

TTAB

STATEK.013M

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

STATEK CORPORATION,

Opposer,

v.

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

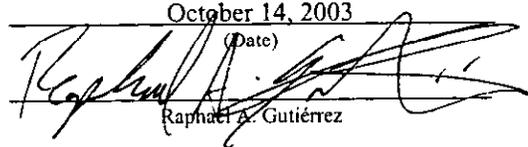
Applicant.

Opposition No. 91,154,712

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

October 14, 2003

(Date)



Raphael A. Gutierrez

**REQUEST TO ACCEPT OPPOSER'S MOTION TO COMPEL ANSWERS TO INTERROGATORIES AND PRODUCTION OF DOCUMENTS**

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

ATT: BOX TTAB - NO FEE



10-16-2003

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

Dear Sir:

On October 10, 2003, I filed a Motion to Compel Answers to Interrogatories and Production of Documents ("Motion to Compel") on behalf of Opposer with the Trademark Trial and Appeal Board ("TTAB") via U.S. Postal Service, First-Class mail. I also served a copy of the Motion to Compel on counsel for Applicant on the same day, also via U.S. Postal Service, First-Class mail.

Subsequent to depositing the service copies in the mail, it was discovered that I had inadvertently mailed the Motion to Compel without signing the Proof of Service. Enclosed with this Request to Accept Opposer's Motion to Compel is a copy of the Motion to Compel complete with a signed certificate of service, noting that I mailed the Motion to Compel on Friday, October

10, 2003. I have mailed a copy of these documents along with the signed certificate of service to Applicant's counsel on October 14, 2003.

Opposer respectfully requests that the Board accept the Motion to Compel.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10.14.03

By: 

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

H:\DOCS\RAG\RAG-2683.DOC  
101303



referred to as the "STATEK marks"). *See* Gutiérrez Decl., ¶¶ 2,3. Opposer's grounds for opposition are that Applicant's Application creates a likelihood of confusion with Opposer's STATEK marks. *See* 15 U.S.C. § 1063. Applicant has also filed a Motion for Summary Judgment concurrently herewith.

### III. ARGUMENT

Where a party fails to timely answer interrogatories or respond to document requests, the requesting party may move for an order compelling the disobedient party to respond to outstanding discovery. *See* 37 C.F.R. § 2.120(e) and TBMP §§ 411.01, 527.04. Opposer timely propounded its First Set of Interrogatories and First Request for Production of Documents (collectively, "Discovery Requests") to Respondent on August 13, 2003. *See* Helmle Decl. ¶3. The answers and responses were due on or before September 17, 2003. When Opposer received no response to its discovery requests, its attorney, Mr. Raphael A. Gutiérrez, faxed another letter to Applicant's counsel on October 2, 2003, inquiring as to whether Applicant planned on responding to Opposer's discovery requests. *See* Gutiérrez Decl. ¶4. The letter requested that Applicant respond to Opposer by October 6, 2003. When Opposer received no response to this letter, Mr. Gutiérrez called counsel for Applicant, Mr. Klaus Bach, on October 10, 2003. *See id.* at ¶ 5. Mr. Bach stated that he had not heard from Applicant and did not know whether Applicant would be responding to Opposer's discovery requests. *See id.* Mr. Gutiérrez advised Mr. Bach that Applicant would be filing a Motion to Compel and a Motion for Summary Judgment. *See id.* at ¶ 5. Mr. Gutiérrez then sent a letter to Mr. Bach confirming Mr. Bach's statements and again advising Mr. Bach of Applicant's intent to file a Motion to Compel and a Motion for Summary Judgment. *See id.* at ¶ 6.

Since Applicant has not responded to Opposer's Discovery Requests and Opposer does not know whether Applicant will be responding at all, Applicant respectfully requests that, pursuant to 37 C.F.R. § 2.120(e) and TBMP § 411.01, the Board compel Applicant to respond to its (1) First Set of Interrogatories, and to its (2) First Requests for Production of Documents.

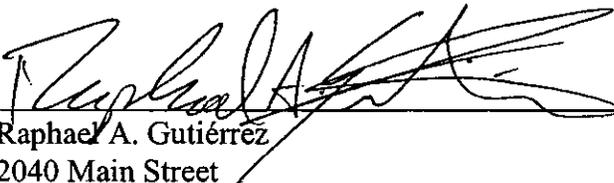
**CONCLUSION**

For the foregoing reasons, Opposer believes that it has satisfied the requirements of TBMP § 523.02 and respectfully requests that its Motion to Compel be granted and that the Board require Applicant to respond to Opposer's First Set of Interrogatories and its First Request for Production of Documents. In addition, Opposer respectfully requests that the Board suspend proceedings in this case pending the determination of this Motion, pursuant to 37 C.F.R. § 2.120(e)(2).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10.10.03

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

H:\DOCS\LXHLXH-1682.DOC  
100903

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Opposer's Motion To Compel Answers To Interrogatories And Production Of Documents 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. Bach  
Klaus J. Bach & Associates  
4407 Twin Oaks Drive  
Murrysville, PA 15668-9447

 10.14.03  
Raphael A. Guierrez

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

STATEK CORPORATION,	)	Opposition No.: 91154712
	)	Mark: STATEK
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  
TO COMPEL ANSWERS TO INTERROGATORIES AND PRODUCTION OF  
DOCUMENTS**

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, 2003, 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 advising him 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

HADOCSLXHLXH-1692.DOC  
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 Pichini*

# Exhibit B

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.*



*2. Todd Johnson*

# 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

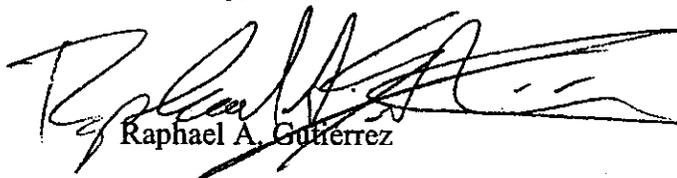
Re: Statek Corporation v. Dipl.-Ing Rainer Puls  
Opposition No.: 91154712  
Mark: STATEC  
Our Reference: STATEK.013M

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

H:\DOCS\VRAG\RAG-2682.DOC  
101003