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

Proceeding	91176953
Party	Defendant RBC Bearings Inc.
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Attachments	1001-0047-1 Answer to 1st Amended Opposition.pdf (5 pages)(24761 bytes)

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

In re : Application Serial No. 78754811
Mark : **500 SERIES**
Applicant : RBC Bearings, Inc.
Goods : Ball bearings for machines, motors, engines, and tools
Class : International Class 007.
Published : December 26, 2006

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

SKF USA Inc.)
)
) Opposer,)
) Opposition No. 91176953
)
) v.)
)
RBC Bearings, Inc.)
)
) Applicant)
)
)

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Answer And Affirmative Defenses To First Amended Notice Of Opposition

Applicant, RBC Bearings, Inc. by its undersigned Attorneys, Answers the First Amended Notice of Opposition herein as follows;

1. In answer to paragraph 1 of the Notice of Opposition, admitted.

2. In answer to paragraph 2 of the Notice of Opposition, admitted.
3. In answer to paragraph 3 of the Notice of Opposition, denied; the mark is not merely descriptive of features, dimensions and characteristics of Applicant's Goods and has been in continuous use by Applicant and its predecessors-in-interest as a unique identifier of the source of goods since 1918.
4. In answer to paragraph 4 of the Notice of Opposition, denied as to each and every allegation and assert Applicant's continuous use since 1918 as a unique identifier of the source of goods has established clear identification in the mind of consumers that it relates to a single source of origin and any use by third parties has been recent in the context of 90 years of use by Applicant.
5. In answer to paragraph 5 of the Notice of Opposition, denied. Applicant's Mark was a randomly chosen term and is not descriptive of any particular type/size of bearing and has been in continuous use by Applicant and its predecessors-in-interest as a unique identifier of the source of Goods since 1918 for 500 SERIES
6. In answer to paragraph 6 of the Notice of Opposition, denied.
7. In answer to paragraph 7 of the Notice of Opposition, denied; the mark through Applicant and its predecessors-in-interest have through nearly ninety years of continuous use has acquired distinctiveness and is believed to have achieved secondary meaning to the consumers.
8. In answer to paragraph 8 of the Notice of Opposition, denied, the mark through Applicant and its predecessors-in-interest have been used as a trademark in advertising materials and catalogs since its first use date.

9. In answer to paragraph 9 of the Notice of Opposition, denied; the mark through Applicant and its predecessors-in-interest have through nearly ninety years of continuous use has acquired distinctiveness to the consumers.

10. In answer to paragraph 10 of the Notice of Opposition, denied.

11. In answer to paragraph 11 of the Notice of Opposition, denied.

Answer / Affirmative Defenses

12. The mark 500 SERIES is a unique descriptor for this type of product. It is not a functional nor a size descriptor nor a generic descriptor of the actual product. There are many alternative identifiers for similar bearing products which are used by manufacturers to identify bearings of a particular size and character. The 500 SERIES term uniquely identifies the source of goods to consumers due to the long usage, since 1918, of the term by Applicant and its predecessors-in interest and it has acquired distinctiveness and secondary meaning by such long use.

13. Opposer is contractually precluded from any current or future use of the Mark under the terms of contracts between Opposer and Applicant, therefore the Opposition is moot and without basis due at least to there being no possible injury to Opposer.

Wherefore, Applicant requests that Opposer's opposition be dismissed, and the mark in question be passed to issue.

Dated: August 26, 2008

/s/Raymond D. Thompson
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO FIRST AMENDED NOTICE OF OPPOSITION was filed electronically and has been served by U.S. Mail, this 26th day of August, 2008 upon the attorney for Opposer, at the following address:

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/s/Raymond D. Thompson
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