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Filing date: **01/13/2009**

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

Proceeding	92047274
Party	Plaintiff Bandit Industries, Inc.
Correspondence Address	Joseph W. Byrne Boardman, Suhr, Curry & Field LLP One South Pinckney Street, Fourth Floor Madison, WI 53703 UNITED STATES jbyrne@boardmanlawfirm.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Robert C. Corbett
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Signature	/Robert C. Corbett/
Date	01/13/2009
Attachments	BAN0101TM Motion to Suspend - cancellation.pdf (3 pages)(108066 bytes) Exhibit 1.pdf (9 pages)(485176 bytes) Exhibit 2.pdf (8 pages)(516363 bytes) Exhibit 3.pdf (4 pages)(360677 bytes) Exhibit 4.pdf (10 pages)(371634 bytes) Service Motion.pdf (1 page)(10127 bytes) BAN0101TM Brief in support of motion - cancellation.pdf (2 pages)(120711 bytes) Service Brief.pdf (1 page)(10452 bytes)

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

BANDIT INDUSTRIES, INC.,
a Michigan corporation,

Petitioner,

v.

Cancellation No. 92047274

ELECTRONIC SOLUTIONS OF HARRISON, LLC.,
a Michigan limited liability company,

Respondent.

_____ /

PETITIONER'S MOTION FOR SUSPENSION OF PROCEEDING

NOW COMES Petitioner, and hereby moves the Trademark and Trial and Appeal Board to suspend the above-captioned proceeding, pursuant to 37 CFR 2.117 for the reason that the parties in this matter are engaged in a civil action which may have a bearing on the case. In support of this motion, Petitioner states as follows:

1. Petitioner initiated this action on March 22, 2007. A copy of the Petition for Cancellation is attached hereto as **Exhibit 1**.

2. Respondent's Answer to the petition was filed May 1, 2007. A copy of the Answer is attached hereto as **Exhibit 2**.

3. The petition to cancel seeks cancellation of the registered trademark "AUTO-FEED PLUS", Registration No. 2,704,634. In the Petition, Petitioner Bandit Industries, Inc. claims, *inter alia*, to have ownership of the trademark "AUTO-FEED PLUS" as the senior user of the trademark. (See Petition for Cancellation, especially paragraphs 17 and 38.)

4. Petitioner Bandit Industries, Inc. filed an application to register the trademark “AUTO-FEED PLUS” on March 20, 2007 (Application Serial No. 77/135666).

5. Respondent Electronic Solutions of Harrison, LLC filed a Notice of Opposition to oppose Petitioner’s registration of the trademark “AUTO-FEED PLUS” on December 11, 2008 (91188033). (A copy of the Notice of Opposition is attached hereto as **Exhibit 3**.)

6. Thus, ownership of the trademark “AUTO-FEED PLUS” is claimed by both the Petitioner and the Respondent.

7. Petitioner and Respondent are parties to a civil action initiated by Respondent on December 11, 2008, as *Electronic Solutions of Harrison, LLC v. Bandit Industries, Inc.*, in the United States District Court for the Eastern District of Michigan, Case No. 1:08-cv-15113-TLL-CEB. (A copy of the Complaint is attached hereto as **Exhibit 4**.)

8. In that civil action, Respondent Electronic Solutions of Harrison, LLC claimed that Petitioner Bandit Industries, Inc. was infringing its registered mark “AUTO-FEED PLUS” under 15 U.S.C. § 1114(1)(a) and also claimed false designation of origin under 15 U.S.C. § 1125(a).

9. Resolution of the civil action, as well as resolution of the Cancellation and Opposition proceedings, involves determining ownership of the trademark “AUTO-FEED PLUS”.


10. 37 CFR 2.117(a) provides:

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

11. It is obvious that the civil action currently pending between the parties has a bearing on the Petition for Cancellation now pending before the Trademark Trial and Appeal Board. Indeed, the identical issues are involved.

WHEREFORE, Petitioner Bandit Industries, Inc., requests that the Trademark Trial and Appeal Board suspend the above-captioned proceedings before it pending a final decision in the civil action currently pending between the parties, *Electronic Solutions of Harrison, LLC v. Bandit Industries, Inc.*, in the United States District Court, Eastern District of Michigan, Civil Action No1:08-cv-15113-TLL-CEB.

Quinn Law Group, PLLC.

BY: 
Robert C. Corbett (P64033)
Quinn Law Group, PLLC
Attorneys for Petitioner
39555 Orchard Hill Place, Suite 520
Novi, MI 48375
(248) 380-9300

Dated: January 13, 2009

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

In re Registration of:

Registrant:	Janet L. Snider, a Michigan Corporation
Reg. No.:	2,704,634
Mark:	AUTO-FEED PLUS
Registration Date:	April 8, 2003
Current Filing Basis:	1A

BANDIT INDUSTRIES, INC.,
a Michigan Corporation,
Petitioner

Cancellation No.:

v.

