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

Proceeding	92051149
Party	Defendant Michael D. Leveille
Correspondence Address	Peter Nils Baylor Nutter McClennen & Fish 155 Seaport Blvd, World Trade Center West Boston, MA 02210 UNITED STATES pbaylor@nutter.com
Submission	Opposition/Response to Motion
Filer's Name	Peter Nils Baylor
Filer's e-mail	pbaylor@nutter.com, hrepicky@nutter.com
Signature	/s/ Peter Nils Baylor
Date	12/30/2009
Attachments	Atwater Opposition.pdf ( 20 pages )(574863 bytes )

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

_____ )	
ATWATER KENT MANUFACTURING )	
COMPANY, )	
)	
Petitioner, )	
)	
v. )	Cancellation No. 92,051,149
)	
MICHAEL D. LEVEILLEE d/b/a )	
J.F. SULLIVAN CO. & ATWATER )	Reg. No. 3,366,780
KENT MANUFACTURING COMPANY, )	
)	
Respondent. )	
_____ )	

**OPPOSITION TO FIRST MOTION TO  
AMEND PETITION FOR CANCELLATION**

Respondent, Michael D. Leveillee d/b/a J.F. Sullivan Co. and Atwater Kent Manufacturing Company (“Respondent”), opposes, for the reasons set forth below, the First Motion to Amend Petition for Cancellation (the “Motion to Amend”) filed December 15, 2009, and served by first-class mail, by Atwater Kent Manufacturing Company (“Petitioner”).<sup>1</sup>

ARGUMENT

Applicable rules

“Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States District Court.” Trademark Rule 2.115, 37 C.F.R. 2.115. “[P]rocedure . . . in *inter partes* proceedings shall be governed by the Federal

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<sup>1</sup> Petitioner concludes its Motion to Amend with a misrepresentation when it states, “Respondent has denied Petitioner’s request for consent to amend the Petition.” In fact, Respondent did not deny Petitioner’s request; rather, on the same day the request was received (12/14/09), Respondent reasonably asked to see a copy of the proposed Amended Petition to which Respondent was being asked to consent. It was *this* request by Respondent that was denied, or rather, ignored. Petitioner made no response to this request and filed its Motion to Amend the next day.

Rules of Civil Procedure.” Trademark Rule 2.116, 37 C.F.R. 2.116. *The Scotch Whisky Association v. United States Distilled Products Company*, 952 F.2d 1317, 1319 (Fed. Cir. 1991).

Under Fed. R. Civ. P. 15, a party may amend its pleadings once as a matter of course at any time before a responsive pleading is filed. Otherwise, a party must receive written consent of the adverse party or leave of court (here, the Board) before it can further amend its complaint (here, the petition). Fed. R. Civ. P. 15(a). Thus, there is no automatic right for Petitioner to amend its petition. While leave to amend pleadings “shall be freely given when justice so requires,” Fed. R. Civ. P. 15(a), such leave is not to be given perfunctorily. The decision is within the discretion of the Board.

When leave to amend may be denied

Grounds for denying leave to amend were enunciated in *Foman v. Davis*, 371 U.S. 178 (1962). The Court’s non-exclusive enumeration includes “undue delay, bad faith or dilatory motive . . . undue prejudice to the opposing party . . . futility of amendment, etc.” *Id.* at 182.

The situation here

a. Undue (unexplained) delay

Neither the Motion to Amend nor the Declaration of Jason M. Drangel [Petitioner’s attorney] in Support of Motion to Amend (the “Declaration”) discloses anything of substance about the new allegation Petitioner seeks to add to its petition. Neither the Motion to Amend nor the Declaration attempts to explain how the new allegation differs from the allegations of the original Petition. The new allegation (proposed to become a new paragraph 25 in the Petition) is described only at the highest level of generality, Petitioner asserting without any supporting specifics that the new allegation is prompted by something recently produced by

Respondent in the court of discovery. Apart from the generality, Petitioner relies on the law's indulgent, but not universally permissive, attitude toward the amendment of pleadings.

