

ESTTA Tracking number: **ESTTA666341**

Filing date: **04/13/2015**

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	Kato Engineering Inc.
Granted to Date of previous extension	04/12/2015
Address	2075 HOWARD DRIVE Mankato, MN 56003 UNITED STATES
Attorney information	Lisa M. DuRoss/Harness, Dickey & Pierce Harness, Dickey & Pierce, PLC 5445 Corporate Drive, Suite 200 Troy, MI 48098 UNITED STATES docketingTM@hdp.com, duross@hdp.com, jgant@hdp.com, lwang@hdp.com, tcomparoni@hdp.com Phone:248-641-1600

**Applicant Information**

Application No	86297334	Publication date	10/14/2014
Opposition Filing Date	04/13/2015	Opposition Period Ends	04/12/2015
Applicant	Diakonia Group, LLC 1886 General George Patton Drive Franklin, TN 37067 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Computer aided design (CAD) software for the design and cost estimation of conveyors and conveyor systems

**Grounds for Opposition**

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

U.S. Registration No.	1238026	Application Date	08/13/1981
Registration Date	05/17/1983	Foreign Priority Date	NONE
Word Mark	KATO		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 1926/00/00 First Use In Commerce: 1926/00/00 Electric Motors, * Electric motors soldas part of motor generator sets, * Electric Generators and Structural Parts Thereof Class 009. First use: First Use: 1926/00/00 First Use In Commerce: 1926/00/00 Electrical Control Apparatus, Converters, Panel Boards, Voltage Regulators and Structural Parts Thereof

Attachments	opposition.pdf(384106 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	/lmd/
Name	Lisa M. DuRoss/Harness, Dickey & Pierce
Date	04/13/2015

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

Kato Engineering Inc.	)	
	)	
Opposer,	)	Opposition No. _____
	)	
v.	)	Mark: CATO
	)	Serial No.: 86/297,334
Diakonia Group, LLC	)	Filed: June 2, 2014
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Opposer, Kato Engineering Inc. (“Kato”), a Delaware corporation, with an address at 2075 Howard Dr., North Mankato, Minnesota 56003, believes that it is being damaged, and will be damaged, by registration of the mark CATO in Application Serial No. 86/297,334, and opposes same. As grounds for opposition, Kato alleges that, upon actual knowledge with respect to Kato’s own acts, and upon information and belief as to other matters:

1. Kato owns the following incontestable standard character U.S. trademark registration for the mark KATO (the “KATO Mark”):

Trademark	Reg. No.	Registration Date	Date of First Use	Goods
KATO	1,238,026	May 17, 1983	1926	Class 7 – Electric Motors, Electric motors sold as part of motor generator sets, Electric Generators and Structural Parts Thereof

Trademark	Reg. No.	Registration Date	Date of First Use	Goods
				Class 9 – Electrical control apparatus, converters, panel boards, voltage regulators and structural parts thereof

A copy of the Certificate of Registration and TSDR printout with Assignment Abstract of Title for the registration is attached as Exhibit A, and made a part hereof by reference and for purposes of reliance.

2. The incontestable registration in Paragraph 1 constitutes conclusive proof of Kato's ownership of and exclusive rights to use the mark in connection with the goods recited in the registration. The registration predates the filing date of Applicant's Application Serial No. 86/297,334 and any date of first use that Applicant can prove.
  
3. Upon information and belief, Applicant Diakonia Group, LLC ("Applicant") is a limited liability company of Tennessee with an address at 1886 General George Patton Drive, Franklin, Tennessee 37067.
  
4. On June 2, 2014, Applicant filed an intent-to-use application under Trademark Act §1(b) for the standard character mark CATO for the following goods in Class 9 "Computer aided design (CAD) software for the design and cost estimation of conveyors and conveyor systems".

