

ESTTA Tracking number: **ESTTA46317**

Filing date: **09/26/2005**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Eagle Precision Technologies, Inc.		
Entity	Corporation	Citizenship	Canada
Address	565 West Street Brantford, Ont N3T 5R7 CANADA		

Attorney information	Olivia Goodkin Rutter Hobbs & Davidoff Incorporated 1901 Avenue of the Stars Suite 1700 Los Angeles, CA 90067 UNITED STATES ogoodkin@rutterhobbs.com Phone:(310) 286-1700
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Applicant Information

Application No	78462211	Publication date	09/20/2005
Opposition Filing Date	09/26/2005	Opposition Period Ends	10/20/2005
Applicant	EATON LEONARD ROBOLIX, INC. Suite A 1391 Specialty Drive Vista, CA 92083 UNITED STATES		

Goods/Services Affected by Opposition

Class 007. First Use: 19740819First Use In Commerce: 19741217
All goods and services in the class are opposed, namely: AUTOMATIC TUBE BENDING, WIRE BENDING AND TUBE END FORMING MACHINES

Class 009. First Use: 19740819First Use In Commerce: 19741217
All goods and services in the class are opposed, namely: COMPUTER HARDWARE AND SOFTWARE FOR CONTROLLING TUBE BENDING MACHINES; MEASURING AND INSPECTING INSTRUMENTS FOR BENT TUBES AND SURFACES AND FOR COMPUTING AND PRINTING DATA THEREFOR

Related Proceedings

1. Opposition No. 91164226; Mark: EATON LEONARD; Serial No. 78462208. 2. Opposition No. 91162316; Mark: EAGLE EATON LEONARD; Serial No. 76491087. 3. Opposition No. 91162315; Mark: EAGLE EATON LEONARD (design); Serial No. 76491086. 4. Opposition No. 91164226; Mark: EATON LEONARD; Serial No. 78462208. 5. Action pending in the United States District Court, Southern District of California as Case No. 03-352 BEN (WMC), entitled Eagle Precision Technologies, Inc. v. Eaton Leonard Robolix, Inc., et al.

Attachments

Opposition EL with design.pdf (6 pages)

Signature

//olivia goodkin//

Name

Olivia Goodkin

Date

09/26/2005

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

In the matter of:) Opposition No.
)
EAGLE PRECISION TECHNOLOGIES,) Mark: EATON LEONARD
INC.,)
) Serial No. 78462211
Opposer,)
v.)
)
EATON LEONARD ROBOLIX, INC.,)
)
Applicant.)
)
_____)

NOTICE OF OPPOSITION

SUBMITTED ELECTRONICALLY

Assistant Commissioner of Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

Dear Assistant Commissioner:

Opposer Eagle Precision Technologies, Inc., a Canadian corporation (“Eagle”), respectfully submits this statement in support of its assertion that it will be damaged by the registration of the mark EATON LEONARD and design, as sought by Eaton Leonard Robolix, Inc., a California corporation (“Applicant”), as shown in Application Serial No. 78/462211, and therefore alleges as follows:

1. Eagle is in the business of the manufacture, sale and servicing of tube bending machines, tube measuring equipment and related products. Applicant is in the same business as Eagle and is a direct competitor.

2. Eaton Leonard, Inc., a California corporation ("ELI"), is a wholly owned subsidiary of Eagle. ELI was the original owner of the registered design mark shown in Registration No. 1066613 (the "Design Mark"). In addition to the Design Mark, ELI used the word mark EATON LEONARD since at least August 19, 1974 in connection with metal tube bending machines in International Class 7, and since at least as early as December 17, 1974 in interstate commerce. ELI used the word mark EATON LEONARD and the Design Mark since at least November 6, 1973 in connection with equipment for the measurement of tubes formed by tube bending machines in International Class 9, and since at least as early as December 12, 1973 in interstate commerce. ELI used the word mark EATON LEONARD and the Design Mark in connection with the repair and maintenance of metal tube bending machines and measuring equipment for bent tubes in International Class 47, and in interstate commerce, since at least December 17, 1974.

3. In 1997, Eagle purchased all of the stock of ELI, and ELI subsequently assigned all of its intellectual property, including the name, trade name and trademark EATON LEONARD, to Eagle. The assignment of the Design Mark from ELI to Eagle was recorded on May 24, 1999 at Reel 1903, Frame 0548. From 1997, Eagle, and its subsidiary ELI, under license from Eagle, continued to use the Design Mark and the name EATON LEONARD.

4. Eagle has used the mark EAGLE EATON LEONARD since March 1, 1997, in interstate commerce, in connection with: (a) metal tube bending machines in

International Class 7; (b) equipment for the measurement of tubes formed by tube bending machines in International Class 9; and (c) the repair and maintenance of metal tube bending machines and measuring equipment for bent tubes in International Class 37.

5. Eagle has used the mark EAGLE EATON LEONARD with a design since March 1, 1997, in interstate commerce, in connection with: (a) metal tube bending machines in International Class 7; (b) equipment for the measurement of tubes formed by tube bending machines in International Class 9; and (c) the repair and maintenance of metal tube bending machines and measuring equipment for bent tubes in International Class 37.

