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

Proceeding	91205542
Party	Defendant Baker Hughes Incorporated
Correspondence Address	ANDRE' J. PORTER BAKER HUGHES INCORPORATED PO BOX 40129 HOUSTON, TX 77240-0129 andre.porter@bakerhughes.com
Submission	Answer and Counterclaim
Filer's Name	Anthony F. Matheny
Filer's e-mail	laipmail@gtlaw.com, mathenya@gtlaw.com
Signature	/Anthony F. Matheny/
Date	07/23/2012
Attachments	Ans-CC.pdf (11 pages)(488318 bytes)

Registration Subject to the filing

Registration No	3738313	Registration date	01/12/2010
Registrant	HALLIBURTON ENERGY SERVICES, INC. 2601 BELTLINE ROAD 1-B-121 CARROLLTON, TX 75006 UNITED STATES		

Goods/Services Subject to the filing

Class 007. First Use: 2008/05/31 First Use In Commerce: 2008/05/31 All goods and services in the class are requested, namely: Drilling machines; Drilling machines and parts therefor

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Halliburton Energy Services, Inc.	§	
	§	Opposition No. 91205542
Opposer,	§	
	§	Application Serial No. 85/402,715
v.	§	
	§	Mark: VACS
Baker Hughes Incorporated,	§	
	§	
Applicant.	§	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM PETITION FOR CANCELLATION

Applicant Baker Hughes Incorporated ("Baker Hughes" or "Applicant") in answer to Opposer Halliburton Energy Services, Inc.'s Notice of Opposition ("Notice") answers as follows:

To the extent an answer is required to the statements in the introductory paragraph on page 1 of the Notice, Baker Hughes admits that Opposer Halliburton Energy Services, Inc. ("Opposer") is seeking to oppose U.S. Trademark Application No. 85/402,715 because Opposer believes it will be harmed by the registration of Applicant's mark VACS which is the subject of U.S. Trademark Application No. 85/402,715. Baker Hughes is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations contained in the introductory paragraph on page 1 of the Notice and, thus, denies all of the remaining allegations.

1. Baker Hughes admits the allegations contained in paragraph 1 of the Notice.
2. Baker Hughes admits the allegations contained in paragraph 2 of the Notice.
3. Baker Hughes admits the allegations contained in paragraph 3 of the Notice.
4. Baker Hughes admits the allegations contained in paragraph 4 of the Notice.

5. Baker Hughes does not understand the allegations contained in paragraph 5 of the Notice because they are ambiguous in that Baker Hughes cannot determine the basis for Opposer's allegation that Baker Hughes did not make a "claim." On one hand, Baker Hughes "claimed" that its mark VACS has become distinctive by virtue of Baker Hughes filing its application to seek registration on the Principal Register and the Examiner's approval of its mark for registration. On the other hand, the Examiner did not require any such "claim," of acquired distinctiveness and, thus, Baker Hughes did not provide any separate evidence of distinctiveness other than its claim to the right of registration, to which the Examiner agreed. Due to the ambiguity of the allegations contained in paragraph 5 of the Notice, Baker Hughes is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 5 and, thus, denies the allegations contained in paragraph 5 of the Notice.

6. Baker Hughes denies the allegations contained in the first, seventh, and eighth sentences of paragraph 6 of the Notice. Baker Hughes admits that the equipment identified in Application Serial No. 85/402,715 removes debris from wellbores as alleged in the second sentence of paragraph 6 of the Notice, but denies the remaining allegations contained in the second sentence of paragraph 6 of the Notice. Baker Hughes is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations contained in paragraph 6 of the Notice and, thus, denies all of the remaining allegations contained in paragraph 6 of the Notice.

7. Baker Hughes admits the allegations contained in paragraph 7 of the Notice.

8. Baker Hughes admits that U.S. Trademark Registration No. 3,738,313 is for the mark VAC TECH on the Supplemental Register as alleged in paragraph 8 of the Notice. Baker Hughes is without sufficient knowledge or information to form a belief as to the truth of the

remaining allegations contained in paragraph 8 and, thus, denies the remaining allegations contained in paragraph 8 of the Notice.

