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

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| Proceeding | 91176837 |
| Party | Plaintiff<br>Peer Bearing Company |
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| Submission | Reply in Support of Motion |
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| Signature | /Thomas C. McDonough/ |
| Date | 06/08/2010 |
| Attachments | Peer's Reply Brief 7600 SERIES.pdf ( 6 pages )(244068 bytes ) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
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| Peer Bearing Company | ) | |
| | ) | |
| Opposer, | ) | |
| | ) | Opposition No. 91176837 |
| v. | ) | |
| | ) | In the matter of Application Serial No.: 78/754,894 |
| RBC Bearings Inc. | ) | Mark: 7600 SERIES |
| | ) | |
| Applicant. | ) | |
| | ) | |

**OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION**
**FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION**

The Motion for Leave to Amend by Opposer Peer Bearing Co. should be granted for several reasons. First, Applicant, RBC Bearings Inc. ("Applicant"), has grossly mischaracterized this Board's rules and standards for granting leave to amend a notice of opposition as well as the Lanham Act's requirement of ownership of a mark sought to be registered. Second, Applicant's Reply fails to provide any explanation or argument whatsoever to refute Opposer's additional grounds of genericness and descriptiveness of the 7600 SERIES term for opposing the subject application. Third, the dismissal of all of the plaintiffs' claims in the Connecticut Litigation[1] means that Opposer Peer is free to use the 7600 SERIES term without objection, regardless of the outcome of the appeal[2] of that litigation. Opposer's unimpedable right to use the 7600 SERIES term therefore precludes Applicant from claiming exclusive rights to the 7600 SERIES term, as would be necessary for Applicant to obtain federal registration of the term. Lastly, Opposer's grounds for opposing Applicant's application are legally sufficient because Applicant

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1 Case No. 3:06-cv-01380 entitled *RBC Bearings, Inc. and Rolling Bearing Company of America, Inc. v. Peer Bearing Company* in the United States District Court for the District of Connecticut.

2 Case No. 10-383 entitled *RBC Bearings, Inc. and Rolling Bearing Company of America, Inc. v. Peer Bearing Company* in the United States Court of Appeals for the Second Circuit.

cannot own, and is therefore not entitled to obtain registration for, the term 7600 SERIES when Opposer and others can continue to use that term in connection with the same goods as identified in the application. Accordingly, this Board should grant Opposer leave to amend its Notice of Opposition.

**Leave To Amend Is Freely Given When Justice Requires And Applicant's Argument To The Contrary Misconstrues The Board's Rules**

The entire basis for Applicant's opposition to Opposer's motion is flawed, in that it misconstrues the Board's rules to argue that "[t]he Board normally denies motions to amend the Notice of Opposition where the moving party seeks to add a new claim and the proposed pleading is legally insufficient or would serve no useful purpose." In support, Applicant cites TBMP §507.02, which does not provide any support for Applicant's position. To the contrary, TBMP §507.02 provides that "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party." *See also Fed. R. Civ. P. 15(a).* TBMP §507.02 continues on to state "this is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint." Applicant also fails to cite any Board precedent to support its unfounded contention that the Board "normally denies motions to amend the Notice Opposition." The Board should disregard Applicant's contentions and grant Opposer leave to amend its Notice of Opposition.

**Applicant Makes No Effort To Contest The Sufficiency Of Opposer's New Grounds Of Genericness And Descriptiveness**

Applicant does not make a single argument that Opposer should not be entitled to raise its new arguments that the 7600 SERIES term is either generic or descriptive. In the Amended

Notice of Opposition, ¶1-14, Opposer set out additional detailed allegations stating its grounds for opposition based on genericness and descriptiveness of the 7600 SERIES term. Applicant's conclusory argument that the grounds for amending the Notice of Opposition are "unfounded, legally insufficient and are of no useful purpose," fails to provide any explanation or argument to support its attack on the sufficiency of these claims. It is, in fact, undisputed that Opposer's allegations are legally sufficient. For this reason alone the Opposer's Motion to Amend should be granted.

