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Filing date: **05/02/2007**

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

Proceeding.	91176627
Applicant	Defendant Hammer, John Brannon
Other Party	Plaintiff Sonotech, Inc.

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Hammer, John Brannon hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Hammer, John Brannon has secured the express consent of all other parties to this proceeding for the suspension requested herein.

Hammer, John Brannon has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
/Dennis T. Griggs/
Dennis T. Griggs
dennis@griggslaw.com
sheilamorrison@dwt.com
05/02/2007

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

SONOTECH, INC.,

Opposer,

v.

JOHN BRANNON HAMMER,

Applicant.

Opposition No. 91176627

App. No. 78911283
Mark: SONOGEL
Int. Class: 001
Published: March 6, 2007

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION ON CONSENT FOR SUSPENSION OF PROCEEDINGS

Pursuant to Trademark Rule of Practice § 2.117(a), Applicant, John Brannon Hammer, with the consent of Opposer, Sonotech, Inc., hereby moves the Trademark Trial and Appeal Board for an order suspending this opposition proceeding pending the outcome of a complaint filed by the Opposer in the United States District Court, District of Oregon (Portland), entitled Sonotech, Inc. v. RHI Company; Canon Safety

Inc.: John Brannon Hammer; and Rodney L. Hammer, Case No. CV- 07-0159-HA (the "Civil Action"). A copy of the complaint is attached hereto as Exhibit A.

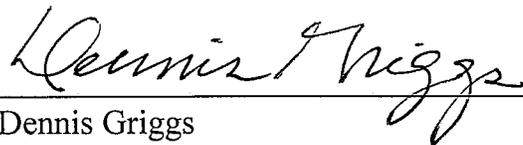
The complaint alleges, among other things, that Applicant's use and registration of the mark SONOGEL constitutes unfair competition; is likely to cause consumer confusion with respect to the origin of Applicant's goods; and infringes certain registered marks allegedly owned by the Opposer.

37 C.F.R. § 2.117 provides "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."

The issues to be determined in the Civil Action are relevant and central to the issues raised in the Notice of Opposition. The central issue in the Civil Action is whether Applicant's mark SONOGEL is confusingly similar to the marks pleaded by the Opposer. In general, where the parties to an opposition proceeding are involved in a civil action which may be dispositive of Board proceedings, the Board proceedings are appropriately suspended in the interest of judicial economy. Black Box Corp. v. Better Box Communications Ltd., 2002 TTAB LEXIS 253 (TTAB 2002). Therefore, Applicant respectfully requests that these proceedings be suspended pending the outcome of the Civil Action.

On April 27, 2007, the undersigned communicated with counsel to Opposer, Sheila Fox Morrison, Esq., who consented to this motion for suspension. Applicant will notify the Board when the Civil Action has been concluded.

Respectfully submitted,

A handwritten signature in cursive script, reading "Dennis Griggs", is written over a horizontal line.

Dennis Griggs
Griggs Bergen LLP
17950 Preston Road, Suite 1000
Dallas, Texas 75252
972-447-4569
972-732-9218 Fax
dennis@griggslaw.com

ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing MOTION ON CONSENT FOR SUSPENSION OF PROCEEDINGS was served on counsel for Opposer on the 2nd day of May 2007, by placing a copy thereof in the United States Postal Service first class mail, proper postage prepaid, addressed as follows:

Sheila Fox Morrison
Davis Wright Tremaine LLP
1300 SW Fifth Avenue, Suite 2300
Portland, OR 97201

A handwritten signature in black ink, appearing to read 'S. Maria Tedesco', written over a horizontal line.

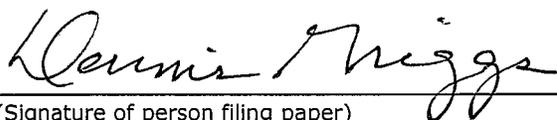
S. Maria Tedesco

CERTIFICATE OF TRANSMISSION

I certify that the foregoing MOTION ON CONSENT FOR SUSPENSION OF PROCEEDINGS (along with any paper referred to as being attached or enclosed) is being filed electronically via ESTTA in the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, on the date shown below.

