

ESTTA Tracking number: **ESTTA284769**

Filing date: **05/19/2009**

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	NAC Harmonic Drive, Inc.
Granted to Date of previous extension	05/20/2009
Address	4720 Salisbury Road, Suite 1 Jacksonville, FL 32256 UNITED STATES

Attorney information	Michael J. Feigin, Esq. Law Firm of Michael Feigin, Esq. 103 The Circle Passaic, NJ 07055 UNITED STATES michael@patentlawny.com Phone:973-685-5280
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Applicant Information

Application No	77373925	Publication date	01/20/2009
Opposition Filing Date	05/19/2009	Opposition Period Ends	05/20/2009
Applicant	Harmonic Drive L.L.C. 247 Lynnfield Street Peabody, MA 019604905 UNITED STATES		

Goods/Services Affected by Opposition

Class 007. First Use: 1960/01/01 First Use In Commerce: 1960/01/01 All goods and services in the class are opposed, namely: Electric motors; motor shaft retention brakes; adjustable shaft couplings and couplings for machines; servo motors for positioning in response to electrical control signals; drives and transmissions in the nature of speed and power increasers and reducers, all except for land vehicles
Class 009. First Use: 1960/01/01 First Use In Commerce: 1960/01/01 All goods and services in the class are opposed, namely: Electric rotary actuators and electronic controllers for producing control signals for electric rotary actuators and motor shaft retention brakes

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23

Other	
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Attachments	NAC001-03b-OppositionPleading2.pdf (4 pages)(60952 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael Feigin/
Name	Michael J. Feigin, Esq.
Date	05/19/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD		
In the matter of:		
Trademark:	HARMONIC DRIVE	
Serial No.:	77/373,925	Opposition No. _____
Filed:	January 17, 2008	
Published:	January 20, 2009	

NAC HARMONIC DRIVE, INC.	}
Opposer,	}
v.	}
	}
HARMONIC DRIVE LLC.	}
Applicant.	}

NOTICE OF OPPOSITION

Opposer, NAC Harmonic Drive, Inc. believes it will be damaged by registration of the trademark shown in the above-identified application filed by Applicant, Harmonic Drive, LLC and hereby opposes same, the time for opposition having been extended accordingly.

The grounds for opposition are as follows:

1. Opposer is a Florida corporation with its headquarters and principal place of business at 4720 Salisbury Road, Suite 1, Jacksonville, FL 32256.

2. Opposer is a leading supplier of ISO9001 certified harmonic drive gearboxes and component sets and sells harmonic drive units through an expanding global network.
3. Opposer established U.S. offices to sell harmonic drive gearboxes, and the like, in 2007 and has sold such products in the United States and worldwide since this time.
4. Opposer serves the aerospace, machine tool, electronics, printing, robotic and motion control industries.
5. The harmonic drive apparatus is the subject of expired patent 2,906,143 (“Strain Wave Gearing”), and this subject matter has long been descriptively referred to as a harmonic drive in numerous text books, learned journal articles, over eight hundred patents, and Applicant’s own marketing materials and catalogs. (In one hundreds of examples, U.S. Patent 7,455,007 to another entity states, “A preferred elevation means is a motor and gear system, with the most preferred being a *harmonic drive* coupled to a servo motor.”)
6. Applicant’s mark is generic or, in the alternative, merely descriptive and registration of the mark would adversely affect opposer’s ability to sell the harmonic drive apparatuses.
7. The U.S. Trademark Office, in application Serial No. 77/030,648, filed by Applicant for a harmonic drive mark, correctly cited a Miriam Webster dictionary definition of “harmonic” as being “a component frequency of a complex wave” (e.g. strain wave) and refused allowance of Applicant’s mark based on descriptiveness.
8. On more than one occasion, applicant has abandoned its registration attempts for this mark and derivatives thereof. The most recent occurrence, in application Serial No. 77/030,648, was within days of filing the present application and Applicant is fraudulently “gaming” the

system by abandoning and re-filing until the desired outcome is reached.

9. Applicant has failed to indicate and mark clearly, in most or all of its marketing materials and catalogs, that “harmonic drive” is a source indicator for its goods, as opposed to a description of a generally known and used functional apparatus. On the contrary, on numerous occasions, applicant itself claims trademark protection in foreign countries, fails to claim protection in the United States, and refers to a harmonic drive in a descriptive manner (e.g. “If any roller moves out of alignment, . . . a harmonic drive differential unit will correct alignment . . .”, The World of Harmonic Drive Gearing, “Printing Presses”, No. 8804-01R-CB, Harmonic Drive Systems, Inc., pg 8, undated).
10. From about 1987 until about 2005, both HD Systems, Inc. and Applicant advertised and sold “harmonic drive” products. While Applicant and HD Systems, Inc. merged in about 2006, to the best of Opposer’s knowledge, Applicant sat on it’s alleged trademark rights and should be estopped from claiming trademark rights at this time.
11. Applicant has made no attempt, or in the alternative, has dismally failed to prevent usage of the harmonic drive name by others in the industry, including but not limited to textbook authors, inventors, and the general public.
12. Applicant further claims that it has been using all of the goods and services alleged in the mark since 1960. In fact, as alleged above and made of record at the U.S. Patent and Trademark Office, applicant has abandoned rights to this mark on numerous occasions since 1960 and still further, many of the goods and services recited in Applicant’s mark were either not yet in existence or not sold by applicant as early as

1960, rendering the present application fraudulent and subject to cancellation solely for this reason.

13. As a result of the above facts, one must reach the inescapable conclusion that Applicant's mark is descriptive, fraudulent, and/or abandoned.
14. Opposer will be damaged by the registration of Application Serial No. 77/373,925 insofar as the registration would be prima facie evidence of: (a) the validity of the registration, (b) Applicant's ownership of the HARMONIC DRIVE mark for the goods specified in the registration, and c) Applicant's exclusive right to use the HARMONIC DRIVE mark in commerce when, in fact, Applicant is not entitled to such rights by virtue of the descriptive or generic nature of the mark and, fraudulent attempts to register the mark.

WHEREFORE, Opposer prays that Applicant Serial No. 77/373,925 be refused registration and this Notice of Opposition by sustained in favor of Opposer.

Sincerely,

MICHAEL J. FEIGIN

/Michael J. Feigin/

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