

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,

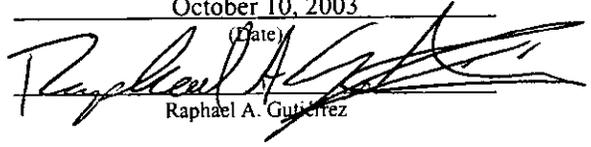
Applicant.

Opposition No. 91154712

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

October 10, 2003

(Date)



Raphael A. Gutierrez

**OPPOSER'S MOTION FOR SUMMARY JUDGEMENT**

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



10-14-2003

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

Dear Sir:

**I. INTRODUCTION**

This is an opposition proceeding having Opposition Number 91154712 ("Opposition") brought by Statek Corporation ("Opposer") against Dipl.-ing Rainer Puls and Dipl.-ing Oliver Puls (collectively, "Applicant") regarding Applicant's U.S. Trademark Application Serial Number 76/202,322 ("Application"). Applicant filed its Application on January 30, 2001 for the mark STATEC, and has a priority filing date of July 31, 2000. Applicant's Application is based on Sections 1(b) and 44(e) of the Trademark Act. Applicant has yet to claim a date of first use. The Application and was filed in connection with speedometers, accelerometers, power meters, force meters, thermometers, pressure meters, and chronographs for use as specialized time recording apparatuses; computers for monitoring and controlling drive and drive components, namely, motors, transmissions, clutches and brakes, in International Class 9; drives for land vehicles, namely motors with transmissions, clutches and brakes, in International Class 12; designing of drives, namely, motors, motors with transmissions, clutches, and brakes, and hoists,

designing structures for supporting drives and hoists, development of computer software for the data processing for controlling drives and testing equipment in International Class 42.

Opposer is the owner of and relies upon its U.S. Trademark Registration Numbers 2,241,565 for the mark STATEK and Design and 2,245,679 for the mark STATEK (collectively referred to as "the STATEK Marks"). Opposer's STATEK and Design mark is registered in connection with electronic timing devices, namely crystals and oscillators in International Class 9. *See* Gutiérrez Decl. ¶ 2. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. The registration issued on April 27, 1999.

Opposer's STATEK mark is registered in connection with electronic timing devices, namely crystals and oscillators in International Class 9 and was registered on the Principal Register on May 18, 1999. *See* Gutiérrez Decl. ¶ 3. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. The registration issued on May 18, 1999.

Thus, Opposer's dates of first use and registration for the STATEK Marks are prior to the date Applicant filed its Application and prior to Applicant's priority filing date, and prior to Applicant's alleged date of first use.

Opposer is filing concurrently herewith a Motion for Summary Judgment in connection with the above-identified Opposition Proceeding. Applicant has failed to respond to Opposer's timely served discovery requests in the two months since the discovery was propounded. Accordingly, Applicant should be precluded from asserting that no likelihood of confusion exists and judgement should be entered in favor of Opposer.

## **II. SUMMARY OF FACTS**

Opposer filed a Notice of Opposition against Applicant's Application on January 7, 2003. Opposer filed such Opposition based on Opposer's prior and senior use and registration of the marks STATEK and STATEK and Design. *See* Helmle Decl. ¶ 2.

Opposer agreed to extend the time for Applicant to file an Answer to the Opposition. On May 13, 2003, the parties filed a stipulation extending Applicant's time to answer. Applicant filed its Answer on June 14, 2003. *See id.* at ¶ 3.

Opposer served its First Set of Requests for Production of Documents on Applicant on August 13, 2003. *See id.* at ¶ 4. Opposer also served its First Set of Interrogatories on Applicant that same day. *See id.*

When Applicant failed to respond to Opposer's discovery requests, counsel for Opposer, Mr. Raphael A. Gutiérrez, faxed a letter to counsel for Applicant, Mr. Klaus Bach, inquiring as to whether Applicant would be responding at all on October 2, 2003. *See* Gutiérrez Decl. ¶ 4. In the letter, Mr. Gutiérrez requested that Applicant respond to the letter no later than October 6, 2003. When Opposer did not receive a response by the requested date, Mr. Gutiérrez telephoned Mr. Bach on October 10, 2003, again inquiring as to the status of the responses to the Discovery Requests. *See id.* at ¶ 5. Mr. Bach informed Mr. Gutiérrez that he had not heard from his client and was unsure of whether his client would respond to the discovery requests at all. *See id.* Mr. Gutiérrez advised Mr. Bach of Applicant's intention to file a Motion to Compel, as well as its intention of filing a Motion for Summary Judgment. Mr. Gutiérrez then sent a letter that same day confirming that it was uncertain whether Applicant would respond and notifying Mr. Bach of Applicant's intention to file a Motion to Compel, based on Applicant's failure to comply with the discovery provisions of the TBMP, as well as a Motion for Summary Judgment. *See id.* at ¶ 6.

### **III. ARGUMENT**

#### **A. 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 Federal Circuit stated in *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984):

The basic purpose of summary judgment procedure is one of judicial economy -- to save the time and expense of a full trial when it is unnecessary because the essential facts necessary to decision of the issue can be adequately developed by less costly procedures, as contemplated by the **FRCP** rules here involved, with a net benefit to society.

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 Trademark Trial and Appeal Board (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).

**B. There is No Issue of Material Fact on the Question of Likelihood of Confusion**

There is no rigid test for analyzing likelihood of confusion. However, T.M.E.P. § 1207.01 lists thirteen factors as relevant in determining the registrability of a mark over an allegedly confusingly similar mark. Of those thirteen factors, the most important factors in this matter are: (1) the similarities in the marks when viewed in their entireties as to overall appearance and commercial impression; and (2) the similarity and nature of the goods as described in the application and registration. In applying the factors summarized above in this matter, it must be concluded that Opposer is entitled to summary judgment in this matter.

**1. The Marks Are Confusingly Similar**

When reviewing the similarity between two marks, the Board will look at the form, spelling, and pronunciation of the marks. *See Interstate Brands Corp. v. McKee Foods Corp.*, 2000 TTAB LEXIS 12, \*11-12 (TTAB 2000). Similarities in any one of those categories alone may be sufficient to support a finding of likelihood of confusion. *See id.*

Opposer's mark and Applicant's mark are nearly identical in terms of sight and sound. The only difference in the appearance of the marks is that Opposer's mark ends in a "k," and Applicant's mark ends in a "c." Other than that minute difference, the marks are identical. Additionally, when one pronounces the marks aloud, they sound exactly the same. Thus, the near identity of appearance and identity of sound of the marks creates a likelihood of consumer confusion.

**2. The Goods Are the Same**

Opposer's STATEK Marks are both registered in connection with "electronic timing devices." Applicant's has applied to register STATEC in connection with, inter alia, "chronographs for use as specialized time recording apparatuses." The fact that both marks are used in connection with timing devices clearly creates a likelihood of confusion for those goods.

In addition, Opposer's goods are used extensively in the automotive industry, the same industry identified in Applicant's Class 12 goods and Class 42 Services.

Where the goods are related, the degree of similarity of marks required to support a finding of likelihood of confusion is less than in the case of non-competing goods. *See Aveda Corp. v. Evita Marketing, Inc.*, 706 F. Supp. 1419, 1429 (D. Minn. 1989). Thus, here, where the marks are nearly identical and the goods are the same, there is no triable issue of fact with respect to consumer confusion. As such, summary judgment should be granted in favor of Opposer.

**C. Request for Suspension**

Pursuant to 37 C.F.R. § 2.127(d) Opposer respectfully requests that the Board suspend proceedings in this Opposition pending the determination of this Motion. If this Motion is denied, Opposer requests that the Board reset the testimony periods accordingly.

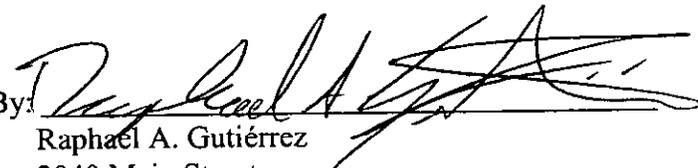
CONCLUSION

For the foregoing reasons, Opposer respectfully requests that Summary Judgement be granted in its favor and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10.10.03

By: 

Raphaël A. Gutiérrez

2040 Main Street

Fourteenth Floor

Irvine, CA 92614

(949) 760-0404

Attorneys for Statek Corporation, Opposer

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the forgoing Motion for Summary Judgement upon Applicant's counsel by depositing one copy thereof in the United States Mail, first class postage prepaid, on October 10, 2003, addressed as follows:

Klaus J. Bash  
Klaus J. Bash & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Raphael A. Gutiérrez

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEC
Opposer,	)	Serial No.: 76/202,322
	)	
v.	)	
	)	
DIPL. -ING RAINER PULS AND	)	
DIPL. -ING OLIVER PULS,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF RAPHAEL A. GUTIÉRREZ**  
**IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

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

**ATT: BOX TTAB NO FEE**

Dear Sir:

I, Raphael A. Gutiérrez, declare as follows:

1. I am an associate with Knobbe, Martens, Olson & Bear LLP (the “Knobbe Firm”), intellectual property counsel for the Opposer, Statek Corporation, (“Opposer”) in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Opposer is the owner of U.S. Trademark Registration No. 2,241,565 (the “’565 Registration”) for the STATEK and Design mark in connection with electronic timing devices. This registration is derived from an application filed on December 4, 1997 based on Opposer’s use of the mark in commerce. This registration claims a date of first use of January 1971 and proceeded to registration on April 27, 1999. A true and correct copy of the ’565 Registration is attached hereto as Exhibit A.

3. Opposer is also the owner of U.S. Trademark Registration No. 2,245,679 (the “’679 Registration”) for the mark STATEK in connection with electronic timing devices. This registration is derived from an application filed on December 4, 1997 based on Opposer’s use of the mark in commerce. This registration claims a date of first use of January 1971 and proceeded to registration on May 18, 1999. A true and correct copy of the ’679 Registration is attached hereto as Exhibit B.

4. On October 2, 3002, I sent counsel for Applicant a Letter (“Letter”). The Letter advised counsel for Applicant that responses to Opposer’s Discovery Requests had not been received and requested that Applicant respond to Opposer’s Discovery Requests. A true and correct copy of the Letter is attached hereto as Exhibit C.

5. On October 10, 2002, I phoned counsel for Applicant. I advised counsel for Applicant that a response to Opposer’s Discovery Requests had not been received and requested that Applicant respond to Opposer’s Discovery Requests. Counsel for Applicant advised me that he did not know whether Applicant would be responding to Opposer’s Discovery Requests. In response, I advised Mr. Bach of Applicant’s intention to file a Motion to Compel the discovery responses, as well as its intention to file a Motion for Summary Judgment.

