

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Contact Number: 571-272-8500

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Mailed: October 2, 2014

Opposition No. 91214938

Baldor Electric Company

v.

KSB Aktiengesellschaft

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

This case comes up on Applicant's motion to dismiss the amended notice of opposition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim. The motion is fully briefed.

# **REEL SuPremE**

On February 17, 2014, Baldor Electric Company filed a notice of opposition against application Serial No. 79112458<sup>1</sup> for the mark shown

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<sup>1</sup> Application Serial No. 79112458 lists:

Motors and engines except for land vehicles; machines, namely, pumps for machines, pumps as parts of machines, motors and engines; installations for transport, regulation and/or treatment and/or filling for liquid media, namely, electric pump motors; pumps, fittings, and parts for electric motors not for land vehicles; units comprising pumps and motors for machines; control and regulating apparatus, namely, pump control valves, regulators being parts of machines, pump monitoring gauges being parts of machines, flow regulators being parts of machines, pressure

above with claims of priority of use and likelihood of confusion with its pleaded Registration No. 2820046 for the mark SUPER-E [standard characters] for “electric motors”, and that Applicant lacked a bona fide intent to use the mark in commerce at the time the application was filed. On March 31, 2014, in lieu of an answer, KSB Aktiengesellschaft filed a motion to dismiss the notice of opposition.

On April 21, 2014, Opposer filed an amended notice of opposition. A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course at any time before a responsive pleading is served. Fed. R. Civ. P. 15(a). Accordingly, Opposer’s amended notice of opposition is accepted.<sup>2</sup>

On May 12, 2014, Applicant filed a motion to dismiss the amended notice of opposition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim. More specifically, Applicant alleges that Opposer’s claim that

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regulators being parts of machines, pumps for machines, and motor controllers in the nature of hydraulic controls for motors

Electric and electronic apparatus, components and instruments for switching, measuring, controlling, regulating, testing, checking and supervision, recording, transmitting and displaying, namely, electrical switches, operation sensors and monitors for sensing and monitoring position, temperature, pressure, leakage, speed, vibration, flow rate and/or liquid level, and associated software for controlling the aforementioned apparatus and bus systems comprising USB hardware and operating software therefor; electric cables and wires; electric drives for use with pumps and valves in the nature of electronic controllers for pumps and valves; electronic components and modules, namely, integrated circuit modules; computer hardware; computer software for use in database management in the field of pumps

<sup>2</sup> Because the original notice of opposition no longer is the operative pleading, the Board will not consider the motion to dismiss the original notice of opposition.

Applicant lacked a bona fide intent to use the mark in commerce at the time the application was filed is legally insufficient.

To withstand a motion to dismiss for failure to state a claim upon which relief may be granted, a notice of opposition need only allege such facts as would, if proven, establish Opposer's standing to maintain the proceeding and a ground or grounds for refusing registration to Applicant. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Specifically, “a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

In addition, where the amended notice of opposition is filed against a Trademark Act Sec. 66(a) application, the Board must ensure that the proposed amendment of the notice of opposition does not add to the grounds for opposition. Trademark Act §68(c)(3) states that, following the filing of an opposition to a Madrid application, and the Director's notification to the International Bureau of “all grounds” for the refusal of an extension of protection based on the opposition, no further grounds for refusal may be transmitted: *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1328 (TTAB 2010). Here, both the original and the amended notice of opposition plead the same grounds of likelihood of confusion and lack of bona fide intent to use. Thus the proposed amendment offers no additional grounds for opposition.

Although the sufficiency of the notice of opposition as a whole was not challenged, the Board reviewed the amended notice of opposition in its entirety. Opposer's pleading of its registration in connection with the likelihood of confusion claim pleads standing to oppose registration of Applicant's mark. *King Candy Co. v. Eunice Kings's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In addition, the likelihood of confusion is legally sufficient. *Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403, 1406-1407 (TTAB 2010).

With respect to the lack of bona fide intent to use claim, the amended notice of opposition alleges:

9. On information and belief, KSB lacked a bona fide intention to use KSB's Mark in United States commerce in connection with all of KSB's Goods at the time KSB filed its request for extension of protection of its international registration to the United States.

10. On information and belief, KSB has not made use of KSB's Mark in United States commerce in connection with any of KSB's Goods. On information and belief, its websites do not reflect planned distribution in the United States of KSB's Goods under KSB's Mark. On information and belief, KSB is merely attempting to reserve a right in KSB's Mark.

Because the standard for proof of a bona fide intent to use the mark in commerce is the same for all trademark Applicants, no matter under what statutory basis they file their application, the standard for pleading the claim that an Applicant lacked a bona fide intent to use the mark in commerce is also the same. *See Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1662 n.5 (TTAB 2009) ("In determining whether an Applicant under § 44(e) has the

requisite bona fide intent to use the mark in U.S. commerce, the Board uses the same objective, good-faith analysis that it uses in determining whether an Applicant under § 1(b) has the required bona fide intent to use the mark in U.S. commerce.”); *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994) (“In determining whether an Applicant under Section 44 possesses the requisite bona fide intention to use the mark in commerce, the Board will employ the analysis suggested or required by the legislative history and case law pertaining to Section 1(b) applications.”).

A legally sufficient claim that an Applicant lacked a bona fide intent to use the mark in commerce must “give Applicant fair notice of why Opposer believes that Applicant lacked the bona fide intent required.” *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Because a “lack of capacity or experience needed to manufacture or otherwise offer his identified goods” is a factor contributing to a finding that an Applicant lacks a bona fide intent to use the mark in commerce, we find opposer’s assertion that Applicant’s website includes no plans to expand Applicant’s business to the United States provides sufficient notice as to the basis for the claim. *L’Oreal S.A. and L’Oreal USA, Inc. v. Robert Victor Marcon*, 102 USPQ2d 1434 (TTAB 2012) (“We agree with Opposer’s assessment that the cumulative effect of the record — including Applicant’s complete lack of documentary evidence or any other objective evidence that he can/will use the mark, lack of capacity or experience needed to manufacture or otherwise offer his identified goods, vague allusions to using the

mark through licensing or outsourcing, and failure to take any concrete actions or to develop any concrete plans for using the mark — demonstrates that Applicant objectively lacks the requisite bona fide intent to use the L'OREAL PARIS mark in commerce for aloe vera drinks.”). Accordingly, Applicant’s motion to dismiss the amended notice of opposition is DENIED.

Applicant is allowed until TWENTY DAYS from the mailing date of this order to file its answer to the amended notice of opposition.

Proceedings herein are resumed.

Deadline for Discovery Conference	<b>11/19/2014</b>
Discovery Opens	<b>11/19/2014</b>
Initial Disclosures Due	<b>12/19/2014</b>
Expert Disclosures Due	<b>4/18/2015</b>
Discovery Closes	<b>5/18/2015</b>
Plaintiff's Pretrial Disclosures	<b>7/2/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>8/16/2015</b>
Defendant's Pretrial Disclosures	<b>8/31/2015</b>
Defendant's 30-day Trial Period Ends	<b>10/15/2015</b>
Plaintiff's Rebuttal Disclosures	<b>10/30/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>11/29/2015</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.