

ESTTA Tracking number: **ESTTA325262**

Filing date: **01/05/2010**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Metso Automation USA Inc.		
Entity	Corporation	Citizenship	Delaware
Address	26275 U.S. Highway 59 Fergus Falls, MN 56537 UNITED STATES		

Attorney information	James T. Nikolai Nikolai & Mersereau, P.A. 900 Second Avenue South Suite 820 Minneapolis, MN 55402 UNITED STATES jim@nm-iplaw.com Phone:612-339-7461		
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Applicant Information

Application No	77785119	Publication date	12/08/2009
Opposition Filing Date	01/05/2010	Opposition Period Ends	01/07/2010
Applicant	Metrix Instrument Co., L.P. 8824 Fallbrook Drive Houston, TX 77064 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Multi-channel electronic monitoring device for measuring changes in the condition of industrial machinery, using accelerometers, eddy current proximity sensors, and process measurements, in a wireless and/or wired network environment
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2184663	Application Date	07/30/1996
Registration Date	08/25/1998	Foreign Priority Date	NONE

Word Mark	HAWKEYE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1996/09/00 First Use In Commerce: 1996/09/00 proximity sensors, namely, linear valve sensors for sensing the position of a valve

Attachments	Notice of Opposition.pdf (6 pages)(64134 bytes)
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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.

Signature	/JAMES T NIKOLAI/
Name	James T. Nikolai
Date	01/05/2010

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

In the matter of Trademark Application Serial No. 77-785,119 for the mark Hawk-i, published in the Official Gazette on December 8, 2009.

January 5, 2010

Metso Automation USA Inc.,

Opposer,

Opposition No. _____

v.

Metrix Instrument Co., L.P.,

Applicant.

NOTICE OF OPPOSITION

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

Opposer, Metso Automation USA Inc. ("Opposer"), a Delaware corporation located and doing business at 26275 U.S. Highway 59, Fergus Falls, Minnesota, believes that it is or will be damaged by the registration on the Principal Register of the mark Hawk-i, U.S. Trademark Application Serial No. 77-785,119 filed by Metrix Instrument Co., L.P., ("Applicant") and hereby opposes the same on the following grounds:

FACTUAL ALLEGATIONS TO ALL COUNTS

1. On July 30, 1996, Opposer's predecessor in interest, Stonel Corporation (Stonel), filed application Serial Number 75-142,115 with the U.S. Patent and Trademark Office seeking registration of the mark HAWKEYE for proximity sensors, namely,

linear valve sensors for sensing the position of a valve. In September of that same year Stonel began using the HAWKEYE mark in connection with such goods. On August 25, 1998 Stonel was granted U.S. Trademark Registration 2,184,663 based on the above referenced application. That registration continues to be in full force and effect.

2. Recently, Stonel was merged into and Opposer. As a result of that merger Opposer now owns all of the assets of Stonel, including the trademark HAWKEYE, the registration of the HAWKEYE mark and the goodwill associated therewith. Stonel, and now Opposer, have continuously and extensively used the HAWYKEYE mark in connection with their proximity sensors since the mark was first used in September of 1996.

3. Opposer supplies and sells its HAWKEYE products either directly to end users or to distributors for distribution to end users.

4. Opposer has expended substantial monies in marketing, advertising and promoting the HAWKEYE mark in connection with its goods in interstate commerce in the United States.

5. Notwithstanding Opposer's established prior use of the HAWKEYE mark, Applicant filed on July 20, 2009 in the United States Patent and Trademark Office an application for trademark registration of the mark Hawk-i for "multi-channel electronic monitoring device for measuring changes in the condition of

industrial machinery, using accelerometers, eddy current proximity sensors, and process measurements, in a wireless and/or wired network environment." (U.S. Trademark Application Serial No. 77-785,119). The Hawk-i mark is identical in sound and meaning and substantially similar in appearance to Opposer's HAWKEYE mark. The goods Applicant proposes to sell under the Hawk-i mark are also substantially similar to Opposer's goods sold under the HAWKEYE mark and are likely to flow through the same or similar channels of trade.

COUNT I - LIKELIHOOD OF CONFUSION

6. Opposer hereby incorporates the allegations in Paragraphs 1 - 5 by reference herein.

7. The mark for which Applicant is seeking registration is substantially similar to Opposer's HAWKEYE mark.

8. The goods for which Applicant is seeking registration of the Hawk-i mark are substantially similar to the goods in connection with which Opposer has used its HAWKEYE mark.

9. Upon information and belief, the goods for which Applicant is seeking registration of the Hawk-i mark are offered to the same classes of customers that Opposer offers its goods in connection with its HAWKEYE mark.

10. Upon information and belief, the goods for which Applicant is seeking registration of its Hawk-i mark are offered through the same channels of trade that Opposer offers its goods

in connection with the HAWKEYE mark.

11. Applicant's Hawk-i mark is confusingly similar to Opposer's HAWKEYE mark. Use thereof by Applicant on the goods specified in the Hawk-i trademark application is likely to cause confusion, mistake or deception that Applicant's goods are those of Opposer or are otherwise endorsed, sponsored, or approved by Opposer, whereby Opposer will be damaged by the registration of Applicant's Hawk-i mark.

12. If Applicant is granted registration of its claimed Hawk-i mark as shown in U.S. Trademark Application Serial No. 77-785,119, Applicant will thereby obtain the *prima facie* exclusive right to use such mark in the United States, and such registration will impair and diminish Opposer's good will and rights in the HAWKEYE mark. This will cause irreparable damage and injury to Opposer.

COUNT II - DECEPTION/FALSE SUGGESTION OF CONNECTION

13. Opposer hereby incorporates the allegations contained in Paragraphs 1 - 12 by reference herein.

14. Applicant's Hawk-i mark so closely resembles Opposer's HAWKEYE mark and that it is likely to cause deception in violation of Lanham Act § 2(a).

15. Given the similarities that exist between Opposer's HAWKEYE mark and the Hawk-i mark, which is the subject of this opposition, purchasers will assume that goods sold under the

Hawk-i mark are connected to Opposer.

16. Applicant's Hawk-i mark is deceptive in that it falsely suggests a connection with Opposer.

COUNT III—Dilution

17. Opposer hereby incorporates the allegations contained in Paragraphs 1 - 16 by reference herein.

18. Prior to the time Applicant filed its application for registration of or commenced use of the Hawk-i mark, Opposer's HAWKEYE mark became famous as a result of the duration, extent and geographic reach of advertising and publicity of the mark, the amount, volume and geographic extent of sales of the goods offered under the mark, the extent of actual recognition of the mark, and the registration of the mark.

19. Applicant's adoption and use of the Hawk-i mark will impair the distinctiveness of Opposer's HAWKEYE mark and thereby cause dilution by blurring given the degree of similarity between the marks, the degree of inherent distinctiveness of the HAWKEYE mark and other factors.

20. Applicant's adoption and use of the Hawk-i mark will also cause dilution by tarnishment given the similarity between the marks, particularly if Applicant's goods are of an inferior quality so as to harm the reputation of the HAWKEYE mark.

PRAYER FOR RELIEF

WHEREFORE, Opposer prays that U.S. Trademark Application

Serial No. 77-785,119 be rejected and that registration of the Hawk-i mark for the goods specified therein be refused and that Opposer be awarded such further relief as this Board deems just and proper.

Respectfully submitted,

NIKOLAI & MERSEREAU, P.A.



James T. Nikolai
Attorneys for Opposer
900 Second Avenue So., Suite 820
Minneapolis, MN 55402
(612) 339-7461