ESTTA Tracking number: **ESTTA644986**

Filing date: **12/17/2014**

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	Carl Schenck AG		
Entity	Corporation	Citizenship	Germany
Address	Landwehrstrasse 55 Darmstadt, 64293 GERMANY		

Attorney information	Marianne Buckley Hanley, Flight & Zimmerman LLC 150 S Wacker Drive Suite 2200 Chicago, IL 60606 UNITED STATES mbuckley@hfzlaw.com, jjasper@hfzlaw.com

Applicant Information

Application No	79141591	Publication date	11/18/2014
Opposition Filing Date	12/17/2014	Opposition Period Ends	12/18/2014
International Registration No.	1189747	International Registration Date	04/15/2013
Applicant	Schunk GmbH & Co. KG Spann- und Greiftechnik BahnhofstraÃ#e 106-134 74348 Lauffen am Neckar, GERMANY		

Goods/Services Affected by Opposition

Class 007. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Metalworking, plastics, wood and ceramic working machines for workpiece machining and for the technology of automation,clamping and gripping as well as structural parts of the aforementioned machines; machine clamping devices for workpieces and tools, in particular electrical, magnetic, pneumatic, hydraulic clamps and spring-activated clamps operating withnegative pressure as well as structuralparts thereof; jaw chucks, expansion jaw chucks, clamping blocks, clamping vices, steady rests, vices, clamping cylinders, collets, clamping tools, zero point clamping devices, clamping plates and clamping tables, tombstones, the aforementioned goods being machine parts; machinegripping devices for workpieces and tools, in particular electrical, magnetic, pneumatic, and hydraulic clamps and spring-activated clamps operating with negative pressure as well as parts thereof; parallel grippers, centric grippers, angular grippers, radial grippers, the aforementioned goods being machine parts; clamping and gripping jaws, in particular top jaws, pendulum jaws, collet jaws for machine clamping devices and gripping devices, the aforementioned goods being parts of machines; machine tools, namely, machine jaw changing devices for clamping and gripping devices as well as structural parts thereof; power-operated machines, namely, machine lifting and holdingdevices for workpieces and tools, in particular electrical, magnetic, pneumatic, hydraulic, spring-activated lifting and holding devices operating with negative pressure as well as structural parts thereof; power-operated machines, namely,machine manipulation devices for

workpieces and tools as well as structural parts thereof; Robots, namely, industrial robots, service robots for personal and clinical use, and robots with hinged brackets for the manipulation of workpieces and tools as well as structural parts thereof; machines for vacuum technology, in particular vacuum suction grippers andclamps, vacuum suction valves, pads andejectors as well as structural parts thereof; electrical, magnetic, pneumatic, hydraulic, spring-activated sliding machines, pivoting machines, lifting machines, elevating machines, turning machines operating with negative pressure as wellas structural parts thereof; electromotive, pneumatic, and hydraulic actuators for clamping, gripping, lifting, manipulating, sliding, pivoting, lifting, elevating and turning devices as well as structural parts thereof; linear actuators and linear modules consisting thereof; machine tilting devices in the nature of machine tools, namely, clamps, mounts andvices; machine parts, namely, turning passage guides for machines; balancing machines for balancing tools; mandrels being parts of machines; modular clutches for machines; power-operated machines, namely, quick change systems for tools andautomation components, consisting of robotic tool changers, robotic collision sensors, machine tool changers and tool retaining systems for positioning and mounting tools; valves as parts of machines, in particular vacuum valves, pressure valves, pressure maintaining valves, check valves; valve blocks as parts of machines; laser machining machines, laser welding machines as well as structural parts thereof
Class 008. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Manually operated clamps, tool holders,and vices; manually operated jaw chucks, expansion chucks, power chucks, power clamping blocks and zero point clamping device, namely, a clamping device consisting of a clamp, a positioning system and mounting system for use in clamping workpieces, pallets, and modules during a manufacturing process; manually operatedelectrical, magnetic, pneumatic, hydraulic, spring-activated clamps, jacks, chucks, collets, lifting jacks, and holdingequipment in the nature of vices, as well as structural parts thereof; manuallyoperated hand tools, namely, collets, lifting jacks, and vices, pincers and wrenches; manually operated tools, namely, vice jaws, namely, clamping and grippingjaws, in particular top jaws, pendulum jaws, collet jaws for manually operated clamping and gripping devices; manually operated tools, namely, vice jaws, namely, manually operated jaw changing devices for clamping and gripping devices as well as structural parts thereof; the aforementioned goods for the use in automation, clamping and gripping technology
Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Electronic control systems for machines, namely, electrical and/or electronic control and adjustment devices for machines; sensors for the measurement of pressure, force, contact, magnetic field, anddisplacement; sensors for control and/or adjustment of the drive of machines; collision sensors, power sensors, magnet sensors, pressure sensors, displacement sensors, force-torque sensors, position sensors, wireless sensors; computer operating software; software for the controland/or adjustment of the operation of machines; laser measuring sensors; electric switches; electric cables, plugs, cable bushings, and connectors; training manuals in electronic form
Class 037. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Installation, maintenance, servicing and repair of machines, of parts of machines and of accessory for machines; the aforementioned services, in particular in relation to automation, clamping and gripping technology
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Services of an engineer, namely, engineering services; services of a physicist,namely, research in the field of physics; technical consultancy, analysis, and configuration of computer networks as well as of software-assisted facilities and technical management of projects, alsovia telephone and via Internet; surveying; planning, designing and technical consultancy concerning the application andoperation of automated clamping and gripping facilities; inspection and technical supervising of machines and equipment; designing and development of computer programs for data processing; maintenance of computer programs; material testing; conducting metallurgical analyses and quality tests; conducting technical measurements; the aforementioned services inparticular in relation to automation, clamping and gripping technology