6. After our telephone conversation, I sent a letter to Mr. Bach, confirming that he did not know whether his client would be responding to Opposer’s Discovery Requests and again of Opposer’s

intention to file a Motion to Compel and a Motion for Summary Judgement. A true and correct copy of said letter is attached hereto as Exhibit D.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: October 10, 2003

By:   
Raphael A. Gutierrez

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A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,241,565

Registered Apr. 27, 1999

TRADEMARK  
PRINCIPAL REGISTER



STATEK CORPORATION (CALIFORNIA CORPORATION)  
512 N. MAIN STREET  
ORANGE, CA 92868

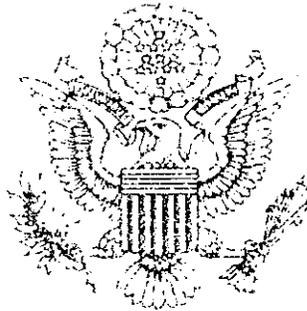
FIRST USE 1-0-1971; IN COMMERCE  
1-0-1971.

SER. NO. 75-400,067, FILED 12-4-1997.

FOR: ELECTRONIC TIMING DEVICES,  
NAMELY CRYSTALS AND OSCILLATORS, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CHERYL STEPLIGHT, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION  
PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

*The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.*

*A copy of the Mark and pertinent data from the application are a part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*J. Todd Johnson*

Acting Commissioner of Patents and Trademarks

G x h B

D O  
Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

**United States Patent and Trademark Office**

Reg. No. 2,245,679

Registered May 18, 1999

**TRADEMARK  
PRINCIPAL REGISTER**

**STATEK**

STATEK CORPORATION (CALIFORNIA COR-  
PORATION)  
512 N. MAIN STREET  
ORANGE, CA 92868

FIRST USE 1-0-1971; IN COMMERCE  
1-0-1971.

SER. NO. 75-400,066, FILED 12-4-1997.

FOR: ELECTRONIC TIMING DEVICES,  
NAMELY CRYSTALS AND OSCILLATORS, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CHERYL STEPLIGHT, EXAMINING ATTOR-  
NEY

# The United States of America



## CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

*The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.*

*A copy of the Mark and pertinent data from the application are a part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*J. Todd Tschumi*

Acting Commissioner of Patents and Trademarks

Exh C

# Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

Raphael A. Gutiérrez  
rgutierrez@kmob.com

October 2, 2003  
**VIA FACSIMILE**

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

Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

10-14-2003  
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

Dear Mr. Bach:

I have been working with Jeffrey L. Van Hoosear on the aforementioned matter. On August 13, 2003 we served the following discovery requests upon you in connection with the aforementioned matter:

- Opposer's First Set of Requests for Production of Documents Nos. 1-42, and
- Opposer's First Set of Interrogatories Nos. 1-15.

Responses to those discovery requests were due on September 17, 2003, pursuant to § 403.03 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") and 37 C.F.R. § 2.120(a). To date we have not received any responsive documents from you or your client. We would like to know if you plan on responding to those requests and, if so, when we might expect those responses. Please note that the address listed in the Requests for Production of Documents is incorrect and should be the same as the 2040 Main Street address on this letter. Please provide us with a response to this letter no later than October 6, 2003.

Please call me with any questions.

Sincerely,

  
Raphael A. Gutiérrez

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092603

San Diego  
619-235-8550

San Francisco  
415-954-4114

Los Angeles  
310-551-3450

Riverside  
909-781-9231

San Luis Obispo  
805-547-5580

EXHD

# Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

Raphael A. Gutiérrez  
rgutierrez@kmob.com

October 10, 2003  
**VIA FACSIMILE**

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

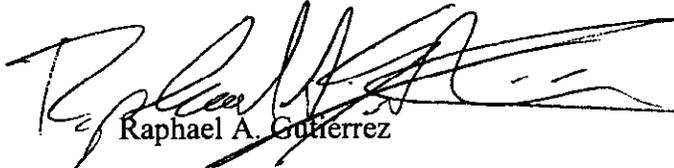
Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

Dear Mr. Bach:

The purpose of this letter is to confirm the details of our telephone conversation earlier today. During our conversation you advised me that you had received our letter dated October 2, 2003 inquiring as to the status of your clients' discovery responses. You informed me that you had not spoken to your client, but that you did not think your client would be filing a response.

As such, I advised you of Statek's intention to file a Motion to Compel a response to its discovery requests. Such motion will be filed today along with Statek's Motion for Summary Judgment.

Sincerely,



Raphael A. Gutierrez

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101003

San Diego  
619-235-8550

San Francisco  
415-954-4114

Los Angeles  
310-551-3450

Riverside  
909-781-9231

San Luis Obispo  
805-547-5580

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEC
Opposer,	)	Serial No.: 76/202,322
	)	
v.	)	
	)	
DIPL. -ING RAINER PULS AND	)	
DIPL. -ING OLIVER PULS,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF LISA HELMLE**  
**IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

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

**ATT: BOX TTAB NO FEE**

Dear Sir:

I, Lisa Helmle, declare as follows:

1. I am a trademark paralegal with Knobbe, Martens, Olson & Bear LLP (the “Knobbe Firm”), intellectual property counsel for the Opposer, Statek Corporation, (“Opposer”) in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Opposer filed a Notice of Opposition against Applicant's Application on January 7, 2003. Opposer filed such Opposition based on Opposers' prior and senior use and registration of the marks STATEK and STATEK and Design.

3. Opposer agreed to extend the time for Applicant to file an Answer to the Opposition. On May 13, 2003, the parties filed a stipulation extending Applicant's time to answer. Applicant filed its Answer on June 14, 2003.

4. Opposer served its First Set of Requests for Production of Documents on Applicant on August 13, 2003. Opposer also served its First Set of Interrogatories on Applicant that same day. True and correct copies of Opposer's First Set of Requests for Production of Documents and First Set of Interrogatories are attached hereto as Exhibits A, and B, respectively.

5. To date, Opposer has not received a response to its Discovery Requests from Applicant.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: October 10, 2003

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

  
Lisa Helmle

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

STATEK CORPORATION	)	Opposition No. 91154712
	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
DIPL.-ING RAINER PULS AND	)	
DIPL.-ING. OLIVER PULS	)	
	)	
Applicant.	)	
<hr/>		

OPPOSER'S FIRST SET OF INTERROGATORIES NOS. 1-15

Pursuant to the Rules of Practice of the United States Patent and Trademark Office, and the applicable Federal Rules of Civil Procedure, Applicant is hereby required to answer separately and fully, in writing and under oath, each of the following Interrogatories:

DEFINITIONS

1. The term "Applicant" shall mean Dipl.-Ing Rainer Puls and Dipl.-Ing. Oliver Puls and any present or former officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country, as well as any related companies.

2. The term "Opposer" shall mean Statek Corporation and any present or former officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country, as well as any related companies.

3. The term "you" shall mean the party or person to whom the Interrogatory is propounded, all agents, employees, servants, attorneys, and all other representatives, and persons over whom the person or party to whom the Interrogatory is propounded has the right to or does control or direct any activities.

4. The term "document" shall mean written, printed, typed and visually or aurally reproduced material of any kind, whether or not privileged, such as (by way of example and not by way of limitation) letters, notes, memoranda, invoices, purchase orders, records, minutes, bills, contracts, agreements, orders, receipts, drawings or sketches, photographs, tapes or discs capable of being mechanically read, advertising or promotional literature, operating manuals or instructions bulletins, cables or telegrams, tape or other recordings, test data and reports.

5. The term "thing" shall mean all tangible objects of any type, composition, construction or nature.

6. The term "person" shall include both natural persons and corporate or other business entities, whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to include the acts and knowledge of that person's directors, officers, members, employees, representatives, agents and attorneys.

7. The term "trademark" or "mark" includes trademarks, service marks, collective marks, certification marks and trade names as defined in 15 U.S.C. § 1127.

#### GENERAL INSTRUCTIONS

8. In multi-part Interrogatories, the separate parts of such Interrogatories are to be read in the context of the entire Interrogatory, but each part is to be answered separately.

9. All requests contained in the following Interrogatories to identify a person are to be answered by providing sufficient information to enable the undersigned to contact the person by

telephone, mail, and to serve legal documents on such person. If such a person is a natural person, state his or her:

- a. full name;
- b. current business and residence addresses, including telephone numbers;
- c. present employer, occupation, and position;
- d. a brief description of the job responsibilities of such person; and
- e. a brief description of the responsibilities of such person with the pertinent

organization, if a person other than a natural person by stating;

- (1) its full name or designation,
- (2) the legal classification of the entity (e.g., corporation, partnership, etc.),

giving the state of incorporation where appropriate,

- (3) the principal place of business,

- (4) the current or last known address and telephone number of the

organization, and

- (5) any other information reasonably necessary to permit efficient contact with the organization.

10. If you claim that any information requested is privileged, please provide all information falling within the scope of the Interrogatory which is not privileged, and identify with sufficient particularity for purposes of a Motion to Compel a Response or Production of each item of information, document or thing, separately, with respect to which you claim a privilege, and state:

- a. the basis on which the privilege is claimed;
- b. the author of the document;

c. each individual or other person to whom the document or copy thereof was sent or otherwise disclosed; and

d. the date of the document.

You are not requested to provide privileged information or information for which you claim privilege, but only to identify such information, document or thing.

11. Applicant's responses to the following Interrogatories are to be promptly supplemented to include subsequently acquired information in accordance with the requirements of Rule 26(e) of the Federal Rules of Civil Procedure.

### INTERROGATORIES

#### INTERROGATORY NO. 1:

Briefly state the nature of the business conducted by Applicant.

#### INTERROGATORY NO. 2:

Identify each person who is or has been an officer, director or principal of Applicant, who has knowledge of the Applicant's use of the mark STATEC or any variation thereof and the time period during which each such person held that position.

#### INTERROGATORY NO. 3:

Describe in detail all goods and/or services in conjunction with which the mark STATEC or any variation thereof has been or is currently being used by Applicant, any franchisee or other authorized user of the STATEC mark.

promoting the goods and services identified in response to Interrogatory No. 2, and indicate the time period(s) during which such activities were conducted.

INTERROGATORY NO. 10:

Describe in detail every search or investigation conducted by or on behalf of Applicant in connection with the STATEC mark or Opposer's STATEK mark including any search of the records of the U.S. Patent and Trademark Office, or of any other records or publications.

INTERROGATORY NO. 11:

Describe in detail the circumstances, including the date, under which the Applicant first acquired knowledge of Opposer's marks as identified in the Notice of Opposition.

