

ESTTA Tracking number: **ESTTA477345**

Filing date: **06/11/2012**

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	Halliburton Energy Services, Inc.
Granted to Date of previous extension	06/13/2012
Address	2601 Beltline Road 1-B-121 Carrollton, TX 75006 UNITED STATES
Correspondence information	Joel D. Leviton Attorney Fish & Richardson P.C. 60 South Sixth Street Suite 3200 Minneapolis, MN 55402 UNITED STATES tmdoctc@fr.com, leviton@fr.com, lls@fr.com, rnr@fr.com Phone:612-335-5070

**Applicant Information**

Application No	85402715	Publication date	02/14/2012
Opposition Filing Date	06/11/2012	Opposition Period Ends	06/13/2012
Applicant	Baker Hughes Incorporated Mail Drop 1360 P.O. Box 40129 Houston, TX 772400129 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 007. First Use: 1998/10/00 First Use In Commerce: 1999/07/14 All goods and services in the class are opposed, namely: Mechanical downhole equipment for use in oil, gas and water wells, namely, downhole tool for removing debris from, and otherwise cleaning, wellbores and downhole casing and tubing
--

**Grounds for Opposition**

The mark is merely descriptive	Trademark Act section 2(e)(1)
--------------------------------	-------------------------------

Attachments	224130019pp1.pdf ( 5 pages )(165686 bytes )
-------------	---

**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	/Joel D. Leviton/
Name	Joel D. Leviton
Date	06/11/2012

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

HALLIBURTON ENERGY SERVICES, INC.,

Opposer,

v.

BAKER HUGHES INCORPORATED

Applicant.

In the matter of App. Serial No. 85/402,715

For the mark VACS

Published February 14, 2012

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Halliburton Energy Services, Inc., a Delaware corporation having a principal place of business at 10200 Bellaire Blvd., Houston, Texas 77072-5206 (“Halliburton” or “Opposer”), believes that it will be damaged by the registration of the claimed mark “VACS” that is the subject of Application Serial No. 85/402,715 (the “Application”) and hereby opposes the same pursuant to the provisions of 15 U.S.C. Section 1063.

The grounds for opposition are as follows:

1. Applicant, Baker Hughes Incorporated (“Applicant”), seeks to register the term “VACS” as a trademark for “Mechanical downhole equipment for use in oil, gas and water wells, namely, downhole tool for removing debris from, and otherwise cleaning, wellbores and downhole casing and tubing” in International Class 7.

2. The Application was filed on August 19, 2011 and has been designated Application Serial No. 85/402,715.

3. The Application was published for opposition on February 14, 2012. On February 16, 2012, Opposer requested and obtained a 90-day extension of time to oppose the Application.

4. In the Application, Applicant claims to have first used the purported mark “VACS” in connection with the goods identified in the Application in 1998.

5. In the Application, Applicant did not claim that the term “VACS” has become distinctive of Applicant’s goods.

6. The term “VACS” as used in connection with the goods identified in the Application is merely descriptive. In particular, the equipment identified in the Application removes debris from wellbores. According to Applicant’s literature about the equipment it offers in connection with the term VACS, Applicant’s equipment, like a vacuum, uses suction to remove debris. Applicant’s equipment, therefore, is a wellbore vacuum. The term “VAC” is a common abbreviation for the term “vacuum.” Applicant’s purported mark “VACS” merely is the plural form of “VAC,” and, when used in connection with vacuum equipment, will be considered shorthand for “vacuum” and/or “vacuums.” Applicant’s goods as illustrated in Applicant’s marketing materials include several different embodiments of wellbore vacuums and therefore may reasonably be understood to refer to the plural vacuums or VACS. Because “VAC” and “VACS” are abbreviations of “vacuum” and “vacuums,” which are terms that are *merely descriptive* of Applicant’s goods or a characteristic thereof, the abbreviation “VACS” clearly is *merely descriptive* in regards to Applicant’s goods. As such, “VACS” is not registrable on the Principal Register without a showing that it has become distinctive of Applicant’s goods.

7. Halliburton is in the business of providing products and services to the oil and gas drilling and production industry.

8. Halliburton uses the term “VAC” in various composite marks, including the composite mark VAC TECH, for which Halliburton owns Registration No. 3,738,313 on the Supplemental Register. Halliburton has an interest in continuing to use the term “VAC” both descriptively and in composite marks.

9. Applicant has objected to Halliburton’s use of the mark VAC TECH, claiming that Halliburton’s VAC TECH mark is confusingly similar to Applicant’s purported VACS mark and has demanded that Halliburton cancel its registration. Halliburton has the equal right to use the letters “VAC” in composite trademarks with other terms to identify its products and services.

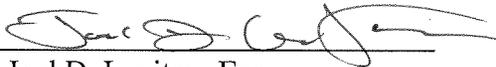
10. Registration of “VACS” without proof that it has acquired distinctiveness as an identifier of a single source of goods would damage Halliburton because such a federal registration would falsely suggest that “VACS” is inherently distinctive and that Applicant has the exclusive right to use “VACS” as a trademark, which is inconsistent with the fact that “VAC” is a common abbreviation for “vacuum” and used in composite marks by Halliburton and others. The existence of a federal registration for “VACS” alone would be a further source of damage to Halliburton due to the evidentiary value the registration would possess. Applicant already has claimed that its purported rights in “VACS” preclude Halliburton’s use of the VAC TECH designation in connection with drilling machines and parts therefor. Such a registration would presumptively give Applicant the exclusive right to use “VACS” in connection with the goods identified in the registration, and, therefore, could be used to improperly prevent Halliburton and third parties from adopting and using composite marks that contain the common element “VAC,” as Applicant already has attempted to do.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Halliburton respectfully requests that Application Serial No. 85/402,715 be rejected and that registration of the mark therein for the goods therein identified be refused.

Please charge the opposition fee to the Deposit Account of Fish & Richardson P.C., Account No. 06-1050.

Respectfully submitted,

Date: 6/11/12

By: 

Joel D. Leviton, Esq.  
FISH & RICHARDSON P.C.  
60 South Sixth Street, Suite 3200  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696  
Email: Leviton@fr.com

Russell N. Rippamonti  
FISH & RICHARDSON P.C.  
1717 Main Street, Suite 5000  
Dallas, TX 75201  
Telephone: 214-747-5070  
Facsimile: 214-747-2091  
Email: Rippamonti@fr.com

ATTORNEYS FOR HALLIBURTON  
ENERGY SERVICES, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the **NOTICE OF OPPOSITION** has been served this 11th day of June, 2012 by First Class U.S. Mail, postage prepaid, upon counsel for Applicant Baker Hughes Incorporated at the following addresses:

ANDRE' J. PORTER  
BAKER HUGHES INCORPORATED  
PO BOX 40129  
HOUSTON, TX 77240-0129

  
Joel D. Leviton