6. On November 25, 2002, Eagle filed an application for registration of the mark EATON LEONARD with the U.S. Patent and Trademark Office in International Classes 7, 9 and 37 for the goods and services listed above. The application was assigned Serial No. 76/469744. Applicant initiated an opposition proceeding against Eagle. The parties entered into a stipulation to stay such proceeding.

7. On February 12, 2003, Eagle filed an application for registration of the mark EAGLE EATON LEONARD with the U.S. Patent and Trademark Office in International Classes 7, 9 and 37 for the goods and services listed above. The application was assigned Serial No. 76/491087. Applicant initiated an opposition proceeding against Eagle. The parties entered into a stipulation to stay such proceeding.

8. On February 12, 2003, Eagle filed an application for registration of the mark EAGLE EATON LEONARD with design with the U.S. Patent and Trademark Office in International Classes 7, 9 and 37 for the goods and services listed above. The

application was assigned Serial No. 76/491086. Applicant initiated an opposition proceeding against Eagle. The parties entered into a stipulation to stay such proceeding.

9. On August 4, 2004, Applicant filed an application for registration of the word mark EATON LEONARD with the U.S. Patent and Trademark Office in International Classes 7 and 9. The application was assigned Serial No. 78/462208. Eagle initiated an opposition proceeding against Applicant, designated No. 91164226. The parties entered into a stipulation to stay such proceeding, due to the pending Federal Action, discussed below. The request for stay has been granted.

10. The EATON LEONARD trademark and Design Mark are famous in the tube bending industry and has acquired great value as an identifier of goods. ELI and Eagle, through extensive sales, advertising and promotion of its goods under the EATON LEONARD and EAGLE EATON LEONARD trademarks and designs, have built up, at great expense and effort, valuable goodwill symbolized by their marks.

11. In or about May 2000, Eagle, ELI, and a company named Financiere Robolix S.A.R.L., entered into a transaction resulting in the creation of Applicant, as a new corporation. The transaction included the license of the right to use the name and mark EATON LEONARD (owned by Eagle at the time and to the present date) to Applicant for use by Applicant only in the capacity as a licensee (not as an owner of the mark), and only with the additional word ROBOLIX used at the end, i.e., EATON LEONARD ROBOLIX, and only for use in the manufacture and sale of particular tube bending equipment specified in the written contract, and for no other purposes. The transaction also included granted the right of Applicant to use the Design Mark for purposes of the

manufacture and sale of particular tube bending equipment specified in the written contract, and for no other purpose.

12. After approximately two years of using the name EATON LEONARD and the Design Mark properly and only in the manner required by the contract, Applicant commenced use of the EATON LEONARD trademark and trade name without the word ROBOLIX and in market segments in which Applicant was not entitled to use the mark, and used the Design Mark in market segments in which Applicant was not entitled to use the mark. On information and belief, this misuse began in or around April 2002, and without the permission of Eagle or its affiliate companies. Despite demand that Applicant, the licensee, cease using the mark EATON LEONARD and the Design Mark in such an unauthorized manner, Applicant has failed and refused to cease such use and has, in fact, filed trademark applications for not only the mark at issue herein, but for the word mark EATON LEONARD, Serial No. 78462208, despite being only a licensee of the portion of mark comprised of the words EATON LEONARD. The improper use of the trademark EATON LEONARD and the Design Mark by Applicant is the subject of a pending action in the United States District Court for the Southern District of California (the "Federal Action").

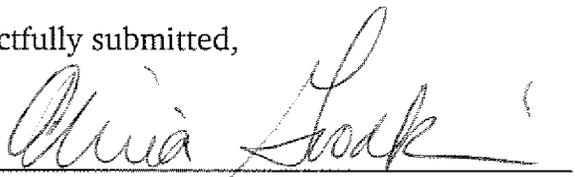
13. Applicant, by virtue of its capacity as a mere licensee of the name and mark EATON LEONARD pursuant to the parties' written contract of May 2000, is legally barred from seeking to file for the trademark registrations of EATON LEONARD and EATON LEONARD with design. Furthermore, as more thoroughly alleged in Eagle's pleadings in the Federal Action, which allegations are incorporated herein: (1) Applicant's use of the mark EATON LEONARD constitutes violation of the contracts

entered into among the parties and their affiliates; (2) Among other things, Applicant's use of the Design Mark and word mark EATON LEONARD as well as its trademark applications for the marks EATON LEONARD and EATON LEONARD and design, constitutes unfair business practices, violates the Lanham Act and constitutes breach of contract, interference with contractual relations, passing off and constructive fraud; and (3) Applicant has used the mark EATON LEONARD and the Design Mark in false and misleading advertising.

WHEREFORE, Eagle prays that the Application Serial No. 78/462211 be rejected and stricken, that no registration be issued to Applicant, and that this Opposition be sustained in its entirety in favor of Eagle.

Dated: September 26, 2005

Respectfully submitted,

By: 
OLIVIA GOODKIN

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