JANET L. SNIDER,
a Michigan Corporation,
Registrant

Box TTAB
FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION

Petitioner, Bandit Industries, Inc. (“Bandit”), in accordance with Trademark Rule 2.112(b), hereby petitions the United States Patent and Trademark Office Trademark Trial and Appeal Board (“TTAB”) to cancel Registration No. 2,704,634 for the trademark, AUTO-FEED PLUS (“Registered Mark”), which was registered on April 8, 2003 on the Principal Register based on the following grounds:

PETITIONER'S STATEMENT

1. Janet L. Snider, a Michigan Corporation (“Snider Corp.”), was not the proper owner at the time of filing the application for the Registered Mark or anytime prior to or thereafter nor was Snider Corp. entitled to use the Registered Mark in commerce at the time of filing the application or anytime prior to or thereafter;
2. Snider Corp. did not and has not applied the Registered Mark to goods that it produces or used the Registered Mark in the sale or advertising of its goods or services that it performs;
3. The Registered Mark is likely to be confused with Bandit’s AUTO-FEED PLUS trademark, which has been used continuously in commerce, in connection with feed systems for wood and brush chippers, since before Snider Corp. used the Registered Mark, in connection with substantially similar and related goods.

BACKGROUND

4. Bandit hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 3.
5. Bandit Industries, Inc. is a corporation organized under the laws of the State of Michigan with a principal place of business at 6750 Millbrook Road in Remus, Michigan 49340.
6. Upon information contained within the Certificate of Registration for the Registered Mark, Registrant, Janet L. Snider (“Snider Corp.”) is a

corporation organized under the laws of the State of Michigan with a principal place of business at 930 W. Spruce Street in Harrison Michigan 48625.

7. On July 5, 2001, Snider Corp. filed a federal trademark application with the United States Patent and Trademark Office (“USPTO”) for the mark, AUTO-FEED PLUS, having Serial Number 78/072477 (the “‘477 Application”). *Exhibit 1.*
8. Snider Corp. originally filed the ‘477 Application within International Class 007 on both a §1(a) and a §1(b) basis for identical goods – “Programmable Digital Auto Feed Control for industrial power machinery.”
9. The ‘477 Application identified the date of first use anywhere and the date of first use in commerce as April 21, 2001 and was signed by Janet L. Snider, a duly authorized officer of Applicant, Janet L. Snider, a Michigan Corporation.
10. On August 3, 2001, the Examining Attorney assigned to the ‘477 Application issued a Non-final Office Action (“First Office Action”) refusing registration based on: §2(d) likelihood of confusion; indefinite recitation of goods; disclaimer requirement; and an unacceptable date of first use in commerce. *Exhibit 2.*
11. On October 30, 2001, Snider Corp. responded to the First Office Action via email correspondence, which: (i) amended the recitation of goods; (ii) disclaimed use of “auto-feed” apart from the mark; (iii) changed the date

- of first use in commerce to April 11, 2001; and (iv) changed the date of first use anywhere to March 1, 2001. *Exhibit 3.*
12. However, the Examining Attorney did not enter the amended dates of use since Snider Corp. did not include the requisite declaration. *See handwritten notes on Exhibit 3.*
 13. On January 14, 2002, the Examining Attorney emailed Snider Corp. indicating that the amended dates of use were unacceptable since they were not accompanied by a signed declaration. The Examining Attorney also provided instructions regarding how Snider Corp. could acceptably amend the dates of first use and prepare an appropriate declaration. *Exhibit 4.*
 14. On February 7, 2002, Snider provided email correspondence in response to the Examining Attorney's January 14th email with the statement, "If I need to do anything else, please let me know." *Exhibit 4.*
 15. On March 14, 2002, a Trademark Examination Worksheet was entered into the file for the '477 Application, which indicated that the date of first use and date of first use in commerce had been amended but did not indicate that a "Certification" or declaration verifying such dates was filed. *Exhibit 5.*
 16. On April 8, 2003, Snider Corp. received registration for the Registered Mark on the Principal Register, having Registration No. 2,704,634 (the "634 Registration"). *Exhibit 6.*

17. Bandit has filed an application with the USPTO for registration of the trademark, AUTO-FEED PLUS, for use in connection with feed systems for wood and brush chippers within International Class 007 based on actual use in commerce at least as early as April 3, 2001, which pre-dates Snider Corp.'s date of first use in commerce. *Exhibit 7.*
18. Bandit's trademark application is currently pending with the USPTO and it is likely that the Examining Attorney assigned to Bandit's trademark application will refuse registration based on the Registered Mark.
19. Bandit has advertised, promoted and sold its products in connection with AUTO-FEED PLUS trademark in the United States and elsewhere since at least as early as March 29, 2001. As a result of such advertising and promotional activities and as a result of sales of the goods bearing the AUTO-FEED PLUS trademark, Bandit's trademark has become favorably known to the trade and to the public, and has become known and recognized as belonging to Bandit, thus identifying to purchasers and prospective purchasers quality goods originating from Bandit.

