ESTTA Tracking number: **ESTTA689755**
Filing date: **08/14/2015**

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

Proceeding	92062025
Party	Plaintiff Simmons Engineering Corporation d/b/a Simmons Knife & Saw Company
Correspondence Address	BRIE A CRAWFORD CRAWFORD INTELLECTUAL PROPERTY LAW LLC 1095 PINGREE ROAD , SUITE 204 CRYSTAL LAKE, IL 60014 UNITED STATES briecrawford@crawfordpatents.com
Submission	Other Motions/Papers
Filer's Name	Brie A. Crawford
Filer's e-mail	briecrawford@crawfordpatents.com
Signature	/Brie A. Crawford/
Date	08/14/2015
Attachments	Simturn 1.pdf(5737213 bytes) Simturn 2.pdf(4534403 bytes) COS 2.pdf(507792 bytes)

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

In the matter of Registration No. 3,835,514
Mark: SIMTURN
Registered: August 17, 2010

PETITION FOR CANCELLATION

Simmons Engineering Corporation, d/b/a Simmons Knife & Saw Company,	)	
Petitioner	)	
VS.	)	Cancellation No. _____
Simtek Prazisionswerkzeuge GmbH	)	
Respondent.	)	

PETITION FOR CANCELLATION

Petitioner, Simmons Engineering Corporation, d/b/a Simmons Knife & Saw Company, believes that it is, and will continue to be, damaged by United States Trademark Registration Number 3,835,514 (the '514 Registration), a copy of each of which is attached as Exhibit A, and hereby petitions to cancel the same under 15 U.S.C. § 1064. Petitioner avers the grounds for cancellation are as follows:

The Parties

1. Simmons Engineering Corporation, d/b/a Simmons Knife & Saw Company (hereinafter "Simmons") is an Illinois corporation having its principal place of business at 400 Regency Drive, Glendale Heights, Illinois 60139 (formerly 1200 S. Willis Avenue, Wheeling, Illinois 60090).

2. The current owner of the '514 Registration is Simtek Prazisionswerkzeuge GmbH ("Simtek"), a German company having its principal place of business at Richard-Burkhardt-Strasse 11, Mossingen 72116 Germany.

Background and Statement of Facts

3. Simmons has been a supplier of unique blades for industrial use since 1946. Simmons manufactures and sells a wide variety of blades for use in industries such as industrial fabrication, manufacturing, and food preparation. Simmons also sells related products, such as blade lubricant, blade tension meters, and grinding wheels.

4. Simmons owns, *inter alia*, two United States Trademark Registrations for SIMMONS. The first is Registration Number 4,591,970 (the '970 Registration), a standard character mark, SIMMONS, for "*Blades for power saws; Machine parts, namely, blades; Power saw blades*" in International Class 007. The '970 Registration issued on August 26, 2014, based on a first use in commerce on December 1, 1946. A copy of this registration is included in Exhibit B.

5. Simmons's second SIMMONS mark is Registration Number 4,636,974 (the '974 Registration), a design-plus-words mark for "*Blades for power saws; Machine parts, namely, blades; Power saw blades*" in International Class 007. The '974 Registration issued on November 11, 2014, based on a first use in commerce on December 1, 1993. A copy of this registration is included in Exhibit B.

6. Simmons also owns a registered trademark for SIMCOR, Registration Number 4,563,989 (the '989 Registration), a standard character mark for "*Blades for power saws; Machine parts, namely, blades; Power saw blades*" in International Class 007. The '989 Registration issued on July 8, 2014, based on a first use in commerce on December 1, 1993. A copy of this registration is included in Exhibit B.

7. Moreover, Simmons has common-law rights in SIMCUT. Currently, Simmons sells multiple types of blades for industrial food slicers under the name SIMCUT, and has done so since at least June 14, 2006. These blades include Simcut Butcher Blades and the Simcut Renegade. Simmons also uses the name SIMCUT in connection with sales of a silicone lubricant, called Simcut 1200 Silicone Lubricant, for use with blades and cutting guides; Simmons has sold this lubricant since at least November 13, 2003.

8. Additionally, Simmons first used SIMCUT on cutting machines in September of 1990. From 1990 to 1992, Simmons sold metal cutting machines, such as horizontal band saws and circular aluminum cutting machines, under the name SIMCUT.

9. Simmons has exhibited its products at tradeshows across the Unites States, including Process Expo in Las Vegas, Nevada; PACKEXPO in Chicago, Illinois; and the International Production & Processing Expo in Atlanta, Georgia.

10. Additionally, Simmons registered the domain name www.simcut.com on August 25, 1997. Since that time, Simmons has used its domain name to actively promote its goods.

