

ESTTA Tracking number: **ESTTA144173**

Filing date: **06/05/2007**

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

Proceeding	91176953
Party	Defendant RBC Bearings Inc. RBC Bearings Inc. One Tribology Center Oxford, CT 06478
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Submission	Answer
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Date	06/05/2007
Attachments	1001-0047-1-Final Answer to SKF Opposition 500.pdf ( 5 pages )(26469 bytes )

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

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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

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

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

Answer And Affirmative Defenses To Notice Of Opposition

Applicant, RBC Bearings, Inc. by its undersigned Attorneys, Answers the 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 through nearly ninety years of continuous use has acquired distinctiveness to the consumers.

9. In answer to paragraph 9 of the Notice of Opposition, denied.
10. In answer to paragraph 10 of the Notice of Opposition, denied.

Answer / Affirmative Defenses

11. 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.

12. 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.

Applicant hereby appoints the law firm of Michaud-Duffy Group LLP and the individual attorneys at such law firm, namely Richard R. Michaud, registration no. 40,088; Wayne R. Grohs, registration no. 48,945; Michael K. Kinney, registration no. 42,740; and John H. Mutchler, registration no. 53,362, Fred Spaeth, registration no. 33,793 and Raymond D. Thompson, registration no. 30,695 as my attorneys with full power of substitution and revocation

to transact all business in and to receive all correspondence from the Patent and Trademark Office connected therewith.

Dated: June 5, 2007

/s/Richard R. Michaud/  
Richard R. Michaud  
Michaud-Duffy Group LLP  
ATTORNEY for APPLICANT

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION was filed electronically and has been served by Express Mail, this 5th day of June, 2007 upon the attorney for Opposer, at the following address:

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/s/Richard R. Michaud/  
Richard R. Michaud  
Michaud-Duffy Group LLP