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

Proceeding	91214938
Party	Plaintiff Baldor Electric Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Baldor Electric Company,	)	
	)	
Opposer,	)	
	)	Opp. No. 91214938
	)	
vs.	)	Directed to U.S. Ser. No. 79/112,458
	)	
KSB Aktiengesellschaft,	)	Mark: REEL SuPremE
	)	
Applicant.	)	

**BALDOR’S OPPOSITION TO KSB’S MOTION TO DISMISS  
COUNT II OF THE FIRST AMENDED NOTICE OF OPPOSITION**

Count II of Baldor’s first amended notice of opposition, which asserts a lack of bona fide intent to use claim against KSB, alleges the following facts in support of the claim:

- KSB has not made use of the subject mark in the United States in connection with any of the applied-for goods.
- Its websites do not reflect planned distribution in the United States of the applied-for goods under the subject mark.

*First Amended Notice of Opposition*, ¶ 10. Baldor respectfully submits that these facts are sufficient to state a claim of lack of bona fide intent to use KSB’s mark.<sup>1</sup>

In *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536 (TTAB 2007), the Board held that similar allegations were sufficient to state a lack of bona fide intent to use claim. *Id.* at 1539. The opposer in that case alleged the following facts:

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<sup>1</sup> In a related opposition involving the same parties and claims, and very similar facts, *Baldor Electric Company v. KSB Aktiengesellschaft*, *Opp. No. 91213891*, the Board recently found that Baldor has properly pled a lack of bona fide intent to use claim against KSB and thus denied KSB’s motion to dismiss. *See attached TTAB Order dated May 27, 2014.*

“Upon information and belief, Applicant has yet to have a bona fide commercial use of the mark in commerce and merely attempts to reserve a right in the mark in its application. Applicant has not supplied any documentation of actual use despite repeated requests by Opposer.”

*Id.* at 1538.

In this case, Baldor has alleged that KSB is not using the subject mark in the United States in connection with any of the applied-for goods. It has further alleged that KSB’s websites do not reflect planned distribution in the United States of the applied-for goods under the subject mark. If KSB is not using the subject mark in the United States in connection with the applied-for goods, and does not have actual plans to do so, then it lacks a bona fide intent to use its mark in the United States. Baldor’s factual allegations certainly state a “plausible” claim and raise “a right to relief above the speculative level.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555-56 (2007). The underlying merits of Baldor’s claim will be decided at trial.

The factual allegations in KSB’s cited cases, *Aktieselskabet AF 21 November 2001 v. Fame Jeans Inc.*, 86 USPQ2d 1527 (D.C. Cir. 2008) and *Fiat Group Automobiles S.p.A. v. ISM Inc.*, 94 USPQ2d 1111 (TTAB 2010), are irrelevant for purposes of deciding this motion. KSB’s argument assumes that the factual allegations in these cases are the *only* sets of factual allegations that state a lack of bona fide intent to use claim. This assumption, of course, is wrong. *See, e.g., Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536 (TTAB 2007). Each case must be decided on its own facts. *See Swatch AG v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1477 (TTAB 2013).

For these reasons, Count II of Baldor’s first amended notice of opposition states a claim of lack of bona fide intent to use the subject mark. In the event the Board disagrees, Baldor respectfully requests leave to file an amended notice of opposition. KSB’s application is based

on Section 66(a), and Baldor may be precluded from amending its notice of opposition during discovery to assert its claim. 37 C.F.R. §2.107(b).

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing was sent via U.S. mail on May 27, 2014 to the following:

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/s/ Hadi S. Al-Shathir

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
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wbc

Mailed: May 27, 2014

Opposition No. 91213891

Baldor Electric Company

v.

KSB Aktiengesellschaft

**By the Trademark Trial and Appeal Board:**

This case comes up before the Board on the following:

1. Applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to plead a lack of bona fide intent to use (filed February 24, 2014);<sup>1</sup>
2. Opposer's response and amended notice of opposition (concurrently filed March 17, 2014);
3. Applicant's second motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to plead lack of bona fide intent to use (filed April 7, 2014); and
4. Opposer's response to the second motion to dismiss (filed April 28, 2014).

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<sup>1</sup> The Board's February 21, 2014 order granted the parties' stipulated motion to extend dates (filed February 18, 2014) in which the deadline to file an answer was extended to February 24, 2014.

The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion and does not recount them here except as necessary to explain the Board's decision.

A plaintiff may amend its complaint once as a matter of course at any time before an answer thereto is served. *See* Fed. R. Civ. P. 15(a); TBMP § 503.03 (3d ed. rev.2 2013) and cases cited therein. Thus, a plaintiff in a proceeding before the Board ordinarily can respond to a motion to dismiss by filing, *inter alia*, an amended complaint. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537 (TTAB 2007). If the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot. *Fair Indigo LLC*, 85 USPQ2d at 1537; TBMP § 503.03.

