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

Proceeding	91224047
Party	Defendant Schmidt & Bender GmbH & Co. KG
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

3M Company and 3M Deutschland GmbH,)	
)	
Opposers,)	In the Matter of Serial No. 79/149,942
)	
v.)	Opposition No. 91224047
)	
Schmidt & Bender GmbH & Co. KG,)	Mark: PENTA PULSE
)	
Applicant.)	
)	

ANSWER TO NOTICE OF OPPOSITION

Applicant Schmidt & Bender GmbH & Co. KG (“Applicant” or “Schmidt”), by and through its attorneys, Marshall, Gerstein & Borun LLP, hereby responds to the Notice of Opposition filed by Opposers 3M Company & 3M Deutschland GmbH (“Opposers”) on September 23, 2015, as follows:

1. 3M Deutschland is the owner of the marks PENTA and PENTAMIX. 3M Deutschland is the wholly-owned subsidiary of 3M Company and licenses the PENTA and PENTAMIX marks to 3M Company for use in the United States. 3M Deutschland, through its predecessor, adopted and began using the PENTA and PENTAMIX marks for dental compounds and instruments at least as early as 1994 and has continuously used its PENTA and PENTAMIX marks with such products since that time.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Notice of Opposition and therefore denies them.

2. Opposers’ PENTA and PENTAMIX marks are inherently distinctive.

ANSWER: Denied.

3. As a result of Opposers' long use and extensive promotion of the PENTA and PENTAMIX marks, the PENTA and PENTAMIX marks have become distinctive to designate Opposers, to distinguish Opposers and their products from the products of others, and to distinguish the source or origin of Opposers' products. As a result of Opposers' efforts, the purchasing public recognizes and associates the PENTA and PENTAMIX marks with Opposers and their products. Opposers have established valuable goodwill in the PENTA and PENTAMIX marks.

ANSWER: Denied.

4. As a result of Opposers' long use and extensive promotion of the PENTA and PENTAMIX marks, Opposers have acquired valuable common law rights in the PENTA and PENTAMIX marks throughout the United States.

ANSWER: Denied.

5. 3M Deutschland is the owner of the following U.S. registrations for the PENTA and PENTAMIX marks:

REG. NO.	MARK	GOODS/SERVICES
2396973	PENTA	<u>International Class 5</u> : Impression material for dental and dental technical uses, bite checking material for dental and dental technical uses, duplicating material for dental and dental technical uses, embedding material for dental and dental technical uses <u>International Class 10</u> : Preparation dental instruments for mixing, dispensation and application of dental impression materials, bite checking materials
1837793	PENTAMIX	<u>International Class 10</u> : Automatic mixing device for elastomer impression materials as used in the field of dental medicine

The above registrations are valid, subsisting and enforceable. True and correct printouts from the TSDR database for each of these registrations are attached as Exhibit A.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition and therefore denies them.

6. The above registrations are incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Consequently, these registrations are conclusive evidence of the validity of the registered marks and of the registration of the marks, of 3M Deutschland's ownership of the marks, and of 3M Deutschland's exclusive right to use the registered marks in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition and therefore denies them.

7. Applicant Schmidt & Bender GmbH & Co. KG ("Applicant") seeks to register the mark PENTA PULSE ("Applicant's Mark") for the following goods and services: "Optical apparatus and instruments, and structural parts and fittings therefor, namely, optical lenses, optical scanners, optical or telescopic lens sights, optical inspection apparatus, and microscopes; Observation instruments, namely, optical or telescopic lens sights, telescopes, binoculars, and microscopes; Instruments containing eyepieces, namely, optical or telescopic lens sights, telescopes, microscopes, and binoculars; Scientific apparatus and instruments for research in laboratories and as laboratory equipment, namely, diode lasers, solid-state lasers, fiber lasers, and laser scanning microscopes for scientific purposes; Microscopes and electron microscopes; Borescopes; Technoscopes; Spectrometers; Extinction meters and plotters, namely, electronic

