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

Proceeding	91172472
Party	Defendant Bayerische Motoren Werke Aktiengesellschaft Bayerische Motoren Werke Aktiengesellschaft aft Petuelring 130 D-80809 DEX Munich,
Correspondence Address	TRINA A. LONGO HOWREY LLP 1299 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2402 UNITED STATES longot@howrey.com, froemmingj@howrey.com, ipdocketing@howrey.com
Submission	Other Motions/Papers
Filer's Name	Jason A. Cody
Filer's e-mail	codyj@howrey.com, ipdocketing@howrey.com, froemmingj@howrey.com, longot@howrey.com
Signature	/Jason A. Cody/
Date	04/20/2007
Attachments	BMW Motion for Judgment on Pleadings.pdf (7 pages)(318707 bytes)

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

Ford Motor Company,	§	
	§	
Opposer,	§	
	§	Opposition No. 91172472
v.	§	
	§	
Bayerische Motoren Werke Aktiengesellschaft,	§	
	§	
Applicant.	§	
	§	



APPLICANT’S MOTION FOR JUDGMENT ON PLEADINGS

Applicant Bayerische Motoren Werke Aktiengesellschaft (“BMW”) hereby moves for judgment on the pleadings, pursuant to Rule 12(c) of the Federal Rules of Civil Procedure and TBMP § 504, based on BMW’s affirmative defense of prior existing registrations (the “Morehouse defense”).

Here, Opposer Ford Motor Company (“Ford”) cannot be “damaged” by the issuance of a registration for Application Ser. No. 78/693,352 (“BMW’s M Mark Application”) because BMW owns prior registrations, covering the same goods, for M marks that Opposer has admitted in its Notice of Opposition create the same commercial impression as the M mark in BMW’s pending application. The Board should therefore grant Applicant’s Motion for Judgment on Pleadings and dismiss the opposition with prejudice. In addition, BMW requests that the Board stay this proceeding pending disposition of this motion, pursuant to Trademark Rule § 2.127(d).

FACTUAL BACKGROUND

1. On August 16, 2005, BMW filed its application to register its mark M in International Class 12 for motor vehicles and structural parts therefor. BMW’s M Mark Application claims ownership of three prior, valid and subsisting M mark registrations:

	Automobiles	Prior Registration No. 1,438,545; Issued May 5, 1987 (Exh. A)
	Valve stem caps; license plate frames, gear shift knobs	Prior Registration No. 2,683,597; Issued February 4, 2003 (Exh. B)
M2	Automobiles and structural parts therefor	Prior Registration No. 2,852,493; Issued on June 15, 2004 (Exh. C)

2. On February 21, 2006, BMW's M Mark Application was published in the Official Gazette.

3. On August 21, 2006, Ford filed the subject opposition against BMW's M Mark Application. In its Notice of Opposition, however, Ford did not allege likelihood of confusion. As best as BMW can tell, Ford claims damage based on allegations that BMW's M Mark does not function as a trademark for BMW's goods (NOP ¶ 28) and BMW could engage in trademark misuse (NOP ¶ 31).

4. In its Notice of Opposition, Ford admits that BMW uses M alphanumerics for vehicles; owns trademark registrations and applications for alphanumeric designations containing the letter M for vehicles, including M2, M3, M4, M5 and M6 (NOP ¶ 21); and uses "the stylized M design ('BMW M Design')," as a designation on vehicles (NOP ¶ 22).

5. In its Notice of Opposition, Ford also admits that "the non-stylized letter M does not create a separate commercial impression apart from BMW's M alphanumeric marks and the BMW M Design mark" (NOP ¶ 26) reflected in BMW's prior M mark registration Nos. 1,438,545, 2,683,597, 2,852,493.

6. On October 2, 2006, BMW filed its Answer to the Notice of Opposition, pleading affirmatively that Ford “is barred by laches due to Ford’s failure to oppose prior similar registrations owned by BMW for its M marks” (the “Morehouse” defense). (Answer at 4.)


ARGUMENT

FORD’S OPPOSITION IS BARRED BY *MOREHOUSE* BECAUSE FORD ADMITS THAT THE M MARK COVERED BY BMW’S APPLICATION CREATES THE SAME COMMERCIAL IMPRESSION AS BMW’S PRIOR REGISTRATIONS



Once the pleadings are closed, but before the beginning of the first testimony period, a party may file a motion for judgment on the pleadings, TBMP § 504.01, Fed. R. Civ. P. 12(c), which tests the undisputed facts appearing in all pleadings, supplemented by any facts of which the Board may take judicial notice. TBMP § 504.02. Judgment on the pleadings is proper where there is no genuine issue of material fact on the facts deemed admitted and the moving party is entitled to judgment as a matter of law. *Id.*; see also Baroid Drilling Fluids Inc. v. Sun Drilling Prods., 24 U.S.P.Q.2d 1048 (T.T.A.B. 1992) (granting judgment on the pleadings where respondent admitted in its answer priority of use and similarities between the mark and goods).