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	652999	Application Date	07/02/1956
Registration Date	10/15/1957	Foreign Priority Date	NONE
Word Mark	SCHENCK CSD		
Design Mark			
Description of Mark	THE DESIGN FEATURES SHOWN ON THE DRAWING CONSIST OF FANCIFUL DESIGNS, EACH OF WHICH MAY BE UNDERSTOOD TO MEANS THE LETTERS "CSD."		
Goods/Services	Class 007. First use: First Use: 1928/00/00 First Use In Commerce: 1949/04/18 CONVEYORS INCLUDING BELT CONVEYORS, ROLLER CONVEYORS, [OSCILLATORY CONVEYORS; OSCILLATORY CLASSIFIERS; FORMING AND MOLDING MACHINES AND APPARATUS FOR THE PRODUCTION OF WOOD-COMPOSITION PANELS;] BALANCE CORRECTING MACHINE TOOLS; [DYNAMOMETRIC BRAKES INCLUDING WATER-EDDY BRAKES-FOR GENERAL PURPOSES INCLUDING USE ON TRUCKS, BUSES AND RAIL VEHICLES] Class 009. First use: First Use: 1928/00/00 First Use In Commerce: 1949/04/18 ELECTRIC CONTROL DEVICES FOR CONTROLLING MACHINE TOOLS AND OTHER FABRICATING MACHINERY; WEIGHING SCALES, BALANCE TESTING MACHINES, ELECTRIC BALANCE-ANALYZING APPARATUS FOR BALANCING MACHINES; MATERIAL TESTING MACHINES; CONDITION-RESPONSIVEELECTRIC SENSING AND CONTROL DEVICE FORTESTING MACHINES, WEIGHING SCALES, [AND FOR DYNAMOMETERS]		

U.S. Registration No.	1184431	Application Date	09/26/1977
Registration Date	01/05/1982	Foreign Priority Date	NONE
Word Mark	SCHENCK		
Design Mark			
Description of Mark	The design portion of this mark comprises a fanciful representation of the letter "S".		
Goods/Services	Class 006. First use: First Use: 0 First Use In Commerce: 0 Metal Goods-Namely, Bunkers and Non-Transportable Bins for Storage and Discharge of Bulk Solids Class 007. First use: First Use: 0 First Use In Commerce: 0		

	Machinery-Namely, Machine Tools, Vibrating Conveyors, Roller Conveyors and Tables, Elevating Tables, Feeders, Screens, Compactors and Elevators; Conveyors-Namely, Feed Screws, Extractor Belts, Scraper Conveyors, Bucket Elevators, Girdle Pocket Elevators, Belt Conveyors, OverheadConveying Monorails, [Storage and Distribution Apparatus for Parcels and Baggage; Machines for the Production of, Storage and Cooling of Chipboard (Particleboard)] Class 009. First use: First Use: 0 First Use In Commerce: 0 Electrical and Testing Apparatus-Namely, Balancing and Testing Units for Wheels, Clutches, Motors and Piston Rods; Vibration Testing Apparatus for Machinery Components-Namely, Turbine Blades and Motors; Material Strength Testing Apparatus;Photoelectric Pickups; Video Display Units for Computers; Computers for Use with Balancing and Testing Units; Calculating Units; Weighing Units; Hard Copy Printing Units for Computers; Dynamometers and Brake Testers Class 012. First use: First Use: 0 First Use In Commerce: 0 Industrial Trucks-Namely, Loading and Unloading Trucks [, Rail-Mounted Container Truck Transporters for Airplane Loading and Off-Loading] , and Mechanically Propelled Lift Trucks

U.S. Registration No.	2726363	Application Date	10/25/2000
Registration Date	06/17/2003	Foreign Priority Date	04/27/2000
Word Mark	SCHENCK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 1928/00/00 First Use In Commerce: 1949/00/00 Sorting machines for sorting industrialproducts [and bulk materials] in accordance with sorting criteria, namely, the unbalance, [the weight, the dimension] or the intended use of the object to be sorted in the fields of balancing, testing, [weighing, feeding, screening] or assembling industrial products; bulk solids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; [bulk solidsmixing and blending machines;] fillingstations for filling of liquids and solids; machines for the classification of bulk solids; [batching machines for batching liquids and/or solids;] vibrationmachines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors, vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratorymachinery, and magnetic exciters; spring elements and universal-joint shafts asmachine components; motor-driven transport machinery,* namely, * [, namely, screws, extractor belts, starfeeders,] chain conveyors, apron feeders, elevators,[vibrating feeders,] bucket conveyors, feeders with elevators, belt conveyors, overhead track conveyors, [paternoster belts,] apron conveyors and chains, conveyors for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece goods, * namely, * [roller trains;] loading arms as machine parts; motor-driven lift carriages and lifting machinery for lifting industrial piece goods; [vehicle lifts, namely, power-operated and hydraulic lifts,		

