This is not a precedent of the TTAB.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Opposition No. 91171191 (parent)
Opposition No. 91176823
Opposition No. 91176837
Opposition No. 91176848
Opposition No. 91176851

Peer Bearing Company

v.

RBC Bearings

---and---

Opposition No. 91216123
Opposition No. 91216129
Opposition No. 91216332
Opposition No. 91219688

Peer Bearing Company

v.

Roller Bearing Co. of America, Inc.

Before Kuhlke, Ritchie, and Lynch,
Administrative Trademark Judges.

By the Board:

RBC Bearings, Inc. and Roller Bearing Company of America, Inc. ("Applicants") have filed applications for the following marks:

1600 SERIES[1] for "Ball bearings for equipment relating to construction, mining, material handling, transportation and off-highway, robotics and automation, farming, machine tool, and semiconductor applications" in International Class 7;

600 SERIES[2] for "Ball bearings for machines, motors, engines, and tools" in International Class 7;

7600 SERIES[3] for "Ball bearings for machines, motors, engines, and tools" in International Class 7;

6900 SERIES[4] for "Ball bearings for machines, motors, engines, and tools" in International Class 7;

7500 SERIES[5] for "Ball bearings for machines, motors, engines, and tools" in International Class 7;

1621[6] for "Machine parts, namely, thin section roller bearings" in International Class 7;

1630[7] for "Thin section roller bearings" in International Class 7;

1641[8] for "Thin section roller bearings for machines" in International Class 7;

1635[9] for "Thin section roller bearings" in International Class 7.

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[1] Serial No. 78535213, filed December 20, 2004, alleging 1946 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91171191.
[2] Serial No. 78745178, filed November 2, 2005, alleging 1946 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91176823.
[3] Serial No. 78754894, filed November 16, 2005, alleging September 1956 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91176837.
[4] Serial No. 78754907, filed November 16, 2005, alleging September 1956 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91176848.
[5] Serial No. 78754876, filed November 16, 2005, alleging September 1956 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91176851.
[6] Serial No. 78664362, filed July 6, 2005, alleging 1946 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91216123.
[7] Serial No. 78664347, filed July 6, 2005, alleging 1946 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91216129.
[8] Serial No. 78664533, filed, July 6, 2005, alleging 1946 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91216332.
[9] Serial No. 78664336, filed July 6, 2005, alleging 1946 as the date of first use and first use in commerce. This mark is the subject of Opposition No. 91219688.

Peer Bearing Company ("Opposer") opposes registration of these marks on the grounds, *inter alia*, that the marks are merely descriptive and/or generic terms in the bearing industry. Opposer alleges that it is a competitor in the ball bearing industry.

This case now comes up for consideration of Applicants' motion (filed August 19, 2016) for summary judgment in its favor on the issue of Opposer's lack of standing.[10] The motion is fully briefed.

Summary judgment is appropriate only when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Products, Inc. v. Eli's, Inc.,* 987 F.2d 766, 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great American Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods,* 22 USPQ2d at 1544.

In support of its motion, Applicants argue that it is undisputed that an order of the U.S. District Court stemming from a civil action between the parties gives Opposer "an unrestricted right to use the 1600 SERIES mark"; that Applicants'

[10] Applicants' request for an oral hearing on the motion is denied. *The Scotch Whiskey Association v. United States Distilled Products Co.*, 13 USPQ2d 1711 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391, 1391 n.3 (TTAB 1991) (issues on motion to dismiss not so extraordinary to warrant an oral hearing), *rev'd on other grounds*, 952F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

registration of the 1600 SERIES mark will have no impact on Opposer's right to use the mark "as it will be subject to [Opposer's] allowable use"; that a stipulation between the parties dismissing certain claims in the civil action "with prejudice as to [Opposer's] use of the 600 SERIES and 6900 SERIES marks, gives [Opposer] an unrestricted right to use the 600 SERIES and 6900 SERIES marks"; that an Order of Judgment in the civil action dismissing with prejudice all of Applicants' claims against [Opposer] for infringement of the 7500 SERIES and 700 SERIES gives [Opposer] an unrestricted right to use the 7500 SERIES and 7600 SERIES marks"; that even despite Opposer's "allowable use" of Applicants' marks, Opposer has not provided evidence during discovery that it has sold products covered by Applicants' marks for over seven years; that the documents Opposer produced amount to "a sworn admission of fact" that Opposer has "not sold any products covered by Applicant's [sic] marks since 2008"; that since Opposer has not sold any products covered by Applicants' marks since 2008, it cannot possibly establish a real interest or personal stake in the outcome of this proceeding; and that any issues of facts as to Opposer's lack of standing to maintain this opposition proceeding do not remain and Applicants are entitled to summary judgment as a matter of law.

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent intermeddlers from initiating proceedings.

Thus, to meet this requirement, a plaintiff need only show that it has a real interest in the outcome of the proceeding. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie,* 50 USPQ2d at 1025. Generally, to establish standing for a claim of genericness or mere descriptiveness, a plaintiff may show that it has a right to use the goods listed in the application or registration in a generic or descriptive manner. *Nature's Way v. Nature's Herbs*, 9 USPQ2d 2077, 2080 (TTAB 1989); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 352 (TTAB 1983); *see also Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

Here, Applicants have failed to demonstrate the absence of a genuine dispute with respect to its assertion of Opposer's lack of standing, and thus has failed to meet its burden of establishing its entitlement to judgment as a matter of law. The findings of the civil court with regard to Opposer's rights to use the marks at issue do not necessarily obviate Opposer's real interest in this proceeding or its reasonable basis for its belief that the challenged marks have caused or will cause damage. At a minimum, an issue of fact remains as to whether Opposer has a real interest in this proceeding.[11]

In view thereof, Applicants' motion for summary judgment with regard to Opposer's lack of standing is hereby denied.[12]

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[11] The fact that we have identified and discussed these genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

[12] The parties should note that the evidence submitted in connection with a motion for summary judgment is of record only for consideration of the motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the

Proceedings herein are resumed. Dates are reset as follows:

Expert Disclosures Due	**3/4/2017**
Discovery Closes	**4/3/2017**
Plaintiff's Pretrial Disclosures Due	**5/18/2017**
Plaintiff's 30-day Trial Period Ends	**7/2/2017**
Defendant's Pretrial Disclosures Due	**7/17/2017**
Defendant's 30-day Trial Period Ends	**8/31/2017**
Plaintiff's Rebuttal Disclosures Due	**9/15/2017**
Plaintiff's 15-day Rebuttal Period Ends	**10/15/2017**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD ("BOARD") RULES OF PRACTICE WILL BE **EFFECTIVE JANUARY 14, 2017**. The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 F.R. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings.
For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website: http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab
- The final rule: http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf

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appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993).

- A chart summarizing the affected rules and changes: http://www.uspto.gov/sites/default/files/documents/RulesChart_01_14_17.pdf

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by mail. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.

- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.101 and 2.111.

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.