

This Opinion is Not a  
Precedent of the TTAB

Mailed: October 9, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Opposition No. 91240198

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*Poreba Machine Tool Company LLC*  
*v.*  
*Fabryka Obrabiarek RAFAMET Spółka Akcyjna*  
—

Eric J. Malnar of Huck Bouma PC  
for Poreba Machine Tool Company LLC

Szymon M. Gurda of Cherskov Flaynik & Gurda LLC  
for Fabryka Obrabiarek RAFAMET Spółka Akcyjna

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Before Shaw, Lynch, and Lebow  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

## **I. Background**

Applicant, Fabryka Obrabiarek RAFAMET Spółka Akcyjna, seeks registration of

the mark  (“POREBA” and “1798” disclaimed) 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.<sup>1</sup>

Opposer, Poreba Machine Tool Company LLC, opposes registration based on likelihood of confusion under Section 2(d), 15 U.S.C. § 1152(d), with its common law mark POREBA, allegedly used in connection with “horizontal lathes and boring mills” since August 31, 1982.<sup>2</sup>

Applicant denied the salient allegations of the complaint.<sup>3</sup> In its answer, Applicant also asserted purported claims against Opposer’s pending application.<sup>4</sup> The Board lacks jurisdiction to entertain the purported counterclaims against the pending application. The only counterclaims the Board can entertain are for cancellation of

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<sup>1</sup> Application Serial No. 79196339, with a filing date of July 27, 2016, is a request for extension of protection under the Madrid Protocol based on Section 66(a) the Trademark Act, 15 U.S.C. §1141f(a). The application includes the following description: “The mark consists of the stylized word ‘POREBA’ in grey within a navy blue and grey oblong. Above the oblong is a partial cog wheel in navy blue and grey with the number ‘1798’ in navy blue between the partial cog wheel and the oblong.” The colors navy blue and grey are claimed as features of the mark.

<sup>2</sup> 1 TTABVUE. Opposer also pleaded that it filed a pending application for the standard-character mark POREBA for “horizontal lathes and boring mills” in International Class 7. Applicant admitted that USPTO “records reflect that Opposer filed application serial number 87/827,131,” 8 TTABVUE 104, but otherwise denied, based on insufficient knowledge, Opposer’s other allegations about the application. During its trial period, Opposer submitted declaration testimony about the application serial number as well as the mark, goods and their classification set out therein, 15 TTABVUE 4, but did not introduce a copy of the application itself. This testimony states that “affiliates of Opposer” filed the application. *Id.*

<sup>3</sup> 8 TTABVUE 103-105.

<sup>4</sup> 8 TTABVUE.

an opposer's registrations. *See Tex. Dept. of Transp. v. Tucker*, 95 USPQ2d 1241, 1242 n.5 (TTAB 2010) (addressing answer to opposition with a "counterclaim" against the opposer's pending application by holding that "[n]o such procedure exists. In that [opposer's] application has not yet been published for opposition, and is suspended pending the outcome of this proceeding, [applicant] necessarily is not able to oppose the application at this time"); *Int'l Tel. and Tel. Corp. v. Int'l Mobile Machs. Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); *see also* Trademark Rule 2.106(b)(3), 37 C.F.R. § 2.106(b)(3). To come within the jurisdiction of the Board, a challenge to the registrability of a pending application must be the subject of an opposition proceeding. We therefore find the "claims" to be mere amplifications of Applicant's denials to the complaint and we treat them as such.

## **II. Evidentiary Record**

To the parties' credit, they lodged no evidentiary objections. Opposer attached an exhibit to its Brief consisting of a screenshot of search results from the USPTO's TESS database. However, because this material was not introduced during Opposer's trial period, it is not part of the evidentiary record, and we have not considered it. *See* Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g) (evidence admissible by notice of reliance must be filed during the party's testimony period).

The record consists of:

- The pleadings.
- The file of opposed Application Serial No. 79196339.<sup>5</sup>

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<sup>5</sup> *See* 37 C.F.R. § 2.122(b).

- Opposer’s testimony declaration and rebuttal testimony declaration of Opposer’s President, Frank Turi, including numerous exhibits.<sup>6</sup>
- Applicant’s testimony declaration of Emanuel Longin Wons, President of Applicant, including numerous exhibits.<sup>7</sup>
- Applicant’s testimony declaration of Slawomir Sywak, Applicant’s former employee, including numerous exhibits.<sup>8</sup>
- Applicant’s First Notice of Reliance on assignment documents and a combined declaration of use/application for renewal from the file of Registration Number 1864529, which has been cancelled.<sup>9</sup>
- Applicant’s Second Notice of Reliance on European Union Certificate of Registration Number 017925590.<sup>10</sup>

### III. Opposer’s Statutory Entitlement to Oppose<sup>11</sup>

To establish entitlement to a statutory opposition cause of action under Section 13 of the Trademark Act, 15 U.S.C. § 1063, Opposer must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at \*3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d

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<sup>6</sup> 15 TTABVUE and 23 TTABVUE.