Petitioner's Motion to Amend should not be indulged. Proposed new paragraph 25 is a futile (see below) cumulative re-hash of original paragraph 11, including its reference to Respondent's web site.<sup>2</sup>

"[C]ourts have denied leave to amend when the moving party knew about the facts on which the proposed amendment was based but omitted the necessary allegations from the original pleading." Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d § 1488 at 688.

Petitioner concedes that this is its situation – facts known but unpled – when it accurately describes its omitted 14(3) claim and its pled false suggestion claim as "intertwined, in that they rely on the same assertion of fact," quoting from *Stanfield v. Osborne Industries, Inc.*, 1999 TTAB Lexis 334 (TTAB 1999), which suggests, if anything, that intertwined claims based on the same facts should be pled together. But Petitioner's citation of *Stanfield* is not only inapposite, it is improper, as the case report is clearly legended: "OPINION: THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB."

Petitioner has not discovered any new facts; instead it has simply paged through the Lanham Act, from Section 2 to Section 14, and now attempts to add belatedly a claim based on facts in its possession at the time it filed the petition. Petitioner offers no explanation for its tardy action. It has simply thought of a new claim it wants to assert against Respondent. As one court has aptly put it, there is good reason to deny a motion to amend where there is no

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<sup>2</sup> Petitioner seeks to portray the (admittedly somewhat inartful) home page of Respondent's web site as an attempt deliberately to "pass off" products, when in fact petitioner's alleged predecessor ceased production of such products in 1928. Respondent's web site is being clarified.

justification for the delay “beyond counsel for the moving party having had a late dawning idea.” *DiVenuti v. Reardon*, 37 Mass. App. Ct. 73, 77-78 (1994).

b. Futility of amendment

Respondent’s mark is registered for

generators, namely, electric generators; starters for motors and engines; and ignition coils, in Class 7

and

condensers; fuel level gauges; oil level sensors; fuel tank sending units in the nature of float-type resistance-based fuel tank level sending units and hydrostatic sending units, in Class 9.

Petitioner has admitted in the course of discovery<sup>3</sup> that its alleged predecessor ceased manufacturing “auto ignition, starting and lighting systems, etc.” in 1928, and that it or its alleged predecessor has since 1936 confined its services to “investment company--securities, real estate, commodities” and “substantial contributor to Atwater Kent Foundation, Inc.” Hence, there is only one source -- Respondent itself -- of ATWATER KENT goods of the kind for which Respondent holds its registration. Respondent is not misrepresenting anything when it says it is the source of its own goods.

In *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624 (Fed. Cir. 1984), the applicant had prevailed against the opposer’s § 2(d) claim that applicant’s mark was “likely . . . to cause confusion, or to cause mistake, or to deceive . . .”, 739 F.2d at 625, whereupon the opposer had sought unsuccessfully to amend its “pleadings under § 2(a) to substitute an allegation of likelihood of confusion or its equivalent for the dismissed pleading of deception.” 739 F.2d at

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<sup>3</sup> Petitioner’s Response to Interrogatory No. 4, Response to Interrogatory No. 5, and Response to Interrogatory No. 6 in Petitioner’s Response to Respondent’s First Set of Interrogatories, dated December 8, 2009, attached hereto as Exhibit A.

628. The Federal Circuit found no error: “[W]e agree that the proposed amendment would serve no purpose.” *Id.*

#### No passing off

Petitioner’s proposed new paragraph 25 of an amended petition asserts that “Respondent has deliberately sought *to pass off* its goods as those of Petitioner. . . .” (emphasis added).

The term “palming off” and “passing off” are “synonym[s].” J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition, 4th ed. (2009) (hereinafter “*McCarthy on Trademarks*”) § 25:1 at 25-5.

Professor McCarthy says “passing off” (as a matter of defendant’s subjective mental intent) should be distinguished from “likelihood of confusion” (as a matter of consumers’ subjective reactions when faced with similar marks) and explains how to do this:

Palming off is an attempt to make the purchaser believe that the product of the subsequent entrant is that of his better known *competitor*.