9. Baker Hughes admits the allegations contained in the first sentence of paragraph 9 of the Notice. Baker Hughes denies the allegations contained in the second sentence of paragraph 9 of the Notice.

10. Baker Hughes admits that Baker Hughes has claimed that its rights in its mark VACS preclude Opposer's use of the term VAC TECH in connection with drilling machines and parts therefor, and that a registration issued to Baker Hughes for its mark VACS would presumptively give Baker Hughes exclusive rights to use its mark VACS on the goods identified in Application Serial No. 85/402,715 as alleged in paragraph 10 of the Notice. Baker Hughes denies the remaining allegations contained in paragraph 10 of the Notice.

AFFIRMATIVE DEFENSES

1. Opposer's claims are barred in part or in whole under the doctrine of unclean hands in that Opposer obtained U.S. Trademark Registration No. 3,738,313 by misrepresenting to the U.S. Patent and Trademark Office during the examination of the application that issued as U.S. Trademark Registration No. 3,738,313 the true nature of Opposer's goods. In particular, Opposer sought and obtained registration of the mark VAC TECH for "drilling machines; drilling machines and parts therefor." However, Opposer's products on which it uses the mark VAC TECH do not fall within this description of goods. To the contrary, Opposer's actual goods are mechanical downhole equipment for use in oil, gas and water wells, namely, downhole tools for removing debris from, and otherwise cleaning, wellbores and downhole casing and tubing. Indeed, the specimen submitted by Opposer showing the use of the mark VAC TECH

does not include any component of a drilling machine or a part for a drilling machine. On information and belief, Opposer purposely and intently withheld this fact from the U.S. Patent and Trademark Office during examination of the application that issued as U.S. Trademark Registration No. 3,738,313. In addition, on information and belief, at the time Opposer filed its application that issued as U.S. Trademark Registration No. 3,738,313, Opposer was aware of Applicant's prior use of the mark VACS on goods that are identical to Opposer's goods, 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. Opposer fraudulently withheld this material information from the U.S. Patent and Trademark Office during the examination of the application that issued as U.S. Trademark Registration No. 3,738,313 so that it could obtain its registration. Further, by withholding this material information, Opposer committed fraud on the U.S. Patent and Trademark Office by declaring at least three times, after being "warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration," that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." These acts constitute unclean hands and, thus, bar Opposer's grounds for opposition.

2. Opposer's claims are barred in whole or in part under the doctrine of estoppel or waiver. In particular, during the examination of the application that issued as U.S. Trademark Registration No. 3,738,313, the U.S. Patent and Trademark Office issued an Office Action in

which Opposer's mark VAC TECH was refused registration as being "merely descriptive" because Opposer's mark VAC TECH "merely describes a function of applicant's goods." In its Response to the Office Action, Opposer represented to the U.S. Patent and Trademark Office:

> The Examining Attorney has rejected the mark "VAC TECH" as allegedly merely descriptive. The Examiner cites reproductions of web pages using the term "Vacuum". However, no where is the term "VAC" cited in connection with specific machines or drilling processes. The word "VAC", without more, does not describe or identify a particular drilling machine or a type of drilling operation. The Examiner contends that the term "VAC" merely describes vacuuming that is done as a part of the drilling process. The Examiner, however, has not shown that the oilfield industry uses the word "VAC". Furthermore, the documents cited by the Examiner show that "vac" is not solely a shortened version of "vacuum". Instead, "vac" may be a shortened version of several different words that have no relation to "vacuum", e.g., vacancy and vacant. Accordingly, the rejection is not proper and should be removed.

Thus, Opposer has admitted that the term "VAC" is not used in the "oilfield industry" and that the term "vac" is not "solely a shortened version of "vacuum." Accordingly, Opposer is estopped from arguing in this proceeding that the term "vac" is used in the oilfield industry and that the term "vac" is "solely a shortened version of vacuum." As a result, the entire predicate of Opposer's basis for opposing the application is unsupportable and thus, bars Opposer's grounds for opposition.