	and stands therefor, for moving and raising vehicles duringmanufacture, and for cleaning, repair, maintenance and inspection purposes;] motor-driven tire changers for vehicle tires, and tire inflating valves; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling and milling machines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mountingand demounting machines for mounting and demounting vehicle components and assemblies;[filling machines for filling vehicle fluids;] mechanical machinery forthe handling of vehicle components; structural and replacement parts of the aforesaid goods; and combinations of the aforesaid goods Class 009. First use: First Use: 1928/00/00 First Use In Commerce: 1949/00/00 Balancing machines for the balancing ofrotors and rotational machine components; material testing machines for the spin testing of rotors; mass centering machines for determining the mass axis of rotors; balancing scales; static balancingmachines for non-rotating balancing of machine components; physical and opticaltransducers; electrotechnical and electronic measuring and data processing instruments; instruments for the purpose of vibration measuring, vibration monitoring and machine monitoring; pickups, namely, displacement transducers, vibration velocity probes and acceleration pickups;testing instruments for predictive maintenance of machines; [testing instruments for testing vibroacoustical characteristics of machinery assemblies;] weighing machines; road weighbridges; moment weighing scales for measuring of mass moments of rotor components; [wind tunnelbalances; force standard machines for calibrating purposes; transducers for multi-component measurements;] belt weighers; weighing components, namely, load cells, load cell mounts, weigh beams, measuring eyes, and special transducers for weighing; feed forward and monitoring electronic instruments for vibratory machines; test stands for testing on functionand on performance, *, namely, * [exhaust] [emission test stands, brake testers for vehicles and engines; tire test stands; hydraulic dynamometers and eddy-current dynamometers; clutch test stands, gearbox test stands, power train test stands, four-square test stands, test stands for the testing of motors and shock-absorbers;] * ; * dynamometers with and without scales; balancing machine accessories, namely, machines for unbalance compensation; compensation mass separators; safety accessories for machinery, namely, light barriers, switches, and guards with respective actuators; [test stands for testing of vehicles and vehicle components, particularly brake testers, wheel alignment test stands, toe and camber measuring machines, toe difference angle measuring machines, headlamp setting machines, radial run-out measuring machines, wheel alignment analyzers, and ball-and-socket joint play testers;] diagnostic analyzers; [testing machines andinstruments for testing on vehicle electric and electronic systems;] electric and electronic computers for feed forward and feedback control of the above-mentioned goods and pertinent peripherals, particularly printers, cabinets for the aforesaid goods, and remote controllers for the aforesaid goods; data carrier-based programs for feed forward and feedback control of the aforesaid goods; structural and replacement parts of the aforesaid goods; combinations of the aforesaidgoods; and electric and electronic computers for feed forward and feedback control, and pertinent peripherals, particularly printers and cabinets, and remote controllers, all for the following goods-- sorting machines for sorting industrial products [and bulk materials] in accordance with sorting criteria, namely, the unbalance, [the weight, the dimension] or the intended use of the object tobe sorted in the fields of balancing, testing, [weighing, feeding, screening]or assembling industrial products; bulksolids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; [bulk solids mixing and blending machines;] filling stations for filling of liquids and solids; machines for the classification ofbulk solids; [batching machines for batching liquids and/or solids;] vibration machines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibroconveyors, vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters,

	unbalance motors for driving vibratory machinery, and magnetic exciters; motor-driven transport machinery, namely, [screws, extractor belts,] [starfeeders,] chain conveyors, apron feeders, elevators, [vibrating feeders,] bucket conveyors, feeders with elevators, belt conveyers, overhead track conveyers, [paternoster belts,] apron conveyors and chains, conveyers for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece goods * ; * [,] [roller trains;] motor-driven lift carriages and lifting machinery for lifting industrialpiece goods; [vehicle lifts, namely, power-operated and hydraulic lifts, and stands therefor, for moving and raising vehicles during manufacture, and for cleaning, repair, maintenance and inspectionpurposes;] motor-driven tire changers for vehicle tires; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling and millingmachines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting and demounting vehicle components and assemblies; filling machines for filling vehicle fluids; and mechanical machinery for the handling of vehicle components Class 042. First use: First Use: 1979/00/00 First Use In Commerce: 1979/00/00 engineering services; designing for others in the field of balancing, testing, [assembling,] weighing, feeding or screening industrial products and materials, and designing machinery for the foregoing; computer software design for others

U.S. Registration No.	2751706	Application Date	10/25/2000
Registration Date	08/19/2003	Foreign Priority Date	NONE
Word Mark	SCHENCK		
Design Mark	SCHENCK		
Description of Mark	The mark includes a fanciful representation of the letters "CSD" as a logo plusthe word "SCHENCK".		
Goods/Services	Class 007. First use: First Use: 1998/01/00 First Use In Commerce: 1998/02/00 Sorting machines for sorting industrialproducts[and bulk materials] in accordance with sorting criteria, namely, the unbalance,[the weight, the dimension] or the intended use of the object to be sorted in the fields of balancing, testing, [weighing, feeding, screening]or assembling industrial products; bulk solidsbins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding;[bulk solids mixingand blending machines;] filling stations for tilling of liquids and solids; machines for the classification of bulk solids; [batching machines for batching liquids and/or solids;] vibration machines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors,vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratory machinery, and magnetic exciters; spring elementsand universal-joint shafts as machine components; motor-driven transport machinery, namely, [screws, extractor belts, starfeeders,] chain conveyors, apron feeders, elevators, [vibrating feeders,] bucket conveyors, feeders with elevators, belt conveyors, overhead track conveyors,[paternoster belts,] apron conveyors and chains, conveyors for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece goods; [roller trains;] loading arms as machine parts; motor-driven lift carriages and lifting machineryfor lifting industrial piece		