INTERROGATORY NO. 12:

Describe in detail every instance of actual or possible confusion, or any reports of such confusion, of which the Applicant is aware between Opposer's goods or services marketed under the mark STATEK and Applicant's goods or services marketed under the STATEC mark.

INTERROGATORY NO. 13:

Describe in detail every instance in which Applicant has ever disclaimed any association with Opposer in connection with Applicant's use of the STATEC mark.

INTERROGATORY NO. 14:

Describe in detail the nature of every objection made by Applicant to the use by others of any trademark or service mark believed by Applicant to be confusingly similar to the STATEC mark, including, without limitation, the mark objected to, the goods or services with which the mark is or was used, the date of the objection and the identity of the person to whom the objection was made.

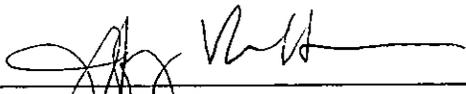
INTERROGATORY NO.15:

Identify any third party trademarks or service marks known by Applicant which employ the STATEC mark or the mark STATEK or any variations thereof.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

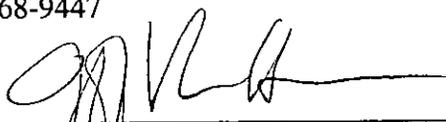
Dated: August 13, 2003

By:   
Jeffrey L. Van Hoosear  
620 Newport Center Drive  
Sixteenth Floor  
Newport Beach, CA 92660  
(949) 760-0404

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES NOS. 1-15 upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on August 13, 2003, addressed as follows:

Klaus J. Bach  
Klaus J. Bach & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Jeffrey L. Van Hoosear

GTHB

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

STATEK CORPORATION	)	Opposition No. 91154712
	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
DIPL.-ING RAINER PULS AND	)	
DIPL.-ING. OLIVER PULS	)	
	)	
Applicant.	)	
<hr/>		

OPPOSER'S FIRST SET OF REQUESTS  
FOR PRODUCTION OF DOCUMENTS NOS. 1 - 42

Pursuant to the Rules of Practice 2.120, Trademark Trial and Appeal Board of Manual of Procedure § 406 and Federal Rules of Civil Procedure 33, Opposer requests that you produce for inspection and copying the documents and things listed below at the offices of Knobbe, Martens, Olson & Bear, LLP, 620 Newport Center Drive, 16th Floor, Newport Beach, CA thirty days from the date of service of this request.

For the purposes of this request for production of documents and things, the following instructions shall apply and the following terms will have the meaning indicated:

DEFINITIONS

1. The term "Applicant" shall mean Dipl.-Ing Rainer Puls and Dipl.-Ing. Oliver Puls, and any present or former officer, director, employee, servant, agent, attorney or other

representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country.

2. The term "Opposer" shall mean Statek Corporation and any present or former officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country.

3. The term "you" or "your" shall mean the party or person to whom this Request is propounded, all agents, employees, servants, attorneys, and all other representatives, and persons over whom the person or party to whom the Interrogatory is propounded has the right to or does control or direct any activities.

4. The term "document" shall mean written, printed, typed and visually or aurally reproduced material of any kind, whether or not privileged, such as (by way of example and not by way of limitation) letters, notes, memoranda, invoices, purchase orders, records, minutes, bills, contracts, agreements, orders, receipts, drawings or sketches, photographs, tapes or discs capable of being mechanically read, advertising or promotional literature, operating manuals or instructions bulletins, cables or telegrams, tape or other recordings, test data and reports.

5. The term "thing" shall mean all tangible objects of any type, composition, construction or nature.

6. The term "person" shall include both natural persons or any corporate or other business entities, legal or governmental entities, or association, whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to include the acts and knowledge of that person's directors, officers, members, employees, representatives, agents and attorneys.

7. The term "concerning" means relating to, referring to, describing, evidencing or constituting.

8. The terms "all" and "each" shall be construed to include all and each.

9. The term "and" shall be construed to include "or" and *vice versa*, and shall be the logical equivalent of "and/or."

10. The use of the singular form of any word also includes the plural and *vice versa*.

11. The term "trademark" or "mark" includes trademarks, service marks, collective marks, certification marks and trade names as defined in 15 U.S.C. § 1127.

#### GENERAL INSTRUCTIONS

12. If you claim that any information requested is privileged, please provide all information falling within the scope of the Request which is not privileged, and identify with sufficient particularity for purposes of a Motion to Compel a Response for Production of each item, document or thing, separately, with respect to which you claim a privilege, and state:

- a. the basis on which the privilege is claimed;
- b. the author of the document;
- c. each individual or other person to whom the document or copy thereof was sent or otherwise disclosed; and
- d. the date of the document.

You are not requested to provide privileged information or information for which you claim privilege, but only to identify such information, document or thing.

13. Applicant responses to the following Requests are to be promptly supplemented to include subsequently acquired information in accordance with the requirements of Rule 26(e) of the Federal Rules of Civil Procedure.

14. You are to produce the original and all copies of each requested document and thing, as well as the file in which they are kept, including all copies which bear any additional file stamps, marginal notes, or other additional markings or writings that do not appear on the original.

15. Complete production is to be made on the date and at the time indicated above. The inspection and copying will begin at that time and will continue from day-to-day thereafter until completed.

16. Applicant has a duty to supplement its responses from now until the time of hearing or trial, as provided by Rule 26(e) of the Federal Rules of Civil Procedure.

#### REQUEST FOR PRODUCTION OF DOCUMENTS

The Applicant is requested to produce:

1. Representative samples of documents referring or relating to the selection, adoption, or first use of the STATEC trademark, including, but not limited to, all invoices, advertisements, brochures, labels, tags, points of display advertising, trademark searches, surveys, or studies.

2. Representative samples of documents referring or relating to any variations of the STATEC mark and/or the goods or services upon which such variations were used, including but not limited to, invoices, advertisements, promotional materials, brochures, tags, labels, packaging, containers, or point of sale displays.

3. Representative samples of documents and things concerning your past, present use, or plans for future use of the STATEC mark or any marks similar to STATEC.

4. Representative samples of documents relating or referring to or tending to show annual sales of Applicant's goods or services on which the mark STATEC or any variation thereof has been used in both units and dollars from inception.

5. Representative samples of documents relating or referring to any discontinuation of the STATEC mark since its initial adoption.

6. Representative samples of documents referring or relating to or tending to show how the STATEC mark was used, advertised or promoted in the U.S., since the date of its initial

adoption, including brochures, newspaper articles, advertisements, magazine or trade journal articles, and radio or television ads.

7. All labels, tags, packaging, containers, catalogs, or printed materials showing use of Applicant's STATEC mark since its initial adoption.

8. Representative samples of documents referring or relating to or tending to show advertising expenditures incurred by Applicant under the mark STATEC since inception.

9. Representative samples of documents evidencing, relating or referring to, authorizations or agreements with third parties involving the STATEC mark or any variation thereof, including but not limited to, all licenses, franchise agreements, or manufacturing agreements.

10. Representative samples of documents referring or relating to advertising conducted by authorized users of the STATEC mark or any variation thereof.

11. Representative samples of documents referring or relating to, or tending to show, the amount of money spent by any authorized users on advertisements for the STATEC mark or any variation thereof.

12. Representative samples of documents referring or relating to Applicant's channels of distribution to ultimate consumers.

13. Representative samples of documents referring or relating to plans for steps toward expansion by Applicant of the number of products and services under which the mark STATEC is used or to alter the present channels of distribution, or to sell to persons other than Applicant's present purchasers.

14. Representative samples of documents referring or relating to any search or investigation of records of the U.S. Patent and Trademark Office or any other records or

publications in connection with the adoption, use or application for registration of the STATEC mark or any variation thereof.

15. Representative samples of documents referring or relating to any reports of the results of any search or investigation in connection with the STATEC mark or any variation thereof or Opposer's STATEK mark.

16. Representative samples of documents referring or relating to any claimed predecessor in title to the STATEC mark or any variation thereof.

17. Representative samples of documents referring or relating to any attempt by Applicant to register the STATEC mark (other than the case in issue) or any variation thereof under the laws of any state or before the U.S. Patent and Trademark Office.

18. Representative samples of documents referring or relating to the Applicant's first knowledge of Opposer's STATEK mark.

19. Representative samples of documents referring or relating to Opposer or its predecessors, or to the use of STATEK by Opposer.

20. Representative samples of documents referring or relating to or tending to show any possible or actual confusion between Applicant's STATEC trademark and Opposer's STATEK trademark.

21. Representative samples of documents referring or relating to or tending to show any possible or actual confusion between Applicant's goods and services and Opposer's goods and services.

22. Representative samples of documents referring or relating to any communication received by Applicant which was intended for Opposer.

23. Representative samples of documents referring or relating to or tending to show a disclaimer made by Applicant as to an association with Opposer in connection with its STATEC trademark.

24. Representative samples of documents referring or relating to any adversarial proceeding involving the STATEC mark or any variation thereof before the T.T.A.B., Bureau of Customs, F.T.C., any court or any foreign trademark office or court.

25. Representative samples of documents referring or relating to any objection raised to Applicant's use or registration of the STATEC mark, by any third party apart from the present proceeding.

26. Representative samples of documents referring or relating to any objections made by Applicant to the use by others, of marks believed by Applicant to be confusingly similar to its STATEC mark.

27. Representative samples of documents and things concerning your efforts to enforce your rights in the STATEC mark against any third persons other than the Opposer.

28. Representative samples of documents and things concerning dates of continuous use of the STATEC mark to identify each of your products and services.

29. Representative samples of documents and things concerning the commercial impression you intend the STATEC mark to have.

30. Representative samples of documents and things concerning your attendance at trade shows and your use of the STATEC mark at trade shows, including but not limited, trade show displays and advertising in connection with trade shows.

31. All magazine, newspaper, trade journal articles and other publications in any medium that concern your products and services identified by the STATEC mark.

32. Representative samples of documents and things concerning the types, characteristics, geographic markets, classes or identities of persons who purchase or obtain your products and services identified by the STATEC mark.

33. Representative samples of documents and things concerning the number of units and dollar value of your products and services identified by the STATEC mark you have sold each month and each year.

34. Representative samples of documents and things concerning studies, tests, ratings or surveys in connection with quality and performance of your products and services identified with the STATEC mark.

35. Representative samples of documents and things concerning studies, tests or surveys in connection with consumer recognition of the STATEC mark and consumer recognition of your products and services identified with your STATEC mark.

36. Representative samples of documents and things concerning business plans, including but not limited to marketing plans, advertising plans, and business forecasts, for your products and services identified with the STATEC mark.

37. Representative samples of documents and things concerning your policies regarding retention, storage, filing and destruction of documents and things.

