

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Baxley

Mailed: December 10, 2004

Opposition No. **91158224**

Opposition No. **91159448**

Scientific Drilling  
International, Inc.

v.

Gyrodata, Inc.

Before Quinn, Hairston and Drost,  
Administrative Trademark Judges

By the Board:

Gyrodata, Inc. ("applicant") seeks to register DROP  
GYRO in typed form for "controlled directional drilling of  
oil wells" in International Class 37<sup>1</sup> and "oil and gas well  
surveying services" in International Class 42.<sup>2</sup>

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<sup>1</sup> Application Serial No. 76131014, filed September 13, 2000, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and alleging September 1997 as the date of first use and date of first use in commerce. The involved application was published for opposition with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f). The opposition to the registration of the mark in International Class 37 was instituted as Opposition No. 91158224.

<sup>2</sup> Application Serial No. 76481141, filed January 9, 2003, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and alleging September 1, 1997 as the date of first use and date of first use in commerce. The involved application was published for opposition with a claim of acquired distinctiveness under Section 2(f). The opposition to the registration of the mark in International Class 42 was instituted as Opposition No. 91159448.

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Scientific Drilling International, Inc. ("opposer") has opposed registration of applicant's proposed mark. As grounds for opposition, opposer alleges that: (1) applicant's proposed mark is generic or merely descriptive of applicant's involved services; (2) applicant's proposed mark has not become distinctive of applicant's services because no customer recognition of the proposed mark as identifying only applicant's services has been achieved; (3) applicant's mark is unregistrable because its involved applications do not show the mark used in commerce; and (4) registration of applicant's mark is barred by the doctrine of *res judicata* because applicant, in a civil action between the parties, withdrew with prejudice its counterclaim alleging that opposer had infringed the proposed mark.<sup>3</sup> Applicant denied the salient allegations of the notices of opposition in its answers. The Board consolidated the proceedings by its own initiative in an April 12, 2004 order.

This case now comes up for consideration of opposer's motion (filed June 23, 2004) for summary judgment on the grounds that applicant's evidence of acquired

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<sup>3</sup> The civil action is styled *Scientific Drilling International, Inc. v. Gyrodata Corporation*, Case No. H-97-3506, filed in the United States District Court for the Southern District of Texas. Although applicant's trademark infringement counterclaim has been withdrawn with prejudice, opposer's patent infringement claim remains pending. In response to the Board's October 12, 2004

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distinctiveness is inadequate and that, because the proposed mark is highly descriptive, registration thereof is improper. Applicant has filed a brief in response thereto.

In support of its motion for summary judgment, opposer contends that evidence made of record by the examining attorney during *ex parte* examination indicates that the involved mark is highly descriptive and that applicant's claims under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), of the mark's acquired distinctiveness in both of the involved applications are unacceptable. In particular, opposer contends that applicant's only support for its Section 2(f) claims are declarations of its director of marketing, Jeffrey Leonard, and that those declarations do not aver that the mark has become distinctive of the involved services through applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the dates thereof and do not include any additional evidence supporting the claims of distinctiveness, such as advertising expenditures and/or revenue figures. Accordingly, opposer contends that the above-captioned oppositions should be sustained and the mark refused registration. As exhibits in support of its motion,

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order, opposer filed copies of the relevant pleadings and decisions in the civil action on October 21, 2004.

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opposer has included copies of the files of the involved applications.<sup>4</sup>

In opposition to opposer's motion for summary judgment, applicant contends that the examining attorneys properly passed the involved applications to publication and that the existence of genuine issues of material fact preclude entry of summary judgment herein. In particular, applicant contends that the involved mark is suggestive; and that, in any event, the declarations in support of the alternative claims of acquired distinctiveness that were submitted during *ex parte* examination are sufficient.<sup>5</sup> Accordingly, applicant asks that the motion for summary judgment be denied. Applicant's exhibits to its brief in opposition to the motion for summary judgment include a supplemental declaration of Mr. Leonard.