CLAIM I – FRAUD

SNIDER CORP. IS NOT THE OWNER OF THE REGISTERED MARK

20. Bandit hereby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 19.

21. The '477 Application identified the owner of the AUTO-FEED PLUS trademark as Janet L. Snider (Snider Corp.), a corporation duly organized under the laws of the State of Michigan. *Exhibit 1*.
22. Snider Corp. was not a juristic person at the time of filing the '477 Application since Snider Corp. did not exist under the laws of the State of Michigan at the time of filing the '477 Application or anytime prior to or thereafter.
23. There was and remains no basis for the assertion of ownership by the Snider Corp. to the AUTO-FEED PLUS trademark at the time of filing the '477 Application or anytime prior to or thereafter.
24. There was and remains no basis for any assertion that the rightful owner entitled Snider Corp. to use the Registered Mark as of the filing date of the '477 Application or anytime prior to or thereafter.
25. Accordingly, the Snider Corp. was not and is not the rightful owner of the Registered Mark. Nor did/does Snider Corp. possess any right in the Registered Mark that could/can be assigned to any natural or juristic person at the time of filing the '477 Application or any time thereafter.
26. The '634 Registration for the AUTO-FEED PLUS trademark to Snider Corp. is void and should be cancelled pursuant to 37 C.F.R. §2.71(d); TMEP §1201.02(b).

CLAIM II – FRAUD

NO BONA FIDE USE OF THE REGISTERED MARK IN COMMERCE

27. Bandit herby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 26.
28. As the Applicant of the ‘477 Application, Snider Corp. initially asserted simultaneous actual dates of first use and first use in commerce (i.e. April 21, 2001). *Exhibit 1*.
29. Snider Corp. was erroneously permitted to amend the initial date of first use and date of first use in commerce to March 1, 2001 and April 11, 2001, respectively, without the requisite, and duly signed, declaration. *Exhibits 3 – 5*.
30. However, Snider Corp. was never a juristic person and, therefore, has never used the Registered Mark in commerce at anytime prior to or after the date of filing the ‘477 Application.
31. Furthermore, Snider Corp. has never produced evidence of actual use at prior to filing the ‘477 Application or at any time thereafter.
32. Accordingly, there was no bona fide use of the Registered Mark by Snider Corp. as required under §1(a) of the Lanham Act (“Act”), 15 U.S.C. §1051(a).
33. The ‘634 Registration for the AUTO-FEED PLUS trademark to Snider Corp. should be cancelled pursuant to a violation of 15 U.S.C. §1051(a).

CLAIM III – PRIORITY / LIKELIHOOD OF CONFUSION

34. Bandit herby incorporates by reference and realleges each and every allegation set forth in Paragraphs 1 through 33.
35. Pursuant to §14(1) of the Act, registrations obtained under §1(a) can be cancelled by any person who believes that he is damaged by the registration of a mark within five years from the date of registration. 15 USC §1064(1).
36. Snider Corp. has neither used the Registered Mark in commerce nor anywhere in the United States at any time either prior to the filing date of the '477 Application or thereafter.
37. Bandit has continuously used its AUTO-FEED PLUS trademark in U.S. commerce since at least as early as April 3, 2001.
38. Bandit is clearly the senior user of the AUTO-FEED PLUS trademark in connection with feed systems for wood and brush chippers in the United States and has superior rights in this mark over Snider Corp.
39. Bandit is and will continue to be damaged by the Registered Mark since, by virtue of such registration: (1) use of the Registered Mark is likely to cause confusion, to cause mistake or to deceive the consuming public as to the source, sponsorship or affiliation of Bandit's goods; (2) use of the Registered Mark will dilute the strength of Bandit's mark and its rights therein; (3) use of the Registered Mark create doubt as to the exclusive right of Bandit to use its mark; and (4) Bandit could be prevented from registering its mark with the USPTO.

40. Accordingly, the Registered Mark should be cancelled in view of: (i) the identical features the Registered Mark and Bandit's AUTO-FEED PLUS trademark; (ii) the substantially similar and relatedness of the goods associated with the trademarks; and (iii) Bandit's senior use of the trademark in the United States.

WHEREFORE, in view of the aforementioned, Bandit Industries, Inc. requests that the TTAB grant this Petition for Cancellation of U.S. Trademark Registration No. 2,704,634 for the AUTO-FEED PLUS mark issued to Janet L. Snider Corporation.

Submitted herewith is the requisite filing fee in the amount of \$300.00.

Respectfully submitted,

Date: March 22, 2007

/Daniel H. Bliss/
Daniel H. Bliss (P-40129)
Gerald E. McGlynn, III (P-41149)
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Attorneys for Petitioner

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

In the matter of trademark Registration No. 2,704,634

MARK: AUTO-FEED PLUS

REGISTERED: April 8, 2003

BANDIT INDUSTRIES, INC,
a Michigan corporation,

Petitioner,

Cancellation No. 92047274

v.

ELECTRONIC SOLUTIONS OF HARRISON, LLC,
a Michigan limited liability company,

Registrant.

ANSWER

Registrant, Electronic Solutions of Harrison, LLC (“Registrant”) hereby answers the Petition for Cancellation (the “Petition”) filed by Petitioner Bandit Industries, Inc. (“Petitioner”) as follows:

1. In response to paragraph 1 of the Petition, Registrant admits that the owner at the time of the filing of the application of the trademark AUTO-FEED PLUS, Registration No. 2,704,634 (the “Registered Mark”), was Janet L. Snider, an individual (“Ms. Snider”). Except as expressly so admitted, Registrant denies the remaining allegations of paragraph 1.

