

TTAB

STATEK.013M

TRADEMARK

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

Statek Corporation,

Opposer,

v.

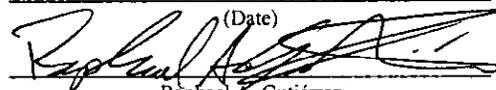
Dipl. -Ing Rainer Puls and Dipl. -Ing Oliver Puls,

Applicant.

Opposition No. 91,154,712

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on

March 15, 2004

(Date)  
  
Raphael A. Gutierrez

**OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR  
SUMMARY JUDGMENT**



Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

03-18-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

ATT: BOX TTAB - NO FEE

Dear Sir:

Statek Corporation ("Opposer"), by and through its counsel, hereby replies to Dipl. -ing Rainer Puls and Dipl. -ing Oliver Puls (collectively "Applicant") response to Opposer's Motion for Summary Judgment.

**I. INTRODUCTION**

On October 10, 2003, in connection with Opposition No. 91,154,712, Opposer filed two motions: (1) a Motion for Summary Judgment, and (2) a Motion to Compel Answers to Interrogatories and Requests for Production of Documents. The motions will be collectively referred to as "Opposer's Motions." Opposer's Motion for Summary Judgment was based on a lack of any material facts in dispute with respect to likelihood of confusion. *See Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 U.S.P.Q. 2d 1545 (T.T.A.B. 1990). Opposer's Motion to Compel was based on Applicant's failure to respond to several of Opposer's discovery requests. *See* 37 C.F.R. § 2.120(e) and TBMP §§ 411.01, 527.04. Both motions were served on opposing counsel

on October 10, 2003, but Opposer's proof of service for the Motion to Compel was not filed until October 14, 2003.

On January 22, 2004, Interlocutory Attorney Angela Lykos sent a letter to Applicant and Opposer indicating that, due to an error by the Trademark Trial and Appeal Board ("Board"), Applicant would be given until February 26, 2004 to respond to Opposer's Motions. On February 25, 2004, instead of providing a substantive response to Opposer's Motions, Applicant filed a single response ("Response") in which Applicant declared it was responding to Ms. Lykos' letter of January 22, 2004. Applicant's Response bears no title, and the substance requests that the Board amend the identification of goods in its application Serial No. 76/202,322 and dismiss this Opposition proceeding. Nothing in Applicant's Response indicates that it was intended to be an opposition to either of Opposer's Motions,<sup>1</sup> but Opposer has elected to treat it as though it was an Opposition and was entitled "Applicant's Response to (1) Opposer's Motion for Summary Judgment and (2) Opposer's Motion to Compel Answers to Interrogatories and Requests for Production of Documents."

As such, Opposer hereby submits the following Reply to Applicant's Response to Opposer's Motion for Summary Judgment. This reply is submitted concurrently with Opposer's Reply to Applicant's Response to Opposer's Motion to Compel Answers to Interrogatories and Requests for Production of Documents.

## **II. ARGUMENT**

### **A. Amending Application During Opposition**

Applicant's Response, filed on February 25, 2004, was the second time that Applicant requested that the Board amend its application. Applicant first requested that the Board amend its application in its Answer, filed on March 6, 2003. An application which is the subject of a Board proceeding may not be amended in substance, nor may a registration be amended or disclaimed in part, except with the consent of the other party and the approval of the Board, or except upon motion. 37 CFR § 2.133(a).

Since Opposer filed its Notice of Opposition on January 7, 2003 - prior to either of Applicant's requests - against Applicant's trademark application Serial No. 76/202,322, the application cannot be amended. Opposer has not consented to the amendment, nor has the

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<sup>1</sup> Indeed, to the contrary, Applicant's Response appears to indicate it is in response to the letter from the Interlocutory Attorney, and not a response or opposition to Opposer's Motions.

