

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

coggins

Mailed: September 7, 2010

Opposition No. 91190278

NAC Harmonic Drive, Inc.

v.

Harmonic Drive L.L.C.

Before Quinn, Holtzman, and Cataldo
Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's motion for summary judgment (filed December 9, 2009) on the ground that the mark is generic.¹

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating

¹ Although the notice of opposition alleges other grounds for opposing registration of applicant's mark, and the motion mentions in passing that "the present application [is] fraudulent" (Mot. p. 4), opposer's motion is clearly predicated solely on the ground of genericness. In view thereof, the Board does not address any other ground.

that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

A mark is a generic name if it refers to the class, genus, or category of goods on which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citations omitted). The test for determining whether a mark is generic involves a two-step inquiry: (1) what is the class, genus, or category of goods at issue? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that class, genus, or category of goods? See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

As evidence in support of its motion, opposer submitted a declaration of its attorney, Michael J. Feigin, through

which opposer makes of record, *inter alia*, portions of applicant's website, excerpts of an Internet search engine result for "harmonic drive," portions of online trade journal articles, portions of alleged competitor websites, an excerpt from a mechanical engineering textbook, a list of patents, copies of various patents, and other online resources. As evidence in opposition to the motion for summary judgment, applicant submitted a declaration of its executive vice president, Zhongmin Yang, in which applicant provided confidential advertising and sales figures, and through which applicant makes of record various advertising and marketing materials, an excerpt of a symposium article, various patents and patent application information, and a purchase order. In addition to providing its own evidence, applicant argued against much of opposer's evidence and submitted various objections thereto.

Upon careful consideration of the arguments and evidence of the parties, and drawing all inferences with respect to the motion in favor of applicant as the nonmoving party, we find that opposer has not demonstrated the absence of a genuine issue of material fact for trial on the ground that applicant's mark is generic. Specifically, genuine issues of material fact remain as to the class, genus, or category of goods at issue, the relevant public, and whether the mark is understood by that relevant public primarily to refer to that class, genus, or category of goods. That is, genuine issues

of material fact remain as to all aspects of the claim of genericness. In view thereof, opposer's motion for summary judgment is denied.²

Schedule

Proceedings are resumed. Remaining dates are reset on the following schedule.

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| Expert Disclosures Due | 11/3/2010 |
| Discovery Closes | 12/3/2010 |
| Plaintiff's Pretrial Disclosures | 1/17/2011 |
| Plaintiff's 30-day Trial Period Ends | 3/3/2011 |
| Defendant's Pretrial Disclosures | 3/18/2011 |
| Defendant's 30-day Trial Period Ends | 5/2/2011 |
| Plaintiff's Rebuttal Disclosures | 5/17/2011 |
| Plaintiff's 15-day Rebuttal Period Ends | 6/16/2011 |

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

² The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).