**The Connecticut Litigation And Appeal Do Not Preclude Opposer's Motion Because All Claims Based On The 7600 SERIES Were Dismissed With Prejudice**

Applicant's reliance on the Connecticut Litigation to oppose this motion is entirely unfounded, as all claims in that case regarding the 7600 SERIES term were dismissed with prejudice. Applicant's argument that it would be prejudiced by being forced to litigate the ownership issue here and in the Connecticut court is simply not correct. Applicant has already conceded Opposer's ability to continue its use of the 7600 SERIES term, without objection, when it filed its dismissal with prejudice of all claims against such use. *See*, Opposer's Status Report filed January 19, 2010 and Exhibits A and B thereto. In fact, Applicant's concession to third party use of the 7600 SERIES term during the Connecticut Litigation is one of the bases for Opposer's ground of Applicant's lack of ownership of the 7600 SERIES. Thus, because of this dismissal, the District Court in Connecticut did not decide ownership of the 7600 SERIES *per se* and, importantly, it cannot decide this issue since the 7600 SERIES term is no longer a part of that case. The Notice of Appeal filed in that case raises no issue on Applicant's purported ownership of the 7600 SERIES term because of this dismissal with prejudice. In sum, there is no basis for Applicant's position that the Connecticut Litigation is relevant to this proceeding.

**Opposer's Ground Of Applicant's**
**Lack Of Ownership Is Legally Sufficient**

Applicant also misconstrues the requirement of ownership of a mark prior to filing a use-based application. Applicant argues that Opposer's Amended Notice is deficient because lack of ownership is not a proper ground for opposing an application. Applicant's position ignores 15 U.S.C. §1051(a)(1), which provides "the owner of a trademark used in commerce may request registration of its trademark on the principal register..." (emphasis added). It is thus inherent in the statute that the applicant be the owner of the mark it seeks to register. Applicant also ignores TMBP §309.03(c) which sets forth examples of various grounds for opposing the registration of a mark. As part of the exemplary list of available grounds for opposition, TBMP §309.03(c)(8) provides "[t]hat defendant is not (and was not, at the time of filing of its application for registration) the rightful owner of the registered mark."

Faced with the statute and this rule, Applicant can only attempt to distinguish the cases cited in support of TBMP §309.03(c)(8) by characterizing the statements therein as *dicta* or as concerning collective marks and concurrent use proceedings. These distinctions, however, are unrelated to the statutory requirement for a §1051(a) use-based filing that Applicant be the owner of the mark it seeks to register. These cases stand for the proposition that, no matter the type of mark, the applicant for registration must be the owner of the alleged mark. In this case, Opposer has demonstrated reasons why Applicant is not the owner of this mark, and Opposer should be entitled to prove up these allegations before the Board.

**Conclusion**

In sum, Applicant has failed to provide any legal justification for why this Board should not grant Opposer leave to amend its Notice of Opposition. The amendment to the Notice is

timely insofar as the discovery period is still open and will not cause Applicant to suffer prejudice. The additional grounds for opposition are legally sufficient and supported by the facts. There are no pending issues in the Connecticut Litigation that concern this Opposition and Applicant's reliance on this litigation is nothing more than a red herring. For these reasons, the Board should grant Opposer's motion for Leave to Amend.

WHEREFORE, Opposer Peer Bearing Company respectfully submits that leave to amend its Notice of Opposition be granted.

Respectfully submitted,

Date: June 8, 2010

By: / Thomas C. McDonough /
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## CERTIFICATE OF TRANSMISSION

I hereby certify that the enclosed **OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at http://estta.uspto.gov/ on the date noted below:

Date: June 8, 2010

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## CERTIFICATE OF SERVICE

I, Thomas C. McDonough, an attorney, state that I served a copy of the enclosed **OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION** upon:

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by depositing said copy in a properly addressed envelope, first class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on the date noted below:

Date: June 8, 2010

By: / Thomas C. McDonough/

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