Dennis Griggs

(Typed name of person filing paper)



(Signature of person filing paper)

Date: May 2, 2007

EXHIBIT "A"

Michael H. Simon, OSB No. 86090
MSimon@perkinscoie.com
PERKINS COIE LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Telephone: 503.727.2018
Facsimile: 503.346.2018

Pro Hac Vice To Be Filed:

Thomas L. Boeder, WSBA No. 408
TBoeder@perkinscoie.com
PERKINS COIE LLP
1201 Third Avenue, Suite 4800
Seattle, WA 98101-3099
Telephone: 206.359.8000
Facsimile: 206.351.9000

**Attorneys for Plaintiff,
SONOTECH, INC.**

**UNITED STATES DISTRICT COURT
DISTRICT OF OREGON**

SONOTECH, INC., a Washington
corporation,

Plaintiff,

v.

RHI COMPANY, a Texas company;
CANON SAFETY INC., a Texas
corporation; **JOHN BRANNON
HAMMER**, an individual; and
RODNEY L. HAMMER, an individual,

Defendants.

Case No. CV 07-0159-HA

AMENDED COMPLAINT

**Lanham Act, § 43a, 15 U.S.C. § 1125(a);
Unfair Competition;
Trademark Infringement;
Preliminary Injunctive Relief;
Permanent Injunctive Relief.
DEMAND FOR JURY TRIAL**

Plaintiff, SONOTECH, INC. ("SONOTECH"), alleges as follows:

PARTIES

1. SONOTECH is a Washington corporation with its principal place of business in Bellingham, Washington. SONOTECH develops, manufactures and sells high quality ultrasonic

1- AMENDED COMPLAINT

18100-0003/12963943.3

Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Phone: 503.727.2000
Fax: 503.727.2222

couplants to medical and industrial customers in the United States and elsewhere around the world. These products include ultrasonic couplants used in ultrasonic inspection of metal, such as SONOTECH'S premier product used in such applications, Ultrigel II®.

2. RHI COMPANY is a Texas company, affiliated with Canon Safety Inc., with its principal place of business in Kilgore, Texas. CANON SAFETY INC. is a Texas corporation with its principal place of business in Kilgore, Texas. On information and belief, CANON SAFETY INC. does business as RHI COMPANY. JOHN BRANNON HAMMER is an individual who resides in Texas. On information and belief, JOHN BRANNON HAMMER does business as RHI COMPANY. RODNEY L. HAMMER is an individual who resides in Texas. On information and belief, RODNEY L. HAMMER does business as RHI COMPANY. As used in this Amended Complaint, RHI COMPANY, CANON SAFETY INC., JOHN BRANNON HAMMER, and RODNEY L. HAMMER will be collectively referred to as "RHI." RHI advertises, distributes and sells ultrasonic couplant for ultrasonic inspection applications. RHI's principal product for such applications is sold under the name SonoGel. RHI sells SonoGel to and through distributors in various locations in the United States, including Portland, Oregon.

JURISDICTION AND VENUE

3. This Court has subject matter jurisdiction over this action on the following bases:
- a. Under 28 U.S.C. § 1331, because this action alleges violations of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);
 - b. Under 28 U.S.C. § 1367 (supplemental jurisdiction); and
 - c. Under 28 U.S.C. § 1332, because there is complete diversity of citizenship between the parties and the matter in controversy exceeds the sum or value of \$75,000, exclusive of interest and costs.

FACTS AND BACKGROUND

4. Ultrasonic couplants are chemical products used to couple or conduct high frequency sound waves between ultrasonic equipment and objects being examined.

