

ESTTA Tracking number: **ESTTA724788**

Filing date: **02/04/2016**

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	Newland Machine Tool Group Inc.
Granted to Date of previous extension	04/06/2016
Address	64 Jardin Drive Suite 3E Vaughan, ON L4K3P3 CANADA
Attorney information	Joshua M. Gerben, Esq. Gerben Law Firm, PLLC 1050 Connecticut Ave NW Suite 500 Washington, DC 20036 UNITED STATES jgerben@gerbenlawfirm.com Phone:202-294-2287

**Applicant Information**

Application No	86514854	Publication date	12/08/2015
Opposition Filing Date	02/04/2016	Opposition Period Ends	04/06/2016
Applicant	Chien, Ju- Chuan 5F., No.20, Ln. 45, Guangfu S. Rd., Songshan Dist., Taipei, TAIWAN		

**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: MACHINE TOOLS, NAMELY, HORIZONTAL BORING, DRILLING, AND MILLING MACHINES, VERTICAL BORING MILLS, PRODUCTION MILLING MACHINES, ELECTRIC PLANERS AND PLANER MILLERS, AND VERTICAL TURRET LATHES; HYDRAULIC PUMPS; HEAT EXCHANGERS BEING PARTS OF MACHINES; COOLING MACHINES; GEAR DEVICES, NAMELY, GEAR DRIVES, FOR MACHINES; ELECTRIC ARC CUTTING APPARATUSES
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)
Other	Application void ab initio for lack of bona fide intent to use

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application No.	86539623	Application Date	02/19/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NEWLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 2009/05/00 First Use In Commerce: 2009/05/00 Boring machines; Lathes; Power operated metalworking machine tools, namely, turning tools; Power-operated tools, namely, grinders Class 037. First use: First Use: 2009/05/00 First Use In Commerce: 2009/05/00 Repair or maintenance of metalworking machines and tools Class 042. First use: First Use: 2009/05/00 First Use In Commerce: 2009/05/00 Machine part design services		

Attachments	86539623#TMSN.png( bytes ) Newland Opposition of Serial No 86539623_v FEB 4.pdf(128859 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	/Joshua M. Gerben/
Name	Joshua M. Gerben, Esq.
Date	02/04/2016

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

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Newland Machine Tool Group Inc.

Opposer,

v.

Ju- Chuan Chien

Applicant,

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Opposition No.: \_\_\_\_\_

Mark: NEWLAND

Application Serial No: 86/514,854

**NOTICE OF OPPOSITION**

Opposer Newland Machine Tool Group Inc. (hereinafter referred to as “Opposer”), a Canadian corporation, believes that it will be damaged by the registration of the mark shown in Application Serial No. 86/514,854 and hereby opposes this application. This application was filed by Ju- Chuan Chien, a Taiwanese citizen (hereinafter referred to as “Applicant”), and was published in the Official Gazette on December 8, 2015.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer is the owner of the NEWLAND mark for machine tools, machine part design services, and repair and maintenance services.
2. The Applicant filed a trademark application on January 26, 2015 under a §1(b) Intent-to-Use filing basis for NEWLAND for: “machine tools, namely, horizontal boring, drilling, and milling machines, vertical boring mills, production milling machines, electric planers and planer millers, and vertical turret lathes; hydraulic pumps; heat exchangers being parts of machines; cooling machines; gear devices, namely, gear drives, for machines; electric arc cutting apparatuses” in International Class 7 (“Applicant’s Mark”) and was assigned Serial Number

86/514854 (the “Applicant’s Application”). On March 24, 2015, Applicant submitted a signed sworn statement, that:

“the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory’s knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

3. On February 19, 2015, Opposer filed a trademark application for its NEWLAND mark for “Boring machines; Lathes; Power operated metalworking machine tools, namely, turning tools; Power-operated tools, namely, grinders” in International Class 7, “Repair or maintenance of metalworking machines and tools” in International Class 37 and “machine part design services” in International Class 42 (“Opposer’s Goods and Services”) and was assigned serial no. 86/539,623 (“Opposer’s Application”).

4. On May 28, 2015, the Examining Attorney examining Opposer’s Application suspended the application on the basis of a likelihood of confusion with Applicant’s Application. Opposer believes that, should Applicant’s Application proceed to registration, Opposer’s Application will be denied based on the resulting registration.

**COUNT 1: PRIORITY AND LIKELIHOOD OF CONFUSION**

1. Applicant’s Application is for NEWLAND, a mark identical to Opposer’s NEWLAND mark.

2. Applicant’s Application is for “machine tools, namely, horizontal boring, drilling, and milling machines, vertical boring mills, production milling machines, electric planers and

planer millers, and vertical turret lathes; hydraulic pumps; heat exchangers being parts of machines; cooling machines; gear devices, namely, gear drives, for machines; electric arc cutting apparatuses” in International Class 7, which is identical and complementary to Opposer’s Goods and Services, namely, “boring machines; Lathes; Power operated metalworking machine tools, namely, turning tools; power-operated tools, namely, grinders” in International Class 7, “repair or maintenance of metalworking machines and tools” in International Class 37 and “machine part design services” in International Class 42.