3. In addition to being inherently distinctive, Applicant's mark VACS has acquired distinctiveness under 15 U.S.C. § 1052(f) based on Applicant's continuous and exclusive use of the mark VACS in interstate commerce since at least July 14, 1999.

PRAYER

WHEREFORE, Applicant Baker Hughes Incorporated prays that Opposer's Notice of Opposition be dismissed, that registration based on U.S. Trademark Application Serial No. 85/402,715 be issued, and that Applicant Baker Hughes Incorporated be granted all other relief, in law or equity, to which it is entitled.

COUNTERCLAIM: PETITION TO CANCEL

1. Baker Hughes Incorporated ("Petitioner"), a Delaware corporation located and doing business in Houston, Texas, believes that it is being, and will continue to be, damaged by U.S. Trademark Registration No. 3,738,313 ("the "313 Registration"), and hereby petitions to cancel that registration based upon the following grounds:

2. Petitioner is the owner of U.S. Trademark Application Serial No. 85/402,715 seeking to register the mark VACS 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." U.S. Trademark Application Serial No. 85/402,715 was filed August 19, 2011, and claimed a first use of the mark VACS on the listed goods at least as early as October, 1998, and a first use in commerce at least as early as July 14, 1999. This application is presently pending and has been published pursuant to 15 U.S.C. § 1062. Upon publication, Respondent Halliburton Energy Services, Inc. ("Respondent") initiated an opposition proceeding against Petitioner's application.

3. Upon information and belief, Respondent Halliburton Energy Services, Inc. is a Delaware corporation located and doing business at 10200 Bellaire Blvd., Houston, Texas 77072. Respondent is the owner of record of the '313 Registration. The '313 Registration was registered on January 12, 2010, for "drilling machines; drilling machines and parts therefor."

4. Respondent's registration should be cancelled on the grounds that: Respondent mislead the U.S. Patent and Trademark Office in obtaining the '313 Registration; Respondent made false statements in the declarations filed by Respondent to obtain the '313 Registration, by declaring that the mark was in use with all of the goods set forth in the '313 Registration, when, at the time of the issuance of the '313 Registration, the mark was not in use with such goods;

Respondent made false statements in the declarations filed by Respondent to obtain the '313 Registration by declaring that Respondent was not aware of any third party marks that conflicted with Respondent's mark as Respondent was well aware of Petitioner's use of the mark VACS on products that are identical to Respondent's VAC TECH branded products; and Respondent's mark VAC TECH is likely to cause the public to be confused, mistaken, or deceived into believing that Respondent's goods originate from Petitioner or are in some way related to, associated with, or sponsored by Petitioner, who started using its mark VACS approximately a decade before Respondent's adoption and use of its mark VAC TECH, and in interstate commerce nearly a decade before Respondent's adoption and use of tis mark VAC TECH. The likelihood of confusion as to the origin, affiliation, association, or sponsorship between Respondent's mark and Petitioner's mark damages Petitioner.

5. Upon filing the application that issued as the '313 Registration, and during examination of the application that issued as the '313 Registration, Respondent, after being "warned that false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document", declared in the application itself and in at least two Amendments to Allege Use, that "all statements made of his/her own knowledge are true". Respondent's declarations, however, were not true. Specifically, Respondent declared that it "is using ... the mark in commerce on or in connection with all the goods ... listed in the existing registration," namely, "drilling machines; drilling machines and parts therefor." Respondent's goods, however, are not "drilling machines; drilling machines and parts therefor," but instead are 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.

Respondent misled the U.S. Patent and Trademark Office during the application process to distract the U.S. Patent and Trademark Office from the fact that another party was using a confusingly similar mark on goods that were identical to Respondent's goods well before Respondent adopted and began using its mark VAC TECH.

5. In addition, Respondent misled and committed fraud on the U.S. Patent and Trademark Office by declaring, at least three times, after being "warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration," that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." On information and belief, at the time that Respondent made these declarations, Respondent was well aware of Petitioner's long, continuous, and exclusive use of its mark VACS on goods that are identical to Respondent's goods on which it uses its VAC TECH mark.

