

reply due

Opposition No. 91158137
WLJ. 076TM-OPP

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

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GROSSMAN, TUCKER,
PERREAULT & PFLEGER, PLLC

Freudenberg Nonwovens)
Limited Partnership)
Opposer-Plaintiff)
v.)
Trikon Holdings Limited)
Applicant-Defendant)

Opposition No. 91158137

Serial No. 76332592
"fxP"

APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE
A CLAIM UPON WHICH RELIEF CAN BE GRANTED

The APPLICANT, Trikon Holdings Limited, by and through undersigned counsel and pursuant to Fed.R.Civ.P. 12(b)(6), hereby moves the Trademark Trial and Appeal Board for an Order dismissing the above-identified Opposition with prejudice, and in support thereof APPLICANT states as follows:

APPLICANT respectfully contends that OPPOSER has failed to state a claim upon which relief can be granted. More specifically, as explained in the memorandum below, OPPOSER has failed to allege facts establishing a valid basis for denying APPLICANT'S registration.

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MEMORANDUM OF POINTS AND AUTHORITIES

I. BACKGROUND

With reference to the records of the U.S. Patent and Trademark Office, Official Notice can be taken as follows¹:

1. The object of this Opposition is Application No. 76332592 (the '592 application), in which APPLICANT seeks registration of the stylized mark "fx9".
2. The '592 application was published on December 10, 2002.
3. As published, the '592 application is directed to use of the fx9 mark on the following goods: Semiconductor and dielectric wafer fabrication and processing equipment and components, namely, chemical vapor deposition reactors, physical vapor deposition reactors, plasma etchers, ion implantors, wafer transport devices for use with semiconductor and dielectric wafer fabrication and processing equipment and components, and parts therefor, in Intl. Class 9.

II. ARGUMENT

The Opposition filed by OPPOSER commencing this proceeding is legally insufficient and should be dismissed for failure to state a claim for which relief can be granted. (TBMP ¶ 503.02; Fed. R. Civ. P. 12(b)(6))

¹ For convenience, a record copy of the '592 application data as contained in the Trademark Applications And Registrations Retrieval (TARR) system is attached as EXHIBIT A.

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Specifically, the Notice Of Opposition alleges that (a) OPPOSER has trademark rights in the term FX9 as applied to polishing pads which predate APPLICANT'S priority date, and (b) likelihood of confusion would result if APPLICANT'S fxP mark was used in commerce on the goods identified in Paragraph 1 of the Notice Of Opposition. Assuming, for purposes of this Motion only, that OPPOSER were to prevail as to both allegations, the OPPOSER would not be entitled relief since the goods identified in Paragraph 1 of the Notice Of Opposition are not the same as the goods recited in APPLICANT'S published trademark application.

Respectfully, this Motion is not based on a mere clerical oversight by OPPOSER. Rather, there are substantive differences between APPLICANT'S recitation of goods and the recitation set forth in the Notice Of Opposition.

Paragraph 9 of the Notice Of Opposition alleges that the APPLICANT'S goods and OPPOSER'S polishing pads are "similar if not identical." This allegation would seem to be premised on a liberal reading of the following recitation of goods appearing in Paragraph 1 of the Notice of Opposition:

"Semi-conductor or dielectric wafer fabrication
and processing apparatus and instruments;
chemical vapor deposition apparatus; physical
vapor deposition apparatus; plasma etchers; ion
implantors; workpiece transport mechanisms and
apparatus; parts and fittings for all of the

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aforesaid good in Int. Class 7." (Emphasis added)

Even assuming *arguendo* that the recitation of goods cited in the Notice of Opposition is so broad as to encompass polishing pads or goods related to polishing pads, the same can not reasonably be said of the following recitation appearing in APPLICANT'S published trademark application:

"Semiconductor and dielectric wafer fabrication and processing equipment and components, namely, chemical vapor deposition reactors, physical vapor deposition reactors, plasma etchers, ion implantors, wafer transport devices for use with semiconductor and dielectric wafer fabrication and processing equipment and components, and parts therefor, in Intl. Class 9." (Emphasis added)

By operation of the word "namely", the goods of APPLICANT'S published application consist of (a) chemical vapor deposition reactors, (b) physical vapor deposition reactors, (c) plasma etchers, (d) ion implantors, (e) wafer transport devices, and (f) parts therefor.

Also worthy of note is that the recitation contained in the Opposition refers to goods of International Class 7 (machinery), whereas APPLICANT'S recitation is directed to International Class 9 (electrical and scientific apparatus).

