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Filing date: **04/27/2018**

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

Proceeding	91240198
Party	Defendant Fabryka Obrabiarek RAFAMET SpÅ³ka Akcyjna
Correspondence Address	SZYMON M GURDA CHERSKOV FLAYNIK & GURDA LLC 123 W MADISON ST CHICAGO, IL 60602 UNITED STATES Email: mail@cherskov.com
Submission	Motion to Extend
Filer's Name	Szymon M. Gurda
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Signature	/Szymon M. Gurda/
Date	04/27/2018
Attachments	Petition.pdf(1049735 bytes)

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

Poreba Machine Tool Company LLC)	Serial No.	: 79/196,339
)	Date of Filing	: July 27, 2016
Petitioner,)		
)		
)	Opposition No.	: 91240198
v.)		
)		
)	Mark	:POREBA and design
Fabryka Obrabiarek RAFAMET S.A.)		
)		
Applicant Respondent.)		

RESPONDENT’S MOTION TO EXTEND TIME

Respondent, Fabryka Obrabiarek RAFAMET S.A., (hereinafter “Rafamet”) submits a request to extend time to file an answer. Due to the circumstances of the case detailed below, Rafamet requires an additional 45 days to assemble documents and file an answer with counter-claims. Respondent has been diligent in securing documents central to the issues of this proceeding, but requires more time to formulate a response. This request is being filed during the initial period to file an answer (the deadline being May 1), and so it is in the form of a motion to extend time.

In support of this motion, Respondent states as follows:

1. On or about January 21, 2016, respondent Rafamet acquired assets the predecessor company Fabryka Urządzeń Mechanicznych Poręba Sp. z o.o. (hereinafter “FUM”) through a bankruptcy proceeding. The acquisition included all trademark rights held by FUM.
2. FUM, and its predecessors have been using the Poreba name and mark since the 19th century. Upon information and belief, FUM had a commercial presence in the U.S. market

even before World War II. Throughout its history, FUM attended international machine tool shows in the US and other jurisdictions. Since at least the 1970's, it appears that FUM was selling machine tools through an entity called Polamco, Polish-American Machinery Corporation of Elk Grove Village, Illinois.

3. During the 1980's, FUM's opportunities to sell abroad directly were limited due to the communist regime in power at that time in Poland. Nonetheless, FUM entered into both formal and informal arrangements with distributors, including in the US.

4. Upon information and belief, one of the results of these arrangements was a distributorship arrangement with ToolMex Corporation to distribute machines under the Poreba name, starting with the 1980's.

5. With the transition to capitalism in Poland in the early 1990's FUM could then enter into formal agreements. At that time, FUM formalized their arrangement with ToolMex. One of the agreements made between FUM and ToolMex gave ToolMex permission to register the trademark as shown in Exhibit A.

6. Petitioner (Poreba) claims to have acquired rights to the Poreba name from ToolMex, which upon information and belief is contrary to the terms of any distributorship agreement between Rafamet or FUM and Toolmex.

7. Rafamet does not have direct or timely access to predecessor FUM's documents. Instead, Rafamet must request the documents from FUM's bankruptcy trustee, who, in turn, assembles the documents and otherwise make them available to Rafamet.

8. Further, any documents received will be in paper form, and will require translation.

9. Rafamet has been diligent in assembling held documents and in attempting to secure documents held by FUM's bankruptcy trustee assembling ahead of the May 1 deadline. For instance, Rafamet has obtained from its records documents showing that ToolMex was authorized to by FUM apply for the trademark application that Poreba now asserts. This document is attached as Exhibit A and demonstrates, at the very least, that a relationship existed between ToolMex and FUM.

10. Further, Rafamet has obtained communications between FUM and Toolmex informing them that Toolmex is to abandon its registration (attached as Exhibit B).

11. Obtaining the complete records in this matter will allow Rafamet to file an answer with the counterclaims it is entitled to raise. The actual license and distributorship agreement is important in determining who is the beneficiary of the good will associated with the mark asserted by Poreba.

12. Upon information and belief, FUM's records may include the actual distributorship and license agreement between FUM and Toolmex, as well as evidence of sales of products bearing the POREBA mark in the US through Toolmex as well as before the Toolmex agreement. Both the agreement or agreements and evidence of sales are highly relevant to the case as Poreba claims to be a senior user of the mark.

13. Rafamet does not believe that the delay will be prejudicial to Poreba. If Rafamet was forced to answer by the May 1 deadline, it would then be entitled to file an amended answer once the documents are retrieved, thereby resetting the deadlines in the case. Instead, the speedy resolution of the case will be aided by presenting claims in its initial answer.

