

ESTTA Tracking number: **ESTTA484583**

Filing date: **07/20/2012**

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	Electro-Motive Diesel, Inc.
Granted to Date of previous extension	08/19/2012
Address	9301 West 55th Street LaGrange, IL 60525 UNITED STATES

Attorney information	Christopher P. Foley Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 901 New York Avenue, NW Washington, DC 20001 UNITED STATES christopher.foley@finnegan.com, docketing@finnegan.com, larry.white@finnegan.com
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**Applicant Information**

Application No	85092214	Publication date	02/21/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	08/19/2012
Applicant	New York Air Brake Corporation 748 Starbuck Avenue Watertown, NY 13601 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Locomotive monitoring system comprising software and processor to process, integrate and display real-time information and data for making real-time evaluations of operating parameters and improving train handling capability; Locomotive monitoring system for installation in locomotives featuring software and processor to process, integrate, and display real-time information and data
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**Applicant Information**

Application No	85092216	Publication date	02/21/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	
Applicant	New York Air Brake Corporation 748 Starbuck Avenue Watertown, NY 13601 UNITED STATES		

## Goods/Services Affected by Opposition

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## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EMD		
Goods/Services	Locomotives and railway trains; railway vehicles, namely, trains, rolling stock, bogies; motors and engines for land vehicles; machine couplings and transmission components for land vehicles; parts and fittings for all the aforesaid goods; Motors and engines except for land vehicles; machine coupling and transmission components except for land vehicles; diesel engines and motors not for land vehicles; internal combustion engines and motors not for land vehicles; electric generators; diesel and fuel injection devices, namely, mechanical and electronic fuel injection modules; turbochargers for machines, motors and engines; exhaust systems in the nature of exhaust silencers and exhaust pipes for combustion engines; diesel engines for machines; glow plugs for diesel engines; electric pumps; electric propulsors; electric drives for machines, motors and engines; mechanical controls for motors and engines; watercraft motors and engines; machine couplings and transmission components for watercrafts; parts and fittings for all the aforesaid goods; Remote monitoring systems for locomotives and engines comprised of computers, telecommunication equipment, locomotive control computers, electronic measuring devices, electronic sensing devices, computer software, operator user interface computers, cellular modems, digital cellular modems, analog cellular modems, LAN devices, wireless LAN devices, global positioning systems, cellular system providers, mainframe servers with web-based applications and databases, event recording systems; electronic measuring, sensing, recording, signaling, and warning apparatus used in operation of locomotives and engines, global positioning system; computer software for use in electrical and electronic monitoring systems, operation systems and control systems in the field of locomotives and engines; electrical and electronic control apparatus and systems for the control of locomotives and engines comprised of computers, telecommunication equipment, locomotive control computers, electronic measuring devices, electronic sensing devices, computer software, operator user interface computers, cellular modems, digital cellular modems, analog cellular modems, LAN devices, wireless LAN devices, global positioning systems, cellular system providers, mainframe servers with web-based applications and databases, event recording systems; electrical and electronic monitoring and switching apparatus and systems comprised of computers, telecommunication equipment, locomotive control computers, electronic measuring devices,		

	<p>electronic sensing devices, computer software, operator user interface computers, cellular modems, digital cellular modems, analog cellular modems, LAN devices, wireless LAN devices, global positioning systems, cellular system providers, mainframe servers with web-based applications and databases, event recording systems for use in the field of locomotives and engines; Global position monitoring services related to railway rolling stock and locomotives for commercial purposes; tracking services of railway rolling stock and locomotives for commercial purposes; consulting services, namely supply chain design and management; Maintenance, servicing, refurbishing, repairing, restoring, and upgrading of machines, motors, engines, railway rolling stock and locomotives; consultancy and advisory services relating to the aforesaid services; performance improvement through the servicing of machines, motors, engines, railway rolling stock and locomotives; consultancy and advisory services relating to the aforesaid services; and Technical condition monitoring of railway machines, motors, engines, railway rolling stock and locomotives, namely, remote tracking for determining the performance of railway machines, motors, engines, railway rolling stock and locomotives</p>
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U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EM2000		
Goods/Services	Microprocessor based control system for managing all critical locomotive functions, including wheel adhesion, ground speed, fault detection, fuel consumption, and traction motor management.		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EMDX		
Goods/Services	Locomotives and railway trains; railway vehicles, namely, trains		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EMLX		
Goods/Services	Locomotives and railway trains; railway vehicles, namely, trains		

Attachments	Notice of Opposition - EM ADVISOR and EM ASSIST.pdf ( 6 pages )(33277 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	/Christopher P. Foley/
Name	Christopher P. Foley

Date	07/20/2012
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>ELECTRO-MOTIVE DIESEL, INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>NEW YORK AIR BRAKE CORPORATION,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. _____</p> <p>Application Nos.: 85/092,214 and 85/092,216</p> <p>Marks: EM ADVISOR and EM ASSIST</p> <p>Filing Date: July 24, 2010</p>
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**NOTICE OF OPPOSITION**

