

ESTTA Tracking number: **ESTTA1024424**

Filing date: **12/20/2019**

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

Proceeding	91240198
Party	Plaintiff Poreba Machine Tool Company LLC
Correspondence Address	NICK MARSICO HUCK BOUMA PC 1755 S NAPERVILLE ROAD #200 WHEATON, IL 60189 UNITED STATES nmarsico@huckbouma.com 630-344-1158
Submission	Testimony For Plaintiff
Filer's Name	Eric J. Malnar
Filer's email	emalnar@huckbouma.com
Signature	/Eric J. Malnar/
Date	12/20/2019
Attachments	Frank Turi Declaration.pdf(1201195 bytes )



trademark in connection with its sale of horizontal lathes and boring mills. Opposer's use of such mark has been continuous since August 31, 1982 and has not been abandoned.

6. On or about June 22, 1993, Fabryka Urzadzen Mechanicznych ("FUM") authorized Toolmex ("Toolmex") corporation to register the trademark "POREBA" for the territory of the U.S.A. I certify that a true and correct copy of the correspondence from FUM to Toolmex is attached hereto as **Exhibit A**.

7. On October 7, 1993, affiliates of Opposer filed an application for registration of trademark "POREBA", Serial No. 74,444,980, for horizontal lathes in International Class 7, which was registered by the Patent and Trademark Office as registration number 1,864,529. Registration number 1,864,529 lapsed on January 8, 2018 because a declaration was not filed under Section 8. However, Opposer in fact continued to use the POREBA trademark continuously since 1982 and has retained its common law rights to the POREBA trademark since 1982.

8. On or about January 1, 2004, FUM entered into an Exclusive Marketing Agreement with Harry Vraets and me to be the sole distributor, importer and sales agents for FUM's line of New Poreba Machine Tools, Products and Spare parts. The agreement also included the authorization for the use of the POREBA name for all sales and marketing purposes. I certify that a true and correct copy of the Exclusive Marketing Agreement is attached hereto as **Exhibit B**.

9. On or about June 22, 2004, Toolmex assigned (the "Assignment") its rights, title and interest in the registered trademark "POREBA" to Poreba North America, LLC. The Assignment was filed with the USPTO on August 24, 2004. I certify that a true and correct copy

of the Assignment is attached hereto as **Exhibit C**. Through a buyout, Poreba North America LLC's interest in the trademark "POREBA" was subsequently transferred to Opposer.

10. On March 9, 2018, affiliates of Opposer filed an application for registration of trademark "POREBA," Serial No. 87,827,131, for horizontal lathes and boring mills in International Class 7. Such affiliates have licensed to Opposer the right to use the "POREBA" trademark.

11. Opposer's mark is symbolic of its goodwill and consumer recognition built up by Opposer through its continued use of Opposer's mark. Opposer has been continuously offering the subject goods to the public. Through its advertising and continuous use since August 31, 1982, the public has come to recognize "POREBA" as signifying Opposer and its goods.

12. Applicant filed its Application Serial No. 79,196,339 seeking to register the trademark "POREBA 1798" and design for "Machine tools, namely: Computer controlled lathes, Lathes for metalworking, Milling machines for metalworking, Milling-drilling machines for metalworking, Drilling machines for metalworking, Numerically controlled turning machines, Power operated metalworking machine tools, namely, turning tools" in International Class 7.

13. Applicant's goods are very similar to Opposer's goods. If Applicant were to be permitted to register its trademark "POREBA 1798," then consumers are likely to be confused, mistaken, or deceived by the concurrent use of Opposer's trademark and the trademark of Applicant to the irreparable harm and damage to Opposer.

14. Consumers are likely to be confused, mistaken, or deceived into the belief, contrary to the fact, that Applicant's goods emanate from or are in some way sponsored or approved by Opposer or are otherwise related to Opposer. Therefore, any objections, faults, or disapproval of consumers with respect to Applicant's goods will reflect negatively upon Opposer

because of the substantial similarity to Opposer's trademark "POREBA 1798." In view of Applicant's trademark with Opposer's trademark, and in view of the similarity of the goods of the respective parties, Applicant's use of its trademark might disparage and falsely suggest a connection with Opposer, which would injure the reputation that Opposer has established for the goods provided under the "POREBA" trademark since 1982.

15. That if sworn as a witness at a trial of this cause, I could competently testify to all of the foregoing based upon my own personal knowledge and the books and records of Opposer, which have been made and kept in the ordinary course of its business.

Further, Declarant saith not.