*McCarthy on Trademarks*, § 25:2 at 25-9 (citation omitted; emphasis added).

Thus, passing, or palming, off requires competition, and there isn’t any between Petitioner and Respondent. Petitioner or its alleged predecessor has not made an auto part since 1928.<sup>4</sup> Hence Petitioner’s proposed amendment “would serve no useful purpose.” *Pure Gold, Inc.*, 739 F.2d at 628.

#### Denial for the sake of completeness

Respondent of course categorically denies the allegation of proposed new paragraph 25, just as it categorically denied the virtually identical allegations of paragraph 11 of the original Petition.

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<sup>4</sup> See *supra* note 3 and accompanying text.

CONCLUSION

For the above reasons, Petitioner's First Motion to Amend Petition for Cancellation should be denied.

MICHAEL D. LEVEILLEE d/b/a  
J.F. SULLIVAN & CO. & ATWATER KENT  
MANUFACTURING COMPANY,  
Respondent

By his attorneys,

December 30, 2009



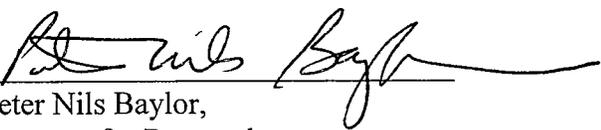
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Peter Nils Baylor  
NUTTER, McCLENNEN & FISH, LLP  
Seaport West  
155 Seaport Boulevard  
Boston, MA 02210-2604  
(617) 439-2390  
e-mail: pbaylor@nutter.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that he this day, by first class mail, postage prepaid, served this Opposition to First Motion to Amend Petition for Cancellations on Petitioner's attorney, Jason M. Drangel, Esq., Epstein Drangel Bazerman & James, LLP, Lincoln Building, Suite 820, 60 E. 42d Street, New York, NY 10165.

December 30, 2009

  
Peter Nils Baylor,  
attorney for Respondent

1885562.1

**EXHIBIT A**  
**to**  
**Opposition to First Motion to Amend Petition for Cancellation**  
**Cancellation No. 92,051,149**

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

In the Matter of Reg. 3,366,870  
for the Trademark ATWATER KENT (Cls. 7 & 9), in  
the name of Michael D. Leveillee  
d/b/a J.F. Sullivan Co. &  
Atwater Kent Manufacturing Company

-----	-X	
ATWATER KENT MANUFACTURING COMPANY	:	
	:	
Petitioner,	:	Cancellation No. 92051149
v.	:	
	:	
MICHAEL D. LEVEILLEE D/B/A J.F. SULLIVAN CO. & ATWATER KENT MANUFACTURING COMPANY	:	
Respondent.	:	
-----	-X	

**RESPONSE TO RESPONDENT'S FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Atwater Kent Manufacturing Company, Petition (hereinafter "Petitioner") hereby responds to Respondent, Michael D. Leveillee d/b/a J.F. Sullivan Co. & Atwater Kent Manufacturing Company (hereinafter "Respondent") First Set of Interrogatories.

**General Objections**

Petitioner hereby asserts the following General Objections and incorporates its General Objections in each of the individual responses set forth below:

1. Petitioner objects to each definition, instruction, and Interrogatory in the First Set of Interrogatories to the extent it imposes obligations on Petitioner beyond those required by the Federal Rules of Civil Procedure.

2. Petitioner objects to each definition, instruction, and Interrogatory to the extent it seeks information protected by the attorney-client privilege, the work-product doctrine, or any other privilege or evidentiary principle available under federal or state statutory, constitutional, or common law. Nothing in Petitioner 's responses to Interrogatories is intended as, or shall in any way be deemed, a waiver of any attorney-client privilege, work-product doctrine, or any other privilege or evidentiary principle available under federal or state statutory, constitutional, or common law.