38. Representative samples of documents referring or relating to or identifying any marks or service marks known by Applicant which employ the terms STATEK or STATEC or any variation thereof.

39. Representative samples of documents referring or relating to or comprising of any investigation conducted on behalf of Applicant in connection with the STATEC mark or Opposer's STATEK mark.

40. Representative samples of documents referring or relating to any survey conducted on Applicant's behalf relating to the STATEC TECHNOLOGIES mark or Opposer's STATEK trademark.

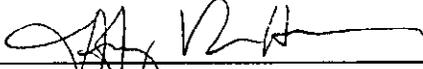
41. Representative samples of documents referring or relating to the transfer of U.S. Trademark Registration No. 1,476,456 to Applicant.

42. Representative samples of documents identified in response to Opposer's First Set of Interrogatories.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 13, 2003

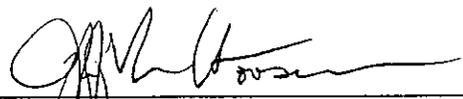
By: 

Jeffrey L. Van Hoosear  
620 Newport Center Drive  
Sixteenth Floor  
Newport Beach, CA 92660  
(949) 760-0404

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS NOS. 1-42 upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on August 13, 2003, addressed as follows:

Klaus J. Bach  
Klaus J. Bach & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Jeffrey L. Van Hoosear

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,

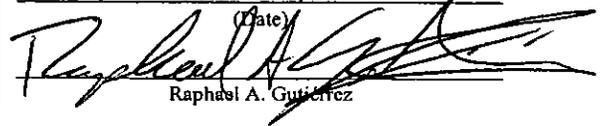
Applicant.

Opposition No. 91154712

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

October 10, 2003

(Date)



Raphael A. Gutierrez

**OPPOSER'S MOTION FOR SUMMARY JUDGEMENT**

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



10-14-2003

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

Dear Sir:

**I. INTRODUCTION**

This is an opposition proceeding having Opposition Number 91154712 ("Opposition") brought by Statek Corporation ("Opposer") against Dipl.-ing Rainer Puls and Dipl.-ing Oliver Puls (collectively, "Applicant") regarding Applicant's U.S. Trademark Application Serial Number 76/202,322 ("Application"). Applicant filed its Application on January 30, 2001 for the mark STATEC, and has a priority filing date of July 31, 2000. Applicant's Application is based on Sections 1(b) and 44(e) of the Trademark Act. Applicant has yet to claim a date of first use. The Application and was filed in connection with speedometers, accelerometers, power meters, force meters, thermometers, pressure meters, and chronographs for use as specialized time recording apparatuses; computers for monitoring and controlling drive and drive components, namely, motors, transmissions, clutches and brakes, in International Class 9; drives for land vehicles, namely motors with transmissions, clutches and brakes, in International Class 12; designing of drives, namely, motors, motors with transmissions, clutches, and brakes, and hoists,

designing structures for supporting drives and hoists, development of computer software for the data processing for controlling drives and testing equipment in International Class 42.

Opposer is the owner of and relies upon its U.S. Trademark Registration Numbers 2,241,565 for the mark STATEK and Design and 2,245,679 for the mark STATEK (collectively referred to as "the STATEK Marks"). Opposer's STATEK and Design mark is registered in connection with electronic timing devices, namely crystals and oscillators in International Class 9. *See* Gutiérrez Decl. ¶ 2. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. The registration issued on April 27, 1999.

Opposer's STATEK mark is registered in connection with electronic timing devices, namely crystals and oscillators in International Class 9 and was registered on the Principal Register on May 18, 1999. *See* Gutiérrez Decl. ¶ 3. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. The registration issued on May 18, 1999.

Thus, Opposer's dates of first use and registration for the STATEK Marks are prior to the date Applicant filed its Application and prior to Applicant's priority filing date, and prior to Applicant's alleged date of first use.

Opposer is filing concurrently herewith a Motion for Summary Judgment in connection with the above-identified Opposition Proceeding. Applicant has failed to respond to Opposer's timely served discovery requests in the two months since the discovery was propounded. Accordingly, Applicant should be precluded from asserting that no likelihood of confusion exists and judgement should be entered in favor of Opposer.

## **II. SUMMARY OF FACTS**

Opposer filed a Notice of Opposition against Applicant's Application on January 7, 2003. Opposer filed such Opposition based on Opposer's prior and senior use and registration of the marks STATEK and STATEK and Design. *See* Helmle Decl. ¶ 2.

Opposer agreed to extend the time for Applicant to file an Answer to the Opposition. On May 13, 2003, the parties filed a stipulation extending Applicant's time to answer. Applicant filed its Answer on June 14, 2003. *See id.* at ¶ 3.

Opposer served its First Set of Requests for Production of Documents on Applicant on August 13, 2003. *See id.* at ¶ 4. Opposer also served its First Set of Interrogatories on Applicant that same day. *See id.*

When Applicant failed to respond to Opposer's discovery requests, counsel for Opposer, Mr. Raphael A. Gutiérrez, faxed a letter to counsel for Applicant, Mr. Klaus Bach, inquiring as to whether Applicant would be responding at all on October 2, 2003. *See* Gutiérrez Decl. ¶ 4. In the letter, Mr. Gutiérrez requested that Applicant respond to the letter no later than October 6, 2003. When Opposer did not receive a response by the requested date, Mr. Gutiérrez telephoned Mr. Bach on October 10, 2003, again inquiring as to the status of the responses to the Discovery Requests. *See id.* at ¶ 5. Mr. Bach informed Mr. Gutiérrez that he had not heard from his client and was unsure of whether his client would respond to the discovery requests at all. *See id.* Mr. Gutiérrez advised Mr. Bach of Applicant's intention to file a Motion to Compel, as well as its intention of filing a Motion for Summary Judgment. Mr. Gutiérrez then sent a letter that same day confirming that it was uncertain whether Applicant would respond and notifying Mr. Bach of Applicant's intention to file a Motion to Compel, based on Applicant's failure to comply with the discovery provisions of the TBMP, as well as a Motion for Summary Judgment. *See id.* at ¶ 6.

### III. ARGUMENT

#### A. 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 Federal Circuit stated in *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984):

The basic purpose of summary judgment procedure is one of judicial economy -- to save the time and expense of a full trial when it is unnecessary because the essential facts necessary to decision of the issue can be adequately developed by less costly procedures, as contemplated by the FRCP rules here involved, with a net benefit to society.

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 Trademark Trial and Appeal Board (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).

**B. There is No Issue of Material Fact on the Question of Likelihood of Confusion**

There is no rigid test for analyzing likelihood of confusion. However, T.M.E.P. § 1207.01 lists thirteen factors as relevant in determining the registrability of a mark over an allegedly confusingly similar mark. Of those thirteen factors, the most important factors in this matter are: (1) the similarities in the marks when viewed in their entireties as to overall appearance and commercial impression; and (2) the similarity and nature of the goods as described in the application and registration. In applying the factors summarized above in this matter, it must be concluded that Opposer is entitled to summary judgment in this matter.

**1. The Marks Are Confusingly Similar**

When reviewing the similarity between two marks, the Board will look at the form, spelling, and pronunciation of the marks. *See Interstate Brands Corp. v. McKee Foods Corp.*, 2000 TTAB LEXIS 12, \*11-12 (TTAB 2000). Similarities in any one of those categories alone may be sufficient to support a finding of likelihood of confusion. *See id.*

Opposer's mark and Applicant's mark are nearly identical in terms of sight and sound. The only difference in the appearance of the marks is that Opposer's mark ends in a "k," and Applicant's mark ends in a "c." Other than that minute difference, the marks are identical. Additionally, when one pronounces the marks aloud, they sound exactly the same. Thus, the near identity of appearance and identity of sound of the marks creates a likelihood of consumer confusion.

**2. The Goods Are the Same**

Opposer's STATEK Marks are both registered in connection with "electronic timing devices." Applicant's has applied to register STATEC in connection with, inter alia, "chronographs for use as specialized time recording apparatuses." The fact that both marks are used in connection with timing devices clearly creates a likelihood of confusion for those goods.

In addition, Opposer's goods are used extensively in the automotive industry, the same industry identified in Applicant's Class 12 goods and Class 42 Services.

Where the goods are related, the degree of similarity of marks required to support a finding of likelihood of confusion is less than in the case of non-competing goods. *See Aveda Corp. v. Evita Marketing, Inc.*, 706 F. Supp. 1419, 1429 (D. Minn. 1989). Thus, here, where the marks are nearly identical and the goods are the same, there is no triable issue of fact with respect to consumer confusion. As such, summary judgment should be granted in favor of Opposer.

C. **Request for Suspension**

Pursuant to 37 C.F.R. § 2.127(d) Opposer respectfully requests that the Board suspend proceedings in this Opposition pending the determination of this Motion. If this Motion is denied, Opposer requests that the Board reset the testimony periods accordingly.

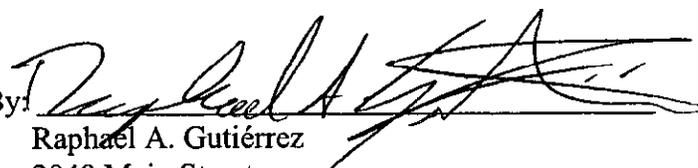
**CONCLUSION**

For the foregoing reasons, Opposer respectfully requests that Summary Judgment be granted in its favor and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10.10.03

By: 

Raphaël A. Gutiérrez

2040 Main Street

Fourteenth Floor

Irvine, CA 92614

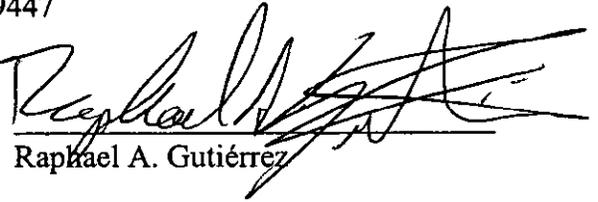
(949) 760-0404

Attorneys for Statek Corporation, Opposer

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the forgoing Motion for Summary Judgement upon Applicant's counsel by depositing one copy thereof in the United States Mail, first class postage prepaid, on October 10, 2003, addressed as follows:

Klaus J. Bash  
Klaus J. Bash & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Raphael A. Gutiérrez

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEC
Opposer,	)	Serial No.: 76/202,322
	)	
v.	)	
	)	
DIPL. -ING RAINER PULS AND	)	
DIPL. -ING OLIVER PULS,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF RAPHAEL A. GUTIÉRREZ**  
**IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

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

**ATT: BOX TTAB NO FEE**

Dear Sir:

I, Raphael A. Gutiérrez, declare as follows:

1. I am an associate with Knobbe, Martens, Olson & Bear LLP (the “Knobbe Firm”), intellectual property counsel for the Opposer, Statek Corporation, (“Opposer”) in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Opposer is the owner of U.S. Trademark Registration No. 2,241,565 (the "565 Registration") for the STATEK and Design mark in connection with electronic timing devices. This registration is derived from an application filed on December 4, 1997 based on Opposer's use of the mark in commerce. This registration claims a date of first use of January 1971 and proceeded to registration on April 27, 1999. A true and correct copy of the '565 Registration is attached hereto as Exhibit A.

