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

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| Proceeding | 91221590 |
| Party | Plaintiff<br>Emerson Electric Co. |
| Correspondence Address | LISABETH H COAKLEY<br>HARNESS DICKEY & PIERCE PLC<br>5445 CORPORATE DRIVE STE 200<br>TROY, MI 48098<br>UNITED STATES<br>coakley@hdp.com, tjcomparoni@hdp.com, docketingtm@hdp.com |
| Submission | Other Motions/Papers |
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| Signature | /lhc/ |
| Date | 07/21/2015 |
| Attachments | 79138965 - First Amended Notice of Opposition 072115.PDF(687675 bytes ) |

**Attorney Docket No. 3165-501007**

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

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| Emerson Electric Co., Opposer, | ) | |
| | ) | Opposition No. _____ |
| v. | ) | Serial No. 79/138,965 |
| | ) | Mark: EMERSON TECHNIK & Design |
| S.C. Ion Mos S.R.L. Applicant. | ) | Published: October 21, 2014 |

**FIRST AMENDED NOTICE OF OPPOSITION**

Emerson Electric Co. ("Emerson Electric" or "Opposer"), a Missouri corporation with a business address of 8000 W. Florissant Avenue, St. Louis, Missouri 63136, hereby files its First Amended Notice of Opposition and Opposes registration of the mark EMERSON TECHNIK & Design that is the subject of Application Serial No. 79/138,965 published in the *Official Gazette* on October 21, 2014, and requests that registration to Applicant be refused.

The initial Notice of Opposition was timely filed on April 20, 2015. Applicant filed Applicant's Motion to Dismiss Counts II and III for Failure to State a Claim Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503, and Motion for Suspension of Proceeding, on June 30, 2015. This First Amended Notice of Opposition is intended to clarify the initial Notice of Opposition pursuant to Fed. R. Civ. P. 15 (a)(1)(B) and 37 CFR §2.107(b). Count III of Emerson's original Notice of Opposition included a claim under Section 2(a) for false suggestion of connection and this claim has been deleted and Opposer's original claim for Dilution (which was originally Count IV) is now Count III.

As grounds for its First Amended Notice of Opposition, Opposer alleges that, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

1. Opposer, by and through its predecessors and related companies (collectively "Emerson") for many years, and well prior to the filing of the subject application and long prior to any date of first use upon which Applicant can rely, has adopted and continuously used the mark "EMERSON" and marks consisting of "EMERSON" for a wide range of goods and services including, but not limited to, equipment, machinery and various machinery parts for the food industry in International Classes 7 and 11.

2. Opposer is the owner of the following United States Trademark Registrations:

| Mark | Reg. No. / Reg. Date | Goods |
|---|---|---|
| EMERSON | 3,689,743<br>09/29/2009 | Class 11: Replacement parts for ranges. |
| EMERSON | 1,717,861<br>09/22/1992 | Class 11: Water purifying units; electric water boilers; ceiling fans; valves for heating systems; electric water heaters and electric non-coin operated hot water dispensers permanently attached to plumbing; gas burner igniters. |
| EMERSON | 3,744,986<br>02/02/2010 | Class 11: Thermostatic valves; hot water heaters and dispensers. |
| EMERSON | 3,718,938<br>12/01/2009 | Class 7: Power operated pipe groovers; drain and sewer cleaning machines in the nature of power operated snakes, drain diagnostic machines for diagnosing problems with blocked drains; pipe inspection machines, pipe cutting machines, namely, groovers; power operated pipe cutters; food waste disposers and garbage disposals. |
| EMERSON | 1,795,612<br>09/28/1993 | Class 7: Compressors for use in refrigeration, heating, ventilation, and air conditioning; and valves for fluid control being parts of machines. |
| EMERSON | 111,931<br>08/15/1916 | Class 7: Electric motors, electric fans, including fans of portable, wall, ceiling, and floor types, electric exhaust-fans, electric generators, electric motor-generators, electrically-operated water pumps, electrically-operated lathes, grinders<br>Class 11: Electrically-operated furnace-blowers. |