2- AMENDED COMPLAINT

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Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
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5. Ultrasonic couplants are used to conduct sound waves into metal during ultrasonic nondestructive testing, such as in the inspection for hidden flaws or defects in welds and structural components of power generating plants including nuclear power plants, pipelines, ships, military weapons and transportation vehicles, automobiles, amusement park rides, and ski lifts, among many other applications. These ultrasonic couplants also are used for gauging the thickness of machined parts during and after fabrication and in ultrasonic flow meters, which determine the flow in pipes and pipelines. For safety reasons, it is important that an ultrasonic couplant used in such testing not itself cause corrosion of the metal being tested or of adjoining metals or fasteners.

6. RHI competes with SONOTECH in the United States for supply of nondestructive testing ultrasonic couplants.

7. In the regular course of the promotion and sale of the SonoGel product for ultrasonic inspections, in competition with Sontech's Ultragel II®, RHI has emphasized that SonoGel is a "Premium" ultrasonic couplant that "has superior corrosion inhibiting properties on all metals and alloys except magnesium."

8. In truth and in fact, scientific tests by experts, including independent metallurgists conducting tests at SONOTECH's request, confirm that samples of SonoGel ultrasonic couplants purchased from a Portland, Oregon distributor of RHI products in fact cause corrosion (contrary to RHI's representations to customers) and that the corrosive properties of the SonoGel product tested vary significantly within the batch tested.

9. As a direct and proximate result of RHI's actions alleged in this Amended Complaint, SONOTECH has been and is likely to continue to be substantially injured in its business, including its reputation, resulting in lost revenue and profits, and diminished goodwill and reputation.

10. SONOTECH has suffered an ascertainable loss.

11. RHI has acted intentionally, willfully, and in bad faith.

3- AMENDED COMPLAINT

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Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Phone: 503.727.2000
Fax: 503.727.2222

**FIRST CAUSE OF ACTION
UNFAIR COMPETITION—LANHAM ACT
(False Advertising under 15 U.S.C. § 1125(a)(1)(B))**

12. SONOTECH realleges paragraphs 1-11 above.

13. The conduct of RHI as alleged above, including the use of false and misleading representations that its products have superior corrosion inhibiting properties on all metals and alloys except magnesium, constitutes a violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B), for which SONOTECH is entitled to recover damages in an amount to be proven at trial and other remedies as determined by the Court.

**SECOND CAUSE OF ACTION
UNFAIR COMPETITION—RCW 19.86**

14. SONOTECH realleges paragraphs 1-11 above.

15. The conduct of RHI, as alleged above, including the use of false and misleading representations with respect to the purported non-corrosive effects of its ultrasonic couplant is contrary to the public interest and constitutes unfair acts and practices and an unfair method of competition in violation of the Washington Unfair Business Practices--Consumer Protection Act, RCW 19.86.

**THIRD CAUSE OF ACTION
UNFAIR COMPETITION—COMMON LAW**

16. SONOTECH realleges paragraphs 1-11 above.

17. The conduct of RHI, as alleged above, including the use of false and misleading representations with respect to the purported non-corrosive effects of its ultrasonic couplants constitutes unfair competition under the common law.

**FOURTH CAUSE OF ACTION
TRADEMARK INFRINGEMENT
(Trademark Infringement under 15 U.S.C. § 1114(1))**

18. SONOTECH realleges and incorporates by reference paragraphs 1 through 11 above.

19. SONOTECH is the owner of federal trademark registrations for SONOTECH (Reg. No. 2104567), SONOGARD (Reg. No. 2,788,648), SONOGLIDE (Reg. No. 2,790,956), SONO IMAGE (Reg. No. 2,272,097), SONOMIX (Reg. No. 1,924,113), SONOTEMP (Reg. No. 1,236,910) for use in connection with ultrasonic couplants and medical ultrasonic couplants (collectively, the "SONOTECH Marks").