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APPLICANT speculates that the Notice Of Opposition was filed by OPPOSER with the mistaken belief that APPLICANT'S recitation of goods encompassed polishing pads, or perhaps goods that use polishing pads. In fact, APPLICANT'S recitation encompasses neither polishing pads, machines that use polishing pads, nor goods somehow related to polishing pads.

In any event, the alleged likelihood of confusion that would result if APPLICANT'S fxP mark was used in commerce on the goods identified in Paragraph 1 of the Notice Of Opposition is not a valid basis for denying APPLICANT'S registration. For at least this reason, the Notice Of Opposition does not state a claim for which relief can be granted.

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III. CONCLUSION

In view of the foregoing, APPLICANT requests that its Motion To Dismiss be granted and that the Notice Of Opposition be dismissed with prejudice.

November 26, 2003

Respectfully submitted,
Trikon Holdings Limited

By:



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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA, 22202-3514, this 26th day of November, 2003.



Angie Loomis, Office Manager

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-11-24 10:46:38 ET

Serial Number: 76332592

Registration Number: (NOT AVAILABLE)

Mark

fxp

(words only): FXP

Standard Character claim: No

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2003-10-18

Filing Date: 2001-11-02

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:
HAN DAWN L Employee Location

Current Location: 845 -TTAB

Date In Location: 2003-11-05

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. TRIKON HOLDINGS LIMITED

Address:
TRIKON HOLDINGS LIMITED
COED RHEDYN RINGLAND WAY
NEWPORT, GWENT, NP18 2TA,
United Kingdom

EXHIBIT A – page 1 of 3

Latest Status Info

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Legal Entity Type: Corporation
State or Country of Incorporation: United Kingdom

GOODS AND/OR SERVICES

Semiconductor and dielectric wafer fabrication and processing equipment and components, namely, chemical vapor deposition reactors, physical vapor deposition reactors, plasma etchers, ion implantors, wafer transport devices for use with semiconductor and dielectric wafer fabrication and processing equipment and components, and parts therefor

International Class: 009

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 44(e)

ADDITIONAL INFORMATION

Foreign Application Number: 2269243

Foreign Registration Number: 2269243

Foreign Registration Date: 2001-05-04

Country: United Kingdom

Foreign Filing Date: 2001-05-04

Foreign Expiration Date: 2011-05-04

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-10-18 - Opposition instituted for Proceeding

2003-01-16 - Extension of time to oppose - Filed

2002-12-10 - Published for opposition

2002-11-20 - Notice of publication

2002-09-23 - Approved for Pub - Principal Register (Initial exam)

2002-09-04 - ITU claim deleted

2002-09-04 - Examiner's amendment mailed

2002-07-31 - Communication received from applicant

2002-08-01 - Communication received from applicant

EXHIBIT A – page 2 of 3

Latest Status Info

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2002-08-01 - PAPER RECEIVED

2002-01-31 - Non-final action mailed

2002-01-24 - Case file assigned to examining attorney

CONTACT INFORMATION

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Domestic Representative

VOLENTINE FRANCOS, PLLC

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing
APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM
UPON WHICH RELIEF CAN BE GRANTED in Opposition No. 91158137 has been
deposited with the United States Postal Service in a postage paid envelope addressed to:
Commissioner for Trademarks, Trademark Trial and Appeal board, 2900 Crystal Drive,
Arlington, VA, 22202-3514; and a true and correct copy of same deposited with the
United States Postal Service in a postage paid envelope addressed to representative of
Opposer:

Teresa C. Tucker, Esq.
GROSSMAN, TUCKER, PERREAULT & PFLEGER PLLC
55 South Commercial Street
Manchester, NH 03101

this 26th day of November, 2003.

Respectfully submitted,


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FACSIMILE TRANSMITTAL SHEET

DELIVER THE FOLLOWING PAGES TO:

NAME: George Woods

DATE: February 9, 2004

FIRM: TTAB at USPTO

FROM: Teresa C. Tucker

PHONE NO:

OUR REF: FRD012

FAX NO: 703.308.9333

YOUR REF: Opposition No. 91158137

NUMBER OF PAGES INCLUDING COVER SHEET: 11

[X] This will be the only form of delivery of transmitted document.

ATTACHED IS THE FOLLOWING:

- 1) **Cover Sheet (1 pg)**
- 2) **Applicant's Motion to Dismiss... filed by Trikon (10 pgs)**

CONFIDENTIALITY NOTICE

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