| Mark | Reg. No. / Reg. Date | Goods |
|---|---|---|
| EMERSON | 1,331,669<br>04/23/1985 | class 7: Mechanical adjustable speed drives; agricultural watering machines; electric alternators; bearing units and parts thereof; bearings for machines; belt conveyors; pipe, tube conduit and rod bending machines; blowing machines; bracket adapters for geared threaders; hydraulic brakes for machines; cable sheave brackets; brushes for attachment to power drives; cams for machinery; carriages for holding pipe and bolt threaders on power drives; check valves, relief valves, gate valves, and globe valves, being parts of machines; pipe threading machines; drill presses and lathes; chucks, chuck keys, and chuck adapters; drill bits; drills; rotary driven cable for sewer cleaning machines; cutting heads for sewer cleaning machines; clutches for machines; clutch-brake transmissions for machines; trash compactors; conservation vent valves; conveyor pulleys; hubs and bushings; couplings for connecting input to output shafts to transmit power therebetween, cranes, crushers, current generators gas mixers for welding torches, cutting torches and tips, depth locators for portable power tools; derricks; die head adapters for lathes and drill presses; drive bars for transmitting power; drive shafts with universal joints therein; power drives for rotating pipe and rods; electric generators; electric motors not for land vehicles; high speed flexible shaft electric tools, swivel base or wall mounted; emery wheels; stands and holders for electric tools. kits comprising various combinations of tools and including sandpaper, polishing pads, drills, saw blades, brushes, carving cutters, routing cutters, collets, emery wheels dressing stones, polishing wheels, cutoff wheels, buffing wheels, grinding wheels, wire wheels, engraving points, mandrels and chucks, sold as a unit; flexible couplings for machines; floatation type separators for material separation; gear boxes for machines; gear reducers; gear transmission pump drives; gears for machinery; grinding and finishing mills; grinding machines (garbage disposals); hoists; igniters for clothes driers and gas furnaces; index drives; indexing conveyors keys for shafts of machines not vehicles; leaf shredders; liquid seal valves and units; loops for geared threaders; machine belts; motor driven tubing brushing machines; pipe and bolt threading machines; motor bases for machines; nozzles for machines; oil separating machines; oscillator drives; overload clutches for machines; piston and vane actuators; polishing heads (parts of machines); portable electric tools-namely, chisels, cut-off, machines, disc grinders, die grinders, drills, hammer drills, hammers, impact wrenches, laminate trimmers, nut runners, planes, polishers, sanders, (disc, belt and orbital), saws (circular, jig, recipro and saber), screwdrivers and shears; portable gasoline powered drives; power drill speed reducers; power driven chain saws; power tool attachments-namely, threading dies, drive adapters, nipple chucks, pipe cutters and reamers, taps and brushes; power transmission |

| Mark | Reg. No. / Reg. Date | Goods |
|---|---|---|
| | | equipment-namely, gears, racks and pinions, pulley, pillow and flange blocks, machine pulleys. pumps-namely, submersible, hollow shaft irrigation, and sewage pumps; riddles, being parts of machines; roller bearings in barrel and swivel form; router-duplicators; routers; set collars for shafts; sewer and drain cleaning machines; shaft bearings; shaft couplings; sharpening wheels; sieves (machine); speed reducers and reversible speed reducers for electric drills; machine sprockets; chains for power transmission application for machines; stand mounted sanding, grinding and abrasive machines; starters for motors and engines not for land vehicles; electric motor stators; support arms for supporting threaders on power drives; supports for supporting pipe during machine threading operation; take-up units and frames for belt and chain drives; tamping and packing machines; tapping machines; torque limiters and tighteners; vibrating screens; vibratory separators; waste disposal machines, and worm gears not for land vehicles and parts therefor. |
| EMERSON | 1,795,768<br>09/28/1993 | Class 11: Valves for fluid control. |
| EMERSON PROCESS MANAGEMENT | 3,673,383<br>08/25/2009 | Class 7: Pneumatic valve actuators; linear valve actuators. |
| EMERSON PROFESSIONAL TOOLS | 3,722,741<br>12/08/2009 | Class 7: Sliding platforms for vehicles; industrial vacuum cleaners; power tools, namely, abrasive saws, power-operated core drills; power-operated drain cleaning machines; hydraulic knock-out sets comprising hydraulic punches; pipe and bolt threading machines; pipe roll grooving machines; power operated pipe threading machines; power-operated pipe threading equipment, namely, die heads for threading machines, pipe dies for use with threading machines; power-operated geared threader parts, namely, die heads, die head racks, leg, tray, wheel and cabinet stands; machine parts, namely, carriages especially adapted for holding pipe and bolt threading machines; power drive machines, namely, machines for rotating pipe and rods; machine parts, namely, loops specially adapted for power-operated geared threaders; power operated machine parts, namely, support arms and pipe supports for supporting pipe during threading operation; power drill bits; power operated pipe roll groovers; power operated drain and pipe machines for cleaning drains, namely, power operated plumbing snakes, power operated drain and sewer cleaning machines, namely, sink machines, drum machines, sectional machines, rodder machines and water jetting machines; power operated drain diagnostic machines for cleaning and inspecting pipes, sump pumps, electric utility sewage pumps, electric semi-trash pumps, electric sewage ejection pumps, namely, power operated sink machines, power operated drum machines, power operated sectional machines, power operated |