3. Opposer is also the owner of U.S. Trademark Registration No. 2,245,679 (the "679 Registration") for the mark STATEK in connection with electronic timing devices. This registration is derived from an application filed on December 4, 1997 based on Opposer's use of the mark in commerce. This registration claims a date of first use of January 1971 and proceeded to registration on May 18, 1999. A true and correct copy of the '679 Registration is attached hereto as Exhibit B.

4. On October 2, 2002, I sent counsel for Applicant a Letter ("Letter"). The Letter advised counsel for Applicant that responses to Opposer's Discovery Requests had not been received and requested that Applicant respond to Opposer's Discovery Requests. A true and correct copy of the Letter is attached hereto as Exhibit C.

5. On October 10, 2002, I phoned counsel for Applicant. I advised counsel for Applicant that a response to Opposer's Discovery Requests had not been received and requested that Applicant respond to Opposer's Discovery Requests. Counsel for Applicant advised me that he did not know whether Applicant would be responding to Opposer's Discovery Requests. In response, I advised Mr. Bach of Applicant's intention to file a Motion to Compel the discovery responses, as well as its intention to file a Motion for Summary Judgment.

6. After our telephone conversation, I sent a letter to Mr. Bach, confirming that he did not know whether his client would be responding to Opposer's Discovery Requests and again of Opposer's

intention to file a Motion to Compel and a Motion for Summary Judgement. A true and correct copy of said letter is attached hereto as Exhibit D.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: October 10, 2003

By:   
Raphael A. Gutierrez

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101003

# Exhibit A

D

Int. Cl.: 9

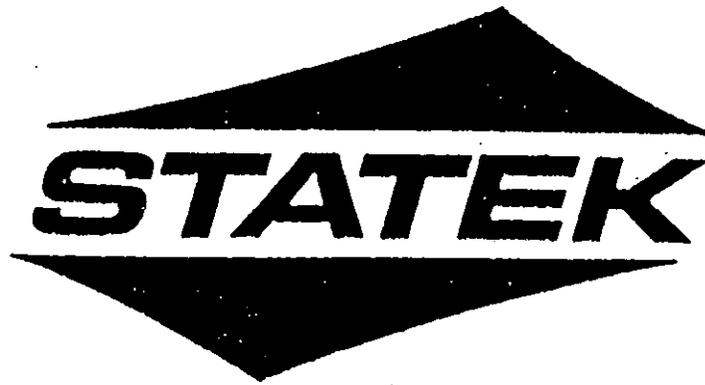
Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,241,565

Registered Apr. 27, 1999

TRADEMARK  
PRINCIPAL REGISTER



STATEK CORPORATION (CALIFORNIA COR-  
PORATION)  
512 N. MAIN STREET  
ORANGE, CA 92868

FIRST USE 1-0-1971; IN COMMERCE  
1-0-1971.

SER. NO. 75-400,067, FILED 12-4-1997.

FOR: ELECTRONIC TIMING DEVICES,  
NAMELY CRYSTALS AND OSCILLATORS, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CHERYL STEPLIGHT, EXAMINING ATTOR-  
NEY

The United States of America



CERTIFICATE OF REGISTRATION  
PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

*The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.*

*A copy of the Mark and pertinent data from the application are a part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*J. Todd Johnson*

Acting Commissioner of Patents and Trademarks

# Exhibit B

D O  
Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,245,679

Registered May 13, 1999

**TRADEMARK  
PRINCIPAL REGISTER**

**STATEK**

STATEK CORPORATION (CALIFORNIA COR-  
PORATION)  
512 N. MAIN STREET  
ORANGE, CA 92868

FIRST USE 1-0-1971; IN COMMERCE  
1-0-1971.

SER. NO. 75-400,066, FILED 12-4-1997.

FOR: ELECTRONIC TIMING DEVICES,  
NAMELY CRYSTALS AND OSCILLATORS, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CHERYL STEPLIGHT, EXAMINING ATTOR-  
NEY

# The United States of America



## CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

*The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.*

*A copy of the Mark and pertinent data from the application are a part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*J. Todd Johnson*

Acting Commissioner of Patents and Trademarks

# Exhibit C

# Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

Raphael A. Gutiérrez  
rgutierrez@kmob.com

October 2, 2003  
VIA FACSIMILE

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

Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

Dear Mr. Bach:

I have been working with Jeffrey L. Van Hoosear on the aforementioned matter. On August 13, 2003 we served the following discovery requests upon you in connection with the aforementioned matter:

- Opposer's First Set of Requests for Production of Documents Nos. 1-42, and
- Opposer's First Set of Interrogatories Nos. 1-15.

Responses to those discovery requests were due on September 17, 2003, pursuant to § 403.03 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") and 37 C.F.R. § 2.120(a). To date we have not received any responsive documents from you or your client. We would like to know if you plan on responding to those requests and, if so, when we might expect those responses. Please note that the address listed in the Requests for Production of Documents is incorrect and should be the same as the 2040 Main Street address on this letter. Please provide us with a response to this letter no later than October 6, 2003.

Please call me with any questions.

Sincerely,



Raphael A. Gutiérrez

# Exhibit D

# Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

Raphael A. Gutiérrez  
rgutierrez@kmob.com

October 10, 2003

**VIA FACSIMILE**

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

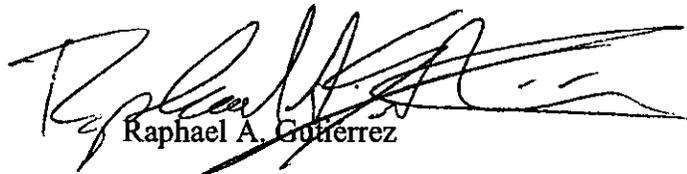
Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

Dear Mr. Bach:

The purpose of this letter is to confirm the details of our telephone conversation earlier today. During our conversation you advised me that you had received our letter dated October 2, 2003 inquiring as to the status of your clients' discovery responses. You informed me that you had not spoken to your client, but that you did not think your client would be filing a response.

As such, I advised you of Statek's intention to file a Motion to Compel a response to its discovery requests. Such motion will be filed today along with Statek's Motion for Summary Judgment.

Sincerely,



Raphael A. Gutiérrez

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101003

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEC
Opposer,	)	Serial No.: 76/202,322
	)	
v.	)	
	)	
DIPL. -ING RAINER PULS AND	)	
DIPL. -ING OLIVER PULS,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF LISA HELMLE**

**IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

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

**ATT: BOX TTAB NO FEE**

Dear Sir:

I, Lisa Helmle, declare as follows:

1. I am a trademark paralegal with Knobbe, Martens, Olson & Bear LLP (the "Knobbe Firm"), intellectual property counsel for the Opposer, Statek Corporation, ("Opposer") in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Opposer filed a Notice of Opposition against Applicant's Application on January 7, 2003. Opposer filed such Opposition based on Opposers' prior and senior use and registration of the marks STATEK and STATEK and Design.

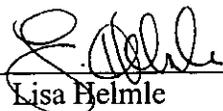
3. Opposer agreed to extend the time for Applicant to file an Answer to the Opposition. On May 13, 2003, the parties filed a stipulation extending Applicant's time to answer. Applicant filed its Answer on June 14, 2003.

4. Opposer served its First Set of Requests for Production of Documents on Applicant on August 13, 2003. Opposer also served its First Set of Interrogatories on Applicant that same day. True and correct copies of Opposer's First Set of Requests for Production of Documents and First Set of Interrogatories are attached hereto as Exhibits A, and B, respectively.

5. To date, Opposer has not received a response to its Discovery Requests from Applicant.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: October 10, 2003

By:   
Lisa Helmle

H:\DOCS\LXHLXH-1690.DOC  
101003

# Exhibit A

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

STATEK CORPORATION	)	Opposition No. 91154712
	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
DIPL.-ING RAINER PULS AND	)	
DIPL.-ING. OLIVER PULS	)	
	)	
Applicant.	)	
_____	)	

OPPOSER'S FIRST SET OF INTERROGATORIES NOS. 1-15

Pursuant to the Rules of Practice of the United States Patent and Trademark Office, and the applicable Federal Rules of Civil Procedure, Applicant is hereby required to answer separately and fully, in writing and under oath, each of the following Interrogatories:

DEFINITIONS

1. The term "Applicant" shall mean Dipl.-Ing Rainer Puls and Dipl.-Ing. Oliver Puls and any present or former officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country, as well as any related companies.

2. The term "Opposer" shall mean Statek Corporation and any present or former officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country, as well as any related companies.

3. The term "you" shall mean the party or person to whom the Interrogatory is propounded, all agents, employees, servants, attorneys, and all other representatives, and persons over whom the person or party to whom the Interrogatory is propounded has the right to or does control or direct any activities.

4. The term "document" shall mean written, printed, typed and visually or aurally reproduced material of any kind, whether or not privileged, such as (by way of example and not by way of limitation) letters, notes, memoranda, invoices, purchase orders, records, minutes, bills, contracts, agreements, orders, receipts, drawings or sketches, photographs, tapes or discs capable of being mechanically read, advertising or promotional literature, operating manuals or instructions bulletins, cables or telegrams, tape or other recordings, test data and reports.

5. The term "thing" shall mean all tangible objects of any type, composition, construction or nature.

6. The term "person" shall include both natural persons and corporate or other business entities, whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to include the acts and knowledge of that person's directors, officers, members, employees, representatives, agents and attorneys.

7. The term "trademark" or "mark" includes trademarks, service marks, collective marks, certification marks and trade names as defined in 15 U.S.C. § 1127.

#### GENERAL INSTRUCTIONS

8. In multi-part Interrogatories, the separate parts of such Interrogatories are to be read in the context of the entire Interrogatory, but each part is to be answered separately.

9. All requests contained in the following Interrogatories to identify a person are to be answered by providing sufficient information to enable the undersigned to contact the person by

telephone, mail, and to serve legal documents on such person. If such a person is a natural person, state his or her:

- a. full name;
- b. current business and residence addresses, including telephone numbers;
- c. present employer, occupation, and position;
- d. a brief description of the job responsibilities of such person; and
- e. a brief description of the responsibilities of such person with the pertinent

organization, if a person other than a natural person by stating;

- (1) its full name or designation,
- (2) the legal classification of the entity (e.g., corporation, partnership, etc.),

giving the state of incorporation where appropriate,

- (3) the principal place of business,
- (4) the current or last known address and telephone number of the

organization, and

- (5) any other information reasonably necessary to permit efficient contact with the organization.