	goods; [vehicle lifts, namely, power-operated and hydraulic lifts, and stands therefor, for moving and raising vehicles during manufacture, and for cleaning, repair, maintenance and inspection purposes;] motor-driven tire changers for vehicle tires, and tire inflating valves; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling andmilling machines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting and demounting vehicle components and assemblies; [filling machines for filling vehicle fluids;] mechanical machinery for thehandling of vehicle components; structural and replacement parts of the aforesaid goods; and combinations of the aforesaid goods Class 009. First use: First Use: 1998/01/00 First Use In Commerce: 1998/02/00 Balancing machines for the balancing ofrotors and rotational machine components; material testing machines for the spin testing of rotors; mass centering machines for determining the mass axis of rotors; balancing scales; static balancingmachines for non-rotating balancing of machine components; physical and opticaltransducers; electrotechnical and electronic measuring and data processing instruments; instruments for the purpose of vibration measuring, vibration monitoring arid machine monitoring; pickups, namely, displacement transducers, vibration velocity probes and acceleration pickups; testing instruments for predictive maintenance of machines; [testing instruments for testing vibroacoustical characteristics of machinery assemblies;] weighing machines; road weighbridges; moment weighing scales for measuring of mass moments of rotor components;[wind tunnel balances; force standard machines for calibrating purposes; transducers for multi-component measurements;] belt weighers; weighing components, namely, load cells,load cell mounts, weigh beams, measuring eyes, and special transducers for weighing; feed forward and monitoring electronic instruments for vibratory machines;test stands for testing on function andon performance; [exhaust emission test stands, brake testers for vehicles and engines; tire test stands; hydraulic dynamometers and eddy-current dynamometers; clutch test stands, gearbox test stands,power train test stands, foursquare test stands, test stands for the testing of motors and shock absorbers;] dynamometers with and without scales; balancing machine accessories, namely, machines forunbalance compensation; compensation mass separators; safety accessories for machinery, namely, light barriers, switches, and guards with respective actuators;[test stands for testing of vehicles and vehicle components, particularly braketesters, wheel alignment test stands, toe and camber measuring machines, toe difference angle measuring machines, headlamp setting machines, radial run-out measuring machines, wheel alignment analyzers, and ball-and-socket joint play testers;] diagnostic analyzers; [testing machines and instruments for testing on vehicle electric and electronic systems;] electric and electronic computers for feedforward and feedback control of the abovementioned goods and pertinent peripherals, particularly printers, cabinets for the aforesaid goods, and remote controllers for the aforesaid goods; data carrierbased programs for feed forward and feedback control of the aforesaid goods;structural and replacement parts of theaforesaid goods; combinations of the aforesaid goods; and electric and electronic computers for feed forward and feedback control, and pertinent peripherals, particularly printers and cabinets, and remote controllers, all for the followinggoods-- sorting machines for sorting industrial products [and bulk materials] in accordance with sorting criteria, namely, the unbalance, [the weight, the dimension] or the intended use of the objectto be sorted in the fields of balancing, testing, [weighing, feeding, screening] or assembling industrial products; bulk solids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; [bulk solids mixing and blending machines;] fillingstations for filling of liquids and solids; machines for the classification of bulk solids; [batching machines for batching liquids and/or solids;] vibration machines for shaking, feeding, screening,compacting, and classifying bulk solidsor liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors, vibrating screens and soil com-

	pactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratory machinery, and magnetic exciters; motor-driven transport machinery, namely, [screws, extractor belts, starfeeders,] chain-conveyors, apron feeders, elevators, [vibrating feeders,] bucket conveyors, feeders with elevators, belt conveyors, overhead track conveyors, [paternoster belts,]apron conveyors and chains, conveyorsfor continuous operation and foundries,motor-driven conveyors, magazines and sorting machines for industrial piece goods; [roller trains;] motor-driven lift carriages and lifting machinery for lifting industrial piece goods; [vehicle lifts, namely, power-operated, and hydrauliclifts, and stands therefor, for moving and raising vehicles during manufacture,and for cleaning, repair, maintenance and inspection purposes;] motor-driven tire changers for vehicle tires; match mounting machines for wheels and tires; pneumatic tire inflating machines; drillingand milling machines for removing material from objects for balancing purposes;machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting anddemounting vehicle components and assemblies; filling machines for filling vehicle fluids; and mechanical machinery forthe handling of vehicle components Class 042. First use: First Use: 1998/01/00 First Use In Commerce: 1998/02/00 Engineering services; designing for others in the field of balancing, testing, [assembling,] weighing, feeding or screening industrial products and materials, and designing machinery for the foregoing; computer software design for others

Attachments	72011415#TMSN.png(bytes) 73142415#TMSN.png(bytes) 76153433#TMSN.png(bytes) 76153432#TMSN.png(bytes) WO2014_0144-US_Opposition.pdf(156644 bytes)

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	/Marianne Buckley/
Name	Marianne Buckley
Date	12/17/2014

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

Carl Schenck AG	)	
	)	
Petitioner	)	Opposition No. _____
	)	
vs.	)	Mark: SCHUNK
	)	
Schunk GmbH & Co. KG Spann- und Greiftechnik	)	Application No. 79/141,591
	)	
	)	
Applicant.		