plotters, digital plotters, and laser plotters; Photometers; Fluorometers; Stereoscopes; Protective eyepieces; Optical lenses; Semiconductor lenses, namely, optical semiconductor amplifiers; Microscope objectives, namely, lenses for microscopes and lenses for lasers; Optical lenses, prisms, and wedges, namely, optical lenses, prisms for optic purposes, prisms for scientific purposes, and prisms for lasers; Flat optical components, namely, optical mirrors, laser mirrors, filters for optical devices, laser filters, colored glass filters for optical devices, and colored glass filters for lasers; Crystal components and synthetic crystals for optical purposes, namely, optical mirrors, prisms for microscopes, and prisms for lasers; Colorimeters; Optical crystals and optical plummets, namely, optical mirrors, laser mirrors, prisms for microscopes, and prisms for lasers, all the aforesaid goods being for optical purposes and not for medical purposes; Lasers for non-medical use; Microscopes for non-surgical, non-medical purposes; Electron microscopes for non-surgical, non-medical purposes; Diffraction apparatus in the nature of microscopy for non-surgical, non-medical purposes, namely, microscopes and their parts for non-surgical use. Head-mounted magnifiers for non-medical purposes, namely, head-mounted binoculars and head-mounted video magnifiers; Microscope lenses for non-surgical, non-medical purposes,” in International Class 009; “Surgical, medical, dental, and veterinary apparatus and instruments, equipment, and auxiliary devices, namely, surgical apparatus and instruments for medical, dental, or veterinary use, surgical apparatus and instruments for use in ophthalmic surgery, microscopes for surgical operations, dental drills, lasers for surgical operations, lasers for dental cleaning, lasers for use in soft tissue surgery and dermatology, and structural parts and fittings for the aforesaid goods; Optical apparatus, instruments, and equipment for medical purposes, namely, magnifying glasses for medical examination purposes that fit on the user's face in the manner of eyeglasses, endoscopy cameras, and scanning laser ophthalmoscopes; Optical

measuring instruments for medical purposes, namely, optometric instruments for locating the optical center of ophthalmic lenses and optometric instruments for measuring the diameter of ophthalmic lenses; Instruments containing eyepieces for medical purposes, namely, microscopes for surgical operations, endoscopy cameras, and endoscopes; Optical instruments for medical endoscopy, endoscopes, and technoscopes, namely, endoscopy cameras, endoscopes, rigid and flexible medical endoscopes, and technoscopes specifically designed for surgical use; Probes for medical purposes; Optical scanners for medical inspection purposes, namely, optical laser computed tomography (CT) scanners and medical and dental apparatus for dimensional measurement in the nature of a 3-D scanner for human body; Optical temperature measuring instruments for medical inspection purposes, namely, thermometers for medical purposes; Optical tomography apparatus for medical purposes, namely, computed tomography (CT) apparatus for medical use and nuclear spin tomographs for medical purposes; Medical apparatus and instruments for use in positron emission tomography (PET) imaging; Spectrometers for medical purposes. Extinction analysers and plotters for medical purposes, namely, electronic plotters specifically for use with ophthalmoscopes to determine vision loss; Photometers for medical purposes; Fluorometers for medical purposes; Stereoscopes for medical purposes; Lasers for medical purposes; Eyepieces, lenses, semiconductor lenses, optical lenses, prisms, and wedges, all specifically designed for use with ophthalmoscopes and medical microscopes; Flat optical components, namely, surgical mirrors, dental mirrors, filters for optical devices used for medical purposes, namely, magnifying glasses for medical examination purposes that fit on the user's face in the manner of eyeglasses, endoscopy cameras, and scanning laser ophthalmoscopes, laser filters, intraocular lens filters for diagnosing eye disease, and colored glass filters, namely, colored intraocular lens filters for diagnosing eye disease; Optical crystal

components and synthetic optical crystals for medical purposes, namely, intraocular lenses; perimeters, namely, instruments for measuring the diameter of ophthalmic lenses and devices for measuring the size of wounds; Colorimeters, optical crystals, and optical plummets, namely, intraocular lenses and meters for medical use for measuring a person's ability to see colors; All of the aforesaid goods being for medical purposes,” in International Class 010; and “Repair, maintenance and servicing of optical apparatus, equipment and instruments, in particular of optical apparatus, equipment and instruments for medical purposes; repair, maintenance and servicing of lasers and laser systems, apparatus and components therefor in International Class 37 (“Applicant’s Goods”).

ANSWER: Denied. Applicant’s identification in Class 10 was restricted as a result of a partial ceasing of effect of the international registration that forms the basis for Applicant’s Application Serial No. 79/149,942. The restriction was recorded in the International Register on December 3, 2015.