10. If you claim that any information requested is privileged, please provide all information falling within the scope of the Interrogatory which is not privileged, and identify with sufficient particularity for purposes of a Motion to Compel a Response or Production of each item of information, document or thing, separately, with respect to which you claim a privilege, and state:

- a. the basis on which the privilege is claimed;
- b. the author of the document;

c. each individual or other person to whom the document or copy thereof was sent or otherwise disclosed; and

d. the date of the document.

You are not requested to provide privileged information or information for which you claim privilege, but only to identify such information, document or thing.

11. Applicant's responses to the following Interrogatories are to be promptly supplemented to include subsequently acquired information in accordance with the requirements of Rule 26(e) of the Federal Rules of Civil Procedure.

### INTERROGATORIES

#### INTERROGATORY NO. 1:

Briefly state the nature of the business conducted by Applicant.

#### INTERROGATORY NO. 2:

Identify each person who is or has been an officer, director or principal of Applicant, who has knowledge of the Applicant's use of the mark STATEC or any variation thereof and the time period during which each such person held that position.

#### INTERROGATORY NO. 3:

Describe in detail all goods and/or services in conjunction with which the mark STATEC or any variation thereof has been or is currently being used by Applicant, any franchisee or other authorized user of the STATEC mark.

INTERROGATORY NO. 4:

With regard to each of the goods and services identified in response to Interrogatory No. 3, provide the date under which the STATEC mark or any variation thereof was first used, as to both interstate and intrastate commerce.

INTERROGATORY NO. 5:

With respect to each of the goods and services identified in response to Interrogatory No. 3, specify whether the STATEC mark is currently being used by Applicant, any franchisee, or authorized user in the United States in conjunction therewith.

INTERROGATORY NO. 6:

With respect to each of the goods and services identified in response to Interrogatory No. 3, state the annual sales in units and dollars from inception.

INTERROGATORY NO. 7:

With respect to each of the goods and services identified in response to Interrogatory No. 3, describe in detail the manner in which the STATEC mark is advertised and/or promoted in the United States.

INTERROGATORY NO. 8:

Identify the person or persons who, from the date of Applicant's first use of the STATEC mark to the present, have been responsible for the marketing and/or promotion of goods and/or services under the STATEC mark indicating the period during which each person was so responsible.

INTERROGATORY NO. 9:

Identify all advertising agencies, public relations agencies or market research agencies which Applicant has used, participated with or cooperated with in advertising, marketing or

promoting the goods and services identified in response to Interrogatory No. 2, and indicate the time period(s) during which such activities were conducted.

INTERROGATORY NO. 10:

Describe in detail every search or investigation conducted by or on behalf of Applicant in connection with the STATEC mark or Opposer's STATEK mark including any search of the records of the U.S. Patent and Trademark Office, or of any other records or publications.

INTERROGATORY NO. 11:

Describe in detail the circumstances, including the date, under which the Applicant first acquired knowledge of Opposer's marks as identified in the Notice of Opposition.

INTERROGATORY NO. 12:

Describe in detail every instance of actual or possible confusion, or any reports of such confusion, of which the Applicant is aware between Opposer's goods or services marketed under the mark STATEK and Applicant's goods or services marketed under the STATEC mark.

INTERROGATORY NO. 13:

Describe in detail every instance in which Applicant has ever disclaimed any association with Opposer in connection with Applicant's use of the STATEC mark.

INTERROGATORY NO. 14:

Describe in detail the nature of every objection made by Applicant to the use by others of any trademark or service mark believed by Applicant to be confusingly similar to the STATEC mark, including, without limitation, the mark objected to, the goods or services with which the mark is or was used, the date of the objection and the identity of the person to whom the objection was made.

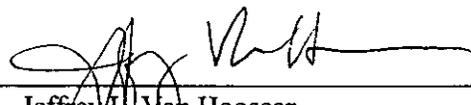
INTERROGATORY NO.15:

Identify any third party trademarks or service marks known by Applicant which employ the STATEC mark or the mark STATEK or any variations thereof.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 13, 2003

By:   
Jeffrey L. Van Hoosear  
620 Newport Center Drive  
Sixteenth Floor  
Newport Beach, CA 92660  
(949) 760-0404

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES NOS. 1-15 upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on August 13, 2003, addressed as follows:

Klaus J. Bach  
Klaus J. Bach & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Jeffrey L. Van Hoosear

# Exhibit B

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

STATEK CORPORATION	)	Opposition No. 91154712
	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
DIPL.-ING RAINER PULS AND	)	
DIPL.-ING. OLIVER PULS	)	
	)	
Applicant.	)	
_____	)	

**OPPOSER'S FIRST SET OF REQUESTS  
FOR PRODUCTION OF DOCUMENTS NOS. 1 - 42**

Pursuant to the Rules of Practice 2.120, Trademark Trial and Appeal Board of Manual of Procedure § 406 and Federal Rules of Civil Procedure 33, Opposer requests that you produce for inspection and copying the documents and things listed below at the offices of Knobbe, Martens, Olson & Bear, LLP, 620 Newport Center Drive, 16th Floor, Newport Beach, CA thirty days from the date of service of this request.

For the purposes of this request for production of documents and things, the following instructions shall apply and the following terms will have the meaning indicated:

**DEFINITIONS**

1. The term "Applicant" shall mean Dipl.-Ing Rainer Puls and Dipl.-Ing. Oliver Puls, and any present or former officer, director, employee, servant, agent, attorney or other

representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country.

2. The term "Opposer" shall mean Statek Corporation and any present or former officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any predecessor or successor either within the United States or a foreign country.

3. The term "you" or "your" shall mean the party or person to whom this Request is propounded, all agents, employees, servants, attorneys, and all other representatives, and persons over whom the person or party to whom the Interrogatory is propounded has the right to or does control or direct any activities.

4. The term "document" shall mean written, printed, typed and visually or aurally reproduced material of any kind, whether or not privileged, such as (by way of example and not by way of limitation) letters, notes, memoranda, invoices, purchase orders, records, minutes, bills, contracts, agreements, orders, receipts, drawings or sketches, photographs, tapes or discs capable of being mechanically read, advertising or promotional literature, operating manuals or instructions bulletins, cables or telegrams, tape or other recordings, test data and reports.

5. The term "thing" shall mean all tangible objects of any type, composition, construction or nature.

6. The term "person" shall include both natural persons or any corporate or other business entities, legal or governmental entities, or association, whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to include the acts and knowledge of that person's directors, officers, members, employees, representatives, agents and attorneys.

7. The term "concerning" means relating to, referring to, describing, evidencing or constituting.

8. The terms "all" and "each" shall be construed to include all and each.

9. The term “and” shall be construed to include “or” and *vice versa*, and shall be the logical equivalent of “and/or.”

10. The use of the singular form of any word also includes the plural and *vice versa*.

11. The term “trademark” or “mark” includes trademarks, service marks, collective marks, certification marks and trade names as defined in 15 U.S.C. § 1127.

#### GENERAL INSTRUCTIONS

12. If you claim that any information requested is privileged, please provide all information falling within the scope of the Request which is not privileged, and identify with sufficient particularity for purposes of a Motion to Compel a Response for Production of each item, document or thing, separately, with respect to which you claim a privilege, and state:

- a. the basis on which the privilege is claimed;
- b. the author of the document;
- c. each individual or other person to whom the document or copy thereof was sent or otherwise disclosed; and
- d. the date of the document.

You are not requested to provide privileged information or information for which you claim privilege, but only to identify such information, document or thing.

13. Applicant responses to the following Requests are to be promptly supplemented to include subsequently acquired information in accordance with the requirements of Rule 26(e) of the Federal Rules of Civil Procedure.

14. You are to produce the original and all copies of each requested document and thing, as well as the file in which they are kept, including all copies which bear any additional file stamps, marginal notes, or other additional markings or writings that do not appear on the original.

15. Complete production is to be made on the date and at the time indicated above. The inspection and copying will begin at that time and will continue from day-to-day thereafter until completed.

16. Applicant has a duty to supplement its responses from now until the time of hearing or trial, as provided by Rule 26(e) of the Federal Rules of Civil Procedure.

#### REQUEST FOR PRODUCTION OF DOCUMENTS

The Applicant is requested to produce:

1. Representative samples of documents referring or relating to the selection, adoption, or first use of the STATEC trademark, including, but not limited to, all invoices, advertisements, brochures, labels, tags, points of display advertising, trademark searches, surveys, or studies.

2. Representative samples of documents referring or relating to any variations of the STATEC mark and/or the goods or services upon which such variations were used, including but not limited to, invoices, advertisements, promotional materials, brochures, tags, labels, packaging, containers, or point of sale displays.

3. Representative samples of documents and things concerning your past, present use, or plans for future use of the STATEC mark or any marks similar to STATEC.

4. Representative samples of documents relating or referring to or tending to show annual sales of Applicant's goods or services on which the mark STATEC or any variation thereof has been used in both units and dollars from inception.

5. Representative samples of documents relating or referring to any discontinuation of the STATEC mark since its initial adoption.

6. Representative samples of documents referring or relating to or tending to show how the STATEC mark was used, advertised or promoted in the U.S., since the date of its initial

adoption, including brochures, newspaper articles, advertisements, magazine or trade journal articles, and radio or television ads.

7. All labels, tags, packaging, containers, catalogs, or printed materials showing use of Applicant's STATEC mark since its initial adoption.

8. Representative samples of documents referring or relating to or tending to show advertising expenditures incurred by Applicant under the mark STATEC since inception.

9. Representative samples of documents evidencing, relating or referring to, authorizations or agreements with third parties involving the STATEC mark or any variation thereof, including but not limited to, all licenses, franchise agreements, or manufacturing agreements.

10. Representative samples of documents referring or relating to advertising conducted by authorized users of the STATEC mark or any variation thereof.

11. Representative samples of documents referring or relating to, or tending to show, the amount of money spent by any authorized users on advertisements for the STATEC mark or any variation thereof.

12. Representative samples of documents referring or relating to Applicant's channels of distribution to ultimate consumers.

13. Representative samples of documents referring or relating to plans for steps toward expansion by Applicant of the number of products and services under which the mark STATEC is used or to alter the present channels of distribution, or to sell to persons other than Applicant's present purchasers.

14. Representative samples of documents referring or relating to any search or investigation of records of the U.S. Patent and Trademark Office or any other records or

publications in connection with the adoption, use or application for registration of the STATEC mark or any variation thereof.

