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

Proceeding	91176953
Party	Plaintiff SKF USA Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	05/28/2008
Attachments	91176953_Motion for Leave to File Amended Notice of Opposition.pdf (8 pages) (246020 bytes)

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

SKF USA INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91176953
)	App. Serial No. 78/754811
RBC BEARINGS, INC.,)	Mark: 500 SERIES
)	
Applicant.)	
)	

MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION

Opposer, SKF USA Inc., hereby moves for leave to file an amended pleading, namely, a First Amended Notice of Opposition. The proposed amended notice is attached hereto as Exhibit A. The grounds in support of this motion are as follows.

I. **Background**

1. Opposer is SKF USA Inc. Applicant is RBC Bearings, Inc.
2. Opposer maintains that Applicant is not now, and was not at the time of application, entitled to registration of the mark “500 SERIES” (Serial No. 78/754811).
3. Applicant answered Opposer’s original Notice of Opposition on May 29, 2007. Opposer propounded interrogatories and requests for production of documents and things on September 14, 2007. On December 18, 2007, Applicant responded to Opposer’s interrogatories, and on December 26, 2007, Applicant responded to Opposer’s requests for production of documents and things. Discovery is now closed. The testimony period has not yet opened, and is set to open on June 10, 2008.
4. Opposer now wishes to amend its original notice of opposition, only to add the grounds for opposition that Applicant’s alleged mark has not been used in commerce as a trademark within the meaning defined in 15 U.S.C. §§1051, 1052 and 1127. It instead has only

been used as a descriptive designation in promotional materials, and only in a generic manner that does not rise to the level of trademark use, so it does not warrant registration.

5. On May 8, 2008, counsel for Opposer requested Applicant's consent to amend the notice of opposition but has not yet received consent.

II. Discussion

Applicant produced 7,211 pages of documents. Of those 7,211 pages, none contained a specimen demonstrating actual trademark use of Applicant's alleged mark. Based on Opposer's review of these documents, Opposer requests leave to amend its notice of opposition to add a claim that the alleged mark is not being used as a trademark in accordance with 15 U.S.C. §§1051, 1052 and 1127. Applicant only appears to use its alleged trademark on promotional materials. Applicant does not appear to use the alleged mark on or in connection with the applied for goods – bearings – or bearing packaging. Applicant's apparent use of the alleged trademark on promotional materials is insufficient to support a federal registration. TMEP §904.07(b); *In re Craigmyle*, 224 U.S.P.Q. 791 (TTAB 1984); *In re Tilcon Warren, Inc.*, 221 U.S.P.Q. 86, 88 (TTAB 1984).

Unless Applicant can show prejudice, bad faith or undue delay, leave to file an amended pleading should be freely granted. *Foman v. Davis*, 371 U.S. 178, 182, 83 S. Ct. 227, 230 (1962). Such leave is always given when justice so requires. Fed. R. Civ. P. 15(a); *Walton v. Mental Health Ass'n*, 168 F.3d 661, 665 (3d. Cir. 1999).

Opposer's proposed amendment to the notice of opposition will not prejudice Applicant. Applicant already possess any and all facts related to the nature of its own purported use of the applied-for trademark, so the amendment will not cause unfair surprise. Moreover, Applicant will not require and Opposer does not seek additional discovery as to the ground sought to be added, since Applicant already possesses any facts related to the nature of its own

purported use. See *Metromedia Steakhouses, Inc. vs. Pondco II Inc.*, 28 U.S.P.Q.2d 1205 (TTAB 1993) (close of discovery is not a reason to deny leave to amend where no extra discovery is needed); *Focus 21 Int'l, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (no prejudice to applicant in granting leave to amend when testimony had not yet opened). The testimony period has not yet opened and Applicant will not be prejudiced.

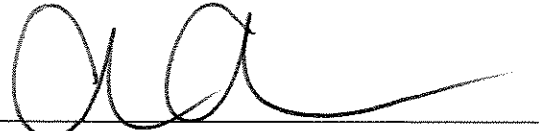
Further, Opposer's motion is timely. While reviewing the 7,211 pages of documents Applicant produced to Opposer, and prior to the testimony period, it became apparent that Applicant's purported use of the applied-for trademark is limited to promotional materials. Once Opposer's counsel identified this new ground for opposition, they contacted Applicant's counsel seeking consent to amend. Not having received a substantive response from Applicant's counsel, Opposer now moves for leave to amend. Undue delay is a ground for denial of leave to amend inasmuch as it prejudices the non-moving party. *Marshall Field & Co. vs. Mrs. Fields Cookies*, 11 U.S.P.Q.2d 1355 (TTAB 1989) (finding no undue delay because "the concept of 'undue delay' is inextricably linked with the concept of prejudice to the non-moving party and, in this case, we find no such prejudice"); *Int'l Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 1604 (TTAB 2002). Here there was neither undue delay nor prejudice.

III. **Conclusion**

Opposer's motion for leave to file its amended notice of opposition was timely filed and will not unduly prejudice Opposer, and therefore should be granted.

WHEREFORE, Opposer respectfully requests that the Board grant Opposer's Motion for Leave to File Amended Notice of Opposition and that it enter the proposed amended notice of opposition attached hereto as Exhibit A.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'DR', written over a horizontal line.

David Richman
Michael J. Leonard
Christopher D. Olszyk, Jr.
Pepper Hamilton LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103
215.981.4000

Attorneys for Opposer
SKF USA Inc.

Dated: May 28, 2008

EXHIBIT A

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

SKF USA INC.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91176953
	:	App. Serial No. 78/754,811
RBC BEARINGS, INC.	:	
	:	
Applicant.	:	Mark: 500 SERIES
	:	

FIRST AMENDED NOTICE OF OPPOSITION

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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 19, 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 use of its alleged mark does not qualify as trademark use in accordance with 15 U.S.C. §§1051, 1052 and 1127. Applicant has not used its mark on the applied-for goods, their packaging, or any other means not deemed unsatisfactory for evidence of use in commerce by the USPTO, as set forth non-exhaustively in TMEP §904.07. Thus, Applicant's use of the alleged mark does not rise to the level of trademark use, and does not warrant registration. TMEP §904.07(b).

9. 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.

10. 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-

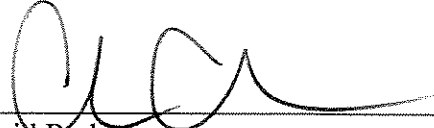
trademark manner in connection with bearings and/or other goods related to those identified in the application.

11. 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.



David Richman

Michael J. Leonard

Christopher D. Olszyk, Jr.

Pepper Hamilton LLP

3000 Two Logan Square

Eighteenth and Arch Streets

Philadelphia, PA 19103

215.981.4000

Attorneys for Opposer

Date: May 28, 2008

CERTIFICATE OF FILING AND OF SERVICE

The undersigned certifies that the foregoing Motion for Leave to File Amended Notice of Opposition is being (a) filed this 28th day of May, 2008, with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, via the Electronic System for Trademark Trial and Appeals (“ESTTA”), and (b) served on Applicant’s counsel via deposit of a copy with the United States Postal Service, postage pre-paid, First-Class Mail, addressed to:

Raymond D. Thompson, Esquire
Michaud-Duffy Group LLP
3006 Industrial Park Road, Suite 206
Middletown, CT 06457

A handwritten signature in black ink, appearing to read 'C. Olszyk, Jr.', written over a horizontal line.

Christopher D. Olszyk, Jr.