NOTICE OF OPPOSITION

This is a notice of opposition against U.S. Trademark Application Serial No. 79/141,591 for the mark SCHUNK, owned by Schunk GmbH & Co. KG Spann- und Greiftechnik (hereinafter "Applicant") on the grounds of likelihood of confusion with U.S. Trademark Registration No. 652,999 for SCHENCK CSD; U.S. Trademark Registration No. 1,184,431 for SCHENCK; U.S. Trademark Registration No. 2,726,363 for SCHENCK; and U.S. Registration No. 2,751,706 for SCHENCK.

FACTS

1. Carl Schenck AG (hereinafter "Petitioner") is the owner of U.S. Reg. No. 652,999 for SCHENCK CSD.
2. Reg. No. 652,999 was registered on October 15, 1957.
3. Reg. No. 652,999 covers at least:

International Class 007 for conveyors including belt conveyors, roller conveyors, balance correcting machine tools; first used in 1928 and first used in commerce on April 18, 1949; and

International Class 009 for electric control devices for controlling machine tools and other fabricating machinery; weighing scales, balance testing machines, electric balance-analyzing apparatus for balancing machines; material testing machines; condition-responsive electric sensing and control device for testing machines, weighing scales, first used in 1928 and first used in commerce on April 4, 1949.

4. Petitioner also owns U.S. Reg. No. 1,184,431 for SCHENCK, claiming priority under § 44(e) of the Trademark Act, 15 U.S.C. § 1126, to German Trademark Registration No. 960,949, which was registered on July 26, 1977.

5. Reg. No. 1,184,431 was registered on January 5, 1982.

6. Reg. No. 1,184,431 covers at least:

International Class 006 for metal goods-namely, bunkers and non-transportable bins for storage and discharge of bulk solids;

International Class 007 for machinery-namely, machine tools, vibrating conveyors, roller conveyors and tables, elevating tables, feeders, screens, compactors and elevators; conveyors-namely, feed screws, extractor belts, scraper conveyors, bucket elevators, girdle pocket elevators, belt conveyors, overhead conveying monorails;

International Class 009 for electrical and testing apparatus-namely, balancing and testing units for wheels, clutches, motors and piston rods; vibration testing apparatus for machinery components-namely, turbine blades and motors; material strength testing apparatus; photoelectric pickups; video display units for computers; computers for use with balancing and testing units; calculating units; weighing units; hard copy printing units for computers; dynamometers and brake testers; and

International Class 012 for industrial trucks-namely, loading and unloading trucks and mechanically propelled lift trucks.

7. In addition, Petitioner owns U.S. Reg. No. 2,726,363 for SCHENCK.

8. Reg. No. 2,726,363 was registered on June 17, 2003.

9. Reg. No. 2,726,363 covers at least:

International Class 007 for sorting machines for sorting industrial products in accordance with sorting criteria, namely, the unbalance, or the intended use of the object to be sorted

in the fields of balancing, testing, or assembling industrial products; bulk solids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; filling stations for filling of liquids and solids; machines for the classification of bulk solids; vibration machines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors, vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratory machinery, and magnetic exciters; spring elements and universal-joint shafts as machine components; motor-driven transport machinery, namely, chain conveyors, apron feeders, elevators, bucket conveyors, feeders with elevators, belt conveyors, overhead track conveyors, apron conveyors and chains, conveyors for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece goods, namely, loading arms as machine parts; motor-driven lift carriages and lifting machinery for lifting industrial piece goods; motor-driven tire changers for vehicle tires, and tire inflating valves; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling and milling machines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting and demounting vehicle components and assemblies; mechanical machinery for the handling of vehicle components; structural and replacement parts of the aforesaid goods; and combinations of the aforesaid goods, first used in 1928, first used in commerce in 1949;

International Class 009 for balancing machines for the balancing of rotors and rotational machine components; material testing machines for the spin testing of rotors; mass centering machines for determining the mass axis of rotors; balancing scales; static balancing machines for non-rotating balancing of machine components; physical and optical transducers; electrotechnical and electronic measuring and data processing instruments; instruments for the purpose of vibration measuring, vibration monitoring and machine monitoring; pickups, namely, displacement transducers, vibration velocity probes and acceleration pickups; testing instruments for predictive maintenance of machines; weighing machines; road weighbridges; moment weighing scales for measuring of mass moments of rotor components; belt weighers; weighing components, namely, load cells, load cell mounts, weigh beams, measuring eyes, and special transducers for weighing; feed forward and monitoring electronic instruments for vibratory machines; test stands for testing on function and on performance, namely, dynamometers with and without scales; balancing machine accessories, namely, machines for unbalance compensation; compensation mass separators; safety accessories for machinery, namely, light barriers, switches, and guards with respective actuators; diagnostic analyzers; electric and electronic computers for feed forward and feedback control of the above-mentioned goods and pertinent peripherals, particularly printers, cabinets for the aforesaid goods, and remote controllers for the aforesaid goods; data carrier-based programs for feed forward and feedback control of the aforesaid goods; structural and replacement parts of the aforesaid goods; combinations of the aforesaid goods; and electric and electronic computers for feed forward and feedback control, and pertinent peripherals, particularly printers and cabinets, and remote controllers, all for the following goods-- sorting machines for sorting industrial products in accordance with