The law is clear that an opposer cannot be damaged by registration of an application which covers the same or legally equivalent mark for the same or substantially the same goods as any prior registration of the applicant. Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 160 U.S.P.Q. 715 (C.C.P.A. 1969); see also Morehouse Mfg. Corp. v. J. Strickland & Co., 150 U.S.P.Q. 688, 694 (no damage where the mark covered by applicant’s registration and application were the same, albeit in different logotype, and the goods were the same); Joseph & Feiss Co. v. Sportempos, Inc., 172 U.S.P.Q. 235 (C.C.P.A. 1971) (same).

The Board routinely dismisses cases similar to this one based on the Morehouse defense. For example, in Nat'l Bakers Servs., Inc. v. Hain Pure Food Co., 207 U.S.P.Q. 701, 706 (T.T.A.B. 1980), the Board stated that whether marks are the same or legally equivalent centers on whether the consuming public would consider the two marks as substantially the same mark, projecting the same image and symbolizing a single and continuing commercial impression. Despite variations in the HOLLYWOOD marks below, the Board recognized they were legal equivalents and the opposer could not be damaged:

HOLLYWOOD	Opposed Application
	Prior Registration

Id. at 707. The same was true in Continental Specialties Corp. v. Continental Connector Corp., 192 U.S.P.Q. 449, 451 (T.T.A.B. 1976), where the Board granted the applicant's motion to dismiss on the basis of the following application and prior registrations:

CONTINENTAL	Opposed Application
	Prior Registration
	Prior Registration

There the Board stated: "An opposer cannot be legally damaged by the registration of a mark which is the same as or substantially identical to a mark already registered to applicant for the same or similar goods. [Citations omitted.] That principle applies in this case because 'CONTINENTAL' per se creates the same psychological impression and makes the same commercial impact as do 'CONTINENTAL' displayed against a background of interlocking

letter 'c's' . . . or a background of interlocking circles. . . . Hence, 'CONTINENTAL' per se is substantially identical to applicant's registered marks." Id. at 451-52.

Indeed, in both National Bakers and Continental, the Board held that marks appearing in non-stylized form were substantially identical to prior registered marks which appeared with a design and utilized a special font or logotype. The same is true here. The mark claimed in BMW's M Application appears in non-stylized form and this mark is substantially identical to BMW's prior registered marks which appear with a design and utilize a special font or logotype.

Importantly, Ford acknowledges in its opposition that BMW owns registrations for and uses the M mark in connection with automobiles (NOP ¶¶ 21-22), and further admits that the M mark depicted in BMW's application "does not create a separate commercial impression apart from BMW's alphanumeric marks and the BMW M Design mark" (NOP ¶ 26), as depicted in the Notice of Opposition and the prior registrations above.

Ford thus has admitted in its pleadings that the Morehouse defense bars its opposition to BMW's application to register the mark M depicted in Ser. No. 78/693,352. BMW is entitled to judgment on the pleadings.


CONCLUSION

For the foregoing reason, the Board should grant Applicant's Motion for Judgment on Pleadings and dismiss the opposition with prejudice.

Respectfully submitted,

Date: April 20, 2007

By:


John G. Froemming
Trina A. Longo
Jason A. Cody
HOWREY LLP
1299 Pennsylvania Avenue, NW
Washington, D.C. 20004

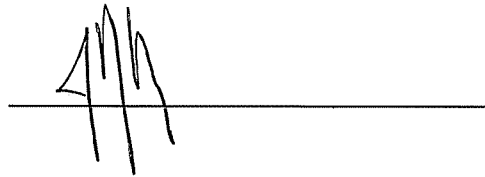
(202) 783-0800

Attorneys for Applicant
Bayerische Motoren Werke Aktiengesellschaft

CERTIFICATE OF SERVICE

This is to certify that on this 20th day of April 2007, a true and correct copy of the foregoing Applicant's Motion for Judgment on Pleadings was served via First Class mail, postage prepaid to:

Elizabeth F. Janda, Esq.
Brooks Kushman PC
1000 Town Center
22nd Floor
Southfield, MI 48075

A handwritten signature in black ink, appearing to read "E. Janda", is written over a solid horizontal line. The signature is stylized and somewhat cursive.