  
FRANK TURI



# FABRYKA URZĄDZEŃ MECHANICZNYCH



ZAKŁAD • POREBA • 42-480 POREBA, UL. ZAKŁADOWA 1

TOOLMEX CORPORATION  
MACHINE TOOL DIVISION  
1702 Taylor's Lane  
Cinnaminson, New Jersey 08077

Telefon:  
ZAWIERCIE 21-601

Telex:  
6312624  
6315081

K-2 1001;  
NRP O/Zawiercie  
27401-39

Socjalizm własny:  
Poręba

Stron Informatyczny: FUM POREBA

Poręba, dnia 22 CZERWCA 1983 r.

Nasz znak;  
Na piśmie znak;  
z dnia;  
Sprawa

Wyrażam zgodę na zarejestrowanie przez Toolmex Corporation znaku towarowego FOREBAR na obrabiarki produkowane przez Fabrykę Urządzeń Mechanicznych w Porębie.

Powyższe zastrzeżenie dotyczy terenu U.S.A. tj. obszaru działania Spółki Toolmex Corporation.

  
Stanisław Cichon  
Dyrektor Naczelny

- ZAKŁAD SPECJALIZOWANY W PRACOWNIACH OBRÓBKĄ SZKŁEM SĄCZONYCH I GIEŁCZONYCH MASZYNAMI SPECJALISTYCZNYMI
- TOKARSKIE KŁOWYCH I OBRÓBKOWYCH GIEŁCZONYCH
- PRZETWARZANIE
- WYKONANIE PRZEKŁAD
- WYKONANIE PRACOWNI OBRÓBKĄ SZKŁEM SĄCZONYCH I GIEŁCZONYCH MASZYNAMI SPECJALISTYCZNYMI
- OBRÓBKOWYCH I OBRÓBKOWYCH
- OBRÓBKOWYCH DO 20 TON

MON 1/16/95

**TOOLMEX CORPORATION**

**MACHINERY DIVISION HEADQUARTERS**

1702 Taylors Lane  
Cinnaminson, NJ 08077

(609) 786-1500 800-221-1846 Telex #215037  
FAX: (609) 786-8138

P. 01  
U.S. Distributors  
TOOLMEX CO

Cinnaminson, 1/16/95

TO: Ed Palmgren  
FROM: Jack Danski

Dear Ed,

Per your request, below please find translation of letter from POREBA regarding trademark "POREBA":

" Poreba June 23, 1993

FABRYKA URZADZEN MECHANICZNYCH  
(name of factory in Poland)

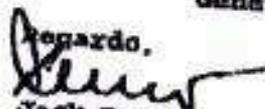
TO: TOOLMEX CORPORATION  
MACHINE TOOL DIVISION  
1702 Taylors Lane  
Cinnaminson, NJ 08077

We hereby authorize Toolmex Corporation to register the "POREBA" restricted trade mark for the machine tools produced by Fabryka Urzadzen Mechanicznych POREBA in Poreba.

The foregoing restriction applies to the territory of the U.S.A., i.e. the terrain of Toolmex Corporation activity.

sincerely,

(Signed)  
Stanislaw Cichon  
General Manager"

Regards,  
  
Jack Danski

PHILADELPHIA

PHILADELPHIA

CHICAGO

BOSTON

EXCLUSIVE MARKETING AGREEMENT

COPY

Parties:

Fabryka Urządzeń Mechanicznych „PORĘBA” Sp. z o.o., ul. Zakładowa 2, 42-480 Poreba, Poland  
and  
Partnership of Harry Vraets & Frank Turi

- 1) By order of the President of the Board, and with approval of the directors of FUM Poreba, Fabryka Urządzeń Mechanicznych „PORĘBA” Sp. z o.o. hereby awards the exclusive rights to be the sole distributor, importer, and sales agents for its product line of New Poreba Machine Tools, Products, and Spare Parts to the partnership of Harry Vraets and Frank Turi for the North American and Benelux markets commencing 01-01-2004.
- 2) This above authorization also includes the use of the PORĘBA name for all its products for all sales and marketing purposes.
- 3) This is an ongoing and continuing contract and in return the partnership of Harry Vraets and Frank Turi agrees to purchase a minimum:
  - 1 000 000,00 USD for the North American market
  - 200 000,00 EUR for Benelux market
- 4) Orders for given year the partnership of Harry Vraets and Frank Turi will send to FUM Poreba till the end of September (to a maximum) and prepayment till the end of October (to a maximum).

Fabryka Urządzeń Mechanicznych „PORĘBA”

Harry Vraets Werktuigmachines C.V.

Grzegorz Markowski  
Prezident Zarządu

*Grzegorz Markowski*

inż. Wiesław Dworak  
Dyrektor Techniczno-Handlowy

DYREKTOR  
Techniczno-Handlowy

*inż. Wiesław Dworak*

FABRYKA URZĄDZEŃ MECHANICZNYCH  
„PORĘBA” Sp. z o.o.  
ul. Zakładowa 2, 42-480 Poreba  
tel: 046/82 67-71499; fax 0315201  
42-480 POREBA

Harry Vraets

*Harry Vraets*

Harry Vraets Werktuigmachines  
PO Box 24 - 6020 AA Dordrecht  
THE NETHERLANDS

①

Letter of Intent

Written on 12.07.2003

Location: Harry Vraets Werktuigmachines, Dreumel, NL

Between:

Fabryka Urzadzen Mechanicznych Poreba Ltd.