sorting criteria, namely, the unbalance, or the intended use of the object to be sorted in the fields of balancing, testing, or assembling industrial products; bulk solids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; filling stations for filling of liquids and solids; machines for the classification of bulk solids; vibration machines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors, vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratory machinery, and magnetic exciters; motor-driven transport machinery, namely, chain conveyors, apron feeders, elevators, bucket conveyors, feeders with elevators, belt conveyers, overhead track conveyers, apron conveyors and chains, conveyers for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece goods; motor-driven lift carriages and lifting machinery for lifting industrial piece goods; motor-driven tire changers for vehicle tires; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling and milling machines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting and demounting vehicle components and assemblies; filling machines for filling vehicle fluids; and mechanical machinery for the handling of vehicle components, first used in 1928; first used in commerce in 1949; and

International Class 042 for engineering services; designing for others in the field of balancing, testing, weighing, feeding or screening industrial products and materials, and designing machinery for the foregoing; computer software design for others, first used in 1979, and first used in commerce in 1979.

10. Petitioner also owns U.S. Reg. No. 2,751,706 for SCHENCK.

11. Reg. No. 2,751,706 was registered on August 19, 2003.

12. Reg. No. 2,751,706 covers at least:

International Class 007 for sorting machines for sorting industrial products in accordance with sorting criteria, namely, the unbalance, or the intended use of the object to be sorted in the fields of balancing, testing, or assembling industrial products; bulk solids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; filling stations for tilling of liquids and solids; machines for the classification of bulk solids; vibration machines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors, vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratory machinery, and magnetic exciters; spring elements and universal-joint shafts as machine components; motor-driven transport machinery, namely, chain conveyors, apron feeders, elevators, bucket conveyors, feeders with elevators, belt conveyors, overhead track conveyors, apron conveyors and chains, conveyors for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece goods; loading

arms as machine parts; motor-driven lift carriages and lifting machinery for lifting industrial piece goods; motor-driven tire changers for vehicle tires, and tire inflating valves; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling and milling machines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting and demounting vehicle components and assemblies; mechanical machinery for the handling of vehicle components; structural and replacement parts of the aforesaid goods; and combinations of the aforesaid goods, first used in January 1998, first used in commerce in February 1998;

International Class 009 for balancing machines for the balancing of rotors and rotational machine components; material testing machines for the spin testing of rotors; mass centering machines for determining the mass axis of rotors; balancing scales; static balancing machines for non-rotating balancing of machine components; physical and optical transducers; electrotechnical and electronic measuring and data processing instruments; instruments for the purpose of vibration measuring, vibration monitoring arid machine monitoring; pickups, namely, displacement transducers, vibration velocity probes and acceleration pickups; testing instruments for predictive maintenance of machines; weighing machines; road weighbridges; moment weighing scales for measuring of mass moments of rotor components; belt weighers; weighing components, namely, load cells, load cell mounts, weigh beams, measuring eyes, and special transducers for weighing; feed forward and monitoring electronic instruments for vibratory machines; test stands for testing on function and on performance; dynamometers with and without scales; balancing machine accessories, namely, machines for unbalance compensation; compensation mass separators; safety accessories for machinery, namely, light barriers, switches, and guards with respective actuators; diagnostic analyzers; electric and electronic computers for feed forward and feedback control of the above-mentioned goods and pertinent peripherals, particularly printers, cabinets for the aforesaid goods, and remote controllers for the aforesaid goods; data carrier-based programs for feed forward and feedback control of the aforesaid goods; structural and replacement parts of the aforesaid goods; combinations of the aforesaid goods; and electric and electronic computers for feed forward and feedback control, and pertinent peripherals, particularly printers and cabinets, and remote controllers, all for the following goods-- sorting machines for sorting industrial products in accordance with sorting criteria, namely, the unbalance, or the intended use of the object to be sorted in the fields of balancing, testing, or assembling industrial products; bulk solids bins with discharge machines; feeders and loss-in-weight feeders for material handling and feeding; filling stations for filling of liquids and solids; machines for the classification of bulk solids; vibration machines for shaking, feeding, screening, compacting, and classifying bulk solids or liquid/solid mixtures; vibrating tables, vibrating feeders, helical vibro conveyors, vibrating screens and soil compactors; components for vibratory machinery, namely, directional force exciters, unbalance motors for driving vibratory machinery, and magnetic exciters; motor-driven transport machinery, namely, chain conveyors, apron feeders, elevators, bucket conveyors, feeders with elevators, belt conveyors, overhead track conveyors, apron conveyors and chains, conveyors for continuous operation and foundries, motor-driven conveyors, magazines and sorting machines for industrial piece

goods; motor-driven lift carriages and lifting machinery for lifting industrial piece goods; motor-driven tire changers for vehicle tires; match mounting machines for wheels and tires; pneumatic tire inflating machines; drilling and milling machines for removing material from objects for balancing purposes; machine clamping tools for balancing machines and mounting machinery; mounting and demounting machines for mounting and demounting vehicle components and assemblies; filling machines for filling vehicle fluids; and mechanical machinery for the handling of vehicle components, first used in January 1998, first used in commerce in February 1998; and

International Class 042 for engineering services; designing for others in the field of balancing, testing, weighing, feeding or screening industrial products and materials, and designing machinery for the foregoing; computer software design for others, first used in January 1998, first used in commerce in February 1998.

