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

Proceeding	91240198
Party	Plaintiff Poreba Machine Tool Company LLC
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Date	06/02/2020
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.:	79,196,339
Mark:	POREBA 1798
Published in the Official Gazette on:	February 20, 2018
Poreba Machine Tool Company LLC Opposer, v. Fabryka Obrabiarek RAFAMET Spólka Akcyjna, Applicant.	Opposition No. 91240198

OPPOSER'S BRIEF IN SUPPORT OF OPPOSITION

Poreba Machine Tool Company LLC ("**Opposer**"), by its attorneys for its Brief in Opposition states the following.

STANDING

Opposer has standing to bring this Opposition because it has a real interest in the proceeding and a reasonable basis for believing it will suffer damages if the mark is registered. As shown below supported by sworn Declaration, Opposer has an interest in the mark "POREBA" and therefore believes that the approval of Applicant's mark of "POREBA 1798" would cause confusion in the marketplace and therefore damage Opposer.

FACTS AND INTRODUCTION

1. Opposer, including its predecessors, since at least as early as August 31, 1982, has been and continues to manufacture and sell horizontal lathes and boring mills. See Declaration and Rebuttal Declaration of Frank Turi.

2. Opposer, including its predecessors, since at least as early as August 31, 1982, has been and continues to use the mark "POREBA" extensively in U.S. commerce as a 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. See Declaration and Rebuttal Declaration of Frank Turi.

3. 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. See Declaration and Rebuttal Declaration of Frank Turi.

4. 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. See Declaration and Rebuttal Declaration of Frank Turi.

5. On or about January 1, 2004, FUM entered into an Exclusive Marketing Agreement with Harry Vraets and Frank Turi 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. See Declaration and Rebuttal Declaration of Frank Turi.

6. 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. Through a buyout, Poreba North

America LLC's interest in the trademark "POREBA" was subsequently transferred to Opposer. See Declaration and Rebuttal Declaration of Frank Turi.

7. 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. See Declaration and Rebuttal Declaration of Frank Turi.

8. 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. See Declaration and Rebuttal Declaration of Frank Turi.

9. 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. See Declaration and Rebuttal Declaration of Frank Turi.

10. 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. *Id.*

11. 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. *Id.*

ANALYSIS

Opposer has brought this opposition based on the likelihood of confusion between the two Marks. "The ultimate question of the likelihood of consumer confusion has been termed a question of fact. If labeled a mixed question or one of law, it is necessarily drawn from the probative facts in evidence. As so often said, each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases. In testing for likelihood of confusion under sec. 2(d), therefore, the following, when of record, must be considered:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

(3) The similarity or dissimilarity of established, likely-to-continue trade channels.

(4) The conditions under which and buyers to whom sales are made, i.e. impulsive v. careful, sophisticated purchasing.

(5) The fame of the prior mark (sales, advertising, length of use).

(6) The number and nature of similar marks in use on similar goods.

(7) The nature and extent of any actual confusion.

(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

(10) The market interface between applicant and the owner of a prior mark.

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

(12) The extent of potential confusion, i.e. whether de minimis or substantial.

(13) Any other established fact probative of the effect of use."

Application of E.I. Dupont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).

In the First factor, there is no dispute that the marks look and sound similar because they are based on the same word "POREBA." Opposer's mark is "POREBA" and Applicant's proposed mark "POREBA 1798." The words look and sound the same because they are derived from the same original company in Poland. Declaration of Slawomir Sywak, ¶ 4. As such, the connotation and commercial impressions are the same because the reference to "POREBA" in each of the marks refers to the same thing. Applicant's addition of the "1798" to "POREBA" is a reference to the original date the company began operations in Poreba, Poland. *Id.*

In the Second factor, there is no dispute that the nature of the goods or services are almost identical. Both Opposer and Applicant sell similar heavy machinery such as mills and lathes. Frank Turi Re-Buttal Declaration, ¶ 4. In the Fourth factor, the purported machines sold by both the Opposer and Applicant are expensive and would likely involve "careful, sophisticated purchasing.

In the Fifth factor, by their own admission in paragraph 6 of the Sywak Declaration, Applicant's purported predecessor does not appear to have sold any products bearing the POREBA name since 1981. Moreover, by their own admission, Applicant only gained its purported interest in the "POREBA" name from a purported involuntary dissolution bankruptcy proceeding in "…2015 and 2016 in Poland…" Declaration of Emanuel Longin Wons, ¶ 6. As such, Applicant's purported interest is only 4-5 years old. Applicant has not provided any evidence of sales using the mark since its acquisition of its predecessor. Whereas Opposer has sold since 2006 approximately 180 machines under the "POREBA" mark. Re-Buttal Declaration of Frank Turi, ¶ 4. Indeed, these machines bearing the "POREBA" mark have been and continue to be advertised on Opposer's website www.porebamachinetool.com as well as listed for sale on www.surplusrecord.com. Moreover, Opposer sends out approximately 32,000 emails every two weeks to its various clients and prospects regarding the sale of the products containing the Mark. *Id.*

In the Sixth factor, there does not appear to be any similar marks in use on similar goods as the only results from a search under "POREBA" shows only the Opposer and Applicant's current live applications as referenced above. See TESS record list display attached hereto as **Exbhit A**.

For the Seventh factor, evidence for actual confusion is only speculative because Applicant's predecessor had not sold a "POREBA" machine since 1981 and Applicant's interest in the mark only began in 2015/2016. This also applies to the Eight factor which is moot in this matter.

For the Twelfth factor, the potential for confusion is substantial because the marks are so similar and involve the same products. Moreover, based on the undisputed history as to how the

Opposer acquired the mark, and Applicant's purported purchase of the assets of a bankrupt company demonstrate that the Applicant is trying to lay claim to the same mark derived from the very same original company in Poreba, Poland.

For the Thirteenth factor, it is obvious based on the history and the amount of use and sales involving the mark that Opposer has built a brand and reputation here in the United States involving the sale of at least 180 machines since 2006. Re-Buttal Declaration of Frank Turi, ¶ 4. Applicant, a Polish company, who purportedly purchased the assets of a company in bankruptcy in Poland is now attempting try and sell its products using the same mark in the United States.

CONCLUSION

Based on the foregoing, Opposer has demonstrated that it has standing to bring this claim and that based on the factors above there is a strong likelihood of confusion to the consumer. Looking to Factors 1 and 2 alone shows that the marks themselves are identical because they derive from the same company from Poland and that both the Opposer and Applicant sell almost identical products.

/s Eric J. Malnar

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing BRIEF has been served on attorney for Applicant Fabryka Obrabiarek RAFAMET Spólka Akcyjna by forwarding a copy to:

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via e-mail to sgurda@cherskov.com on June 2, 2020. A paper copy of the filing was also sent.

/s Eric J. Malnar

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1	87827131		POREBA	TSDR	LIVE
2	79196339		POREBA 1798	TSDR	LIVE
3	74444980	1864529	POREBA	TSDR	DEAD