**LIKELIHOOD OF CONFUSION**

5. Kato repeats and realleges each and every allegation in Paragraphs 1-4.

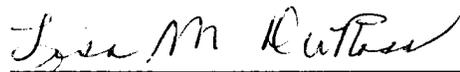
6. Kato has priority based on its pleaded prior-issued registration for the KATO Mark.
7. Application Serial No. 86/297,334 for the CATO mark covers goods that are related to the goods covered by the KATO Mark.
8. Applicant's CATO mark so resembles Kato's prior-registered KATO Mark as to be likely, when used in connection with Applicant's 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, Kato believes that it is being and will be damaged by the registration of the mark shown in Application Serial No. 86/297,334, and requests that the opposition be sustained, and that registration to Applicant be refused.

Please charge the filing fee for this Opposition to the Deposit Account of Harness, Dickey & Pierce, PLC, No. 080750.

KATO ENGINEERING INC.

Date: 04/13/2015



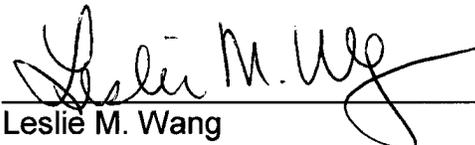
Lisa M. DuRoss  
Michael P. Brennan  
Harness, Dickey & Pierce, P.L.C.  
5445 Corporate Drive, Suite 200  
Troy, Michigan 48098  
Phone: (248) 641-1600  
Fax: (248) 641-0270  
Email: [docketingtm@hdp.com](mailto:docketingtm@hdp.com)  
[lmduross@hdp.com](mailto:lmduross@hdp.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail, postage prepaid, on this 13<sup>th</sup> day of April, 2015, on counsel for Applicant at the following address of record:

**Correspondent of Record:**

Robert Layne  
5121 Maryland Way, Ste. 301  
Brentwood, Tennessee 37027-7516  
615-377-6116  
boblayne@thevisibilitycompany.com

A handwritten signature in black ink, appearing to read "Leslie M. Wang", is written over a horizontal line.

Leslie M. Wang  
Harness, Dickey & Pierce, PLC  
5445 Corporate Drive, Suite 200  
Troy, Michigan 48098  
Phone: 248-641-1600

Opposition to Serial No. 86/297,334

**EXHIBIT A  
TO  
NOTICE OF OPPOSITION**

# United States of America

United States Patent and Trademark Office

## KATO

**Reg. No. 1,238,026**

EMERSON ELECTRIC CO. (DELAWARE CORPORATION)  
8000 WEST FLORISSANT AVENUE  
ST. LOUIS, MO 63136

**Registered May 17, 1983**

**Renewal Term Begins  
May 17, 2013**

FOR: ELECTRIC MOTORS, \* ELECTRIC MOTORS SOLD AS PART OF MOTOR GENERATOR SETS, \* ELECTRIC GENERATORS AND STRUCTURAL PARTS THEREOF, IN CLASS 7 (U.S. CLS. 13, 19, 21, 23, 31, 34 AND 35).

**10 Year  
Renewal/Corrected**

FIRST USE 0-0-1926; IN COMMERCE 0-0-1926.

**Int. Cls.: 7 and 9**

FOR: ELECTRICAL CONTROL APPARATUS, CONVERTERS, PANEL BOARDS, VOLTAGE REGULATORS AND STRUCTURAL PARTS THEREOF, IN CLASS 9 (U.S. CLS. 21 AND 26).

**TRADEMARK**

FIRST USE 0-0-1926; IN COMMERCE 0-0-1926.

**PRINCIPAL REGISTER**

SEC. 2(F).

SER. NO. 73-323,357, FILED 8-13-1981.



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office



UNITED STATES  
Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

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## Attorney/Correspondence Information

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### Attorney of Record

**Attorney Name:** Michael P. Brennan and Lisa M. DuRoss  
**Attorney Primary Email Address:** [docketingtm@hdp.com](mailto:docketingtm@hdp.com)

**Docket Number:** 8930-200007/  
**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Michael P. Brennan and Lisa M. DuRoss  
Harness, Dickey & Pierce, P.L.C.  
P.O. Box 828  
Bloomfield Hills, MICHIGAN 48303  
UNITED STATES  
**Phone:** (248) 641-1600  
**Correspondent e-mail:** [docketingtm@hdp.com](mailto:docketingtm@hdp.com)

