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

Proceeding	91196904
Party	Plaintiff OSRAM GmbH
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IN THE US PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

In re SN 77/558,655
for OSTER in CL. 09

OSRAM GmbH
Opposer

vs.

SUNBEAM PRODUCTS INC.
Applicant

Opposition # 91-196904

OPPOSER'S RESPONSE TO MOTION TO DISMISS

INTRODUCTION

Opposer OSRAM GmbH is among the two leading global producers of lighting products, is the owner of the Int. Reg. # **861 261** for the mark **OSTAR** in Classes 9, 11 & 42, the protection of which has been extended to numerous foreign countries, and is the owner of **OSTAR** US Application S.N. 76/633,973, published DEC. 6, **2005** for opposition, which is the subject of now-pending Opposition # 91-171206 filed by SUNBEAM PRODUCTS, INC., which alleged (and continues to allege) confusing similarity to various of its **OSTER** registered marks. Despite repeated attempts to settle Opposition # 91-171206, the litigation has now delayed registration of the OSTAR mark in the United States **for more than 5 years**, and defending it has caused OSRAM GmbH expenses of **more than \$20,000.00** which it cannot recover.

SUNBEAM PRODUCTS, INC. now seeks registration of **OSTER** in **Class 9**, the **same** class as Opposer OSRAM's lighting products, yet contends that OSRAM "does not allege any reasonable basis for believing it will suffer any damage from registration." Based on the facts, SUNBEAM's contention stretches credulity to the extreme.

ARGUMENT

As authority for its argument that OSRAM lacks standing to bring the present opposition, SUNBEAM relies primarily upon *Ritchie v. Simpson*, 41 USPQ 2d 1861 (TTAB), reversed, 170 F.3d 1062 (Fed. Cir. 1999). There is a saying that "hard cases make bad law." O.J. Simpson is the former football star who became nationally infamous when he was tried for, and acquitted of, murdering his wife in Southern California. Mr. Simpson sought to register the marks OJ SIMPSON, OJ and THE JUICE. Mr. Ritchie, an individual resident of New Hampshire, contended that the marks contained immoral or scandalous matter, and opposed the applications on that basis. The TTAB, apparently believing that the trademark registration process was not an appropriate forum for one individual to express moral disapproval of another individual, dismissed the oppositions. However, the Federal Circuit stated: "Because the law, as properly understood, **grants standing** in an opposition proceeding to a person in Mr. Ritchie's position, **we reverse** the decision of the Board and **remand** the case for further proceedings."

Opposer OSRAM respectfully submits that the TTAB dismissal of Mr. Ritchie's oppositions was bad law, based upon the peculiar facts of that case, as demonstrated by the 1999 reversal by the Federal Circuit, and that OSRAM clearly has a commercial interest in whether it has freedom to conduct business in the United States, using the **OSTAR** mark which it has already registered in much of the rest of the world, or will be inhibited by continued SUNBEAM harassment, based upon alleged similarity to **OSTER**, to be extended into Class 9.

COMMERCIAL INTEREST IN OSTER

In order to further its position in Opp. # 91-171206, SUNBEAM

contends that OSRAM must admit that **OSTAR** for OSRAM's goods (Light Emitting Diodes) is confusingly similar to **OSTER** for SUNBEAM's goods (here: EASY-READ MEASURING CUPS; KITCHEN SCALES; MEASURING CUPS AND SPOONS; REFRIGERATOR MAGNETS; THERMOMETERS; TIMERS; JIGGERS). However, section 2(d) similarity is not the only possible basis for standing.

During the last 30 years, the TTAB has reversed its former disinclination to permit trademark opposers to assert so-called "ex parte" issues such as surname objections. See Lefkowitz, Recent Changes in Practice Before the Trademark Trial & Appeal Board, 69 Trademark Reporter 479ff; *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544, F.2d 1098 (Fed. Cir. 1976); *Fort Howard Paper Co. v. Kimberly-Clark Corporation*, 390 F.2d 1015, 157 USPQ 55 (CCPA 1968); *The Community of Roquefort v. Santo*, 443 F.2d 1196, 170 USPQ 205 (CCPA 1971).

OSRAM's commercial interest is in its own mark **OSTAR**. OSRAM's freedom to use its mark **OSTAR** is likely to be inhibited if SUNBEAM's intent-to-use application to register **OSTER** in Class 9 succeeds. It has been held that the *mere fact that a registration is being asserted against an opposer* is sufficient to raise a presumption of damage. *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200 (CCPA 1979), affirmed 200 US PQ 103; *DaimlerChrysler v. American Motors*, 94 USPQ2d 1086 (TTAB 2010). Although the OSTER SN 77/558,655 mark has **not yet** been asserted by SUNBEAM against OSRAM, the fact that SUNBEAM **has** asserted **others** of its registrations for the OSTER mark against OSRAM leads one to infer that this mark, too, is likely to be asserted against OSRAM, **if and when** it matures to registration.