3. Petitioner objects to each definition, instruction, and Interrogatory to the extent that it purports to require Petitioner to disclose confidential or proprietary business information concerning itself or a third party or the content of any part of any agreement between Petitioner and a third party which by its terms may not be disclosed by Petitioner. Petitioner will not disclose any such information absent the consent of the third party in question or pursuant to the terms of the Protective Order entered in this action.

4. Petitioner objects to each definition, instruction, and Interrogatory to the extent that it seeks information that is not in the possession, custody, or control of Petitioner.

5. Petitioner objects to each definition, instruction, and Interrogatory as being unduly burdensome to the extent it seeks information that is a matter of public record or that is equally available to Respondent from other sources.

6. Petitioner objects to each definition, instruction, and Interrogatory to the extent that it seeks information that could be obtained more efficiently through other methods of discovery.

7. Petitioner objects to each definition, instruction, and Interrogatory to the extent it asks for duplicative or cumulative information.

8. Petitioner objects to each definition, instruction, and Interrogatory as unduly burdensome insofar as it may be construed to require Petitioner to create or compile documents or things.

9. Petitioner objects to each definition, instruction, and Interrogatory to the extent that it requires interpretation and application of the legal conclusions and contentions of the parties.

10. Petitioner objects to each definition, instruction, and Interrogatory to the extent that it contains any factual or legal misrepresentation.

11. Petitioner objects to each definition, instruction, and Interrogatory to the extent that it calls for information that is not now known by or reasonably available from sources within the custody or control of Petitioner. Petitioner's search for information is ongoing. Petitioner reserves the right to rely on facts, documents, or other evidence that may develop or come to Petitioner's attention at a later time, or that are produced by the other party in or third parties to this action. Petitioner's responses are based on information presently known to KRUSH and are set forth without prejudice to Petitioner's right to assert additional objections and/or provide supplemental responses should Petitioner discover additional grounds for objections or additional documents or information. Petitioner reserves the right to supplement or amend its responses to the Interrogatories at any time prior to the trial(s) of this proceeding. Any statement made herein is not an admission of any factual or legal contention contained in any Interrogatory.

12. Petitioner's responses and objections are made solely for the purpose of discovery in this action. Nothing herein is intended to waive the following objections, which are expressly reserved: all objections as to competency, relevancy, materiality, and admissibility of the subject matter of the Interrogatories; all objections as to vagueness, ambiguity, or undue burden; all

objections to the use of any information, document or things identified or provided in response to these Interrogatories; all objections to any request for further responses to these or other discovery requests; all objections to the privileged or work-product nature of any information, document or thing; and any other objections which would require or permit the exclusion from evidence of any information, document or things provided in response to these Interrogatories, all of which objections are reserved and may be interposed at the time of trial.

Subject to and without waiver of these General Objections, Petitioner responds to the Interrogatories as follows:

## **INTERROGATORIES**

### **INTERROGATORY NO. 1**

Identify: (a) the address of Petitioner's principal place of business; (b) its place of incorporation; and (c) the addresses of all Petitioner's offices or related companies in the United States.

### **RESPONSE TO INTERROGATORY NO. 1**

- (a). 101 Springer Building  
3411 Silverside Road  
Wilmington, DE 19810
- (b). Delaware.
- (c). None other than above.

### **INTERROGATORY NO. 2**

Identify the names and business addresses of all of Petition's officers, directors, or managers.

### **RESPONSE TO INTERROGATORY NO. 2**

Officers:	James R. Weaver	President/Director
	Geralyn N. Flora	Treasurer/Secretary
	Joanne Steppi	Assistant Secretary

James L. Van Alen, II            Director  
E. Hewlett Kent                 Director

Address on all of the above: 101 Springer Building  
3411 Silverside Road  
Wilmington, DE 19810

**INTERROGATORY NO. 3**

If you contend that there is a relationship between the Petitioner and a Pennsylvania company known as ATWATER KENT MANUFACTURING COMPANY (which closed its factory in 1936), please describe the relationship between the two companies and state the basis for the contention, including in your answer the identification of:

- A. every document that supports the contention;
- B. every communication that supports the contention;
- C. every act or omission to act (nature, time, and place) of any person (name and address)

that supports the contention; and

- D. any other fact that forms the basis of the cancellation contention.