<sup>7</sup> 18 TTABVUE.

<sup>8</sup> 19 TTABVUE.

<sup>9</sup> 20 TTABVUE.

<sup>10</sup> 21 TTABVUE. Applicant described the relevance of the foreign registration as “show[ing] ownership of the name in [Applicant’s] home territory, the only authorized source of goods having the Poreba mark.” *Id.* at 2.

<sup>11</sup> Despite the shift in nomenclature from “standing,” our prior decisions and those of the Court of Appeals for the Federal Circuit that refer to “standing” in interpreting Section 13 remain applicable.

1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Mr. Turi testified that Opposer has used the mark POREBA since 1982 for horizontal lathes and boring mills.<sup>12</sup> *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (common law use of similar mark sufficient to establish standing). Based on his testimony regarding alleged common law use, Opposer has asserted a plausible likelihood of confusion claim against the involved application, thereby showing a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of damage. We therefore conclude that Opposer has proven its entitlement to bring this opposition proceeding.

#### **IV. Section 2(d) Claim – Priority**

As a threshold matter, to prevail on its likelihood of confusion claim, Opposer must establish priority. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013) (citing *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987)). Applicant is entitled to rely on its application filing date of July 27, 2016 as its constructive use date. Opposer has not pleaded ownership of a federal registration, but instead relies on common law rights in its mark. Therefore, Opposer must establish prior proprietary rights in the mark for its claimed goods. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995). Specifically, Opposer must prove that it owns a trademark that was used in connection with the goods, and not abandoned, prior to

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<sup>12</sup> 15 TTABVUE 2-3.

Applicant's July 27, 2016 constructive use date. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

### A. Opposer's Evidence

Opposer rests its priority claim solely on Mr. Turi's declaration testimony and the exhibits attached to his opening and rebuttal declarations. With the exception of one exhibit dated 2020, discussed further below, none of the exhibits refer specifically to Opposer. Mr. Turi's opening declaration includes the following relevant portions:<sup>13</sup>

5. Opposer, including its predecessors, since at least as early as August 31, 1982, has been and continues to use the trademark "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.

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<sup>14</sup> 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

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<sup>13</sup> 15 TTABVUE 2-4 (Turi Declaration).

<sup>14</sup> No further detail is provided about Opposer's "affiliates," which may or may not be considered related companies under the applicable rules. Section 45 the Trademark Act, 15 U.S.C. § 1127, defines as "related company" as "any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used. For purposes of priority, use by a related company inures to the benefit of the owner. See 37 C.F.R. § 2.38(a). The definition of "affiliate" in the American Heritage Dictionary online, of which we take judicial notice, is "[a] person, organization, or establishment associated with another as a subordinate, subsidiary, or member: *network affiliates*." <https://www.ahdictionary.com/word/search.html?q=affiliate>, accessed October 6, 2020. See *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018).

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<sup>15</sup> 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.

As indicated in his testimony, Mr. Turi attached some documents to his declarations. Exhibit A includes a translated copy of a letter that does not refer to Opposer, but in which FUM "authorize[s] Toolmex Corporation to register the 'POREBA' restricted trade mark for the machine tools produced by [FUM] in Poreba," only in the U.S.<sup>16</sup> Exhibit A also contains a 2003 Letter of Intent and the mentioned "Exclusive Marketing Agreement" that also does not refer to Opposer, but "awards the exclusive rights to be the sole distributor, importer, and sales agent 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

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<sup>15</sup> Again, no further detail is provided about the "affiliates."

<sup>16</sup> 15 TTABVUE 7.

commencing 01-01-2004.”<sup>17</sup> The Agreement further provides that “[t]his above authorization also includes the use of the POREBA name for all its products for all sales and marketing purposes.”<sup>18</sup>

In a document titled “Trademark Assignment” dated “6-22-04,” included in Exhibit A, Opposer is again not mentioned, but Toolmex Corporation assigns 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....”<sup>19</sup>

No documentary evidence supports Mr. Turi’s declaration testimony regarding Opposer’s purported “buyout” of Poreba North America LLC or the attendant transfer of trademark rights.

Subsequently, in his rebuttal declaration, Mr. Turi states in relevant part:

4. Since approximately 2006 to the Present, Opposer has sold approximately 180 of the following machines under the Mark [POREBA 1798] in the United States:

- a. Horizontal Boring Mills;
- b. Manual Lathes;
- c. CNC Lathes;
- d. CNC Vertical Machining Center.

These machines and others have been and continue to be advertised on Opposer’s website [www.porebamachinetool.com](http://www.porebamachinetool.com) as well as listed for sale on [www.surplusrecord.com](http://www.surplusrecord.com). See Attached. Moreover, Opposer sends out

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<sup>17</sup> 15 TTABVUE 8.

