

ESTTA Tracking number: **ESTTA599604**

Filing date: **04/21/2014**

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

Proceeding	91214938
Party	Plaintiff Baldor Electric Company
Correspondence Address	Matthew J. Himich Thompson Coburn LLP One US Bank Plaza St. Louis, MO 63101 UNITED STATES mhimich@thompsoncoburn.com, hal-shathir@thompsoncoburn.com, ipdocket@thompsoncoburn.com, mnoelke@thompsoncoburn.com
Submission	Opposition/Response to Motion
Filer's Name	Hadi S. Al-Shathir
Filer's e-mail	hal-shathir@thompsoncoburn.com, ipdocket@thompsoncoburn.com, mnoelke@thompsoncoburn.com
Signature	/s/ Hadi S. Al-Shathir
Date	04/21/2014
Attachments	opposition to motion to dismiss.pdf(137000 bytes)

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.)	

**OPPOSER’S OPPOSITION TO APPLICANT’S
MOTION TO DISMISS COUNT II OF THE NOTICE OF OPPOSITION**

Pursuant to Federal Rule of Civil Procedure 15(a)(1)(B), Opposer Baldor Electric Company (“Baldor”) has timely filed a first amended notice of opposition in response to Applicant KSB Aktiengesellschaft’s (“KSB”) motion to dismiss count II of the notice of opposition. Baldor respectfully submits that its amended pleading moots KSB’s motion to dismiss.

Count II of the original and first amended notices of opposition asserts a lack of bona fide intent to use claim. KSB’s application is based on Section 66(a) of the Lanham Act, which requires that an applicant have a bona fide intention to use the mark in commerce at the time an applicant files its request for extension of protection of its international registration to the United States. 15 U.S.C. §1141f(a). KSB argues that Baldor did not plead sufficient facts to support the claim in its original notice of opposition. Baldor’s first amended notice of opposition pleads the following facts:

“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.”

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 the opposed mark. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538-40(TTAB 2007)(holding that factual allegation of no actual use of mark in commerce sufficient to state a claim of lack of bona fide intent to use). Accordingly, KSB's motion to dismiss count II should be denied as moot.

Respectfully submitted,

By: /s/ Hadi S. Al-Shathir
Matthew J. Himich
Hadi S. Al-Shathir
THOMPSON COBURN LLP
One US Bank Plaza
St. Louis, MO 63101
(314) 552-6000
mhimich@thompsoncoburn.com
hal-shathir@thompsoncoburn.com
ipdocket@thompsoncoburn.com

Attorneys for Opposer,
Baldor Electric Company

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was sent via U.S. mail on April 21st, 2014 to the following:

William J. Sauers
Crowell & Moring LLP
P.O. Box 14300
Washington, D.C. 20044-4300

/s/ Hadi S. Al-Shathir