13. Collectively, the marks are referred to as the "SCHENCK Marks."

14. Applicant is the owner of U.S. Trademark Application Serial No. 79/141,591, claiming priority to International Trademark Registration No. 1,189,747, for the mark SCHUNK (herein after "the Pending SCHUNK Mark").

15. The Pending SCHUNK Mark was published on November 18, 2014.

16. The Pending SCHUNK Mark covers:

International Class 007 for metalworking, plastics, wood and ceramic working machines for workpiece machining and for the technology of automation, clamping and gripping as well as structural parts of the aforementioned machines; machine clamping devices for workpieces and tools, in particular electrical, magnetic, pneumatic, hydraulic clamps and spring-activated clamps operating with negative pressure as well as structural parts thereof; jaw chucks, expansion jaw chucks, clamping blocks, clamping vices, steady rests, vices, clamping cylinders, collets, clamping tools, zero point clamping devices, clamping plates and clamping tables, tombstones, the aforementioned goods being machine parts; machine gripping devices for workpieces and tools, in particular electrical, magnetic, pneumatic, and hydraulic clamps and spring-activated clamps operating with negative pressure as well as parts thereof; parallel grippers, centric grippers, angular grippers, radial grippers, the aforementioned goods being machine parts; clamping and gripping jaws, in particular top jaws, pendulum jaws, collet jaws for machine clamping devices and gripping devices, the aforementioned goods being parts of machines; machine tools, namely, machine jaw changing devices for clamping and gripping devices as well as structural parts thereof; power-operated machines, namely, machine lifting and holding devices for workpieces and tools, in particular electrical, magnetic, pneumatic, hydraulic, spring-activated lifting and holding devices operating with negative pressure as well as structural parts thereof; power-operated machines, namely, machine manipulation devices for workpieces and tools as well as structural

parts thereof; Robots, namely, industrial robots, service robots for personal and clinical use, and robots with hinged brackets for the manipulation of workpieces and tools as well as structural parts thereof; machines for vacuum technology, in particular vacuum suction grippers and clamps, vacuum suction valves, pads and ejectors as well as structural parts thereof; electrical, magnetic, pneumatic, hydraulic, spring-activated sliding machines, pivoting machines, lifting machines, elevating machines, turning machines operating with negative pressure as well as structural parts thereof; electromotive, pneumatic, and hydraulic actuators for clamping, gripping, lifting, manipulating, sliding, pivoting, lifting, elevating and turning devices as well as structural parts thereof; linear actuators and linear modules consisting thereof; machine tilting devices in the nature of machine tools, namely, clamps, mounts and vices; machine parts, namely, turning passage guides for machines; balancing machines for balancing tools; mandrels being parts of machines; modular clutches for machines; power-operated machines, namely, quick change systems for tools and automation components, consisting of robotic tool changers, robotic collision sensors, machine tool changers and tool retaining systems for positioning and mounting tools; valves as parts of machines, in particular vacuum valves, pressure valves, pressure maintaining valves, check valves; valve blocks as parts of machines; laser machining machines, laser welding machines as well as structural parts thereof;

International Class 008 for manually operated clamps, tool holders, and vices; manually operated jaw chucks, expansion chucks, power chucks, power clamping blocks and zero point clamping device, namely, a clamping device consisting of a clamp, a positioning system and mounting system for use in clamping workpieces, pallets, and modules during a manufacturing process; manually operated electrical, magnetic, pneumatic, hydraulic, spring-activated clamps, jacks, chucks, collets, lifting jacks, and holding equipment in the nature of vices, as well as structural parts thereof; manually operated hand tools, namely, collets, lifting jacks, and vices, pincers and wrenches; manually operated tools, namely, vice jaws, namely, clamping and gripping jaws, in particular top jaws, pendulum jaws, collet jaws for manually operated clamping and gripping devices; manually operated tools, namely, vice jaws, namely, manually operated jaw changing devices for clamping and gripping devices as well as structural parts thereof; the aforementioned goods for the use in automation, clamping and gripping technology;

International Class 009 for electronic control systems for machines, namely, electrical and/or electronic control and adjustment devices for machines; sensors for the measurement of pressure, force, contact, magnetic field, and displacement; sensors for control and/or adjustment of the drive of machines; collision sensors, power sensors, magnet sensors, pressure sensors, displacement sensors, force-torque sensors, position sensors, wireless sensors; computer operating software; software for the control and/or adjustment of the operation of machines; laser measuring sensors; electric switches; electric cables, plugs, cable bushings, and connectors; training manuals in electronic form;

International Class 037 for installation, maintenance, servicing and repair of machines, of parts of machines and of accessory for machines; the aforementioned services, in particular in relation to automation, clamping and gripping technology; and

> International Class 042 for services of an engineer, namely, engineering services; services of a physicist, namely, research in the field of physics; technical consultancy, analysis, and configuration of computer networks as well as of software-assisted facilities and technical management of projects, also via telephone and via Internet; surveying; planning, designing and technical consultancy concerning the application and operation of automated clamping and gripping facilities; inspection and technical supervising of machines and equipment; designing and development of computer programs for data processing; maintenance of computer programs; material testing; conducting metallurgical analyses and quality tests; conducting technical measurements; the aforementioned services in particular in relation to automation, clamping and gripping technology.