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at 10.

approximately 32,000 emails every two weeks to its various clients and prospects regarding the sale of the products containing the Mark.<sup>20</sup>

The only attachment to the rebuttal declaration consists of three pages of promotional material, and the following mark appears near photos of some of the machines tools

mentioned above:  . The only date is in the 2020 copyright notice appearing on the last page.<sup>21</sup>

### **B. Applicant's Evidence**

Turning to Applicant's evidence, Mr. Won testifies that Mr. Turi "was FUM's distributor starting from 1992, when he began to work for the Belmont Company, which was one of many sub-distributors of Toolmex."<sup>22</sup> Mr. Won's declaration testimony is consistent with Mr. Turi's testimony and documents in stating that FUM authorized Mr. Turi and Mr. Vraets to be its distributors beginning in 2004.<sup>23</sup> Mr. Won also states that "[t]he distributorship [with Mr. Turi] was terminated in 2006 with a registered letter dated July 19," and a copy of the letter was attached to his declaration.<sup>24</sup> Applicant also provided a copy of a response letter to FUM from Mr. Turi, Mr. Vraets, and Terry Lashin indicating that they "have no intention of allowing [FUM] to terminate the distribution rights," and "also reject [FUM's] claim that we

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<sup>20</sup> 23 TTABVUE 2.

<sup>21</sup> 23 TTABVUE 4-6.

<sup>22</sup> 18 TTABVUE 4.

<sup>23</sup> 18 TTABVUE 5, 43.

<sup>24</sup> 18 TTABVUE 5, 62-63.

can not [sic] use the name ‘Poreba,’” noting that “Poreba North America is the registered owner of the ‘Poreba’ trademark.”<sup>25</sup>

Mr. Won further states that Applicant acquired Poreba Machine Tool as a subsidiary following the dissolution and bankruptcy proceedings of former owner FUM.<sup>26</sup> According to Mr. Won, “[t]he acquisition included all rights then held by FUM,” and Opposer was not a party to the bankruptcy proceeding and acquired no assets as a result of it.<sup>27</sup> An exhibit to Mr. Won’s declaration is a Polish Financial Supervision Authority report that corroborates Opposer’s acquisition of FUM assets including “the ‘POREBA 1798 trademark.”<sup>28</sup>

Applicant’s other declarant, Mr. Sywak, states that Mr. Turi “was FUM’s distributor starting from 1992, when he began to work for the Belmont Company, which was one of many sub-distributors of Toolmex. Toolmex was the only authorized distributor of Poreba-branded machines starting with the [19]80’s.”<sup>29</sup> According to Mr. Sywak, after “FUM was involuntarily dissolved by a bankruptcy court in Poland in 2015,” terminating any contractual obligations between FUM, Mr. Turi, and Mr. Vraets.<sup>30</sup>

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<sup>25</sup> *Id.* at 64.

<sup>26</sup> 18 TTABVUE 3.

<sup>27</sup> *Id.*

<sup>28</sup> *Id.* at 15.

<sup>29</sup> 19 TTABVUE 6.

<sup>30</sup> *Id.* at 6-7.

### C. Analysis of Priority

As the plaintiff in this proceeding, Opposer bears the burden of proof. *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (“[T]he burden of proof rests with the opposer . . . to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion”); *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) (“[I]n opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark”). To prevail on the likelihood of confusion ground under Section 2(d), Opposer must prove by a preponderance of the evidence its priority of use based on alleged common law rights. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

Opposer has not introduced documentary evidence showing its own use of the mark except for a promotional exhibit dated 2020. *Cf. Exec. Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (TTAB 2017) (“Oral testimony is strengthened by corroborative documentary evidence”). Instead, Opposer relies on Mr. Turi’s conclusory statement that Opposer has continuously used the mark since 1982. While oral testimony alone can establish priority of use in a trademark proceeding, such testimony must not be characterized by “inconsistencies, contradictions and uncertainties.” *Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). Moreover, we must “look at the evidence as a whole, as if each piece of evidence were part of a puzzle

which, when fitted together, establishes prior use.” *W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

Here, Mr. Turi’s own testimony, standing alone and in the context of the documentary evidence and testimony of other witnesses, reveals inconsistencies and uncertainties. The testimony and exhibits as a whole paint an indefinite picture of Opposer’s alleged ownership of the POREBA mark and present inconsistencies as to the nature of Opposer’s alleged common law use since 1982, and to whose benefit such alleged use would have inured.