14. Further, by providing time to access all documents now, Rafamet will hopefully avoid having to issue third-party subpoenas to ToolMex. Given that these subpoenas would

require district court approval in Massachusetts, such proceedings would also delay this case by more time than the proposed extension to answer.

15. Respondent respectfully submits that attempting to retrieve documents that will indicate who is the beneficiary of petitioner's asserted first use is a good cause to extend the answer deadline. Rafamet has not been guilty of negligence or bad faith, and the privilege of extensions is not abused inasmuch as this is the first request to extend a deadline. *Am. Vitamin Products Inc. v. Dow Brands Inc.*, 22 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1992).

16. Explaining these circumstances, counsel for Respondent attempted to obtain consent to extend the time period from the Petitioner's attorney, but the parties were not able to agree to an extension, thereby necessitating this motion.

WHEREFORE, Petitioner prays that the Board extend the deadline to file an answer.

Respectfully submitted,

April 27, 2018
Date

/Szymon M. Gurda/
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(Tel) 312-621-1330
(Fax) 312-621-0088
Attorney for Respondent

Exhibit A – Instructions from Predecessor to Register Trademark in the US

P. 2

TOOLMEX CORPORATION
MACHINERY DIVISION HEADQUARTERS
1702 Taylors Lane
Cinnaminson, NJ 08077
(609) 766-1500 800-221-1844 Telex 8715037
FAX (609) 766 8133

U.S. Distributors
POLAMCO

Cinnaminson, 1/16/95

TO: Ed Palmgren
FROM: Jack Dunski

Dear Ed,

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

* Poreba June 22, 1993

FABRYKA UKAZADZEN 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 Ukazaden 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 Dunski
Jack Dunski

COPY

LAC ANGELES PHILADELPHIA CHICAGO BOSTON

Exhibit B – Letter Revoking License

FABRYKA URZĄDZEŃ MECHANICZNYCH

1798

POREBA Spółka z o.o.

Spółka z o.o. 42-480 Poręba, ul. Zakładowa 2
www.fum-poreba.pl

00714

Telefon: +048 (32) 6773400 Telefax: +48(32)6771499

REGON 276140260
NIP: 649-19-09-070
skrót telegr.: FUM-POREBA Sp.z o.o.

Toolmex Corporation
Corporation Massachusetts
1075 Worcester Road Natick
Massachusetts 01760

Poręba, dnia19.07..... 2006..... r.

Nasz znak:
Na pismo znak:
z dnia:
Sprawa:

Translation from Polish language, without empty spaces and instructions.

ZAKŁAD SPECJALIZUJE SIĘ
W PRODUKCJI OBRABIAREK
ŚREDNICH I CIĘŻKICH
ORAZ SPECJALISTYCZNYCH

●
TOKAREK KŁOWYCH
I UCHWYTOWYCH CIĘŻKICH

●
FREZAREK BRAMOWYCH

●
WIERTARKO-FREZAREK

●
WYPOSAŻENIA TECHNOLOGICZNEGO
DO W/W OBRABIAREK

●
ORAZ INNYCH ZŁECONYCH
OBRABIAREK

●
ODLEWÓW DO 30 TON WAGI

Since we know that the “Poręba” trademark has been registered by you at the United States Patent and Trademark Office (USPTO) we inform that we have started the procedure of invalidating the above-mentioned trademark at the Office.

A basis for our demand is article 6 bis of the Paris Convention, because it is obvious that you have appropriated illegally the “Poręba” trademark, which has been commonly known since 1798 also in the US market.

Therefore we forbid to use the above-mentioned trademark, stressing at the same time that if in the US market appear any goods with the “Poręba” trademark which have not been manufactured in our Company, we will have to seek appropriate compensation.

Furthermore we wish to know what was the basis for entering the above-mentioned trademark into the register, because the factual circumstances show you have newer bad any rights to it since during the whole period of our cooperation you have only been the sole distributor of our machine tools in the US market.

*I hereby certify that the above translation corresponds with the Polish document presented to me. Katowice 26th July 2006
Rep. nr 545/2006
Sworn Translator Mr Małgorzata Majewska MA
ul. Roździeńskiego 96/120 40-203 Katowice*

Chairman of the Management Board
Andrzej Buchta



Certificate of Service

I hereby certify that a true and complete copy of the foregoing Respondent's Motion to Extend Time has been served on attorney for Petitioner Poreba Machine Tool Company LLC by forwarding said copy to:

MR. NICK MARSICO
HUCK BOUMA PC
1755 S NAPERVILLE ROAD #200
WHEATON, IL 60189
UNITED STATES

via e-mail to nmarsico@huckbouma.com on April 27, 2018.

April 27, 2018
Date

/Szymon M. Gurda/
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