| Mark | Reg. No. / Reg. Date | Goods |
|---|---|---|
| | | rodder machines, and power operated water jetting machines; power operated pressing tools; manually operated pipe and tubing cutting machines.<br>Class 11: Pipe thawing machines comprising thermoelectric heating units and electric power cables for wrapping around pipes; pipe freezing equipment comprised of refrigeration units, freeze gel and hosing for use in the plumbing field. |
| EMERSON | 3,861,153<br>10/12/2010 | Class 11: Household air cleaners; air purifying units for domestic, commercial and industrial use; ceiling fans; air circulators. |
| EMERSON PROCESS MANAGEMENT | 4,064,996<br>12/06/2011 | Class 7: Regulators being parts of machines, and not part of plumbing, heating or cooling installations, namely, gas flow regulators, gas pressure regulators, gas pressure regulators for controlling gas, air or water, air pressure regulators, pressure regulators, fuel pressure regulators and air and fuel regulators.<br>Class 11: Gas regulators; gas flow regulators in the nature of pressure regulators for gas installations; gas flow regulators in the nature of pressure regulators for gas, air and water installations; automatic valve in the nature of a combination gas pressure regulator and redundant solenoid gas valve for use in forced air furnaces, boilers, clothes dryers and gas water heaters; gas flow regulators being parts of gas, water, and sanitary installations; air pressure regulators being parts of gas, water, and sanitary installations; pressure regulators being parts of gas, water, and sanitary installations; fuel pressure regulators being parts of gas, water, and sanitary installations; air and fuel pressure regulators being parts of gas, water, and sanitary installations. |

("Opposer's Marks"). These registrations are valid, subsisting and over five (5) years old. A copy of the Certificate of Registration, TSDR printout and Assignment Abstract of Title for each of the foregoing registrations has previously been filed with Opposer's original Notice of Opposition. Opposer's Marks together with its common law marks constitute a valuable family of marks ("Opposer's EMERSON Marks" or "EMERSON Marks"). The goods of the EMERSON Marks are collectively referred to as "EMERSON Goods."

3. Emerson has for many years spent considerable sums of money in connection with the advertisement and promotion of the EMERSON Marks and as a result, has established a worldwide reputation for high quality equipment, machinery and various machinery parts including,

but not limited to, for use in the food industry. As a consequence, the EMERSON Marks have come to identify Opposer as the source of superior machinery and equipment for the food industry, including but not limited to, for the heating, cooling, and refrigeration of food, food storage units and various mechanical components and replacement parts therefor.

4. Through the long use of the EMERSON Marks and substantial promotion and public exposure, Opposer has developed valuable goodwill in its distinctive EMERSON Marks, which have long been famous as that term is used in 15 U.S.C. §1125(c)(1).

5. Applicant seeks to register the mark EMERSON TECHNIK & Design ("Applicant's Mark") in the United States for "equipment and machinery for food industry, namely, meat filling machines, choppers, electric tumblers for mixing, coating and marinating food, electric mixers, electric food grinders, electric slicers, machine for brine injection, food processing machines for the preparation of brine" in Class 7 and "electric, steam, diesel, oil and gas-powered cooking and smoking chambers for the food industry, namely smokers, ovens, stoves, roasters, steamers and dehydrators" in Class 11 (collectively "Applicant's Goods"). That application was filed on May 13, 2013, and was assigned Serial No. 79/138,965 (the "Opposed Application").

6. The Opposed Application is based upon Trademark Act Section 66(a) and seeks to extend protection of International Registration No. 1182960 for the mark EMERSON TECHNIK & Design. The International Registration ("IR") is based upon a Romania trademark registration for the mark EMERSON TECHNIK & Design. Opposer has filed, in Romania, Petitions to Cancel both Applicant's IR and the Romanian national registration on which this Opposed Application is dependent. These Cancellation actions are currently pending in the Bucharest Court of Law in Romania and scheduled to go to trial on September 16, 2015. If the basic national Romania

registration is cancelled, the Opposed Application will be refused, the instant Opposition will be moot and all other extensions of protection of the IR will be void.