8. Applicant’s application for and use of Applicant’s Mark has not been authorized by Opposers nor is Applicant affiliated with Opposers.

ANSWER: Denied.

9. There is no issue as to priority. Applicant filed its application under Section 66(a) of the Trademark Act, 15 U.S.C. §§ 1141f(a), on February 21, 2014 with a priority date of August 21, 2013. In contrast, 3M Deutschland, through its licensee 3M Company and predecessor-in-interest, has been continuously using the PENTA and PENTAMIX marks in commerce since 1994. Opposers therefore have priority over Applicant with respect to the marks at issue.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Notice of Opposition and therefore denies them.

10. The mark that Applicant seeks to register so resembles the PENTA and PENTAMIX marks as to be likely, when used on or in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to falsely believe that Applicant's Goods offered under Applicant's Mark are sponsored, endorsed, or approved by Opposers, or are in some way affiliated, connected, or associated with Opposers or Opposers' goods offered under the PENTA and PENTAMIX marks.

ANSWER: Denied.

11. On information and belief, Applicant does not have a bona fide intention to use Applicant's Mark in connection with all of the goods and services identified in the Application, and did not have such intent when filing the Application. As such the Application does not satisfy the bona fide intent to use requirement of Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

ANSWER: Denied.

12. Registration of Applicant's Mark would be a source of damage to Opposers because purchasers are likely to attribute the source or sponsorship of Applicant's Goods to Opposers.

ANSWER: Denied.

13. Registration of Applicant's Mark would be a source of damage to Opposers, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposers' long prior use of the PENTA and PENTAMIX marks.

ANSWER: Denied.

AFFIRMATIVE DEFENSES

In further answer to the Notice of Opposition, Applicant asserts that:

1. Applicant's U.S. Application Serial No. 79/149,942 for the mark PENTA PULSE is based on International Registration No. 1210980. The base application for Applicant's international registration is Community Trade Mark No. 012079968. The goods covered under Applicant's International Registration No. 1210980 and Community Trade Mark No. 012079968 are the same or substantially the same goods and services as those covered in Applicant's U.S. Application Serial No. 79/149,942.

2. On or about January 28, 2014, Opposer 3M Germany GmbH filed an opposition against Applicant's Community Trade Mark No. 012079968. The Office for Harmonization in the Internal Market ("OHIM") issued an order partially refusing Applicant's Community Trade Mark No. 012079968 for certain goods in Class 10, namely, "Surgical, medical, dental and veterinary apparatus and instruments, equipment and auxiliary devices, and parts for the aforesaid goods; Optical apparatus, instruments and equipment for medical purposes, optical diagnostic, treatment, detection and analysis apparatus for medical purposes; Probes for medical purposes; all the aforesaid goods being for medical purposes, not for optical purposes." Opposer 3M Germany GmbH did not appeal OHIM's decision allowing Applicant's Community Trade Mark No. 012079968 for the remaining goods set forth in the application.

3. On or about May 9, 2015, OHIM issued a registration for Applicant's Community Trade Mark No. 012079968 for PENTA PULSE for the following goods: "Optical apparatus and instruments, and parts therefor; Observation instruments; Instruments containing eyepieces; Scientific apparatus and instruments for research in laboratories and as laboratory equipment;

Microscopes; Electron microscopes; Bore scopes, Technoscopes; Spectrometers; Extinction meters and plotters; Photometers; Fluorometers; Stereoscopes; Eyepieces, Lenses, Semiconductor lenses, Microscope objectives; Optical lenses, prisms and wedges; Flat optical components, namely mirrors, Filters, Coloured glass filters; Crystal components and synthetic crystals for optical purposes, perimeters; Colorimeters, optical crystals, optical plummets, all the aforesaid goods being for optical purposes, not for medical purposes; Lasers for non-medical use; Microscopes for medical purposes; Electron microscopes for medical purposes; Diffraction apparatus (microscopy) for medical purposes; Head-mounted magnifiers for medical purposes; Microscope lenses for medical purposes” in Class 9; “Optical measuring instruments for medical purposes; Instruments containing eyepieces, for medical purposes; Optical instruments for medical endoscopy, endoscopes, technoscopes; Optical scanners for medical inspection purposes; Optical temperature measuring instruments for medical inspection purposes; Optical tomography apparatus for medical purposes; spectrometers for medical purposes; Extinction analysers and plotters for medical purposes; Photometers for medical purposes; Fluorometers for medical purposes; Stereoscopes for medical purposes; Lasers for medical purposes; Eyepieces, lenses, semiconductor lenses, optical lenses, prisms and wedges for medical purposes; Flat optical components, namely mirrors, Filters, Coloured glass filters; Optical crystal components and synthetic optical crystals for medical purposes, perimeters; Colorimeters, optical crystals, optical plummets; All the aforesaid goods being for medical purposes, not for optical purposes” in Class 10; “Repair, maintenance and servicing of optical apparatus, equipment and instruments, in particular of optical apparatus, equipment and instruments for medical purposes; Repair, maintenance and servicing of lasers and laser systems, apparatus and components therefor” in Class 37.