Inasmuch as opposer could amend its notice of opposition as of right, the Board accepts the amended opposition as the operative pleading, and now considers the second motion to dismiss<sup>2</sup> with respect to the amended notice of opposition, and determines whether the notice of opposition asserts a proper claim. *See id.*

To state a claim upon which relief can be granted, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina*

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<sup>2</sup> In view of the Board's order herein and opposer's amended pleading filed March 17, 2104 in response to the applicant's motion to dismiss, the motion to dismiss filed February 24, 2014 is moot.

Co., 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint must contain sufficient factual matter, accepted as true, that states a claim to relief that is plausible on its face. *See Ashcroft v. Iqbal*, 556 U.S. 662 (2009). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for the opposition or cancellation exists. *Cf. Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 556 (2007). In particular, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). “The elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice.” *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAAB 2007) (*citing* Fed. R. Civ. P. 8(e)(1); *see also Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (since function of pleadings is to give fair notice of claim, a party is allowed reasonable latitude in its statement of its claims)).

Although not raised by the parties, upon review of the amended notice of opposition, the Board finds opposer adequately pleaded its standing in paragraphs 1-5 of the amended notice of opposition. *See, e.g., Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d

1842, 1844 (Fed. Cir. 2000); *Internat'l Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984).

In its amended petition to cancel, opposer pleads two grounds for relief – likelihood of confusion and lack of bona fide intent to use. An opposition against a Trademark Act § 66(a) application may not be amended to add an entirely new claim or a claim based on an additional registration in support of an existing, 15 U.S.C. § 1052(d) claim. Trademark Rule 2.107(b); TBMP § 507.02. Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. *See* TBMP § 507.01.

Inasmuch as opposer's original notice of opposition included a claim of likelihood of confusion and lack of bona fide intent to use, the claims of likelihood of confusion and lack of bona fide intent to use in the amended notice of opposition, are permissible amplifications and/or clarifications the existing grounds for opposition. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 55,748, 55,757 (Sept. 26, 2003) (“An opposer may make amendments to grounds asserted in the notice of opposition, for example, for clarification.”); *Cf. O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327 (TTAB 2010). The Board now turns to the sufficiency of those grounds.

*Likelihood of Confusion*

Although not raised by the parties, in the interests of being complete, the Board has *sua sponte* reviewed opposer's claim of likelihood of confusion. See TBMP 506.01.

To allege a valid ground for cancellation under Section 2(d), opposer need only allege it has priority of use and that applicant's mark so resembles opposer's mark as to be likely to cause confusion. See Lanham Act § 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Opposer has alleged, in paragraphs 6-7, that applicant's mark so resembles opposer's mark when used on or in connection with the goods of applicant, that applicant's mark is likely "to cause confusion, or to cause mistake or to deceive" with damage to opposer. Further, opposer alleges in paragraph 4 that "prior to the filing date" of applicant's application or any use by applicant of its mark, opposer began using. See *Kohler C. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). As such, opposer's claim of likelihood of confusion under Section 2(d) is sufficiently pleaded.

*Lack of Bona Fide Intent to Use*

In evaluation of an applicant's bona fide intent to use a mark in commerce, certain circumstances may support or confirm the bona fide nature of an applicant's intent while others may cast doubt thereon or even completely disprove it. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*

*Opposition*, 26 USPQ2d 1503, 1507 (TTAB 1993). In pleading a ground of lack of intent to use,<sup>3</sup> a party should set forth facts which would give applicant fair notice of why opposer believes that applicant lacked a bona fide intent. See *Commodore Electronics*, 26 USPQ2d at 1506.

Paragraph 10 of the amended notice of opposition sets forth facts which give applicant fair notice of why opposer believes applicant lacked a bona fide intent to use, namely, applicant's "websites do not reflect planned distribution in the United States of [applicant's goods] under [applicant's mark]."

Inasmuch as opposer alleges that applicant lacks a bona fide intent to use its mark in the United States for all the goods in the opposed application at the time it filed its request for extension of protection and includes facts upon which it bases these allegations, opposer's claim of lack of bona fide intent to use is properly pleaded.

In view thereof, applicant's motion to dismiss is **denied**.

Proceedings herein are resumed. Dates are reset as follows:

Time to Answer	<b>6/25/2014</b>
Deadline for Discovery Conference	<b>7/25/2014</b>
Discovery Opens	<b>7/25/2014</b>
Initial Disclosures Due	<b>8/24/2014</b>
Expert Disclosures Due	<b>12/22/2014</b>
Discovery Closes	<b>1/21/2015</b>

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<sup>3</sup> Section 66(a) provides that:

A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.

Plaintiff's Pretrial Disclosures	<b>3/7/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>4/21/2015</b>
Defendant's Pretrial Disclosures	<b>5/6/2015</b>
Defendant's 30-day Trial Period Ends	<b>6/20/2015</b>
Plaintiff's Rebuttal Disclosures	<b>7/5/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>8/4/2015</b>

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.