where opposer filed motion for leave to amend four days after the close of the testimony period).

Moreover, a review of X/Open's petition to cancel demonstrates that Mr. Choy knew or should have known about the factual basis for his counterclaims at the time he filed his answer in the '631 Cancellation. Paragraphs 1 and 2 of the petition to cancel, set forth below, specifically reference X/Open's use of the UNIX mark for a computer software ***certification program***:

> 1. Petitioner, itself or through its predecessor in interest and related companies provides computer software, operating systems and ***computer software certification programs*** internationally, including in the United States; and
>
> 2. Since at least as early as 1972, and long prior to Registrant's claimed dates of first use, or first use in interstate commerce, as well as long prior to the date of Registrant's application, or registration, Petitioner itself, or through its predecessors and related companies have used the mark, UNIX in connection with computer software, computer operating systems and ***computer software certification and validation programs*** in the United States, and internationally. Petitioner's services offered under the UNIX mark are available through the web, and are offered and promoted by Petitioner through the website www.unix.org. (emphasis added).

While Mr. Choy may have learned additional facts supporting the counterclaims through the Nunn Testimony Deposition, the foregoing allegations were sufficient to put Mr. Choy on notice of the factual basis for his counterclaims such that he should have asserted the counterclaims when he filed his answer in the '631 Cancellation. *See* Trademark Rule 2.114(b)(2)(i) ("If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer.").

In addition, Exhibits 3 and 4 to the Nunn Testimony Deposition consist of two website documents describing X/Open's "Single UNIX Specification." 20 TTABVUE 8-14. These documents bear the case caption for the '631 Cancellation and Bates numbers supporting X/Open's assertion that it provided relevant documents to Mr. Choy during the discovery period, which closed on April 9, 2014 – more than six months before Mr. Choy filed the '287 and '293 Cancellations. *See Trek Bicycle,* 64 USPQ2d at 1541 (finding undue delay where motion to amend to add dilution claim was filed eight months after the notice of opposition was filed and was based on facts that appeared to be within opposer's knowledge at the time the opposition was filed).

In view of the foregoing, we find that Mr. Choy unduly delayed in asserting his compulsory counterclaims. Accordingly, the '287 and '293 Cancellations are **DISMISSED WITH PREJUDICE**. To the extent the Combined Motion seeks to

consolidate and suspend the '631 Cancellation pending disposition of the '287 and '293 Cancellations, the motion is moot and will be given no further consideration.[4]

Lastly, we consider Mr. Choy's request that he "be allowed time to conduct the deposition upon written questions of [his] lone witness in the instant matter." Combined Motion at p. 3. Three days remain in Mr. Choy's thirty day testimony period. Trademark Rule 2.124(b)(1) requires that a party seeking to take a testimony deposition upon written questions "serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice." *See also* TBMP § 703.02(g) (2014). In addition, Trademark Rule 2.142(d)(1) states that the notice of deposition on written questions "shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition." Mr. Choy does not dispute X/Open's assertion that he has failed to serve a notice of a deposition on written questions accompanied by the written questions to be propounded as required by Trademark Rules 2.124(b)(1) and 2.124(d)(1).[5] Response to Combined Motion, p. 3. Mr. Choy also did not file with the Board a copy of any notice to take a deposition on written questions. *See* Trademark Rule 2.124(b)(1) (requiring that notice of a deposition on written questions be filed with the Board). Mr. Choy's request to take a deposition on written questions is untimely and procedurally deficient. To the extent we

[4] In view hereof, X/Open's motions to suspend filed in the '287 and '293 Cancellations also are moot and will be given no further consideration.

[5] Mr. Choy also does not dispute X/Open's assertion that he failed to serve pretrial disclosures as required by Trademark Rule 2.121(e), but we note that he has not moved to reopen his pretrial disclosure deadline. Response to Combined Motion, p. 3.

construe Mr. Choy's request as a motion to reopen his deadline to comply with the notice requirement of Trademark Rules 2.124(b)(1) and 2.124(d)(1), and a motion to extend his testimony period to allow him time to complete a deposition on written questions, the construed motion is **DENIED**. *See* Fed. R. Civ. P. 6(b)(1); TBMP § 509.01.

A party seeking to reopen a deadline must demonstrate that his failure to act was the result of excusable neglect, while a party requesting to extend a deadline must establish "good cause" for the extension. *See id.* A motion to reopen or extend a deadline must "set forth with particularity" the facts upon which a claim of excusable neglect or good cause is based; mere conclusory allegations are insufficient. TBMP §§ 509.01(a) and 509.01(b)(1) and cases cited in footnotes 1 and 5 therein.

Mr. Choy has not argued, much less submitted, any evidence or factual basis to establish either excusable neglect to reopen his time to provide notice of a deposition on written questions pursuant to Trademark Rules 2.124(b)(1) and 2.124(d)(1), or good cause for extending his testimony period.

Proceedings will resume on August 10, 2015 on the schedule set forth below:[6]

Defendant's 30-day Trial Period Ends	**8/12/2015**
Plaintiff's Rebuttal Disclosures Due	**8/27/2015**
Plaintiff's 15-day Rebuttal Period Ends	**9/26/2015**

[6] As set forth in footnote 3 herein, three days remain in Mr. Choy's testimony period.

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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