11. Simmons has a pending United States trademark application for the standard character mark SIMCUT, namely United States Trademark Application Serial Number 86/724,130, for "*All purpose lubricants; Industrial lubricants; Lubricants for industrial machinery; Lubricating oils; Premium specialty industrial lubricants*" in International Class 004; and for "*Blades for power saws; Blades for power tools; Machine parts, namely, blades; Power saw blades; Power tool parts, namely, endless band or belt type, band saw blades*" in International Class 007.

12. On August 15, 2007, Simtek filed an application to register the mark SIMTURN (the "Simturn Mark") as a standard character mark for "*Machines, namely, cutting machines, boring machines, drilling machines, pneumatic hammers, industrial machine presses, polishing*

machines for polishing wood, ceramics, rice and barley; saws, namely, chain saws, table saws, jig saws, and circular saws; machine tools, namely, metalworking machine tools, tool bits for machines, extension bars for power tools, namely, for power and electrical drills, routers; power-operated machine tools, namely, milling cutters, power operated nailing guns, chucks for power drills, ratchet wrenches, screwdrivers, power operated reel for garden hose, shredders for industrial use, power saw blades, blades for power saws, polishers, spray guns for spraying paint, drill bits; metal-cutting tools and metal-removing tools, namely, cutting blades as part of machines, cutting dies for use in cutting boxes for the packaging industry, cutting dies as part of machine, power-operated chisels, power drills, milling cutters, countersinking cutters, electric planes, power operated files, grinders, saws for such machines and tool machines; power-operated machine tools for machining metal, wood or plastics, namely, metal working machines, injection plastic molding machines, and electric scissors; and holders and receptacles for use with the aforementioned tools and machines" in International Class 007.

13. In the same application, Simtek sought to register its Simturn Mark for "*Manually operated tools and devices for metal-cutting and non-cutting tools, namely, cutting blades, cutting dies, chisels, drills, milling cutters, countersinking cutters, planes, files, grinders, saws for machining metal, wood or plastics; and holders and receptacles for use with the aforementioned tools*" in International Class 008.

14. Simtek's claimed date of first use in commerce for its Simturn Mark in both International Classes 007 and 008 is April 8, 2010.

15. The '514 Registration issued from United States Trademark Application Serial Number 77/256,241 on August 17, 2010 and is currently on the Principal Register.

16. Simmons began doing business in interstate commerce under the name SIMMONS on December 1, 1946. Simmons has used the name SIMCOR in interstate commerce since at least December 1, 1993. Simmons began doing business in interstate commerce using the name SIMCUT at least as early as September of 1990, and Simmons has been using SIMCUT continuously in interstate commerce since at least November 20, 2003. Simmons is well-known and prominent in its industry under the names SIMMONS, SIMCOR, and SIMCUT (collectively the "Simmons Marks"). Simmons has used all of the Simmons Marks in the United States long prior to the filing date of the '514 Registration, and before any date of actual first use which may be claimed by Simtek.

17. Simmons's use of the name SIMMONS has been valid and continuous since at least December 1, 1946. Simmons's use of the name SIMCOR has been valid and continuous since at least December 1, 1993. Simmons's use of the name SIMCUT has been valid and continuous since at least November 20, 2003.

18. In view of Simmons's earlier date of first use of all of the Simmons Marks, and valid and continuous use thereof in interstate commerce, Simmons has priority of use over Simtek.

19. Simmons has invested significant money to establish a valuable reputation and goodwill in the Simmons Marks by reason of its long use, extensive promotion, and sale of goods in association with the Simmons Marks.

20. As a result of Simmons's long use and extensive marketing efforts, the Simmons Marks are well-known, and the public has come to associate Simmons with each of the Simmons Marks.

21. By reason of Simmons's widespread and continuous use of the Simmons Marks, Simmons has extensive statutory and common law rights, whether registered or unregistered, in

the Simmons Marks. These rights substantially pre-date any rights that might be claimed by Simtek.

22. Simmons has and will assert its common-law and statutory rights resulting from its ownership of the '970, '974 and '989 Registrations and use of the name SIMMONS and SIMCOR in connection with its various goods, and which the relevant consuming public associates with Simmons. Simmons has not abandoned SIMMONS or SIMCOR.

23. Simmons has and will assert its common-law rights resulting from its ownership and use of the name SIMCUT in connection with its various goods, and which the relevant consuming public uses and associates with Simmons. Simmons has not abandoned SIMCUT.

COUNT I: PRIORITY AND LIKELIHOOD OF CONFUSION: 15 U.S.C. § 1052(d)

24. Simmons hereby incorporates by reference and re-alleges each and every allegation set forth in Paragraphs 1 through 23.

25. Upon information and belief, Simtek's goods with which it used its Simturn Mark, and the goods with which Simmons uses the Simmons Marks, are offered for sale and are sold through the same channels of trade.

26. Upon information and belief, Simtek's and Simmons's goods are offered and sold to the same class of purchasers. Specifically, both companies provide parts, and related goods, for industrial machines.