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2. Ms. Snider used, licensed and subsequently assigned the Registered Mark to Registrant, of which she is co-founder. Registrant denies the remaining allegations of paragraph 2 of the Petition.

3. Registrant admits that the Registered Mark is likely to be confused with Petitioner's alleged AUTO-FEED PLUS mark, specifically denies that Petitioner use the AUTO-FEED PLUS mark before Ms. Snider, and otherwise denies the allegations of paragraph 3 of the Petition.

4. In response to paragraph 4 of the Petition, Registrant re-alleges and incorporates by reference the allegations of paragraphs 1 through 3.

5. Registrant has insufficient information with which to respond to paragraph 5 of the Petition and on that basis denies the allegations of paragraph 5.

6. Registrant admits that Ms. Snider's residence was located at 930 W. Spruce Street, Harrison, MI 48625 and otherwise denies the allegations of paragraph 6 of the Petition.

7. In response to paragraph 7 of the Petition, Registrant admits that Ms. Snider filed a federal trademark application with the United States Patent and Trademark Office for the mark AUTO-FEED PLUS, Serial No. 78/072,477. Except as expressly so admitted, Registrant denies the remaining allegations of paragraph 7.

8. In response to paragraph 8 of the Petition, Registrant admits that Ms. Snider filed a federal trademark application with the United States Patent and Trademark Office for the mark AUTO-FEED PLUS, Serial No. 78/072,477, and that the application speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 8.

9. In response to paragraph 9 of the Petition, Registrant admits that Ms. Snider filed a federal trademark application with the United States Patent and Trademark Office for the mark AUTO-FEED PLUS, Serial No. 78/072,477, and that the application speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 9.

10. In response to paragraph 10 of the Petition, Registrant admits that Ms. Snider filed a federal trademark application with the United States Patent and Trademark Office for the mark AUTO-FEED PLUS, Serial No. 78/072,477, and that the Examining Attorney issued a Non-Final Office Action. The Non-Final Office Action speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 10.

11. In response to paragraph 11 of the Petition, Registrant admits that Ms. Snider responded to the Non-Final Office Action. Ms. Snider's response to the Non-Final Office Action speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 11.

12. Registrant has insufficient information with which to respond to paragraph 12 of the Petition and on that basis denies the allegations of paragraph 12.

13. In response to paragraph 13 of the Petition, Registrant admits that the Examining Attorney emailed Ms. Snider on January 14, 2002 and that the email speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 13.

14. In response to paragraph 14 of the Petition, Registrant admits that Ms. Snider emailed Examining Attorney Lynn Luthey on February 7, 2002 and that the email speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 14.

15. Registrant has insufficient information with which to respond to paragraph 15 of the Petition and on that basis denies the allegations of paragraph 15.

16. In response to paragraph 16 of the Petition, Registrant admits that the Registered Mark was registered on April 8, 2003 to Ms. Snider as owner and that the Certificate of Registration speaks for itself. Except as expressly so admitted, Registrant denies the allegations of paragraph 16.

17. In response to paragraph 17 of the Petition, Registrant denies that Petitioner used the mark AUTO-FEED PLUS prior to Ms. Snider's first use of the Registered Mark. Ms. Snider's licensee first sold the AUTO-FEED PLUS brand electronic controllers to Petitioner and authorized Petitioner to use such electronic controllers on its equipment. Ms. Snider never assigned any portion of her ownership interest in AUTO-FEED PLUS to Petitioner. Registrant has insufficient information with which to respond to the remaining allegations of paragraph 17 of the Petition and on that basis denies the allegations of paragraph 17.

18. Registrant has insufficient information with which to respond to the allegations of paragraph 18 of the Petition and on that basis denies the allegations of paragraph 18.

19. Registrant admits that Ms. Snider authorized Petitioner to use AUTO-FEED PLUS on units that featured the genuine AUTO-FEED PLUS[®] electronic controllers manufactured by Registrant in or around March 2001 and otherwise has insufficient information with which to respond to paragraph 19 of the Petition and on that basis denies the allegations of paragraph 19.

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20. In response to paragraph 20 of the Petition, Registrant re-alleges and incorporates by reference the allegations of paragraphs 1 through 19.

21. Registrant denies the allegations of paragraph 21 of the Petition.

22. Registrant denies the allegations of paragraph 22 of the Petition.

23. Registrant denies the allegations of paragraph 23 of the Petition.

24. Registrant denies the allegations of paragraph 24 of the Petition.

25. Registrant denies the allegations of paragraph 25 of the Petition.

26. Registrant denies the allegations of paragraph 26 of the Petition.

27. In response to paragraph 27 of the Petition, Registrant re-alleges and incorporates by reference the allegations of paragraphs 1 through 26.

28. Registrant denies the allegations of paragraph 28 of the Petition.

29. Registrant denies the allegations of paragraph 29 of the Petition.

30. Registrant denies the allegations of paragraph 30 of the Petition.

31. Registrant denies the allegations of paragraph 31 of the Petition.

32. Registrant denies the allegations of paragraph 32 of the Petition.

33. Registrant denies the allegations of paragraph 33 of the Petition.

34. In response to paragraph 34 of the Petition, Registrant re-alleges and incorporates by reference the allegations of paragraphs 1 through 33.