15. Representative samples of documents referring or relating to any reports of the results of any search or investigation in connection with the STATEC mark or any variation thereof or Opposer's STATEK mark.

16. Representative samples of documents referring or relating to any claimed predecessor in title to the STATEC mark or any variation thereof.

17. Representative samples of documents referring or relating to any attempt by Applicant to register the STATEC mark (other than the case in issue) or any variation thereof under the laws of any state or before the U.S. Patent and Trademark Office.

18. Representative samples of documents referring or relating to the Applicant's first knowledge of Opposer's STATEK mark.

19. Representative samples of documents referring or relating to Opposer or its predecessors, or to the use of STATEK by Opposer.

20. Representative samples of documents referring or relating to or tending to show any possible or actual confusion between Applicant's STATEC trademark and Opposer's STATEK trademark.

21. Representative samples of documents referring or relating to or tending to show any possible or actual confusion between Applicant's goods and services and Opposer's goods and services.

22. Representative samples of documents referring or relating to any communication received by Applicant which was intended for Opposer.

23. Representative samples of documents referring or relating to or tending to show a disclaimer made by Applicant as to an association with Opposer in connection with its STATEC trademark.

24. Representative samples of documents referring or relating to any adversarial proceeding involving the STATEC mark or any variation thereof before the T.T.A.B., Bureau of Customs, F.T.C., any court or any foreign trademark office or court.

25. Representative samples of documents referring or relating to any objection raised to Applicant's use or registration of the STATEC mark, by any third party apart from the present proceeding.

26. Representative samples of documents referring or relating to any objections made by Applicant to the use by others, of marks believed by Applicant to be confusingly similar to its STATEC mark.

27. Representative samples of documents and things concerning your efforts to enforce your rights in the STATEC mark against any third persons other than the Opposer.

28. Representative samples of documents and things concerning dates of continuous use of the STATEC mark to identify each of your products and services.

29. Representative samples of documents and things concerning the commercial impression you intend the STATEC mark to have.

30. Representative samples of documents and things concerning your attendance at trade shows and your use of the STATEC mark at trade shows, including but not limited, trade show displays and advertising in connection with trade shows.

31. All magazine, newspaper, trade journal articles and other publications in any medium that concern your products and services identified by the STATEC mark.

32. Representative samples of documents and things concerning the types, characteristics, geographic markets, classes or identities of persons who purchase or obtain your products and services identified by the STATEC mark.

33. Representative samples of documents and things concerning the number of units and dollar value of your products and services identified by the STATEC mark you have sold each month and each year.

34. Representative samples of documents and things concerning studies, tests, ratings or surveys in connection with quality and performance of your products and services identified with the STATEC mark.

35. Representative samples of documents and things concerning studies, tests or surveys in connection with consumer recognition of the STATEC mark and consumer recognition of your products and services identified with your STATEC mark.

36. Representative samples of documents and things concerning business plans, including but not limited to marketing plans, advertising plans, and business forecasts, for your products and services identified with the STATEC mark.

37. Representative samples of documents and things concerning your policies regarding retention, storage, filing and destruction of documents and things.

38. Representative samples of documents referring or relating to or identifying any marks or service marks known by Applicant which employ the terms STATEK or STATEC or any variation thereof.

39. Representative samples of documents referring or relating to or comprising of any investigation conducted on behalf of Applicant in connection with the STATEC mark or Opposer's STATEK mark.

40. Representative samples of documents referring or relating to any survey conducted on Applicant's behalf relating to the STATEC TECHNOLOGIES mark or Opposer's STATEK trademark.

41. Representative samples of documents referring or relating to the transfer of U.S. Trademark Registration No. 1,476,456 to Applicant.

42. Representative samples of documents identified in response to Opposer's First Set of Interrogatories.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 13, 2003

By:   
Jeffrey L. Van Hoosear  
620 Newport Center Drive  
Sixteenth Floor  
Newport Beach, CA 92660  
(949) 760-0404

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS NOS. 1-42 upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on August 13, 2003, addressed as follows:

Klaus J. Bach  
Klaus J. Bach & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Jeffrey L. Van Hoosear

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,

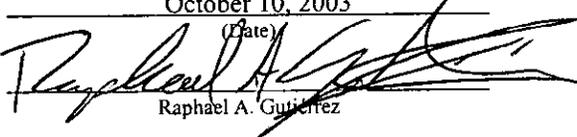
Applicant.

Opposition No. 91154712

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

October 10, 2003

(Date)



Raphael A. Gutierrez

**OPPOSER'S MOTION FOR SUMMARY JUDGEMENT**

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



10-14-2003

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

Dear Sir:

**I. INTRODUCTION**

This is an opposition proceeding having Opposition Number 91154712 ("Opposition") brought by Statek Corporation ("Opposer") against Dipl.-ing Rainer Puls and Dipl.-ing Oliver Puls (collectively, "Applicant") regarding Applicant's U.S. Trademark Application Serial Number 76/202,322 ("Application"). Applicant filed its Application on January 30, 2001 for the mark STATEC, and has a priority filing date of July 31, 2000. Applicant's Application is based on Sections 1(b) and 44(e) of the Trademark Act. Applicant has yet to claim a date of first use. The Application and was filed in connection with speedometers, accelerometers, power meters, force meters, thermometers, pressure meters, and chronographs for use as specialized time recording apparatuses; computers for monitoring and controlling drive and drive components, namely, motors, transmissions, clutches and brakes, in International Class 9; drives for land vehicles, namely motors with transmissions, clutches and brakes, in International Class 12; designing of drives, namely, motors, motors with transmissions, clutches, and brakes, and hoists,

designing structures for supporting drives and hoists, development of computer software for the data processing for controlling drives and testing equipment in International Class 42.

Opposer is the owner of and relies upon its U.S. Trademark Registration Numbers 2,241,565 for the mark STATEK and Design and 2,245,679 for the mark STATEK (collectively referred to as "the STATEK Marks"). Opposer's STATEK and Design mark is registered in connection with electronic timing devices, namely crystals and oscillators in International Class 9. *See* Gutiérrez Decl. ¶ 2. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. The registration issued on April 27, 1999.

Opposer's STATEK mark is registered in connection with electronic timing devices, namely crystals and oscillators in International Class 9 and was registered on the Principal Register on May 18, 1999. *See* Gutiérrez Decl. ¶ 3. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. The registration issued on May 18, 1999.

Thus, Opposer's dates of first use and registration for the STATEK Marks are prior to the date Applicant filed its Application and prior to Applicant's priority filing date, and prior to Applicant's alleged date of first use.

Opposer is filing concurrently herewith a Motion for Summary Judgment in connection with the above-identified Opposition Proceeding. Applicant has failed to respond to Opposer's timely served discovery requests in the two months since the discovery was propounded. Accordingly, Applicant should be precluded from asserting that no likelihood of confusion exists and judgement should be entered in favor of Opposer.

## **II. SUMMARY OF FACTS**

Opposer filed a Notice of Opposition against Applicant's Application on January 7, 2003. Opposer filed such Opposition based on Opposer's prior and senior use and registration of the marks STATEK and STATEK and Design. *See* Helmle Decl. ¶ 2.

Opposer agreed to extend the time for Applicant to file an Answer to the Opposition. On May 13, 2003, the parties filed a stipulation extending Applicant's time to answer. Applicant filed its Answer on June 14, 2003. *See id.* at ¶ 3.

Opposer served its First Set of Requests for Production of Documents on Applicant on August 13, 2003. *See id.* at ¶ 4. Opposer also served its First Set of Interrogatories on Applicant that same day. *See id.*

When Applicant failed to respond to Opposer's discovery requests, counsel for Opposer, Mr. Raphael A. Gutiérrez, faxed a letter to counsel for Applicant, Mr. Klaus Bach, inquiring as to whether Applicant would be responding at all on October 2, 2003. *See Gutiérrez Decl.* ¶ 4. In the letter, Mr. Gutiérrez requested that Applicant respond to the letter no later than October 6, 2003. When Opposer did not receive a response by the requested date, Mr. Gutiérrez telephoned Mr. Bach on October 10, 2003, again inquiring as to the status of the responses to the Discovery Requests. *See id.* at ¶ 5. Mr. Bach informed Mr. Gutiérrez that he had not heard from his client and was unsure of whether his client would respond to the discovery requests at all. *See id.* Mr. Gutiérrez advised Mr. Bach of Applicant's intention to file a Motion to Compel, as well as its intention of filing a Motion for Summary Judgment. Mr. Gutiérrez then sent a letter that same day confirming that it was uncertain whether Applicant would respond and notifying Mr. Bach of Applicant's intention to file a Motion to Compel, based on Applicant's failure to comply with the discovery provisions of the TBMP, as well as a Motion for Summary Judgment. *See id.* at ¶ 6.

### **III. ARGUMENT**

#### **A. 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 Federal Circuit stated in *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984):

The basic purpose of summary judgment procedure is one of judicial economy -- to save the time and expense of a full trial when it is unnecessary because the essential facts necessary to decision of the issue can be adequately developed by less costly procedures, as contemplated by the **FRCP** rules here involved, with a net benefit to society.

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 Trademark Trial and Appeal Board (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).

**B. There is No Issue of Material Fact on the Question of Likelihood of Confusion**

There is no rigid test for analyzing likelihood of confusion. However, T.M.E.P. § 1207.01 lists thirteen factors as relevant in determining the registrability of a mark over an allegedly confusingly similar mark. Of those thirteen factors, the most important factors in this matter are: (1) the similarities in the marks when viewed in their entireties as to overall appearance and commercial impression; and (2) the similarity and nature of the goods as described in the application and registration. In applying the factors summarized above in this matter, it must be concluded that Opposer is entitled to summary judgment in this matter.

**1. The Marks Are Confusingly Similar**

When reviewing the similarity between two marks, the Board will look at the form, spelling, and pronunciation of the marks. *See Interstate Brands Corp. v. McKee Foods Corp.*, 2000 TTAB LEXIS 12, \*11-12 (TTAB 2000). Similarities in any one of those categories alone may be sufficient to support a finding of likelihood of confusion. *See id.*

Opposer's mark and Applicant's mark are nearly identical in terms of sight and sound. The only difference in the appearance of the marks is that Opposer's mark ends in a "k," and Applicant's mark ends in a "c." Other than that minute difference, the marks are identical. Additionally, when one pronounces the marks aloud, they sound exactly the same. Thus, the near identity of appearance and identity of sound of the marks creates a likelihood of consumer confusion.