27. The goods offered under the Simmons Marks on the one hand, and Simtek's Simturn Mark on the other, are similar or identical.

28. The Simturn Mark is similar to the Simmons Marks.

29. In view of the similarity of the respective marks, similar channels of trade, and the similar goods offered for sale by the respective parties, Simtek's Simturn Mark so resembles the

Simmons Marks as to be likely to cause confusion or mistake, or to deceive as to source by suggesting that Simtek's goods are associated with, sold, approved, endorsed, affiliated, authorized, or sponsored by Simmons.

COUNT II: ABANDONMENT: 15 U.S.C. § 1064(3)

30. Simmons hereby incorporates by reference and re-alleges each and every allegation set forth in Paragraphs 1 through 29.

31. Additionally, and in the alternative – On information and belief, Simtek has not done business under the Simturn Mark in the United States.

32. On information and belief, Simtek operates the website www.simtek.com.

33. The webpage www.simtek.com/markets/global/index_english.html includes a list of 41 countries outside of Germany in which Simtek claims to do business. The United States is not listed on that page, although other countries in North America are (namely Canada and Mexico). A site search of www.simtek.com performed using Google for the term "United States" (both with and without full-phrase quotation marks) yields no hits; neither does a search for "America." A search for "USA" (in quotes) yields nothing, but a search for USA (without quotes) brings up a single false-positive result for the list of 41 countries mentioned above. An internal search of the webpage on which that list appears indicates that the phrase USA does not appear therein.

34. On information and belief, Simtek does not have a United States subsidiary or a United States affiliate. No such entity is mentioned on the website www.simtek.com.

35. Alternately, if Simtek has made past use of the Simturn Mark in commerce in the United States, then, on information and belief, Simtek has since discontinued any such use of the Simturn Mark.

36. On information and belief, such discontinued use by Simtek was with the intent not to resume use of the Simturn Mark.

37. On information and belief, Simtek has abandoned the Simturn Mark in the United States.

38. Simmons is likely to be damaged by the '514 Registration, in that the *prima facie* effect of the '514 Registration tends to impair Simmons's free and legal use of the Simmons Marks, and the ability to register its SIMCUT mark.

39. Simmons therefore respectfully requests that the '514 Registration be cancelled and that this Petition for Cancellation be sustained.

WHEREFORE, Simmons respectfully requests that the Registrations be cancelled, for all goods listed therein, and that this Petition for Cancellation be sustained.

A fee of $600 is submitted herewith.

Respectfully submitted,

Crawford Intellectual Property Law LLC

By Brie A Crawford

Brie A. Crawford
1095 Pingree Road
Suite 204
Crystal Lake, Illinois 60014
(815) 893-8149 (telephone)
(815) 261-4350 (fax)
briecrawford@crawfordpatents.com

Attorney for Petitioner
Simmons Engineering Corporation,
d/b/a Simmons Knife & Saw Company

Dated: August 13, 2015

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITION TO CANCEL has been served on Simtek Prazisionswerkzeuge GmbH, by mailing said copy on August 13, 2015, via Express Mail (Express Mail Label Number: EK436387755US), postage prepaid to Simtek's listed Domestic Representative on file with the United States Patent and Trademark Office, namely Mr. Horst M. Kasper, at the following address:

Simtek Prazisionswerkzeuge GmbH
C/O Mr. Horst M. Kasper, Esquire
Kasper and Laughlin
13 Forest Drive
Warren, New Jersey 07059-5832

By Brie A Crawford

CRAWFORD INTELLECTUAL PROPERTY LAW LLC
Brie A. Crawford
1095 Pingree Road
Suite 204
Crystal Lake, Illinois 60014
(815) 893-8149 (phone)
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briecrawford@crawfordpatents.com

Attorney for Petitioner
Simmons Engineering Corporation,
d/b/a Simmons Knife & Saw Company