35. Paragraph 35 of the Petition is a legal conclusion for which no response is required.

36. Registrant denies the allegations of paragraph 36 of the Petition.

37. Registrant denies the allegations of paragraph 37 of the Petition.
38. Registrant denies the allegations of paragraph 38 of the Petition.
39. Registrant denies the allegations of paragraph 39 of the Petition.
40. Registrant denies the allegations of paragraph 40 of the Petition.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim)

41. Petitioner has failed to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

(Estoppel)

42. Petitioner is estopped from contesting Registrant's rights to the Registered Mark or its registration thereof.

THIRD AFFIRMATIVE DEFENSE

(Laches)

43. By the doctrine of laches, Petitioner is precluded from contesting Registrant's exclusive right to use and/or register the Registered Mark and to authorize others to use the Registered Mark under license.

FOURTH AFFIRMATIVE DEFENSE

(Waiver)

44. Petitioner has waived any right to oppose Registrant's use and/or registration of the Registered Mark.

FIFTH AFFIRMATIVE DEFENSE

(Acquiescence)

45. Petitioner has acquiesced to Registrant's nationwide use of the Registered Mark and now may not contest Registrant's rights to use and register the Registered Mark.

SIXTH AFFIRMATIVE DEFENSE

(Unclean Hands)

46. Petitioner is precluded from contesting Registrant's right to use and register the Registered Mark by the doctrine of unclean hands.

WHEREFORE, Registrant prays that this Petition for Cancellation be dismissed.

Dated: May 1, 2007

Respectfully submitted,

GRACE & GRACE LLP

By: 
Michael K. Grace (Cal. SBN 126737)
Jill M. Abasto (Cal. SBN 190622)
444 S. Flower Street, Suite 3875
Los Angeles, California 90071
Telephone: 213.452.1220
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Attorneys for Electronic Solutions of
Harrison, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Answer** has been served on Daniel H. Bliss, counsel for the Petitioner, by mailing said copy on May 1, 2007, via First Class Mail, postage prepaid to:

Daniel H. Bliss
BLISS McGLYNN, P.C.
2705 W. Big Beaver, Suite 600
Troy, MI 48084



Jill M. Abasto

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

In the matter of trademark application Serial No. 77/135,666

MARK: AUTO-FEED PLUS

FILED: March 20, 2007

PUBLISHED: December 2, 2008

ELECTRONIC SOLUTIONS OF HARRISON, LLC,
a Michigan limited liability company,

Opposer,

Opposition No. _____

v.

BANDIT INDUSTRIES, INC.,
a Michigan corporation,

Applicant.

NOTICE OF OPPOSITION

Opposer, Electronic Solutions of Harrison, LLC, a limited liability company organized and existing under the laws of Michigan, and doing business at 3200 S. Clare Ave., Clare, Michigan 48617, believes that it would be damaged by issuance of a registration for AUTO-FEED PLUS as shown in Serial No. 77/135,666 and hereby opposes such registration.

The grounds for opposition are as follows:

1. Since at least as early as December 2000, Opposer, as the exclusive licensee of Opposer's co-founder Janet Snider, has continuously used, and now owns and uses, the AUTO-

FEED PLUS trademark in interstate commerce to identify, advertise and promote its all-in-one digital, programmable hour meter, tachometer and electronic control devices (the “Reversing Electronic Control System”) that control and reverse the feed systems of heavy-duty machinery like wood chippers and stump grinders. Each of these devices sells for hundreds of dollars and is essential to the safe and effective operation of heavy-duty agricultural equipment with automatic feeders.

2. On July 5, 2001, Opposer’s co-founder, Janet Snider, registered the AUTO-FEED PLUS trademark in her own name on the Principal Register in the United States Patent and Trademark Office for use in connection with “dual out put electronic control used on outdoor power equipment and heavy machinery used in the tree care, forestry, and recycling industries.” Throughout her ownership of the brand, she licensed use of the brand to Opposer exclusively. Effective March 5, 2007, Snider assigned ownership of AUTO-FEED PLUS, the goodwill associated therewith, and Reg. No. 2,704,634, to Opposer.

3. Opposer owns U.S. Registration No.2,704,634 for AUTO-FEED PLUS.

4. Opposer has invested substantial time, money, and effort to develop and promote AUTO-FEED PLUS.

5. From December 2000 to January 2005, Opposer supplied its AUTO-FEED PLUS Reversing Electronic Control System to Applicant Bandit Industries, Inc., (“Applicant”) and authorized Applicant to use the AUTO-FEED PLUS[®] trademark in connection with Applicant’s advertising and sale of machinery featuring Opposer’s Control System.

6. In January 2005, Applicant stopped purchasing AUTO-FEED PLUS Reversing Electronic Control Systems from Opposer and began purchasing reversing control systems from

other manufacturers.

7. In February 2007, Applicant began affixing the AUTO-FEED PLUS trademark and the ® registration symbol on or in proximity to the electronic control systems sold to Applicant by other manufacturers. Applicant also has affixed the AUTO-FEED PLUS® trademark to product programming and operating instructions.