**2. The Goods Are the Same**

Opposer's STATEK Marks are both registered in connection with "electronic timing devices." Applicant's has applied to register STATEC in connection with, inter alia, "chronographs for use as specialized time recording apparatuses." The fact that both marks are used in connection with timing devices clearly creates a likelihood of confusion for those goods.

In addition, Opposer's goods are used extensively in the automotive industry, the same industry identified in Applicant's Class 12 goods and Class 42 Services.

Where the goods are related, the degree of similarity of marks required to support a finding of likelihood of confusion is less than in the case of non-competing goods. *See Aveda Corp. v. Evita Marketing, Inc.*, 706 F. Supp. 1419, 1429 (D. Minn. 1989). Thus, here, where the marks are nearly identical and the goods are the same, there is no triable issue of fact with respect to consumer confusion. As such, summary judgment should be granted in favor of Opposer.

**C. Request for Suspension**

Pursuant to 37 C.F.R. § 2.127(d) Opposer respectfully requests that the Board suspend proceedings in this Opposition pending the determination of this Motion. If this Motion is denied, Opposer requests that the Board reset the testimony periods accordingly.

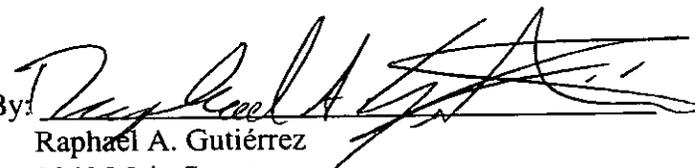
CONCLUSION

For the foregoing reasons, Opposer respectfully requests that Summary Judgment be granted in its favor and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10.10.03

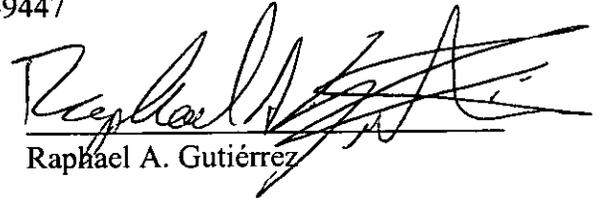
By: 

Raphaël A. Gutiérrez  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404  
Attorneys for Statek Corporation, Opposer

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the forgoing Motion for Summary Judgement upon Applicant's counsel by depositing one copy thereof in the United States Mail, first class postage prepaid, on October 10, 2003, addressed as follows:

Klaus J. Bash  
Klaus J. Bash & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

  
Raphael A. Gutiérrez

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEC
Opposer,	)	Serial No.: 76/202,322
	)	
v.	)	
	)	
DIPL. -ING RAINER PULS AND	)	
DIPL. -ING OLIVER PULS,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF RAPHAEL A. GUTIÉRREZ**  
**IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

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

**ATT: BOX TTAB NO FEE**

Dear Sir:

I, Raphael A. Gutiérrez, declare as follows:

- I am an associate with Knobbe, Martens, Olson & Bear LLP (the “Knobbe Firm”), intellectual property counsel for the Opposer, Statek Corporation, (“Opposer”) in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Opposer is the owner of U.S. Trademark Registration No. 2,241,565 (the "'565 Registration") for the STATEK and Design mark in connection with electronic timing devices. This registration is derived from an application filed on December 4, 1997 based on Opposer's use of the mark in commerce. This registration claims a date of first use of January 1971 and proceeded to registration on April 27, 1999. A true and correct copy of the '565 Registration is attached hereto as Exhibit A.

3. Opposer is also the owner of U.S. Trademark Registration No. 2,245,679 (the "'679 Registration") for the mark STATEK in connection with electronic timing devices. This registration is derived from an application filed on December 4, 1997 based on Opposer's use of the mark in commerce. This registration claims a date of first use of January 1971 and proceeded to registration on May 18, 1999. A true and correct copy of the '679 Registration is attached hereto as Exhibit B.

4. On October 2, 2002, I sent counsel for Applicant a Letter ("Letter"). The Letter advised counsel for Applicant that responses to Opposer's Discovery Requests had not been received and requested that Applicant respond to Opposer's Discovery Requests. A true and correct copy of the Letter is attached hereto as Exhibit C.

5. On October 10, 2002, I phoned counsel for Applicant. I advised counsel for Applicant that a response to Opposer's Discovery Requests had not been received and requested that Applicant respond to Opposer's Discovery Requests. Counsel for Applicant advised me that he did not know whether Applicant would be responding to Opposer's Discovery Requests. In response, I advised Mr. Bach of Applicant's intention to file a Motion to Compel the discovery responses, as well as its intention to file a Motion for Summary Judgment.

6. After our telephone conversation, I sent a letter to Mr. Bach, confirming that he did not know whether his client would be responding to Opposer's Discovery Requests and again of Opposer's

intention to file a Motion to Compel and a Motion for Summary Judgement. A true and correct copy of said letter is attached hereto as Exhibit D.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: October 10, 2003

By:

  
Raphael A. Gutierrez

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101003

Gth A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,241,565

Registered Apr. 27, 1999

TRADEMARK  
PRINCIPAL REGISTER



STATEK CORPORATION (CALIFORNIA COR-  
PORATION)  
512 N. MAIN STREET  
ORANGE, CA 92868

FIRST USE 1-0-1971; IN COMMERCE  
1-0-1971.

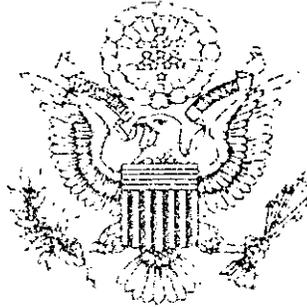
SER. NO. 75-400,067, FILED 12-4-1997.

FOR: ELECTRONIC TIMING DEVICES,  
NAMELY CRYSTALS AND OSCILLATORS, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CHERYL STEPLIGHT, EXAMINING ATTOR-  
NEY

D J

# The United States of America



## CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

*The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.*

*A copy of the Mark and pertinent data from the application are a part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*J. Todd Tschumi*

Acting Commissioner of Patents and Trademarks

$G_{xh}^B$

D

Q

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

**United States Patent and Trademark Office**

Reg. No. 2,245,679

Registered May 18, 1999

**TRADEMARK  
PRINCIPAL REGISTER**

**STATEK**

STATEK CORPORATION (CALIFORNIA COR-  
PORATION)  
512 N. MAIN STREET  
ORANGE, CA 92868

FIRST USE 1-0-1971; IN COMMERCE  
1-0-1971.

SER. NO. 75-400,066, FILED 12-4-1997.

FOR: ELECTRONIC TIMING DEVICES,  
NAMELY CRYSTALS AND OSCILLATORS, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

CHERYL STEPLIGHT, EXAMINING ATTOR-  
NEY

# The United States of America



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*A copy of the Mark and pertinent data from the application are a part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*J. Todd Johnson*

Acting Commissioner of Patents and Trademarks

Exh C

# Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

Raphael A. Gutiérrez  
rgutierrez@kmob.com

October 2, 2003  
**VIA FACSIMILE**

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

Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

10-14-2003  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #79

Dear Mr. Bach:

I have been working with Jeffrey L. Van Hoosear on the aforementioned matter. On August 13, 2003 we served the following discovery requests upon you in connection with the aforementioned matter:

- Opposer's First Set of Requests for Production of Documents Nos. 1-42, and
- Opposer's First Set of Interrogatories Nos. 1-15.

Responses to those discovery requests were due on September 17, 2003, pursuant to § 403.03 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") and 37 C.F.R. § 2.120(a). To date we have not received any responsive documents from you or your client. We would like to know if you plan on responding to those requests and, if so, when we might expect those responses. Please note that the address listed in the Requests for Production of Documents is incorrect and should be the same as the 2040 Main Street address on this letter. Please provide us with a response to this letter no later than October 6, 2003.

Please call me with any questions.

Sincerely,

  
Raphael A. Gutiérrez

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092603

San Diego  
619-235-8550

San Francisco  
415-954-4114

Los Angeles  
310-551-3450

Riverside  
909-781-9231

San Luis Obispo  
805-547-5580

EXHD

# Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

Raphael A. Gutiérrez  
rgutierrez@kmob.com

October 10, 2003  
**VIA FACSIMILE**

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

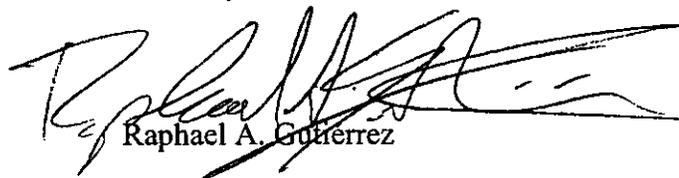
Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

Dear Mr. Bach:

The purpose of this letter is to confirm the details of our telephone conversation earlier today. During our conversation you advised me that you had received our letter dated October 2, 2003 inquiring as to the status of your clients' discovery responses. You informed me that you had not spoken to your client, but that you did not think your client would be filing a response.

As such, I advised you of Statek's intention to file a Motion to Compel a response to its discovery requests. Such motion will be filed today along with Statek's Motion for Summary Judgment.

Sincerely,



Raphael A. Gutiérrez

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101003

San Diego  
619-235-8550

San Francisco  
415-954-4114

Los Angeles  
310-551-3450

Riverside  
909-781-9231

San Luis Obispo  
805-547-5580

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEC
Opposer,	)	Serial No.: 76/202,322
	)	
v.	)	
	)	
DIPL. -ING RAINER PULS AND	)	
DIPL. -ING OLIVER PULS,	)	
	)	
Applicant.	)	
_____	)	

**DECLARATION OF LISA HELMLE**  
**IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

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

**ATT: BOX TTAB NO FEE**

Dear Sir:

I, Lisa Helmle, declare as follows:

1. I am a trademark paralegal with Knobbe, Martens, Olson & Bear LLP (the “Knobbe Firm”), intellectual property counsel for the Opposer, Statek Corporation, (“Opposer”) in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Opposer filed a Notice of Opposition against Applicant's Application on January 7, 2003. Opposer filed such Opposition based on Opposers' prior and senior use and registration of the marks STATEK and STATEK and Design.

3. Opposer agreed to extend the time for Applicant to file an Answer to the Opposition. On May 13, 2003, the parties filed a stipulation extending Applicant's time to answer. Applicant filed its Answer on June 14, 2003.

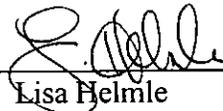
4. Opposer served its First Set of Requests for Production of Documents on Applicant on August 13, 2003. Opposer also served its First Set of Interrogatories on Applicant that same day. True and correct copies of Opposer's First Set of Requests for Production of Documents and First Set of Interrogatories are attached hereto as Exhibits A, and B, respectively.

5. To date, Opposer has not received a response to its Discovery Requests from Applicant.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: October 10, 2003

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

  
Lisa Helmle

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