**RESPONSE TO INTERROGATORY NO. 3**

Petitioner will produce copies of the following documents in the ordinary course of its production of documents and things:

-Agreement of Sale of Business - Purchase by Atwater Kent Manufacturing Company from Atwater Kent Manufacturing Works signed September 4, 1919.

-Certificate of Incorporation - The Atwater Kent Manufacturing Company, incorporated September 1919 in the State of Pennsylvania.

-Certificate of Incorporation - Kent Company, a wholly owned subsidiary of Atwater Kent Manufacturing Company, formed on April 22, 1972

-Certificate of Ownership and Mergers, Atwater Kent Manufacturing Company (DE), effective 12:01 AM on January 1, 2007. Atwater Kent Manufacturing Co, (PA) was merged into Kent Company (DE)

**INTERROGATORY NO. 4**

Describe the nature of any goods manufactured by or on behalf of Petitioner and their date(s) of manufacture.

**RESPONSE TO INTERROGATORY NO. 4**

1902-1916	home telephones and voltmeters
1904-1928	auto ignition, starting and lighting systems, etc.
1916-1918	fire control instruments for gunnery
1921 - 1935	radio receiving sets and parts
1935 - 1936	electric refrigerators

**INTERROGATORY NO. 5**

Describe the nature of any services provided by Petitioner or by a licensee of Petitioner and the dates when any such services were provided.

**RESPONSE TO INTERROGATORY NO. 5**

1902-1936	manufacturer. See Response to Interrogatory No. 4.
1936 - present	investment company - securities, real estate, commodities
1945 - 1950	substantial contributor to Atwater Kent Foundation, Inc.

**INTERROGATORY NO. 6**

Describe in detail the nature of any licenses by Petitioner or related companies of the mark "ATWATER KENT" including the name and addresses of said licensee(s), the dates of any such licenses, the goods or services provided by said licensees under the name ATWATER KENT and their dates of first sale or other introduction into commerce, from 1936 to the present.

**RESPONSE TO INTERROGATORY NO. 6**

No licenses to third parties that petitioner is aware of.

**INTERROGATORY NO. 7**

Describe any failed attempts by petitioner to license ATWATER KENT including the names and addresses of potential licensees and the dates of any related negotiations.

**RESPONSE TO INTERROGATORY NO. 7**

None that Petitioner is aware of.

**INTERROGATORY NO. 8**

Describe why, since 1919, Petitioner has failed to obtain or even apply for a Federal Trademark Registration for the mark ATWATER KENT.

**RESPONSE TO INTERROGATORY NO. 8**

Petitioner has not failed to obtain or apply for a Federal registration.

**INTERROGATORY NO. 9**

Describe the nature of the relationship between Petitioner and any of the following:

- A. <http://www.atwater-kent.net/>
- B. <http://www.atwaterkent.info/>
- C. <http://www.atwaterkentradio.com/>
- D. DJ Equipment Kent(<http://hubpages.com/hub/djequipmentkent>)

**RESPONSE TO INTERROGATORY NO. 9**

There is no relationship.

**INTERROGATORY NO. 10**

Were any surveys, marketing studies, focus group studies, or polls ("Surveys") conducted or commissioned by Petitioner relating to the mark ATWATER KENT? If so, please state what the

results were and identify who was involved. In addition, please identify all documents constituting, evidencing, or referring to the Surveys or the Survey results.

**RESPONSE TO INTERROGATORY NO. 10**

None that Petitioner is aware of.

**INTERROGATORY NO. 11**

Describe any instances of actual confusion between Petitioner and Respondent of which Petitioner is aware.

**RESPONSE TO INTERROGATORY NO. 11**

None that Petitioner is aware of.