8. Applicant filed an application on March 20, 2007, to register AUTO-FEED PLUS for a “power chipper feed system comprised of feed wheels and electronic controls for feeding material into wood and brush chippers” in International Class 7. Applicant alleges first use of AUTO-FEED PLUS on March 29, 2001.

9. Applicant’s use of AUTO-FEED PLUS is confusingly similar to Opposer’s use of AUTO-FEED PLUS.

10. Applicant’s use of AUTO-FEED PLUS so resembles Opposer’s use of AUTO-FEED PLUS as to be likely, when used in connection with the goods identified in the Application, to cause confusion or mistake, or to deceive, within the meaning of Title 15 U.S.C. Section 1052(d).

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11. Opposer has not endorsed, approved, or associated itself with Applicant or in any manner.

WHEREFORE, Opposer requests that this Opposition to Application Serial No. 77/135,666 be sustained and registration refused.

Respectfully submitted,
GRACE & GRACE LLP

Dated: December 11, 2008

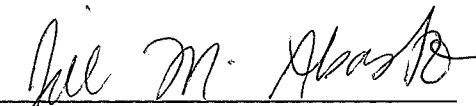
By: 
Michael K. Grace (Cal. SBN 126737)
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E-mail: mgrace@gracelaw.com

Attorneys for Electronic Solutions of
Harrison, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Joseph A. Paparella, Bandit Industries, Inc., by mailing said copy on December 11, 2008, via First Class Mail, postage prepaid to:

Joseph A. Paparella
Paparella & Associates
3878 Cascade Rd. SE
Grand Rapids, MI 49546


Jill M. Abasto

2. After years of purchasing genuine AUTO-FEED PLUS brand controllers from ESH, BANDIT began using the AUTO-FEED PLUS trademark on products not made by ESH, and claiming the AUTO-FEED PLUS[®] trademark as BANDIT'S own property. BANDIT'S brazen attempt to steal ESH's federally registered trademark has caused widespread confusion and threatens to destroy ESH's business if not stopped by this Court.

JURISDICTION AND VENUE

3. This Court has original subject matter jurisdiction over Plaintiff's federal claims pursuant to 15 U.S.C. § 1121, 28 U.S.C. §§ 1331 and 1338(a), 28 U.S.C. §§ 2201 and 2202, and 35 U.S.C. §§ 1 *et seq.* This Court has supplemental subject matter jurisdiction over Plaintiff's state law claims pursuant to 28 U.S.C. § 1367(a).

4. Venue is proper in this judicial district and division pursuant to 28 U.S.C. § 1391(b)-(c) because a substantial part of the events or omissions giving rise to the claim occurred in this district and also because defendants do business or reside in this district.

THE PARTIES

5. Plaintiff ESH is a limited liability company with its principal place of business in Clare, Michigan.

6. On information and belief, Defendant BANDIT INDUSTRIES, INC. ("BANDIT") is a Michigan corporation with its principal place of business at 6750 Millbrook Road, Remus, MI 49340.

BACKGROUND FACTS

7. ESH develops, manufactures, and supplies high quality and reliable electronic controllers under the federally registered trademark AUTO-FEED PLUS for the tree care, construction, commercial and forest industries.

8. Defendant BANDIT is a distributor of chipper, grinder, and waste recycling machinery that require electronic controllers.

9. As early as December 2000, ESH, as the exclusive licensee of ESH's co-founder Janet Snider, has continuously used, and now owns and uses, the AUTO-FEED PLUS[®] trademark to identify, advertise and promote its all-in-one digital, programmable hour meter, tachometer and electronic control devices (the "Reversing Electronic Control System") that control and reverse the feed systems of heavy-duty machinery like wood chippers and stump grinders. Each of these devices sells for hundreds of dollars and is essential to the safe and effective operation of heavy-duty agricultural equipment with automatic feeders.

10. From December 2000 to January 2005, ESH supplied its AUTO-FEED PLUS[®] Reversing Electronic Control System to BANDIT and authorized BANDIT to use the AUTO-FEED PLUS[®] trademark in connection with BANDIT's advertising and sale of machinery featuring ESH's Control System. The AUTO-FEED PLUS[®] Reversing Electronic Control Systems sold to BANDIT, and subsequently sold to purchasers of BANDIT's machinery, were backed by ESH's warranty and customer support.

11. In January 2005, BANDIT stopped purchasing AUTO-FEED PLUS[®] Reversing Electronic Control Systems from ESH and began purchasing reversing control systems from other manufacturers.

12. In 2007, BANDIT began affixing the AUTO-FEED PLUS[®] trademark and the ® registration symbol on or in proximity to the electronic control systems sold to BANDIT by other manufacturers. BANDIT also has affixed the AUTO-FEED PLUS[®] trademark to product programming and operating instructions.

13. Although BANDIT's machinery does not contain genuine AUTO-FEED PLUS[®] Reversing Electronic Control Systems, BANDIT is using a facsimile of ESH's registered trademark to identify, advertise and sell electronic control systems for chipper and grinder machinery, which ESH has not authorized.