Applicant moved the Board for such an amendment, nor has it supplied the Board with any reason as to why the amendment should be entered. Furthermore, even if Applicant's filing on February 25, 2004 is treated as a motion to request that its application be amended, such motion should be denied. Pursuant to Ms. Lykos' January 22 letter any papers "filed during the pendency of [Statek's two] motions which are not relevant thereto will be given no consideration."

**B. Summary Judgment Standard**

Summary judgment should be granted where it is shown that there is no genuine issue of material fact, and the moving party is entitled to judgment as a matter of law. See FRCP 56(c). Summary judgment is an appropriate method of disposing of an opposition in which there is no genuine issue of material fact on the question of likelihood of confusion. See *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 U.S.P.Q. 2d 1545 (T.T.A.B. 1990).

As the moving party, Opposer has the burden of demonstrating that it is entitled to summary judgment. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 324-25 (1986). If Opposer meets its burden of identifying undisputed facts entitling it to relief, Applicant must submit *specific* facts showing that there is a genuine issue for trial. See *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). These general principles of summary judgment apply under Federal Rule of Civil Procedure 56 to inter-party proceedings before the Board. See, e.g., *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987).

**C. Opposer Has Met Its Summary Judgment Burden**

In its Motion for Summary Judgment, Opposer identified certain undisputed facts with respect to the issues of the similarity of the marks at issue and the similarity of Opponent's and Applicant's services. Opposer identified undisputed facts regarding the similarity of Applicant's mark, STATEC, to Opposer's registered mark, STATEK, in terms of sight and sound. Opposer also noted that its mark is registered in connection with "timing devices" and Applicant's application seeks to register its mark in connection with, inter alia, "chronographs for use as specialized time recording apparatuses." Opposer further noted that Opposer's goods are used in the automotive industry, and that Applicant sought to register its goods in connection with "automotive" goods and services, as described in its Class 12 and Class 41 identifications of goods and services.

**D. Applicant Failed to Meet Its Summary Judgment Burden**

In its Response, Applicant failed to contradict any of Opposer's asserted undisputed facts, thereby failing to indicate that there are any issues that remain for trial. The only argument that Applicant made was that deleting the goods quoted by Opposer in its summary judgment motion would obviate any risk of consumer confusion. This, however, is not an issue that remains for trial as Applicant has not amended its application to delete those goods, nor has it moved the Board to do so. An opposition to a motion for summary judgment cannot speak to prospective actions in arguing that there are issues that remain for trial.

Applicant did not address the remaining undisputed facts identified by Opposer. The Federal Circuit has quoted the Rules of the District Court for the Northern District of Illinois with approval: "All material facts set forth in the statement required of the moving party will be deemed to be admitted unless controverted by the statement of the opposing party." *See* *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 861 (Fed. Cir. 1981)(quoting General Rule 12(m) USDC N.D. Ill.). As such, Applicant is deemed to have admitted that the marks are similar, that Opposer's mark is registered in connection with "timing devices," that Applicant's application currently seeks to register the STATEC mark in connection with, inter alia, "chronographs for use as specialized time recording apparatuses," that Opposer's goods are used in the automotive industry, and that Applicant sought to register its goods in connection with "automotive" goods and services.

Since Applicant has admitted that the marks are identical with the exception of one letter and that the goods and services are the same, or at the very least, are similar and overlapping, summary judgment should be granted in favor of Opposer.

**III. CONCLUSION**

For the foregoing reasons, Opposer respectfully requests that its Motion for Summary Judgment be granted and that Applicant's application to register STATEC be refused on the grounds that it creates a likelihood of confusion with Opposer's registration for STATEK.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

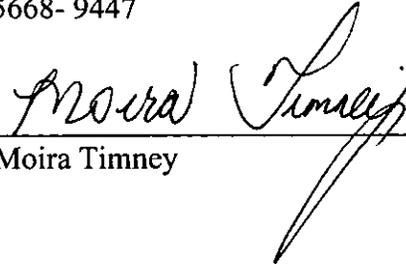
Dated: 3.15.04

By:   
Raphael A. Gutiérrez  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404  
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Opposer's Reply to Applicant's Response to Opposer's Motion for Summary Judgment upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on March 15, 2004, addressed as follows:

Klaus J. Bach  
KLAUS J. BACH & ASSOCIATES  
4407 Twin Oaks Drive  
Murrysville, PA 15668- 9447

  
\_\_\_\_\_  
Moira Timney

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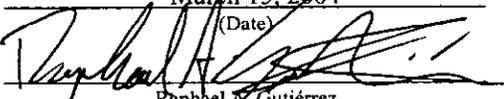
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Raphael A. Gutierrez

**OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO  
COMPEL ANSWERS TO INTERROGATORIES AND PRODUCTION OF  
DOCUMENTS**

Commissioner for Trademarks  
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reason as to why the amendment should be entered. Furthermore, even if Applicant's filing on February 25, 2004 is treated as a motion to request that its application be amended, such motion should be denied. Pursuant to Ms. Lykos' January 22 letter any papers "filed during the pendency of [Statek's two] motions which are not relevant thereto will be given no consideration."

**B. Compelling Production**

As described in Opposer's Motion to Compel, Opposer tried several times to obtain discovery responses from Applicant. Despite Opposer's efforts, Applicant never responded to nor submitted objections to Opposer's requests. Where a party fails to timely answer interrogatories or respond to document requests, the requesting party may move for an order compelling the disobedient party to respond to outstanding discovery. *See* 37 C.F.R. § 2.120(e) and TBMP §§ 411.01, 527.04.

Opposer moved for such an order, and only one portion of Applicant's Response appears to be directed to Opposer's Motion to Compel. Applicant states that if its application were amended there would be "no basis for interrogatories, no reason for supplying any documents and certainly no reason to compel answers to interrogatories." The fact remains, however, that the application has not been amended as such, nor has Applicant moved the Board to amend it, nor has it supplied the Board with a reason to amend its application this late in the proceedings.

In its Response, Applicant further neglected to supply the Board with any reason for its failure to respond to Opposer's discovery requests other than it thinks there is no basis for the opposition. Applicant did not give the Board a reason to indicate why it has burdened the Board with ruling on Opposer's Motion to Compel. Applicant's actions appear to be designed to do nothing more than further delay resolution of this matter.

Opposer has made a good faith effort to resolve the issues regarding Applicant's discovery requests prior to filing its Motion to Compel. It has corresponded with Applicant in connection with the outstanding discovery, and has been unable to reach an agreement with Applicant due to Applicant's failure to respond to Opposer's letters regarding its discovery requests. Opposer believes it has complied in good faith with the requirements of 37 C.F.R. § 2.120(e)(1), and respectfully requests that, in the event its Motion for Summary Judgment is denied, Applicant be ordered to respond to the outstanding discovery.

**III. CONCLUSION**

As Applicant has repeatedly chosen to avoid responding to Opposer's discovery requests (and Opposer's letters regarding the same) in disregard of the applicable rules, Opposer respectfully requests that, in the event its Motion for Summary Judgment is denied, Opposer's Motion to Compel Answers to Interrogatories and Production of Documents be granted.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: \_\_\_\_\_

3.19.04

By: \_\_\_\_\_

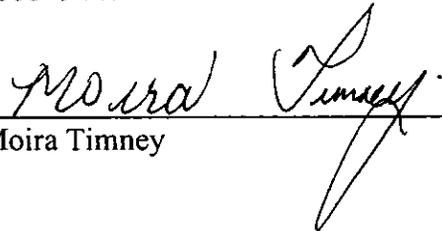


Raphael A. Gutiérrez  
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(949) 760-0404  
Attorneys for Applicant

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Klaus J. Bach  
KLAUS J. BACH & ASSOCIATES  
4407 Twin Oaks Drive  
Murrysville, PA 15668- 9447

  
\_\_\_\_\_  
Moira Timney

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