**Fax:** (248) 641-0270

**Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

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## Prosecution History

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Date	Description	Proceeding Number
Apr. 30, 2014	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Feb. 13, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Feb. 13, 2014	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	76985
Feb. 13, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	76985
Oct. 31, 2013	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	76985
Feb. 13, 2014	CERTIFICATE OF CORRECTION ISSUED	76985
Oct. 31, 2013	SEC 7 REQUEST FILED	76985
Nov. 05, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76985
Oct. 31, 2013	TEAS SECTION 8 & 9 RECEIVED	
Oct. 31, 2013	TEAS SECTION 7 REQUEST RECEIVED	
Oct. 31, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 24, 2008	CASE FILE IN TICRS	
Aug. 08, 2003	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Aug. 08, 2003	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
May 19, 2003	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
May 16, 2003	TEAS SECTION 8 & 9 RECEIVED	
Jul. 26, 1989	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Apr. 03, 1989	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
May 17, 1983	REGISTERED-PRINCIPAL REGISTER	
Feb. 22, 1983	PUBLISHED FOR OPPOSITION	
May 17, 1983	REGISTERED-PRINCIPAL REGISTER	
Jan. 18, 1983	NOTICE OF PUBLICATION	
Jan. 05, 1983	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 08, 1982	NON-FINAL ACTION MAILED	

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## Maintenance Filings or Post Registration Information

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**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** May 17, 2013

**Change in Registration:** Yes

**Correction made to Registration:** In the statement, Column 1, line 4 after electric motors, "electric motors sold as part of motor generator sets", should be inserted.

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## TM Staff and Location Information

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### TM Staff Information - None

#### File Location

**Current Location:** GENERIC WEB UPDATE

**Date in Location:** Feb. 13, 2014

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## Assignment Abstract Of Title Information

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### Summary

**Total Assignments:** 4

**Registrant:** Reliance Electric Company

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#### Assignment 1 of 4

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**Conveyance:** ASSIGNS THE ENTIRE INTEREST AND THE GOOD WILL AS OF DECEMBER 31, 1986

**Reel/Frame:** 0575/0178

**Pages:** 3

**Date Recorded:** Jul. 01, 1987

**Supporting Documents:** No Supporting Documents Available

#### Assignor

**Name:** RELIANCE ELECTRIC COMPANY

**Execution Date:** Jun. 23, 1987

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

#### Assignee

**Name:** RELIANCE ELECTRIC INDUSTRIAL COMPANY

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

**Address:** 29325 CHAGRIN BLVD.  
CLEVELAND, OHIO 44122

#### Correspondent

**Correspondent Name:** RELIANCE ELECTRIC

**Correspondent Address:** P.O. BOX 22280, 29325 CHAGRIN BLVD.  
CLEVELAND, OH 44122

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#### Domestic Representative - Not Found

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#### Assignment 2 of 4

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**Conveyance:** ASSIGNS THE ENTIRE INTEREST

**Reel/Frame:** 1821/0034

**Pages:** 4

**Date Recorded:** Nov. 23, 1998

**Supporting Documents:** assignment-tm-1821-0034.pdf

#### Assignor

**Name:** RELIANCE ELECTRIC INDUSTRIAL COMPANY

**Execution Date:** Nov. 20, 1998

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

#### Assignee

**Name:** CATERPILLAR INC.

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

**Address:** 100 N. E. ADAMS ST.  
PEORIA, ILLINOIS 61629-6480

#### Correspondent

**Correspondent Name:** GENE BOLMARCICH

**Correspondent Address:** 100 N.E. ADAMS ST.  
PEORIA, IL 61629-6480

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#### Domestic Representative - Not Found

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#### Assignment 3 of 4

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**Conveyance:** ASSIGNS THE ENTIRE INTEREST

**Reel/Frame:** 1990/0266

**Pages:** 4

**Date Recorded:** Nov. 15, 1999

**Supporting Documents:** assignment-tm-1990-0266.pdf

#### Assignor

**Name:** CATERPILLAR INC.

**Execution Date:** Jun. 15, 1999

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** No Place Where Organized Found

Organized:

**Assignee**

Name: EMERSON ELECTRIC CO.  
Legal Entity Type: CORPORATION

State or Country Where Organized: No Place Where Organized Found  
Organized:

Address: P.O. BOX 4100  
8000 WEST FLORISSANT AVENUE, BLDG. AA  
ST. LOUIS, MISSOURI 63136

**Correspondent**

Correspondent Name: FISH & NEAVE  
Correspondent Address: MICHELLE W. WAITES  
1251 AVENUE OF THE AMERICAS  
NEW YORK, NY 10020

Domestic Representative - Not Found

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**Assignment 4 of 4**

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Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 5265/0697

Pages: 5

Date Recorded: Apr. 22, 2014

Supporting Documents: assignment-tm-5265-0697.pdf

**Assignor**

Name: EMERSON ELECTRIC CO.  
Legal Entity Type: CORPORATION

Execution Date: Apr. 08, 2014

State or Country Where Organized: MISSOURI  
Organized:

**Assignee**

Name: KATO ENGINEERING INC.  
Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE  
Organized:

Address: 2075 HOWARD DRIVE  
NORTH MANKATO, MINNESOTA 56003

**Correspondent**

Correspondent Name: MICHAEL P. BRENNAN, LISA M. DUROSS  
Correspondent Address: 5445 CORPORATE DRIVE, SUITE 200  
TROY, MI 48098

Domestic Representative - Not Found



United States Patent and Trademark Office

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## Assignments on the Web > Trademark Query

### Trademark Assignment Abstract of Title

#### Total Assignments: 4

Serial #: 73323357

Filing Dt: 08/13/1981

Reg #: 1238026

Reg. Dt: 05/17/1983

Registrant: Reliance Electric Company

Mark: KATO

#### Assignment: 1

Reel/Frame: 0575/0178

Recorded: 07/01/1987

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOOD WILL AS OF DECEMBER 31, 1986

Assignor: RELIANCE ELECTRIC COMPANY

Exec Dt: 06/23/1987

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: RELIANCE ELECTRIC INDUSTRIAL COMPANY

29325 CHAGRIN BLVD.  
CLEVELAND, OHIO 44122

Correspondent: RELIANCE ELECTRIC  
P.O. BOX 22280, 29325 CHAGRIN BLVD.  
CLEVELAND, OH 44122

#### Assignment: 2

Reel/Frame: 1821/0034

Recorded: 11/23/1998

Pages: 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: RELIANCE ELECTRIC INDUSTRIAL COMPANY

Exec Dt: 11/20/1998

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: CATERPILLAR INC.

100 N. E. ADAMS ST.  
PEORIA, ILLINOIS 61629-6480

Correspondent: GENE BOLMARCICH  
100 N.E. ADAMS ST.  
PEORIA, IL 61629-6480

#### Assignment: 3

Reel/Frame: 1990/0266

Recorded: 11/15/1999

Pages: 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: CATERPILLAR INC.

Exec Dt: 06/15/1999

Entity Type: CORPORATION

Citizenship: NONE

Entity Type: CORPORATION

Citizenship: NONE

Assignee: EMERSON ELECTRIC CO.

P.O. BOX 4100  
8000 WEST FLORISSANT AVENUE, BLDG. AA  
ST. LOUIS, MISSOURI 63136

Correspondent: FISH & NEAVE  
MICHELLE W. WAITES  
1251 AVENUE OF THE AMERICAS  
NEW YORK, NY 10020

#### Assignment: 4

Reel/Frame: 5265/0697

Recorded: 04/22/2014

Pages: 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: EMERSON ELECTRIC CO.

Exec Dt: 04/08/2014

**Assignee:** KATO ENGINEERING INC.  
2075 HOWARD DRIVE  
NORTH MANKATO, MINNESOTA 56003

**Correspondent:** MICHAEL P. BRENNAN, LISA M. DUROSS  
5445 CORPORATE DRIVE, SUITE 200  
TROY, MI 48098

**Entity Type:** CORPORATION

**Citizenship:** MISSOURI

**Entity Type:** CORPORATION

**Citizenship:** DELAWARE

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.5  
Web interface last modified: July 25, 2014 v.2.5

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