14. BANDIT has not sought or obtained permission from ESH to use the AUTO-FEED PLUS[®] trademark for any purpose whatsoever.

15. On March 20, 2007, BANDIT filed a United States Trademark application to register the AUTO-FEED PLUS trademark for use in connection with a "power chipper feed system comprised of feed wheels and electronic controls for feeding material into wood and brush chippers," in International Class 7 (emphasis added), Serial No. 77/135,666, claiming a first use date of March 29, 2001.

16. On March 21, 2007, BANDIT filed an intent-to-use United States Trademark application to register the mark AUTO FEED PLUS for use in connection with "wood and brush chippers having electronically controlled feed systems," in International Class 7 (emphasis

added), and “feed systems comprised of electronic controls and feed wheels for feeding material into wood and brush chippers,” in International Class 9 (emphasis added).

FIRST CLAIM

Federal Trademark Infringement, 15 U.S.C. § 1114(1)(a)

17. Plaintiff realleges herein paragraphs 1-16 of this complaint.

18. Beginning in December 2000 and continuing to the present, ESH has used the AUTO-FEED PLUS[®] trademark to advertise and sell genuine Reversing Electronic Control Systems designed and manufactured by ESH. The AUTO-FEED PLUS[®] trademark has become associated in the public mind with ESH’s superior quality, reliable, and technologically superior Reversing Electronic Control Systems.

19. On July 5, 2001, ESH’s co-founder, Janet Snider, registered the AUTO-FEED PLUS[®] trademark in her own name on the Principal Register in the United States Patent and Trademark Office for use in connection with “dual out put electronic control used on outdoor power equipment and heavy machinery used in the tree care, forestry, and recycling industries.” Throughout her ownership of the brand, she licensed use of the brand to ESH exclusively. Effective March 5, 2007, Snider assigned ownership of AUTO-FEED PLUS[®], the goodwill associated therewith, and Reg. No. 2,704,634, to ESH. At all times relevant to the claims alleged herein, U.S. Registration No. 2,704,634 has been and remains in full force and effect.

20. BANDIT is using and displaying counterfeit copies of the AUTO-FEED PLUS[®] trademark to identify, advertise and promote BANDIT’s products, which wrongful conduct has

created actual confusion and creates a likelihood of confusion as to the origin of BANDIT's control systems and whether BANDIT is affiliated with, or licensed or endorsed by, ESH.

21. BANDIT has intentionally and knowingly used, and continues to use the AUTO-FEED PLUS[®] trademark for the purpose of trading off ESH's excellent reputation for high quality, reliable control devices and causing confusion, mistake or deception as to the origin of BANDIT's goods.

22. BANDIT is selling and offering for sale electronic control systems in connection with a mark that is identical with or substantially indistinguishable from AUTO-FEED PLUS[®]. Such goods are counterfeit as defined in 15 U.S.C. Section 1116(d)(1)(B).

23. Plaintiff has been damaged by the wrongful conduct of BANDIT as alleged above.

24. By reason of BANDIT's wrongful conduct, ESH is entitled to recover from BANDIT all of BANDIT's profits and ESH's damages suffered thereby.

25. BANDIT has engaged in the foregoing conduct knowingly and willfully. As a result, ESH is entitled to BANDIT's wrongful profits and ESH's actual damages, treble damages, plus attorneys' fees and costs as an exceptional case within the meaning of the Lanham Act, 15 U.S.C. Section 1117(a).

26. At its election, ESH is entitled to recover statutory damages for use of a counterfeit mark in an amount to be determined by the Court.

27. Unless preliminarily and permanently enjoined by this Court, BANDIT will continue to infringe ESH's registered trademark and will continue to sell the counterfeit branded electronic control systems, forcing ESH to file multiple actions to protect its trademark rights.

SECOND CLAIM

False Designation of Origin, 15 U.S.C. § 1125(a)

28. Plaintiff realleges herein paragraphs 1-16 of this complaint.

29. BANDIT'S unauthorized use of AUTO-FEED PLUS[®] to identify, advertise, and promote BANDIT'S goods creates a likelihood of confusion as to the origin, sponsorship, or approval of Defendant's goods and as to the affiliation, connection, or association of Defendants with ESH.

30. By reason of the foregoing, BANDIT has violated and is continuing to violate 15 U.S.C. Section 1125(a).

31. BANDIT's conduct as alleged above has damaged, and unless restrained and enjoined by this Court, will continue to cause great and irreparable damage to ESH, which damage cannot be adequately compensated or measured by money alone. ESH has no adequate remedy at law.

32. As a result of BANDIT's conduct as alleged above, ESH has suffered and will continue to suffer damages in an amount not finally ascertained but in excess of \$6.6 million.

33. BANDIT has engaged in the foregoing conduct knowingly and willfully. As a result, ESH is entitled to BANDIT's wrongful profits and ESH's actual damages, treble

damages, plus attorneys' fees and costs as an exceptional case within the meaning of the Lanham Act, 15 U.S.C. Section 1117(a).