The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to change the outcome. See

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<sup>4</sup> We note that the application files form part of the record without any action by the parties. See Trademark Rule 2.122(b).

<sup>5</sup> Contrary to applicant's apparent contention, evidence of acquired distinctiveness is not properly considered in connection with regard to suggestive marks. See *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983). Rather, publication of the mark in the involved applications with applicant's Section 2(f) claims noted is clear indicia that the examining attorneys maintained the refusals of registration on the Section 2(e)(1) ground.

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*Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 730 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). See also TBMP section 528.01 and cases cited therein.

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). Opposer, as the party moving for summary judgment, has the initial burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). An issue is material when its resolution would affect the outcome of the proceeding under governing law. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 106 S. Ct. 2505 (1986); and *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

We note initially that in both of the involved applications, applicant argued the merits of the examining attorneys' refusals of registration on the ground that the involved mark is merely descriptive of its services under Section 2(e)(1) and claimed in the alternative that the involved mark has acquired distinctiveness under Section

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2(f). In both applications, the Section 2(f) claims were accepted by the examining attorneys as *prima facie* evidence that the mark had acquired distinctiveness.<sup>6</sup> Where, as here, an applicant seeks registrations based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact. See *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576-78, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

We note that the support therefor that applicant submitted during *ex parte* examination consists of five years use declarations signed by applicant's director of marketing, Jeffrey G. Leonard. These declarations are unacceptable as *prima facie* evidence that the mark has become distinctive because the declarant does not allege therein that applicant has had "substantially exclusive and continuous use in commerce" of the involved mark for the five years preceding the dates of the affidavits.<sup>7</sup> See

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<sup>6</sup> Although applicant filed a notice of appeal in connection with application Serial No. 76131014, the *ex parte* appeal was rendered moot by the examining attorney's acceptance of the Section 2(f) claim.

<sup>7</sup> "The wording 'substantially exclusive and continuous use in commerce' is essential." TMEP Section 1212.05(d). Although the declaration submitted during *ex parte* examination in support of application Serial No. 76131014 states that applicant's use of the mark has been continuous, the declarant does not allege that such use has been either substantially exclusive or in commerce for the five years preceding the date thereof. Although the declaration in support of application Serial No. 76481141 alleges that applicant's use of the mark has been continuous and that no other entity is using the mark in connection with similar services, the declarant does not allege that such use has been

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Trademark Act Section 2(f), 15 U.S.C. Section 1052(f); TMEP Section 1202.05(d). However, applicant has submitted a supplemental declaration of Mr. Leonard that includes both acceptable language for a five years use declaration and provides actual evidence of acquired distinctiveness, i.e., revenue figures for services applicant has sold under the DROP GYRO mark.

After reviewing the parties' arguments and evidence, we find that opposer has not met its burden of establishing that no genuine issue of material fact that applicant's mark has not acquired distinctiveness and that it is entitled to judgment as a matter of law. At a minimum, a genuine issue of material fact exists with regard to whether the mark has not acquired distinctiveness for applicant's involved services in commerce.

In view thereof, opposer's motion for summary judgment is hereby denied.<sup>8</sup> Proceedings herein are resumed. Discovery and trial dates are hereby reset as follows.

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either substantially exclusive or in commerce for the five years preceding the date thereof. See *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987) ("[C]ontinuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive."). The record must indicate that the five years of use has been in commerce that may lawfully be regulated by Congress. See *Blanchard & Co., Inc. v. Charles Gilman & Son, Inc.*, 145 USPQ 62 (D. Mass. 1965), *aff'd*, 353 F.2d 400, 147 USPQ 263 (1<sup>st</sup> Cir. 1965), *cert. denied* 383 U.S. 968, 149 USPQ 905 (1966).

<sup>8</sup> The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final

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DISCOVERY PERIOD TO CLOSE: **02/25/05**  
Plaintiff's 30-day testimony period to close: **05/26/05**  
Defendant's 30-day testimony period to close: **07/25/05**  
15-day rebuttal testimony period to close: **09/08/05**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).