For example, Mr. Turi states that “[t]hrough [Opposer’s] advertising and continuous use since August 31, 1982, the public has come to recognize ‘POREBA’ as signifying Opposer and its goods.”<sup>31</sup> However, he also acknowledges that in June 1993, Toolmex’s registration of the POREBA mark in the U.S. was authorized by FUM shortly before “affiliates of Opposer filed an application for registration” in October 1993.<sup>32</sup> In addition, Mr. Turi acknowledges that as of January 2004, FUM authorized Mr. Turi and Mr. Vraets to be “the sole distributor, importer and sales agents for FUM’s new line of New Poreba Machine Tools, Products and Spare parts,” and that “[t]he agreement also included the authorization for the **use** of the POREBA name for all sales and marketing purposes.”<sup>33</sup>

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<sup>31</sup> 15 TTABVUE 4.

<sup>32</sup> *Id.* at 3.

<sup>33</sup> *Id.* (emphasis added).

Thus, at that point, any use of the mark by Mr. Turi and Mr. Vraets (perhaps among the “predecessors” Opposer refers to) was authorized in their capacities as distributors. However, absent an express agreement otherwise as to ownership, “a U.S. distributor of goods manufactured by a foreign producer does not acquire the right of ownership in the manufacturer’s mark merely by virtue of its activity as the importer and seller of the foreign producer’s goods.” *Societe Civile des Domaines Dourthe Freres v. S.A. Consortium Vinicole de Bordeaux et de la Gironde*, 6 USPQ2d 1205, 1210 (TTAB 1988); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1201.06(a) (Oct. 2018) (providing that a distributor does not own a mark “merely because it moves the goods in trade”). Thus, given the distributor arrangement in 2004, such use would have inured to the benefit of FUM. *See Genie Sales Co. v. The Alliance Mfg. Co.*, 136 USPQ 84, 85 (TTAB 1962) (rejecting as “clearly without merit” distributor’s contention that it was entitled to the benefit of the use it made of a mark as distributor); *Scranton Plastic Laminating, Inc. v. Mason*, 187 USPQ 335, 342-43 (TTAB 1975) (the manufacturer-sales agent relationship created a “prima facie presumption that any use of the mark ‘SANALITE’ during this period by applicant was done so as a representative or an agent of opposer, on behalf of opposer, and in the furtherance of opposer’s business; and that any goodwill created by such use inured to opposer’s benefit).

Mr. Turi next states that later in 2004, Toolmex assigned to Poreba North America, LLC the rights, title and interest in the registered POREBA mark,<sup>34</sup>

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<sup>34</sup> *Id.*

presumably the registration that resulted from the 1993 application by “affiliates of Opposer.” Next, Mr. Turi testifies that at some unspecified time “subsequently,” Opposer acquired from Poreba North America, LLC the “interest in the trademark ‘POREBA.’”<sup>35</sup> Oddly, even though Mr. Turi’s testimony places ownership of the mark with Opposer at that point, the next paragraph of Mr. Turi’s declaration states that “affiliates of Opposer” applied to register POREBA in 2018 and “have licensed to Opposer the right to use the ‘POREBA’ trademark.”<sup>36</sup> It is unclear why, if Opposer were the owner of the mark, its “affiliates” would apply for registration and license the mark to Opposer.

We also consider Mr. Turi’s uncorroborated statements in his rebuttal declaration regarding Opposer’s sales since “approximately 2006.”<sup>37</sup> We note that the record reflects that Mr. Turi remained FUM’s exclusive distributor at least through July 2006, when FUM issued its termination letter,<sup>38</sup> and further reflects that Mr. Turi expressed a view at that time that the distributorship relationship would continue.<sup>39</sup> This evidence casts doubt on his rebuttal declaration testimony regarding sales and to whose benefit such sales would inure.

Ultimately, the inconsistencies regarding ownership of the mark and the indefinite nature of Opposer’s alleged use lead us to find that Mr. Turi’s conclusory

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<sup>35</sup> *Id.* at 4.

<sup>36</sup> *Id.*

<sup>37</sup> 23 TTABVUE 2.

<sup>38</sup> 18 TTABVUE 5, 62-63.

<sup>39</sup> *Id.* at 64.

statement about Opposer's continuous use of the mark since 1982 does not "carry with it conviction of its accuracy and applicability" that would merit its serving as the basis for Opposer's priority. *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945); *see also Exec. Coach Builders*, 123 USPQ2d at 1184 (discrediting witness testimony that was "indefinite and internally inconsistent; unsupported by documentary evidence; and contradicted by the documentary evidence that is of record, as well as by the clear and consistent testimony of eight other trial witnesses"). Opposer has not demonstrated common law rights in the mark that pre-date Applicant's July 27, 2016 constructive use date. Therefore, Opposer has not established priority, and cannot prevail on its likelihood of confusion claim. *See* 15 U.S.C. § 1052(d) (requiring "a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States"); *see also Bose Corp.*, 63 USPQ2d at 1305.

**Decision:** The opposition is dismissed.