6. As discussed above, Petitioner has been using its mark VACS on the products listed in U.S. Trademark Application Serial No. 85/402,715 since at least as early as July 14, 1999. The goods listed in Petitioner's U.S. Trademark Application Serial No. 85/402,715 are identical to goods sold and offered for sale by Respondent in connection with its mark VAC TECH. Further, the parties' respective customers and potential customers are virtually identical, and the advertising media for the parties' respective goods and the channels of distribution for the parties' respective goods are virtually identical. In addition, upon information and belief, Respondent had knowledge of Petitioner's use of its mark VACS on goods that are identical to

Respondent's goods well before Respondent began using its mark on goods identical to Petitioner's goods, Thus, Respondent's later adoption, use, and registration of its mark VAC TECH was intended to cause confusion among customer and potential customers.

7. In view of the similarity of the parties' respective marks, goods identified by these marks, customers and potential customers of the goods identified by these marks, advertising media used to promote and advertise the goods identified by these marks, and channels of distribution used by the parties to sell and offer for sale their respective goods identified by these marks, Respondent's mark so resembles Petitioner's mark as to be likely to cause the public to be confused, mistaken, or deceived into believing that Respondent's goods originate from Petitioner or are in some way related to, associated with, or sponsored by Petitioner.

8. The likelihood of confusion as to the origin, affiliation, association, or sponsorship between Respondent's mark and Petitioner's mark damages Petitioner.

9. As set out above, Petitioner is being, and will continue to be damaged by the existence of Respondent's '313 Registration, because the continued registration of the mark of the '313 Registration, to which Respondent is not entitled, creates a likelihood of confusion as to the source of Respondent's goods and those of Petitioner. Further, Respondent fraudulently obtained the '313 Registration in violation of federal law. In addition, Respondent has asserted the '313 Registration as a basis to oppose Petitioner's application for registration of its mark VACS. Thus, the continued existence of the '313 Registration is being used, and will be used in the future, by Respondent to impair Petitioner's ability to freely use and register Petitioner's mark VACS.

10. The Commissioner is authorized to charge the filing fee of $300.00 for this Petition to Cancel, as well as any other fees that may be due, or credit any overpayment, to Greenberg Traurig Deposit Account No. 50-2638, Order No. 104697.016300.

PRAYER

WHEREFORE, Petitioner prays that this Petition for Cancellation be granted, that Respondent's trademark registration, U.S. Trademark Registration No. 2,402,208, be cancelled, and for any and all further other relief that the Trademark Trial and Appeal Board may deem just and proper.

CONCLUSION

WHEREFORE, Applicant Baker Hughes Incorporated prays that the Notice of Opposition be dismissed, that registration based on U.S. Trademark Application Serial No. 85/402,715 be issued, and that U.S. Trademark Registration No. 3,738,313 be cancelled, and that Applicant Baker Hughes Incorporated be granted all other relief, in law or equity, to which it is entitled.

Respectfully submitted,

DATED: July 23, 2012

/Anthony F. Matheny/

Anthony F. Matheny
Mark G. Chretien
GREENBERG TRAURIG LLP
1000 Louisiana Street, Suite 1700
Houston, Texas 77002
Tel: 713-374-3583
Fax: 713-754-7583
E-mail: mathenya@gtlaw.com

ATTORNEYS FOR APPLICANT,
BAKER HUGHES INCORPORATED

CERTIFICATE OF SERVICE

I hereby certify that on July 23, 2012, a true and correct copy of the foregoing Applicant's Answer to Notice of Opposition was served by first class mail, postage prepaid, and e-mail on the following:

Joel D. Leviton
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, Minnesota 55402
tmdoctc@fr.com, leviton@fr.com, lls@fr.com; rnr@fr.com

Russell N. Rippamonti
Fish & Richardson P.C.
1717 Main Street, Suite 5000
Dallas, Texas 75201
rippamonti@fr.com

/Anthony F. Matheny/
Anthony F. Matheny