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

Proceeding	91171191
Party	Plaintiff Peer Bearing Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Peer Bearing Company,	)	Consolidated
	)	Opposition No. 91171191 (Appl. No. 78/535213)
Opposer,	)	
	)	Opposition No. 91176823 (Appl. No. 78/745178)
v.	)	Opposition No. 91176837 (Appl. No. 78/754894)
	)	Opposition No. 91176848 (Appl. No. 78/754907)
Roller Bearing Company of America, Inc.,	)	Opposition No. 91176851 (Appl. No. 78/754876)
	)	
Applicant.	)	Attorney Docket No. 019194.0720

OPPOSER'S RESPONSE TO APPLICANT'S PETITION TO DISQUALIFY PURSUANT TO 37 C.F.R. §11.19(c)

Opposer Peer Bearing Company ("Peer") hereby responds to the Petition to Disqualify Peer's Counsel filed by Applicant Roller Bearing Company of America, Inc. ("RBC").

I. Introduction

The Petition to Disqualify Peer's attorneys is a sham filing designed merely to delay these proceedings, as there is no basis in fact or law for RBC's claims. The Petition omits key facts entirely, and the "facts" upon which RBC relies are directly contrary to a prior finding by an Arbitration Panel to which RBC is bound under collateral estoppel. The law is similarly directly contrary to RBC's position. RBC misconstrues the case law it does cite, and it fails to cite controlling authority directly contrary to at least one of its positions.

Despite RBC's argument to the contrary, this is not a "conflict of interest" case. Peer's attorneys never represented RBC or any of its affiliates and there is no allegation that Peer's attorneys ever had access to any of RBC's privileged information. Every case cited by RBC involves a former client asking that its former counsel be disqualified. That is not the situation here, and RBC offers absolutely no reason or non-frivolous argument why the cases should be

extended in such a manner. Rather, RBC argues that a third party, SKF USA, Inc. ("SKF"), may be in violation of a decision by the Arbitration Panel. If RBC really believes that, its remedy is to pursue a claim against SKF, not to argue that Peer cannot use its own attorneys.

Critically, RBC fails to tell the Commissioner that it has already lost its attempt to have Peer precluded from litigating this opposition. The Arbitration Panel decided this exact question against RBC, as it held that Peer was not enjoined from opposing RBC's applications. RBC also fails to note that it lost a trademark infringement case in district court against Peer on these exact same marks. Therefore, RBC knows that (1) it cannot preclude Peer from litigating this opposition under collateral estoppel and (2) it cannot prevail in this opposition once Peer's co-existing, longstanding legal use of the exact same marks for the exact same goods is put to the Board. There can be no question, therefore, that RBC's sole purpose for filing the Petition is to harass Peer by pursuing vexatious claims.

RBC's assertion that it can have Peer's attorneys disqualified simply because RBC served discovery on the attorneys is nonsensical and directly contrary to a prior controlling decision, which it does not even cite. For these reasons, and as outlined in detail below, RBC's Petition must be denied.

Finally, despite the fact that the Opposition is stayed, at RBC's request, RBC has served subpoenas and discovery on Peer, Peer's attorneys, SKF and SKF's attorneys. The only use of such improper and untimely discovery is to harass Peer and SKF.

II. Facts

In its filings with the Board and in this Petition, RBC made statements that are objectively false and misleading about the outcome of the prior Arbitration between Applicant and SKF. The Arbitration Panel made a series of fact findings that it deemed to be undisputed, and RBC's Petition directly contradicts these facts, and ignores other relevant facts.

A. RBC Lost a Motion to Enjoin this Opposition in the SKF Arbitration

While this Petition is ostensibly one to disqualify attorneys, the clear intent of RBC is to terminate or enjoin these Oppositions. RBC commits a major sin of omission, however, by failing to note that it already lost its attempt to have these trademark oppositions enjoined. In fact, twice in its Petition, at pages 8 and 12, RBC notes that the Arbitration Panel "agreed to opine on whether or not Peer's opposition of RBC's marks should be enjoined," citing to the Interim Order (Exhibit B to the Petition). RBC fails to note, however, that the Arbitration Panel expressly held that Peer is not enjoined from pursuing these Consolidated Oppositions in the Final Order (attached as Exhibit 1 hereto, and as Exhibit A to the Petition).

The Arbitration between Applicant RBC and SKF addressed the specific issue RBC is indirectly raising here, namely, whether Peer, as a subsidiary of SKF, is precluded from pursuing these Oppositions. As the Panel stated,

> Specifically, the relief RBC seeks would constitute a mandatory injunction directing SKF: (a) to stop Peer from opposing RBC's trademark efforts with respect to the product designations included in the Nice catalog;

Final Order, Exhibit 1, p. 6. Thus, Peer's ability to oppose Applicant's trademarks was directly in front of the Arbitration Panel. The Panel expressly held that Peer is not enjoined from pursuing these Oppositions, stating that "RBC's argument is a non sequitur and should be denied, based on the facts and the law." Final Order, Exhibit 1, p. 9. Specifically, the Panel held as follows:

> After carefully reviewing the record, briefs, oral argument, and applicable authorities, the majority has concluded, on balance, that RBC has not demonstrated a "clear right" to the relief it seeks, and that SKF has the better of the argument on the matter currently before the Panel. Therefore, the majority of the Panel will not take the extraordinary step of ordering the mandatory injunctive relief sought by RBC.

Final Order, Exhibit 1, pp. 14-15. The Panel concluded with the following holding:

> "IT IS ORDERED that (1) RBC's request for an injunction against SKF regarding the Peer activities is DENIED; …"

Final Order, Exhibit 1, p. 24 (emphasis in original). There is, therefore, no doubt that Peer is entitled to pursue these Oppositions. Instead of noting the Panel's actual decision in the Final Order, RBC instead quotes misleadingly from the Dissenting Judge's opinion. *See,* Petition, p. 8.

B. The Undisputed Facts Found by the Arbitration Panel are Directly Contrary to RBC's Unsupported Allegations in the Petition

RBC makes many completely unsupported allegations about how Peer and SKF allegedly are or will be acting in concert. However, RBC fails to address or mention the undisputed facts found by the Panel in its Final Order. The key facts the Panel relied on are directly relevant to this Petition, and directly contrary to RBC's statements. Specifically, the Arbitration Panel found the following to be "undisputed facts":

> (1) Peer used the Series designations *well before* the 1997 APA between SKF and RBC and *well before* SKF acquired the stock of Peer;
>
> (2) Peer opposed RBC's trademark efforts before SKF acquired Peer;
>
> (3) Peer is not a party to the APA or to this arbitration and there is no provision in the APA reaching Peer or imposing SKF's restrictions on its affiliates;
>
> (4) Since being acquired by SKF, Peer has not been doing anything vis-à-vis the Series designations or RBC's USPTO proceedings that is more than or different from what it has historically done;
>
> (5) SKF's acquisition of Peer does not alter the extent of any injury (if indeed there is any injury) to RBC as a result of Peer's conduct;
>
> (6) SKF acquired Peer in the exercise of SKF's and its parent company's business judgment to gain the benefits of Peer's expertise and market share in the medium-quality, medium-price bearing market, while SKF's business has concentrated on the high-end bearing market;
>
> (7) There is no evidence that SKF acquired Peer in order to circumvent the APA;
>
> (8) SKF has not engaged in, or interfered with, Peer's day-to-day business operations;

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