**INTERROGATORY NO. 12**

State any and each statutory basis under which Petitioner is seeking cancellation of Respondent's Mark.

**RESPONSE TO INTERROGATORY NO. 12**

See Petition for Cancellation. This is a contention interrogatory. The facts supporting this claim will be accumulated during the course of this action and presented at the end of discovery in a supplemental interrogatory response or at trial.

**INTERROGATORY NO. 13**

State the basis for the contention that Petitioner is entitled to an award of cancellation, including in your answer the identification of:

- A. every document that supports the cancellation contention;
- B. every communication that supports the cancellation contention;

C. every act or omission to act (nature, time, and place) of any person (name and address) that supports the cancellation contention; and

D. any other fact that forms the basis of the cancellation contention.

**RESPONSE TO INTERROGATORY NO. 13**

This is a contention interrogatory. The facts supporting this claim will be accumulated during the course of this action and presented at the end of discovery in a supplemental interrogatory response or at trial.

**INTERROGATORY NO. 14**

Identify any period of time greater than three years from 1936 to the present in which no product was produced or service was provided by Petitioner or Petitioner's licensee under the mark ATWATER KENT

**RESPONSE TO INTERROGATORY NO. 14**

None.

**INTERROGATORY NO. 15**

Identify each Person, with direct knowledge of Petitioner's licensing, use, or manufacturing under the mark ATWATER KENT.

**RESPONSE TO INTERROGATORY NO. 15**

James R. Weaver and E. Hewlett Kent.

**INTERROGATORY NO. 16**

Identify each Person, other than counsel, who assisted Respondent in preparing answers to these

interrogatories, specifying each answer for which such assistance was given by such person.

**RESPONSE TO INTERROGATORY NO. 16**

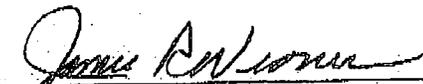
James R. Weaver and E. Hewlett Kent.

**ATWATER KENT MANUFACTURING COMPANY**

Dated:

12/8/09

By:

  
Name: James R. Weaver  
Title: President/Director

As to Objections:

**EPSTEIN DRANGEL  
BAZERMAN & JAMES, LLP**  
*Attorneys for Petitioner*

Dated:

New York, New York

By:

  
Jason M. Drangel  
Lincoln Building  
60 East 42<sup>nd</sup> Street, Suite 820  
New York, New York 10165  
Tel.: (212) 292-5390  
Fax: (212) 292-5391

interrogatories, specifying each answer for which such assistance was given by such person.

**RESPONSE TO INTERROGATORY NO. 16**

James R. Weaver and E. Hewlett Kent.

**ATWATER KENT MANUFACTURING COMPANY**

Dated:

By: \_\_\_\_\_  
Name: James R. Weaver  
Title: President/Director

As to Objections:

Dated: 12/8/03  
New York, New York

**EPSTEIN DRANGEL  
BAZEMAN & JAMES, LLP**  
*Attorneys for Petitioner*

By: \_\_\_\_\_  
Jason M. Drangel  
Lincoln Building  
60 East 42<sup>nd</sup> Street, Suite 820  
New York, New York 10165  
Tel.: (212) 292-5390  
Fax: (212) 292-5391

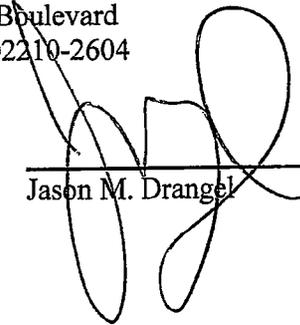
**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **RESPONSE TO RESPONDENT'S FIRST SET OF INTERROGATORIES** was served by electronic mail, on this 27 day of December, 2009, upon Registrant's counsel at:

Peter Nils Baylor  
George A. Xixis  
NUTTER, McCLENNEN & FISH, LLP  
World Trade Center West  
155 Seaport Boulevard  
Boston, MA 02210-2604

New York, New York

By:

  
\_\_\_\_\_  
Jason M. Drangel