

ESTTA Tracking number: **ESTTA335745**

Filing date: **03/05/2010**

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

Proceeding	91193858
Party	Plaintiff Emerson Power Transmission Corporation
Correspondence Address	Lisa M. DuRoss/Jessica S. Sachs Harness, Dickey & Pierce, P.L.C. 5445 Corporate Drive Suite 200 Troy, MI 48098 UNITED STATES jsachs@hdp.com
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/jss/
Date	03/05/2010
Attachments	Amended Notice of Opposition.PDF (13 pages)(427609 bytes)

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3. Opposer is a leading manufacturer and seller of power transmission products, including drives, sheaves, bearings, bushings, and components.

4. Opposer has been continuously using the VORTEX trademark in connection with sheaves, belt drives, pulleys and related products since at least as early as 1999, and continues to use the mark in connection with such products.

5. McGuire is a distributor of bearings and power transmission products.

6. McGuire was an authorized distributor of Opposer's products for approximately thirty (30) years. On September 30, 2005, McGuire's status as an authorized distributor of Opposer's products expired.

7. McGuire was an authorized distributor of Opposer's products offered in connection with the VORTEX mark for several years, from at least 1999 until 2005.

8. Opposer is the owner of a pending trademark application (Application Serial No. 77/311,141), and the common law rights associated therewith, in the United States for the trademark VORTEX for "sheaves; belt drives; v-belt drives; v-drives; pulleys being parts of machines" in International Class 7 ("Opposer's Mark"). Copies of the TARR printout and Assignment Abstract of Title for Opposer's Mark are attached hereto as Exhibit A.

9. Opposer's Mark symbolizes the goodwill, reputation, and recognition built up by Opposer as a result of the time, resources and effort spent advertising, promoting, and publicizing the goods offered in connection with Opposer's Mark, and establishing Opposer's Mark in the minds of consumers as an indicator of high-quality products offered by Opposer. As

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a result, Opposer's Mark has become, through favorable public acceptance and recognition, an asset of value as a symbol of Opposer, its quality products and its goodwill.

10. McGuire seeks to register the trademark VORTEX for "machine parts, namely, gear-boxes, speed reducers, and shaft mount reducers" ("McGuire's Mark") in International Class 7. Said trademark was published in the October 27, 2009 edition of the *Official Gazette*.

11. McGuire's Application was filed on February 14, 2007 with an asserted date of first use of August 2006. Notably, Opposer has been using Opposer's Mark since at least 1999, a date significantly earlier than either the filing date of McGuire's Application or the asserted date of first use of McGuire's Mark.

12. McGuire's Application for the VORTEX mark has been cited by an Examining Attorney at the U.S. Patent and Trademark Office as a potential bar to registration of Application Serial No. 77/311,141 for Opposer's Mark. Further action on Opposer's application has been suspended.

13. McGuire's Mark is visually, aurally, and conceptually indistinguishable from Opposer's Mark and the goods listed in McGuire's Application are sufficiently related to the goods offered by Opposer as to be likely to cause confusion, or to cause mistake, or to deceive.

14. Opposer reasonably believes that consumers, upon encountering McGuire's Mark used on or in connection with McGuire's goods, are likely to believe that such goods emanate from, are authorized or sponsored by, are made in accordance with instructions or specifications of, or are in some other way affiliated with or connected to Opposer.

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15. McGuire's Mark falsely suggests a connection or association with Opposer. When McGuire's Mark is applied to goods traveling in the same or similar channels of trade as those sold by Opposer in connection with Opposer's Mark, McGuire's Mark so resembles Opposer's Mark as to be likely to cause confusion and lead to deception or mistake as to the origin of McGuire's goods offered under McGuire's Mark. Consequently, Opposer believes that McGuire's use and registration of the VORTEX mark will cause consumers to draw a false conclusion about the origin, nature, or quality of McGuire's goods under circumstances where such a conclusion will be material to the consumer's deliberations regarding the purchase of such goods.

16. If McGuire is permitted to use and register the VORTEX mark for the goods specified in the application herein opposed, confusion in trade resulting in damage and injury to Opposer would result by reason of the similarity between Opposer's Mark and McGuire's Mark. Furthermore, any defect, objection or fault found with McGuire's goods marketed and sold under the VORTEX mark would necessarily reflect upon and seriously injure the reputation that Opposer has established in its mark.

17. Upon information and belief, McGuire filed its application for the VORTEX mark with prior knowledge of Opposer's use of the VORTEX mark.

18. Upon information and belief, at the time McGuire filed its application for the VORTEX mark and executed the oath in support of the application, McGuire knew, as a result of its prior, long-standing status as an authorized distributor of Opposer's products, including products offered in connection with the VORTEX mark, that Opposer was using the VORTEX mark and had been using the mark for many years.

19. Upon information and belief, McGuire filed its application for the VORTEX mark with prior knowledge of Opposer's superior rights in the VORTEX mark.

20. Upon information and belief, at the time McGuire filed its application for the VORTEX mark and executed the oath in support of the application, McGuire knew, as a result of its prior, long-standing status as an authorized distributor of Opposer's products, including products offered in connection with the VORTEX mark, that Opposer had superior rights to use the VORTEX mark in connection with goods the same as or related to the goods set forth in McGuire's Application.

21. Upon information and belief, at the time McGuire filed its application for the VORTEX mark and executed the oath in support of the application, McGuire did not, as a result of its prior, long-standing status as an authorized distributor of Opposer's products, including products offered in connection with the VORTEX mark, have an honest, good faith belief that it had superior rights in the VORTEX mark or that no other person, firm or corporation had the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, firm or corporation, to cause confusion, or to cause mistake, or to deceive.