And

Harry Vraets Werktuigmachines

The intention of both parties is to enter into an agreement in the cooperation for the sale and marketing of all "Poreba" products.

The details concerning the markets and details of the agreement will be determined in negotiations between both parties.

It is foreseen to grant Harry Vraets Werktuigmachines exclusive sales rights for all Poreba products for mutually agreed upon markets.

Harry Vraets has the intention to purchase Poreba equipment in the amount of 1,000,000 Euros for the year 2004 in exchange for the exclusive sales rights for the markets mutually agreed upon.

**F.U.M. Poreba Ltd.**

1) Prezes Grzegorz Markowski

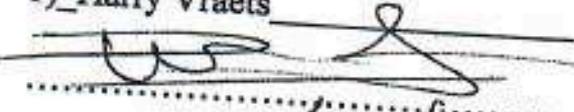


2) Wieslaw Dworak

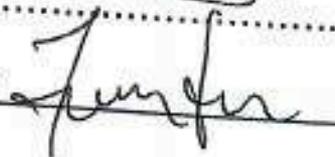
2) Janusz Stróżecki

**Harry Vraets Werktuigmachines**

1) Harry Vraets



2) Frank Turi



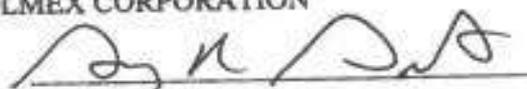
TRADEMARK ASSIGNMENT

This TRADEMARK ASSIGNMENT ("Trademark Assignment") dated as of 6-22-04, 2004 ("Effective Date"), is made by Toolmex Corporation, a Massachusetts corporation ("Assignor").

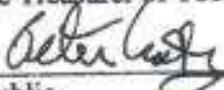
For good and valuable consideration, and pursuant to authority duly granted by the Assignor's Board of Directors, Assignor hereby assigns, transfers and conveys to Poreba North America, LLC all of its rights, title and interest in and to the trademark "Poreba", and the registration relating thereto in the United States Patent and Trademark Office, registration number 1864529, dated November 29, 1994, together with the goodwill of the business symbolized by said trademark and all rights, claims and privileges pertaining thereto, including, without limitation, the right to sue and recover damages for past, present and future infringement thereof.

IN WITNESS WHEREOF, Assignor has caused this Trademark Assignment to be executed as of the Effective Date.

TOOLMEX CORPORATION

By:   
Title: Treasurer

On this 22<sup>nd</sup> day of June, 2004, by Gary R. Greenstein, known to the undersigned notary public to be the person who signed the preceding, upon acknowledgment that he signed it voluntarily for its stated purpose as the Treasurer of Toolmex Corporation.

  
Notary Public  
Commonwealth of Massachusetts

My Commission Expires: Oct. 11, 2007

EXHIBIT B

RECORDATION FORM COVER SHEET  
TRADEMARKS ONLY

Tab settings ⇌ ⇌ ⇌ ▼ ▼ ▼ ▼ ▼ ▼ ▼

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):  
Toolmex Corporation

Individual(s)                       Association  
 General Partnership               Limited Partnership  
 Corporation-State MA  
 Other \_\_\_\_\_

Additional name(s) of conveying party(ies) attached?  Yes  No

2. Name and address of receiving party(ies)  
Name: Poreba North America, LLC  
Internal \_\_\_\_\_  
Address: \_\_\_\_\_  
Street Address: 35 Pinelawn Road  
City: Melville State: NY Zip: 11747

Individual(s) citizenship \_\_\_\_\_  
 Association \_\_\_\_\_  
 General Partnership \_\_\_\_\_  
 Limited Partnership \_\_\_\_\_  
 Corporation-State \_\_\_\_\_  
 Other Limited Liability Company - NY

If assignee is not domiciled in the United States, a domestic representative designation is attached:  Yes  No  
(Designations must be a separate document from assignment)  
Additional name(s) & address(es) attached?  Yes  No

3. Nature of conveyance:  
 Assignment                               Merger  
 Security Agreement                       Change of Name  
 Other \_\_\_\_\_

Execution Date: \_\_\_\_\_

4. Application number(s) or registration number(s):  
A. Trademark Application No. (s) \_\_\_\_\_  
B. Trademark Registration No. (s) 1864529