## COUNT I

### Applicant's Mark is Likely to Cause Confusion

7. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 – 6.

8. The Opposed Application covers goods that are related to those covered by Opposer's Marks.

9. Opposer's customers, and the public generally, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's Goods marketed under Applicant's Mark and misled into believing that such goods emanate from, or are licensed by or are in some way directly or indirectly associated with or sponsored by Opposer, to the damage and detriment of Opposer.

10. Applicant's Mark so resembles Opposer's Marks previously used and registered as to be likely, when applied to the goods claimed in the Opposed Application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d).

## COUNT II

### Applicant's Mark is Deceptive

11. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 – 10.

12. Applicant's Mark includes the term "TECHNIK", which is the phonetic and conceptual equivalent of "TECHNIQUE" and, as represented by Applicant during prosecution, "the English translation of TECHNIK in the mark is TECHNOLOGY."

13. The term "TECHNOLOGY" is defined as and is reasonably known to mean "the practical application of knowledge especially in a particular area" and "a manner of accomplishing a task especially using technical processes, methods, or knowledge."[1]

14. Applicant's "EMERSON TECHNIK" Mark is likely to deceive consumers into believing that Applicant's Goods have been developed and manufactured consistent with the highly respected technology and "techniques" employed by Emerson in the manufacture of its machinery and various machinery parts used in, but not limited to, the food industry.

15. Were Applicant to produce, market, and distribute Applicant's Goods under the challenged EMERSON TECHNIK mark, those products would be promoted and marketed to Emerson's customers for, and would be distributed in the same and/or similar channels of trade as, many of the EMERSON Goods offered under the EMERSON Marks. Accordingly, persons familiar with Opposer's EMERSON Marks are likely to be deceived into purchasing and using Applicant's Goods offered under Applicant's Mark in the mistaken belief that those goods were produced under Emerson's manufacturing techniques and emanate from, or are authorized, sponsored and/or endorsed by, Emerson within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a). As a result, Opposer would be injured by the registration of Applicant's Mark.

16. Emerson has been in existence since at least as early as September 24, 1890.

17. Applicant's Mark falsely suggests a connection between Applicant's Goods and Emerson. EMERSON was and is a well-known name for Opposer of sufficient fame or reputation such that with any use of Applicant's EMERSON TECHNIK mark for Applicant's Goods, a connection with Emerson would be assumed, resulting in injury to Opposer.

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[1] See "TECHNOLOGY" at http://www.merriamwebster.com.

## COUNT III

### Applicant's Mark Will Dilute Opposer's EMERSON Marks

18. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 – 17.

19. Opposer's EMERSON Marks are distinctive and became famous long before Applicant filed the Opposed Application or first used the applied for mark.

20. Applicant's Mark is highly and sufficiently similar to Opposer's EMERSON Marks so as to impair the distinctiveness of Opposer's EMERSON Marks.

21. Applicant's mark is likely to dilute Opposer's EMERSON Marks within the meaning of the Federal Trademark Dilution Action of 1995, as amended by the Trademark Revision Act of 2006, resulting in damage and injury to Opposer's Registered Marks. As a result, Opposer would be injured by the registration of Applicant's Mark.

22. Applicant's EMERSON TECHNIK & Design Mark, as shown in challenged U.S. Trademark Application No. 79/138,965, so closely resembles Opposer's previously registered and used EMERSON Marks as to be likely to cause dilution of the distinctive quality of the famous EMERSON Marks in violation of Section 43(c), 15 U.S.C. §1125(c).

WHEREFORE, Opposer prays that this Opposition be sustained and that registration to Applicant be refused.

Respectfully Submitted,

EMERSON ELECTRIC CO.

Dated: July 21, 2015

By: _____
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**Attorney Docket No. 3165-501007**

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **First Amended Notice of Opposition** has been served on Applicant S.C. Ion Mos S.R.L., by mailing said copy to the correspondence address of record with the Trademark Trial and Appeal Board, on July 21, 2015, via First Class Mail, postage prepaid, to:

Michael D. Fishman
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Timothy J. Comparoni



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