22. Upon information and belief, at the time McGuire filed its application for the VORTEX mark and executed the oath in support of the application, McGuire, as a result of its prior, long-standing status as an authorized distributor of Opposer's products, including products offered in connection with the VORTEX mark, knew that Opposer had superior rights in the mark and either believed that a likelihood of confusion would result from its use of the VORTEX mark or had no reasonable basis for believing otherwise.

23. Upon information and belief, at the time McGuire filed its application for the VORTEX mark and executed the oath in support of the application, McGuire knowingly, purposely, and willfully failed to disclose Opposer's prior, superior rights in the VORTEX mark, even though McGuire knew, as a result of its prior, long-standing status as an authorized distributor of Opposer's products, including products offered in connection with the VORTEX mark, that Opposer was using the mark.

24. Upon information and belief, McGuire's intentional failure to disclose Opposer's prior, superior rights in the VORTEX mark was in bad faith and with the intent to obtain a registration for which it would not otherwise have been entitled.

25. Upon information and belief, McGuire knowingly and purposely filed its application and executed the oath in support of the application in bad faith and in an attempt to perpetrate fraud upon the U.S. Patent and Trademark Office because McGuire knew or was in reckless disregard of the truth that Opposer had been using the VORTEX mark for many years and had prior, superior rights in the mark.

26. McGuire's intentional failure to disclose Opposer's prior, superior rights in the VORTEX mark was material to the prosecution and acceptance of McGuire's Application.

27. Reasonably relying on the truth of the statements contained in McGuire's Application that no other user had prior rights in the VORTEX mark superior to McGuire's, the Examining Attorney approved the application for publication.

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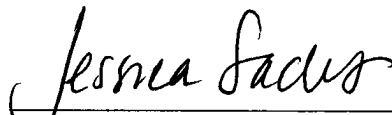
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WHEREFORE, Opposer prays that this opposition be sustained and that McGuire be denied registration of the mark VORTEX as identified in Application Serial No. 77/107,787 in International Class 7.

Respectfully submitted,

Date: March 5, 2010



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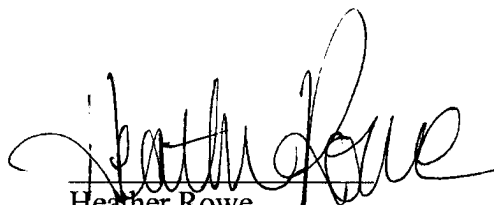
Emerson Power Transmission Corporation

CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of March, 2010, I mailed, via First Class Mail, postage prepaid, a true and correct copy of the foregoing AMENDED NOTICE OF OPPOSITION to:

Correspondent of Record:

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Ater Wynne LLP
1331 NW Lovejoy Street
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Portland, Oregon 97209



Heather Rowe

**EXHIBIT A
TO
AMENDED NOTICE OF OPPOSITION**

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

This page was generated by the TARR system on 2010-03-05 13:52:23 ET

Serial Number: 77311141 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

VORTEX

(words only): VORTEX

Standard Character claim: Yes

Current Status: Further action on the application has been suspended.

Date of Status: 2010-01-25

Filing Date: 2007-10-23

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 107

Attorney Assigned:
LAMOTHE LESLEY

Current Location: L70 -TMEG Law Office 107

Date In Location: 2010-01-25

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

1. EMERSON POWER TRANSMISSION CORPORATION

Address:
EMERSON POWER TRANSMISSION CORPORATION
7120 NEW BUFFINGTON ROAD

FLORENCE, KY 41042

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 007

Class Status: Active

Sheaves; belt drives; v-belt drives; v-drives; pulleys being parts of machines

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-01-25 - Report Completed Suspension Check Case Still Suspended

2009-10-21 - Automatic Update Of Assignment Of Ownership

2009-10-14 - Automatic Update Of Assignment Of Ownership

2009-07-24 - Report Completed Suspension Check Case Still Suspended

2009-01-24 - Report Completed Suspension Check Case Still Suspended

2009-01-21 - Assigned To LIE

2009-01-16 - Teas/Email Correspondence Entered

2009-01-16 - Communication received from applicant

2009-01-16 - TEAS Response To Suspension Inquiry Received

2008-07-21 - Notification Of Letter Of Suspension E-Mailed

2008-07-21 - LETTER OF SUSPENSION E-MAILED

2008-07-21 - Suspension Letter Written

2008-06-24 - Teas/Email Correspondence Entered

2008-06-24 - Communication received from applicant

2008-06-24 - TEAS Response to Office Action Received

2007-12-28 - Notification Of Non-Final Action E-Mailed

2007-12-28 - Non-final action e-mailed

2007-12-28 - Non-Final Action Written

2007-12-19 - Assigned To Examiner

2007-10-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

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United States Patent and Trademark Office

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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1**Serial #:** 77311141**Filing Dt:** 10/23/2007**Reg #:** NONE**Reg. Dt:****Applicant:** Emerson Power Transmission Manufacturing**Mark:** VORTEX**Assignment: 1****Reel/Frame:** 4074/0982**Received:** 10/07/2009**Recorded:** 10/07/2009**Pages:** 10**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** EMERSON POWER TRANSMISSION MANUFACTURING**Exec Dt:** 08/07/2009**Entity Type:** PARTNERSHIP**Citizenship:** MISSOURI**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** EMERSON POWER TRANSMISSION CORPORATION

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Search Results as of: 03/05/2010 01:52 PM
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