SUNBEAM amended SN 77/558,655 to insert a section 2(f) claim. *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572;

6 USPQ2d 1001 (Fed. Cir. 1988) holds that an opposer **has standing** to raise the issue of whether or not the trademark applicant has validly satisfied the requirements of section 2(f), in seeking to register a mark which would be rejected without the help of the 2(f) claim. Factually, this is precisely the situation in the present case: the examiner asserted that, *as applied to the recited goods*, OSTER is primarily merely a surname, and SUNBEAM countered with a 2(f) claim. Paragraphs 11-14 of the Notice of Opposition set forth grounds for believing that the 2(f) claim is invalid; according to the *Yamaha* precedent, OSRAM has standing to raise this issue, and there is a public policy interest in keeping marks, which do not satisfy the requirements of Section 2, off the Principal Register. See *Gilson on Trademarks*, Sections 9.03(1)(c) through (1)(f).

CONCLUSION

For purposes of deciding a motion to dismiss, the Board must assume that Opposer will be able to prove the facts alleged. Given the facts alleged in the Notice of Opposition, and further explained above, it is apparent that Opposer OSRAM GmbH has standing, and a real commercial interest in whether or not the opposed mark matures to registration. OSRAM GmbH therefore urges the Board to deny the motion to dismiss, and to require that SUNBEAM PRODUCTS, INC. file its Answer to the Notice of Opposition.

Respectfully submitted,

OSRAM GmbH

By its attorney

/Milton Oliver/

Milton Oliver, Reg. # 28,333

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DATE: DEC. 13, 2010

Attachment: International Reg. # 861,261 for **OSTAR** in I.C. 9, 11, 42



CERTIFICATE OF REGISTRATION

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the indications appearing in the present certificate conform to the recording made in the International Register of Marks maintained under the Madrid Agreement and Protocol.

A handwritten signature in black ink, appearing to read 'G. Bisson'.

G. Bisson
Head

Examination and Registration Section
International Registrations Administration Department

Geneva, October 6, 2005

861 261

Registration date: **October 27, 2004**
Date next payment due: **October 27, 2014**

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(Germany).

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OSTAR

Indication relating to the nature or kind of mark: standard characters

List of goods and services - NCL(8):

- 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transferring, storing, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; lighting control installations; light emitting diodes, including organic light emitting diodes, laser diodes, especially power laser diodes; fiberoptic wave guides, optoelectronic couplers, optical sensors, light barriers; light emitting diode modules (modules with lamp functions, constructed from light emitting diodes, including organic light emitting diodes), in particular for signalling; displays in light emitting diode technology (also displays in organic light emitting diode

technology); electronic ballasts for lighting purposes and for light emitting diodes and laser diodes, ignitors for lighting apparatus, electronic starters for lamps and luminaires.

- 11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; filament lamps, halogen lamps, fluorescent lamps, discharge lamps; special-purpose radiation lamps, especially infrared lamps, sun lamps for domestic use, lamps for solarium, ultraviolet halogen metal vapour lamps, ultraviolet lamps for industrial applications, luminaires of all kinds, including for transport engineering, automobiles and decorative purposes.
- 42 Scientific and industrial services and research and design relating thereto; industrial analysis and research services; planning and developing of computer hardware and computer software; legal services; computer programming; architecture and interior design, in particular in the field of lighting, especially by providing computer animated programs on-line for planning and simulating lighting applications.

Basic registration: Germany, 27.09.2004, 304 42 903.1/09.

Data relating to priority under the Paris Convention: Germany, 27.07.2004, 304 42 903.1/09.

Designations under the Madrid Agreement: Albania, Bulgaria, China, Croatia, Islamic Republic of Iran, Liechtenstein, Monaco, Romania, Russian Federation, Serbia and Montenegro, Switzerland, Viet Nam.

Designations under the Madrid Protocol: Australia, European Community, Japan, Norway, Republic of Korea, Singapore, Turkey.

Declaration of intention to use the mark: Singapore.

Date of notification: 06.10.2005

Language of the international application: English

* As of the 4th February 2003, the name of Serbia and Montenegro is to be used instead of the Federal Republic of Yugoslavia

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
OPPOSER'S RESPONSE TO MOTION TO DISMISS was served on Applicant by
mailing a copy thereof, first-class postage prepaid,
addressed to:

DAVIS WRIGHT TREMAINE LLP
Att'n: Cindy Caditz & Ambika Doran
1201 Third Avenue, # 2200
SEATTLE WA 981010-3045

this 13th day of DECEMBER 2010.


Milton M. Oliver
Milton M. Oliver