Dated: August 13, 2015

EXHIBIT A

United States Patent and Trademark Office

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SIMTURN

Word Mark	**SIMTURN**
Goods and Services	IC 007. US 013 019 021 023 031 034 035. G & S: Machines, namely, cutting machines, boring machines, drilling machines, pneumatic hammers, industrial machine presses, polishing machines for polishing wood, ceramics, rice and barley; saws, namely, chain saws, table saws, jig saws, and circular saws; machine tools, namely, metalworking machine tools, tool bits for machines, extension bars for power tools, namely, for power and electrical drills, routers; power-operated machine tools, namely, milling cutters, power operated nailing guns, chucks for power drills, ratchet wrenches, screwdrivers, power operated reel for garden hose, shredders for industrial use, power saw blades, blades for power saws, polishers, spray guns for spraying paint, drill bits; metal-cutting tools and metal-removing tools, namely, cutting blades as part of machines, cutting dies for use in cutting boxes for the packaging industry, cutting dies as part of machine, power-operated chisels, power drills, milling cutters, countersinking cutters, electric planes, power operated files, grinders, saws for such machines and tool machines; power-operated machine tools for machining metal, wood or plastics, namely, metal working machines, injection plastic molding machines, and electric scissors; and holders and receptacles for use with the aforementioned tools and machines. FIRST USE: 20100408. FIRST USE IN COMMERCE: 20100408 IC 008. US 023 028 044. G & S: Manually operated tools and devices for metal-cutting and non-cutting tools, namely, cutting blades, cutting dies, chisels, drills, milling cutters, countersinking cutters, planes, files, grinders, saws for machining metal, wood or plastics; and holders and receptacles for use with the aforementioned tools. FIRST USE: 20100408. FIRST USE IN COMMERCE: 20100408
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77256241
Filing Date	August 15, 2007

Current Basis	1A
Original Filing Basis	1B
Published for Opposition	February 10, 2009
Registration Number	3835514
Registration Date	August 17, 2010
Owner	(REGISTRANT) SIMTEK Prazisionswerkzeuge GmbH LIMITED LIABILITY COMPANY FED REP GERMANY Richard-Burkhardt-Strasse 11 Mossingen FED REP GERMANY 72116
Attorney of Record	Horst M. Kasper
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

EXHIBIT B

United States Patent and Trademark Office

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SIMMONS

Word Mark	SIMMONS
Goods and Services	IC 007. US 013 019 021 023 031 034 035. G & S: Blades for power saws; Machine parts, namely, blades; Power saw blades. FIRST USE: 19461201. FIRST USE IN COMMERCE: 19461201
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86131098
Filing Date	November 27, 2013
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	June 10, 2014
Registration Number	4591970
Registration Date	August 26, 2014
Owner	(REGISTRANT) Simmons Engineering Corporation CORPORATION DELAWARE 1200 Willis Avenue Wheeling ILLINOIS 60090
Attorney of Record	John A. Franczyk

Type of Mark	TRADEMARK
Register	PRINCIPAL-2(F)
Live/Dead Indicator	LIVE

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Word Mark	SIMMONS
Goods and Services	IC 007. US 013 019 021 023 031 034 035. G & S: Blades for power saws; Machine parts, namely, blades; Power saw blades. FIRST USE: 19931201. FIRST USE IN COMMERCE: 19931201
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	26.03.21 - Ovals that are completely or partially shaded 26.05.25 - Triangles with one or more curved sides 26.17.01 - Bands, straight; Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s) 26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal
Serial Number	86245605
Filing Date	April 8, 2014
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 26, 2014
Registration Number	4636974
Registration Date	November 11, 2014

Owner	(REGISTRANT) Simmons Engineering Corporation CORPORATION ILLINOIS 1200 Willis Avenue Wheeling ILLINOIS 60090
Attorney of Record	John A Franczyk
Description of Mark	Color is not claimed as a feature of the mark. The mark consists of the trademark "SIMMONS" in all-caps and an italicized font, set in an oval and framed on one side by an inverted stylized triangle, and above and below by three horizontal lines of different thicknesses.
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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SIMCOR

Word Mark	**SIMCOR**
Goods and Services	IC 007. US 013 019 021 023 031 034 035. G & S: Blades for power saws; Machine parts, namely, blades; Power saw blades. FIRST USE: 19931201. FIRST USE IN COMMERCE: 19931201
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86131206
Filing Date	November 27, 2013
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 22, 2014
Registration Number	4563989
Registration Date	July 8, 2014
Owner	(REGISTRANT) Simmons Engineering Corporation CORPORATION DELAWARE 1200 Willis Avenue Wheeling ILLINOIS 60090
Attorney of Record	John A Franczyk

Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITION TO CANCEL has been served on Simtek Prazisionswerkzeuge GmbH, by mailing said copy on August 14, 2015, via Express Mail (Express Mail Label Number: EK 063980026 US), postage prepaid to Simtek's listed Domestic Representative on file with the United States Patent and Trademark Office, namely Mr. Horst M. Kasper, at the following address:

Simtek Prazisionswerkzeuge GmbH
C/O Mr. Horst M. Kasper, Esquire
Kasper and Laughlin
13 Forest Drive
Warren, New Jersey 07059-5832

A previous copy of Petitions to Cancel Nos. 92062024, 92062017, and 92062025 may have been misdelivered. Enclosed is a courtesy copy of each.

↳ by the United States Postal Service.

By Brie A Crawford

Brie A. Crawford
1095 Pingree Road
Suite 204
Crystal Lake, Illinois 60014
(815) 893-8149

Attorney for Petitioner
Simmons Engineering Corporation,
d/b/a Simmons Knife & Saw Company

Dated: August 14, 2015