PRAYER FOR RELIEF

WHEREFORE, ESH prays for relief as follows:

1. For judgment in favor of ESH against BANDIT, and an award of damages against BANDIT in an amount to be determined at trial;
2. For a preliminary and permanent injunction preventing BANDIT and its owners, officers, directors, employees, and agents from using, displaying, or registering the AUTO-FEED PLUS[®] trademark except when referring to a genuine ESH Reversing Electronic Control Device.
3. For a report in writing under oath and filed with the Court and served on all parties within 30 days after entry of the injunction setting forth in detail the manner and form in which the BANDIT has complied with the injunction;
4. For an order requiring BANDIT to surrender for destruction all products, labels, packaging, advertisements and other materials constituting a false designation of origin by BANDIT and to recall and surrender for destruction any electronic control devices now offered under the AUTO-FEED PLUS[®] trademark.
5. For treble actual damages to ESH according to proof;
6. For an order requiring BANDIT to disgorge all revenues received from the sale of equipment bearing the AUTO-FEED PLUS[®] trademark other than genuine ESH goods and to restore the same to ESH;

7. At ESH's election, statutory damages for use of the counterfeit mark AUTO-FEED PLUS® in an amount to be determined by the Court;
8. For ESH's reasonable attorneys' fees and costs of suit incurred herein; and
9. For such other and further relief as this Court may deem just and appropriate.

Respectfully submitted,

Date: December 10, 2008

/s/ Michael J. Forster

Michael J. Forster (P25048)

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Attorneys for Plaintiff Electronic Solutions of
Harrison, LLC

DEMAND FOR JURY TRIAL

Pursuant to FRCP Rule 38, plaintiff Electronic Solutions of Harrison, LLC demands a jury trial on all issues so triable.

Respectfully submitted,

Date: December 10, 2008

/s/ Michael J. Forster

Michael J. Forster (P25048)

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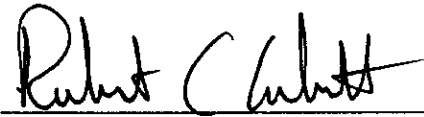
frankandforster@sbcglobal.net

Attorneys for Plaintiff Electronic Solutions of Harrison, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petitioner's Motion For Suspension of Proceeding has been served on Jill M. Abasto, counsel for the Respondent, by mailing said copy on January 13, 2009, via Express Mail Post Office to Addressee, postage prepaid, to:

Jill M. Abasto
Grace & Grace, LLP
444 S. Flower Street, Suite 3875
Los Angeles, CA 90071

A handwritten signature in black ink, appearing to read "Robert C. Corbett", is written over a horizontal line.

Robert C. Corbett

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

BANDIT INDUSTRIES, INC.,
a Michigan corporation,

Petitioner,

v.

Cancellation No. 92047274

ELECTRONIC SOLUTIONS OF HARRISON, LLC.,
a Michigan limited liability company,

Respondent.

_____ /

**PETITIONER'S BRIEF IN SUPPORT OF MOTION FOR SUSPENSION OF
PROCEEDING**

37 CFR 2.117 provides that the Trademark Trial and Appeal Board may suspend proceedings whenever “parties to a pending case are engaged in a civil action ... which may have a bearing on the case.” It is the typical practice of the Board to suspend proceedings if the final determination of the other proceeding will have a bearing on the issues before the Board. See Section 510.02(a) of the Board’s Practice and Procedures and cases collected therein, including *General Motors Corp. v Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933 (TTAB 1992).

In the case at bar, identical issues are pending in the civil action that Petitioner Bandit Industries, Inc. raises before the Board. More particularly, the determination of priority and ownership of the trademark “AUTO-FEED PLUS” is necessary for the resolution of both the civil action and the cancellation at bar. The disposition of this issue, and other issues, pending in the civil action will obviously have a bearing on the decision of this Board and, in fact, will be dispositive of the issues before this Board:

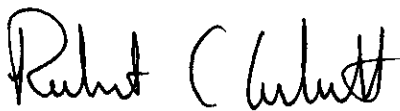
To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.

Section 510.02(A)(TTAB policies and procedures)(citations omitted).

It would be a considerable waste of the resources of the Board and the parties to go forward with the petition while the same issues are pending before the federal district court.

Petitioner Bandit Industries. therefore requests that the Board grant its motion to suspend proceedings pending the outcome of the civil action between the parties, *Electronic Solutions of Harrison, LLC v. Bandit Industries, Inc.*, United States District Court, Eastern District of Michigan, Case No. 1:08-cv-15113-TLL-CEB.

Quinn Law Group, PLLC.

BY: 

Robert C. Corbett (P64033)
Attorneys for Petitioner
39555 Orchard Hill Place, Suite 520
Novi, MI 48375
(248) 380-9300

Dated: January 13, 2009

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petitioner's Brief in Support of Motion For Suspension of Proceeding has been served on Jill M. Abasto, counsel for the Respondent, by mailing said copy on January 13, 2009, via Express Mail Post Office to Addressee, postage prepaid, to:

Jill M. Abasto
Grace & Grace, LLP
444 S. Flower Street, Suite 3875
Los Angeles, CA 90071

A handwritten signature in black ink, appearing to read "Robert C. Corbett", is written above a horizontal line.

Robert C. Corbett