4. Following the issuance of the registration for Community Trade Mark No. 012079968 for PENTA PULSE, Applicant commenced using the mark in commerce.

5. Opposers did not contest, object to, or otherwise oppose Applicant's registration or use of the PENTA PULSE mark nor did it contest Applicant's filing of U.S. Application Serial No. 79/149,942 for PENTA PULSE until the publication period commenced on May 26, 2015.

6. Opposers' actions indicated that Opposers assented to and encouraged Applicant's registration and use of the PENTA PULSE mark in connection with the goods and services set forth in Community Trade Mark No. 012079968, which are the same or substantially the same as those goods and services covered in Applicant's U.S. Application Serial No. 79/149,942.

7. Applicant understood Opposers' actions (or lack thereof) to mean that Opposers did not object to Applicant's use of the PENTA PULSE mark in connection with the goods and services set forth in Community Trade Mark No. 012079968, and Applicant relied on Opposers' lack of objection when it applied to register the PENTA PULSE mark in the United States.

First Affirmative Defense - Acquiescence

8. Applicant reasserts and incorporates Paragraphs 1 through 7 above as if fully set forth herein.

9. By failing to object to, challenge, or take any other action against Applicant's PENTA PULSE mark, Opposers, by clear implication, represented that they would not assert a right or claim against Applicant regarding its use of the PENTA PULSE mark.

10. The extended delay by Opposers in opposing Applicant's PENTA PULSE mark was not excusable.

11. Opposers' delay has caused Applicant undue prejudice because Applicant relied on Opposers' representation that they would not assert a right or claim against Applicant when it applied to register the PENTA PULSE mark in the United States.

12. Opposers are barred by the doctrine of acquiescence from opposing Applicant's PENTA PULSE mark.

Second Affirmative Defense - Estoppel

13. Applicant reasserts and incorporates Paragraphs 1 through 12 above as if fully set forth herein.

14. Opposers' failure to contest, object to, or otherwise oppose Applicant's registration or use of the PENTA PULSE mark in Europe or Applicant's filing of U.S. Application Serial No. 79/149,942 for PENTA PULSE led Applicant to reasonably infer that Opposers would not assert their rights against Applicant in the United States.

15. Applicant relied on Opposers' conduct when it filed U.S. Application Serial No. 79/149,942 for PENTA PULSE.

16. Applicant would be materially prejudiced if the delayed assertion of Opposers' rights is permitted because it would prevent Applicant's lawful registration and use of the PENTA PULSE mark in the United States.

17. Opposers are barred by the doctrine of estoppel from opposing Applicant's PENTA PULSE mark.

Third Affirmative Defense – Failure to State a Claim

18. Applicant reasserts and incorporates Paragraphs 1 through 17 above as if fully set forth herein.

19. Opposers' Notice of Opposition fails to state a claim upon which relief may be granted.

Respectfully submitted,

Dated: April 1, 2016

/Craig Beaker/

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CERTIFICATE OF SERVICE

The undersigned counsel affirms that the ANSWER TO NOTICE OF OPPOSITION was served on Opposers 3M Company and 3M Deutschland GmbH by first class mail, postage prepaid, to their attorney of record, Katherine K. Madianos, Norton Rose Fulbright US LLP, 98 San Jacinto Boulevard, Suite 1100, Austin, Texas 78701, on the date set forth below.

Dated: April 1, 2016

/Craig Beaker/
Craig A. Beaker