3. Opposer has sold and rendered Opposer’s Goods and Services in the United States under the NEWLAND mark since at least as early as 2010, almost five years earlier than the filing date of Applicant’s Application.

4. Opposer has offered Opposer’s Goods and Services under the NEWLAND mark in the United States since at least as early as 2010 and has built up substantial goodwill and customer recognition in the mark in the United States.

5. Upon information and belief, Applicant had actual notice of Opposer’s NEWLAND mark through Opposer’s business partners and sought to unfairly capitalize on Opposer’s substantial goodwill in its mark.

6. Opposer’s mark is symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in sales and promotion of Opposer’s Goods and Services.

7. Therefore, Opposer has priority on the NEWLAND mark based on Opposer’s first use of the NEWLAND mark in the United States prior to the filing date of Applicant’s Application.

8. In view of the fact that the parties' respective marks are identical, and that the goods and services are nearly identical, it is alleged that Applicant's mark so resembles Opposer's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive, and therefore, should be refused under Section 2(d) of the Lanham Act.

9. If Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to Opposer.

10. In view of the above, Applicant is not entitled to federal registration of its alleged NEWLAND mark as Opposer has priority based on prior use of the NEWLAND mark in commerce in connection with highly-related, if not identical, goods and services.

**COUNT 2: APPLICATION VOID AB INITIO FOR  
LACK OF BONA FIDE INTENT TO USE TRADEMARK**

11. Upon information and belief, Applicant had (and has) no *bona fide* intent to use the NEWLAND mark when it filed the Applicant's Application.

12. Upon information and belief, Applicant has taken no business activities with respect to Applicant's Mark.

13. Upon information and belief, Applicant has engaged in no business planning with respect to Applicant's Mark.

14. Upon information and belief, Applicant has no documents that would support its alleged *bona fide* intent to use Applicant's Mark in commerce.

15. Upon information and belief, Applicant knew of Opposer's use of the NEWLAND mark through its United States operations and through Opposer's Taiwanese

business partners and attempted to “squat” on the trademark application in order to prevent Opposer from obtaining a registration in the United States.

16. In view of the fact that Applicant had no bona fide intent to use the NEWLAND mark when it filed its Application, the Applicant’s Application is *void ab initio* and therefore should be refused registration under the Lanham Act.

17. If Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to Opposer.

**COUNT 3: FRAUD ON THE UNITED STATES**  
**PATENT AND TRADEMARK OFFICE**

18. Upon information and belief, Opposer alleges that Applicant’s Application was approved for publication based on a fraudulent sworn statement filed on March 24, 2015, in which it was stated that Applicant had “a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the goods/services in the application” and that it “believes that to the best of the signatory’s knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.” Upon information and belief, said statement was false. The true facts are that Applicant knew about Opposer’s use of the NEWLAND mark on Opposer’s Goods and Services and is simply attempting to prevent Opposer from being able to register its trademark. Applicant did not have a *bona fide* intent to use Applicant’s Mark on any of Applicant’s goods. Said statement was made by an authorized agent of Applicant with the knowledge that said statement was false. Said false

statement was made with the intent to induce the authorized agents of the United States Patent and Trademark Office to grant registration, and, reasonably relying on said false statement, the United States Patent and Trademark Office published Applicant's Application to the Original Gazette.

19. Upon information and belief, Applicant filed Applicant's Application only after learning about the unregistered status of Opposer's NEWLAND mark through Opposer's business partners.

20. In view of the above, Applicant is not entitled to federal registration of its alleged NEWLAND mark because Applicant's Application is *void ab initio* for lack of a *bona fide* intent-to-use the mark in commerce and because Applicant secured publication of Applicant's Application through knowingly perpetrating fraud on the USPTO by signing false affidavits in connection with Applicant's Application.

21. By reason of all the foregoing, Opposer will be gravely damaged by the registration of Applicant's mark.

**WHEREFORE**, by its undersigned attorney, Newland Machine Tool Group Inc. respectfully requests that this Notice of Opposition be sustained and that registration of the mark NEWLAND, Serial No. 86/514,854, be refused.

Dated: February 4, 2016

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that on February 4, 2016, a true and correct copy of the foregoing Opposer's Notice of Opposition has being served by certified mail, return receipt requested on Opposer as shown in the correspondence record in the Office, as follows:

RAPHAEL GUTIÉRREZ  
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106 Starvale Ln  
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Dated: February 4, 2016



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