20. RHI's use of the SonoGel mark, which uses the distinctive "Sono" prefix of the SONOTECH family of marks, in connection with ultrasonic couplants constitutes an infringing use of a reproduction, counterfeit, copy or colorable imitation of the registered SONOTECH Marks, and RHI's sale, offering for sale, distribution or advertising of goods and services under the SonoGel mark is likely to cause confusion or mistake or to deceive the public in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114(1), constituting trademark infringement under the Trademark Laws of the United States, 15 U.S.C. §§ 1051-1125.

FIFTH CAUSE OF ACTION
(Unfair Competition under 15 U.S.C. § 1125(a)(1)(A))

21. SONOTECH realleges and incorporates by reference paragraphs 1 through 20 above.

22. RHI's actions described above constitute unfair competition and false designation of origin in that they are likely to cause confusion or cause mistake, or to deceive others as to the affiliation, connection or association of RHI's goods with those provided by SONOTECH, or as to the origin, sponsorship or approval of SONOTECH, all in violation of Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

JURY DEMAND

23. Pursuant to Fed. R. Civ. P. 38(b), Plaintiff respectfully demands a trial by jury as to all issues in this action for which Plaintiff has a right to trial by jury.

PRAYER FOR RELIEF

WHEREFORE, SONOTECH prays for the following relief:

A. For a preliminary and permanent injunction:

1. Requiring all defendants to notify RHI's customers and the nondestructive testing industry:

- a. Of the results of the metallurgical tests conducted at SONOTECH's request;
- b. That RHI's SonoGel products can cause corrosion of metal products being tested; and
- c. That the corrosion properties of SonoGel vary within product batches.

2. Restraining and prohibiting all defendants and their employees, representatives, agents, distributors and all persons or entities acting in concert with them, from making false, misleading, or deceptive representations, orally or in writing, to the effect that RHI's SonoGel products have superior corrosion inhibiting properties; and

3. Requiring all defendants to disseminate appropriate and effective corrective advertising and promotional materials to RHI's customer base to correct the false, misleading and deceptive representations alleged in this Amended Complaint.

4. Restraining and prohibiting all defendants from using the SonoGel mark or any other name or mark that constitutes a colorable imitation of the SONOTECH Marks in connection with the sale or promotion of ultrasonic couplants or any related goods or services.

5. Restraining and prohibiting all defendants from registering the SonoGel mark or any other name or mark that constitutes a colorable imitation of the SONOTECH Marks in connection with ultrasonic couplants or any related goods or services in any state or with the United States Patent and Trademark Office.

6. Restraining and prohibiting all defendants from otherwise infringing the SONOTECH Marks or using any similar designation, alone or in combination with any other components, causing likelihood of confusion or injury to the business, reputation or goodwill or

reputation of SONOTECH and its goods or causing likelihood of confusion or misunderstanding to the source or sponsorship of RHI's goods.

B. For judgment in favor of SONOTECH, and against all defendants for damages, recovery of unjust enrichment, exemplary damages, and treble damages in such amounts as may be proven at trial;

C. For judgment against all defendants for SONOTECH'S costs of suit, including a reasonable attorney's fee; and

D. For such other relief as the Court may deem just and proper.

DATED this 1st day of February, 2007.

PERKINS COIE LLP

By: /s/ Michael H. Simon

Michael H. Simon, OSB No. 86090

MSimon@perkinscoie.com

1120 N.W. Couch Street, Tenth Floor

Portland, OR 97209-4128

Telephone: 503.727.2000

Facsimile: 503.727.2222

**Attorneys for Plaintiff,
SONOTECH, INC.**

Pro Hac Vice To Be Filed:

Thomas L. Boeder, WSBA No. 408

TBoeder@perkinscoie.com

PERKINS COIE LLP

1201 Third Avenue, Suite 4800

Seattle, WA 98101-3099

Telephone: 206.359.8000

Facsimile: 206.359.9000

**Attorneys for Plaintiff,
SONOTECH, INC.**