Electro-Motive Diesel, Inc. (“EMD”), a Delaware corporation, having its principal place of business at 9301 West 55th Street, LaGrange, Illinois 60525, believes that it will be damaged by the registration of New York Air Brake Corporation’s (“Applicant”) Applications (Serial Nos. 85/092,214 and 85/092,216) for the marks EM ADVISOR and EM ASSIST for “[I]ocomotive monitoring system comprising software and processor to process, integrate and display real-time information and data for making real-time evaluations of operating parameters and improving train handling capability; [I]ocomotive monitoring system for installation in locomotives featuring software and processor to process, integrate, and display real-time information and data.” The applications have been filed on the basis on an intent to use the marks. As grounds for this opposition, EMD alleges that, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to Applicant and Applicant’s mark:

## **EMD's Marks**

1. EMD is the world's largest builder of diesel electric locomotives for all commercial railroad applications: intercity passenger, commuter, freight, switching, industrial and mining. EMD is also a global provider of diesel powered engines for a wide range of applications. EMD also develops software and electronics to integrate the operation of EMD's locomotives. For more than 70 years, the company's products have been advertised, manufactured, traded and serviced under the EMD name and trademark. Throughout this time, EMD manufacturing and maintenance services have set the standard for technological achievement in the locomotive field.

2. EMD products include, for example, EMD AESS, which is a fully integrated software solution that monitors critical operating parameters when the locomotive is idling. Another EMD innovation is a remote monitoring and diagnostics system to provide railroads with live data concerning the operation of their locomotives.

3. Still another leading example of EMD's technological prowess is a system to upgrade older locomotives to the same microprocessor technology available in current model locomotives. This control system, which has been installed in several thousand locomotives worldwide, is identified by the EM2000 name and trademark. Its salient characteristics include a radar-based control logic system to improve wheel adhesion, an interactive display interface, and a traction motor management system.

4. In addition to managing all critical locomotive operating functions, the EM2000 system increases locomotive residual value, improves locomotive availability, reduces fuel consumption and lowers life cycle costs.

5. The EM2000 control system has been in continuous use for more than 20 years. The EM prefix related to Electro-Motive.

6. EMD has used the EMD and EM2000 names and marks for locomotive products and services for decades. EMD also has used other EM-formative marks including EMDX and EMLX, over the years in connection with locomotives. The EMD, EM2000, EMDX and EMLX marks are referred to as “EMD’s EM-formative marks.” Diesel-electric locomotives, related equipment and software, repair and servicing thereof, and the goods and services as identified in Paragraphs 1-5 above are collectively referred to as “EMD’s Products and Services.”

7. EMD has enjoyed substantial sales and has spent vast sums in advertising and promoting EMD’s Products and Services in connection with its EM-formative marks throughout the United States.

**Applicant’s Application for the Marks EM ADVISOR and EM ASSIST**

8. Applicant, New York Air Brake Corporation, is a Delaware Corporation having a place of business at 748 Starbuck Avenue, Watertown, New York 13601. Applicant is the listed owner of Application Serial Numbers 85/092,214 and 85/092,216 for the marks EM ADVISOR and EM ASSIST for “[l]ocomotive monitoring system comprising software and processor to process, integrate and display real-time information and data for making real-time evaluations of operating parameters and improving train handling capability; [l]ocomotive monitoring system for installation in locomotives featuring software and processor to process, integrate, and display real-time information and data” in International Class 9 (collectively, the “Infringing Goods”).

9. Applicant does business in the same channels of trade as EMD. Indeed, EMD has purchased Applicant's brake control systems, among other things.

**Likelihood of Confusion, 15 U.S.C. § 1052(d)**

10. EMD repeats and realleges each and every allegation set forth in Paragraphs 1 through 9.

11. Since prior to the July 24, 2010 filing date of Applicant's Applications (Serial Nos. 85/092,214 and 85/092,216) for the marks EM ADVISOR and EM ASSIST, and any date of first use that may be alleged by Applicant, EMD has used its EM-formative marks in commerce in the United States in connection with the advertising, promotion, and sale of EMD's Products and Services.

12. The Infringing Goods identified in Applicant's Applications (Serial Nos. 85/092,214 and 85/092,216) for the marks EM ADVISOR and EM ASSIST are closely related to EMD's Products and Services sold in connection with EMD's EM-formative marks.

13. Applicant's marks EM ADVISOR and EM ASSIST so resemble EMD's use of EM-formative marks as to be likely, when applied to the identified goods, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15. U.S.C. § 1052(d).

WHEREFORE, for the foregoing reasons, EMD is being and will be damaged by the registration of Applicant's Applications (Serial Nos. 85,092,214 and 85/092,216) for the marks EM ADVISOR and EM ASSIST for "[l]ocomotive monitoring system comprising software and processor to process, integrate and display real-time information and data for making real-time evaluations of operating parameters and

improving train handling capability; [l]ocomotive monitoring system for installation in locomotives featuring software and processor to process, integrate, and display real-time information and data.” EMD respectfully requests that registration of the marks EM ADVISOR and EM ASSIST, as shown respectively in Serial Nos. 85/092,214 and 85/092,216, be refused and that this Notice of Opposition be sustained in favor of EMD.

If the filing fee is found to be insufficient for any reason, please charge the deficiency to Deposit Account No. 06-0916.

Respectfully submitted,

ELECTRO-MOTIVE DIESEL, INC.

Dated: July 20, 2012

By: *Christopher P. Foley*

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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on this 20th day of July 2012, upon Applicant's Attorney at the following address:

Hae Park-Suk, Esq.  
Barnes & Thornburg LLP  
1717 Pennsylvania Avenue, NW  
Suite 500  
Washington, DC 20006-4623

*Christopher P. Foley*

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