

ESTTA Tracking number: **ESTTA137396**

Filing date: **04/25/2007**

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

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| Name | SKF USA Inc. |
| Granted to Date of previous extension | 04/25/2007 |
| Address | 1111 Adams Avenue Norristown, PA 19403 UNITED STATES |

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| Attorney information | Michael J. Leonard, Esquire Pepper Hamilton LLP Eighteenth & Arch Streets 3000 Two Logan Square Philadelphia, PA 19103-2799 UNITED STATES leonardm@pepperlaw.com, kearneyc@pepperlaw.com, wrightp@pepperlaw.com Phone:215-981-4000 |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 78754811 | Publication date | 12/26/2006 |
| Opposition Filing Date | 04/25/2007 | Opposition Period Ends | 04/25/2007 |
| Applicant | RBC Bearings Inc. One Tribology Center Oxford, CT 06478 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 007. First Use: 1918/08/00 First Use In Commerce: 1918/08/00
All goods and services in the class are opposed, namely: Ball bearings for machines, motors, engines, and tools

Grounds for Opposition

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|--------------------------------|-------------------------------|
| The mark is merely descriptive | Trademark Act section 2(e)(1) |
| Genericness | Trademark Act section 23 |

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| Attachments | Notice of Opposition - 500 SERIES.PDF (4 pages)(102735 bytes) |
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|-----------|-----------------------------|
| Signature | /MJL/ |
| Name | Michael J. Leonard, Esquire |
| Date | 04/25/2007 |

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

SKF USA INC.

Opposer,

v.

RBC BEARINGS, INC.

Applicant.

Opposition No. _____
App. Serial No. 78/754,811

Mark: 500 SERIES

NOTICE OF OPPOSITION

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Dear Sir or Madam:

SKF USA Inc., a Delaware corporation with offices at 1111 Adams Avenue, Norristown, PA 19403 (“Opposer”) believes it will be damaged by the issuance of a trademark registration to RBC Bearings, Inc., a Delaware corporation with offices at One Tribology Center, Oxford, CT (“Applicant”) for the mark 500 SERIES (Serial No. 78/754,811) in International Class 7, and hereby opposes the application.

1. Opposer is a leading manufacturer, distributor, and supplier of roller bearings and related goods and services. Opposer’s products are sold in a wide variety of types and sizes under a wide variety of parts numbers and series numbers.

2. Applicant is seeking to obtain, under the provisions of the Trademark Act of 1946, as amended, registration on the Principal Register of the mark 500 SERIES for “ball

bearings for machines, motors, engines and tools” in International Class 7 (“Applicant’s Goods”).

3. Applicant is not now, and never was, entitled to registration on the Principal Register of “500 Series,” either on November 16, 2005, the date of Applicant’s filing of the application, or on December 26, 2006, the date of publication in the *Official Gazette*. The mark of the subject application is merely descriptive and/or laudatory of features, dimensions, and characteristics of Applicant’s Goods.

4. A number of entities have used and are using the phrase “500 Series” or similar phrases in a non-trademark manner to identify and describe bearings. As a result of this widespread use of “500 Series” to refer to bearings, the consuming public is likely to perceive “500 Series” as a descriptive indicator of goods and not as an indicator of the source of the goods. Based in part on the extensive identical and descriptive uses by many in the bearing industry, “500 Series” does not and cannot function as a source identifier for Applicant’s Goods or distinguish Applicant’s Goods from similar goods offered by others. “500 Series” is functional, descriptive, and generic and should be refused registration under Section 2(e) of the Trademark Act of 1946, as amended, 15 U.S.C. §1052(e).

5. Usage of “500 Series” as a term to identify bearings has become so common that the granting of a registration for the term “500 Series” would result in the statutory benefits of Section 33(a) of the Lanham Act, 15 U.S.C. §1115(a) being applied to a descriptive term thereby resulting in injury to Opposer and others.

6. Applicant’s alleged mark fully comprises descriptive and non-distinctive elements that alone or in combination do not function as a trademark and said elements must remain available for others in the trade, including Opposer, to freely use or otherwise face injury.

7. Applicant's alleged mark lacks sufficient distinctive character, is not inherently distinctive and/or has not acquired the requisite level of secondary meaning to warrant registration.

8. Applicant's attempt to obtain registration of the "500 Series" term under Section 2(f) of the Trademark Act must be refused since Applicant did not present the requisite level of evidence in support of its contention that "500 Series" has become distinctive of its Goods. As consumers are confronted with numerous independent users of the "500 Series" term, no application for registration under Section 2(f) could be successful because this term is not perceived by consumers as being distinctive of Applicant or Applicant's goods.

9. Registration of "500 Series" would provide Applicant with prima facie evidence of an exclusive right to use "500 Series" in commerce or on in connection with the applied-for goods. Consequently, Opposer and others in the industry will be seriously damaged by registration of "500 Series" because a registration could be used to inhibit and interfere with Opposer's and others' right to use the phrase "500 Series" or similar terms or phrases in a non-trademark manner in connection with bearings and/or other goods related to those identified in the application.

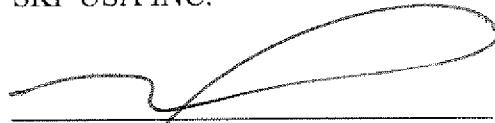
10. Based upon the allegations above, Opposer has a real interest in the outcome of this opposition and a reasonable basis in fact to believe that it and other members of the public will be damaged by registration of "500 Series."

WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 78/754,811, be rejected and that the registration of "500 Series" as a trademark of Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

SKF USA INC.

Date: 25 April 2007



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