Additional number(s) attached  Yes  No

5. Name and address of party to whom correspondence concerning document should be mailed:  
Name: Peter Katz  
Internal Address: Day, Berry & Howard LLP  
260 Franklin Street  
Boston, MA 02110  
Street Address: \_\_\_\_\_  
City: \_\_\_\_\_ State: \_\_\_\_\_ Zip: \_\_\_\_\_

6. Total number of applications and registrations involved: .....

7. Total fee (37 CFR 3.41).....\$ \_\_\_\_\_  
 Enclosed  
 Authorized to be charged to deposit account

8. Deposit account number: \_\_\_\_\_  
(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.  
*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*

Gary R. Greenstein \_\_\_\_\_  
Name of Person Signing                              Signature  
Treasurer, Toolmex Corp.                              \_\_\_\_\_  
Total number of pages including cover sheet, attachments, and document:                               Date \_\_\_\_\_

<b>TRADEMARK ASSIGNMENT</b>
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Electronic Version v1.1

Stylesheet Version v1.1

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT		
<b>NATURE OF CONVEYANCE:</b>	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL		
<b>CONVEYING PARTY DATA</b>			
<b>Name</b>	<b>Formerly</b>	<b>Execution Date</b>	<b>Entity Type</b>
Toolmex Corporation		06/22/2004	CORPORATION: MASSACHUSETTS
<b>RECEIVING PARTY DATA</b>			
<b>Name:</b>	Poreba North America, LLC		
<b>Street Address:</b>	35 Pinelawn Road		
<b>City:</b>	Melville		
<b>State/Country:</b>	NEW YORK		
<b>Postal Code:</b>	11747		
<b>Entity Type:</b>	Limited Liability Company: NEW YORK		
<b>PROPERTY NUMBERS Total: 1</b>			
<b>Property Type</b>	<b>Number</b>	<b>Word Mark</b>	
Registration Number:	1864529	POREBA	
<b>CORRESPONDENCE DATA</b>			
<b>Fax Number:</b>	(860)275-0343		
<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>			
<b>Phone:</b>	860-275-0589		
<b>Email:</b>	ptomail@dbh.com		
<b>Correspondent Name:</b> Barb Villandry, Paralegal			

Address Line 1: CityPlace 1  
 Address Line 4: Hartford, CONNECTICUT 06103-3499

ATTORNEY DOCKET NUMBER:	309185-00140
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NAME OF SUBMITTER:	Barb Villandry, Paralegal
--------------------	---------------------------

Total Attachments: 1  
 source=Poreba#page1.tif

**RECEIPT INFORMATION**

ETAS ID: TM16422  
 Receipt Date: 08/23/2004  
 Fee Amount: \$ 40

**Katz, Peter**

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**From:** Villandry, Barbara A.  
**Sent:** Tuesday, August 24, 2004 8:29 AM  
**To:** Katz, Peter  
**Subject:** FW: ETAS. Assignment confirmation receipt ID: ETASTM16422



ETASTM16422.html  
(4 KB)

Peter--

Here is the confirmation receipt for the assignment. This is not the Notice of Recordation. That will come via fax.

The assignment is already posted in the Assignment database:  
<http://assignments.uspto.gov/assignments/q?db=tm&reel=2921&frame=0422>

Barb

-----Original Message-----

**From:** etas-server@uspto.gov [mailto:etas-server@uspto.gov]  
**Sent:** Monday, August 23, 2004 2:47 PM  
**To:** PTOMail  
**Subject:** ETAS. Assignment confirmation receipt ID: ETASTM16422

#### ELECTRONIC TRADEMARK ASSIGNMENT SYSTEM (ETAS) CONFIRMATION RECEIPT

The USPTO has received a Trademark Assignment submitted through the Electronic Trademark Assignment System (ETAS). This is the only acknowledgement of receipt that will be transmitted for this Trademark Assignment submission. The submission may not be recalled.

After review by Assignment Services Division personnel a Notice of Recordation/Non-Recordation will be returned via fax. USPTO will attempt to fax to the number provided in the submission; fax failures will be delivered via US Postal Service to the Correspondence Address provided in the submission.

If a communication from the Assignment Services Division has not been received within 60 days of your confirmation receipt contact the Assignment Services Division Customer Service Desk at 703-308-9723 or send an e-mail to [etas@uspto.gov](mailto:etas@uspto.gov).

If you have a technical question, comment or concern about your ETAS submission call 703-308-9723 during business hours or e-mail to [etas@uspto.gov](mailto:etas@uspto.gov). Please have your ETAS receipt ID which is 'ETASTM16422' available when calling or writing for assistance.

A printable version of the Confirmation Receipt is attached to this e-mail.

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ETAS server at <http://etas.uspto.gov>

\*\*\* eSafe scanned this email for malicious content \*\*\*

\*\*\* IMPORTANT: Do not open attachments from unrecognized senders \*\*\*