15. This Notice of Opposition is being filed within 30 days after the publication of the Pending SCHUNK Mark.

16. Petitioner has a priority of use in the SCHENCK Marks that is prior to Applicant's rights in the Pending SCHUNK Mark.

17. Applicant's Pending SCHUNK Mark, when used on or in connection with the identified goods or services is confusingly similar to Petitioner's SCHENCK Marks as set forth and protected by Petitioner's trademark registrations.

18. There is a high degree of similarity between Petitioner's goods and/or services and Applicant's good and services such that consumers are likely to be confused, mistaken, or deceived as to the source of the goods and/or services.

19. For example, Applicant's machine clamping devices, balancing machines for balancing tools, machine manipulation devices for workpieces and tools, lifting, elevating, and turning machines; electromotive actuators for clamping, manipulating, and turning devices; and machine lifting and holding devices for workpieces and tools in association with International Class 007 are similar to the Petitioner's balance correcting machine tools, machine clamping tools for balancing machines and mounting machinery, motor-driven conveyors, roller conveyors, and motor-driven lift carriages and lifting machinery for lifting industrial piece goods in Class 007

and balance testing machines in Class 009 for the SCHENCK Marks. Thus, there is a likelihood of confusion with use of the Pending SCHUNK Mark in class 007 in view of the senior SCHENCK Marks.

20. For example, consumers are likely to be confused or believe that Applicant's manually operating lifting jacks for use in automation and gripping technologies in International Class 008 emanate from the Petitioner or from a source connected to the Petitioner in view of the loading arms as machine parts and motor driven lifting machinery in connection with the SCHENCK Marks. Thus, there is a likelihood of confusion with use of the Pending SCHUNK Mark in class 008 in view of the senior SCHENCK Marks.

21. For example, Applicant's electronic control systems for machines, computer operating software, and sensors for control machines including power sensors, magnet sensors, and displacement sensors in International Class 009 similar to the with Petitioner's electric control devices for controlling machine tools, electrical sensing and control devices, displacement transducers, and electric and electronic computers for feed forward and feedback control in Class 009 for the SCHENCK Marks. Thus, there is a likelihood of confusion with use of the Pending SCHUNK Mark in class 009 in view of the senior SCHENCK Marks.

22. For example, marketing for Applicant's installation and servicing relating to clamping and gripping technology in International Class 037 is likely to be encountered by the same purchasers of Petitioner's machine clamping and mounting tools for balancing machines in connection with the SCHENCK Marks in Class 007 under the same or similar circumstances so as to give rise to a mistaken belief of a common originating source or a related source for the goods and services. Thus, there is a likelihood of confusion with use of the Pending SCHUNK Mark in class 037 in view of the senior SCHENCK Marks.

23. For example, Applicant's Pending SCHUNK Mark in connection with engineering services and services including designing and development of computer programs for data processing in International Class 042 is similar to the Petitioner's engineering services and computer software design for others in Class 042 for the SCHUNK Marks. Thus, there is a likelihood of confusion with use of the Pending SCHUNK Mark in class 042 in view of the senior SCHENCK Marks.

24. Consumers are likely to encounter Applicant's goods and services and Petitioner's goods and services in similar channels of trade or under similar circumstances such that consumers are likely to be confused as to whether Applicant's goods and services originate from the Petitioner or a source connected to the Petitioner.

25. The Pending SCHUNK Mark and the SCHENCK Marks are highly similar in appearance, sound, and connotation and are likely to cause confusion, mistake, or deception when used on highly similar or related goods and services.

26. The Pending SCHUNK Mark should not be registered under the Trademark Act § 2(d), 15 U.S.C. § 1052(d) because the Pending SCHUNK Mark so resembles the SCHENCK Marks as to be likely, when used on or in connection with the goods or services of the Pending SCHUNK Mark (e.g., electronic control systems, machine clamping devices, balancing machines for balancing tools, lifting machinery, engineering services, computer program design), to cause confusion, or to cause mistake, or to deceive.

27. The likelihood of confusion created by the pending SCHUNK mark will damage and/or will continue to damage Petitioner.

28. In addition, any defect or fault found with Applicant's products marketed under the Pending SCHUNK Mark would significantly injure the goodwill and reputation the Petitioner has established for the goods and services under the SCHENCK Marks.

29. The foregoing facts show that the Petitioner has a real interest and a direct and personal stake in the registration of the pending SCHUNK mark and a reasonable basis for its belief that it would suffer damage if the mark is registered.

PRAYER FOR RELIEF

WHEREFORE, Petitioner respectfully requests that the Opposition be granted.

Respectfully submitted,

/Marianne Buckley/

December 17, 2014

Marianne Buckley
Joseph T. Jasper
HANLEY, FLIGHT & ZIMMERMAN, LLC
150 South Wacker Drive, Suite 2200
Chicago, Illinois 60606
Telephone: (312) 580-1020
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that the above and foregoing NOTICE OF OPPOSITION was served upon Applicant by depositing a copy of same with the United States Postal Service, first class postage prepaid, on this date, addressed to:

DREISS PATENTANWÄLTE Partnerschaft
Gerokstr. 1
70188 Stuttgart
GERMANY

/Marianne Buckley/

December 17, 2014

Marianne Buckley
Joseph T. Jasper
HANLEY, FLIGHT & ZIMMERMAN, LLC
150 South Wacker Drive, Suite 2200
Chicago, Illinois 60606
Telephone: (312) 580-1020
Attorneys for Petitioner