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

Proceeding	91206026
Party	Defendant Shurjoint Piping Products, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Victaulic Company of America,

Opposer,

v.

Shurjoint Piping Products, Inc.

Applicant.

Opposition No.: 91206026  
Serial No.: 85/502,864

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*Docket No. 091832.000200*

**APPLICANT’S REPLY IN SUPPORT OF MOTION FOR JUDGMENT ON THE  
PLEADINGS**

Applicant, Shurjoint Piping Products, Inc. (hereinafter “Shurjoint”), by and through its undersigned counsel, hereby submits its reply in support of its motion for judgment on the pleadings seeking to dismiss Opposition No. 912 06026 filed by Opposer, Victaulic Company of America, (“Victaulic”).<sup>1</sup>

This proceeding is a meritless harassment of a long-time competitor. A denial of Shurjoint’s motion for judgment would be wasteful of the Board’s resources, wasteful of the parties’ resources, and would enable Victaulic’s abuse of process. The law is simple—laches runs from the publication date of a prior registration that is *substantially* the same, not exactly the same. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION,

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<sup>1</sup> Victaulic’s response to motion for judgment on the pleadings purports to have been filed and served on November 5, 2012. However, despite the certificate of service, Victaulic’s response was not received by undersigned counsel, but rather, was found on The PTO web site on November 26, 2012. As such, to the extent leave of the Board is required, Applicant respectfully requests that the Board grant leave for filing of this reply in consideration of same.

§20:35.50 (4<sup>th</sup> ed. 2012); *see also*, *Aquion Partners L.P. v. Envirogard Prods. Ltd.*, 43 USPQ2d 1371 (TTAB 1997); *see also*, *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992).

Additionally, there are no material facts in dispute. Victaulic argues that there remains a dispute as to whether the marks and goods covered by the prior incontestable registration and the opposed application are the same. First, the marks and goods need not be identical, but rather, substantially the same - e.g., insignificant variations do not alter the impact of a party's failure to act against a prior registration for otherwise the substantially same mark and goods. More importantly, these are simply legal questions ripe for judgment by the Board, not disputed facts. There is no dispute as to what the marks and goods are in the registration and application. The only question is whether the Board as a matter of law finds them substantially similar such that laches runs from the publication date of the incontestable registration.

The marks are essentially identical as depicted below:



The word marks, which are dominant, are the same. The core, dominant design features are the same. There only truly insignificant difference in the marks is a black square added to the core, distinctive part of the design in the application. And, this proceeding relates solely to a claim of likelihood of confusion between SHURJOINT and SNAP-JOINT (despite 40 years of co-existence) – e.g., it is based solely on the word portion of the mark which is identical in both the prior, incontestable registration and the opposed application.

Further, the goods in the incontestable registration are “pipe fittings of metal.” **All** goods

in the opposed application are types of “pipe fittings of metal,” with the minute addition of “pipes of metal.” That distinction is so microscopically insignificant that it does not keep the prior registration and opposed application from being *substantially* the same. To the extent “pipes of metal” are distinguishable from “pipe fittings of metal,” it is analogous to finding that the failure to oppose or seek to cancel a prior registration for the a mark for “fruit” does not give rise to laches preventing opposition to an application for the same mark for “apples (fruit), bananas (fruit), and apple sauce” because apple sauce is arguably slightly different from fruit. The potential for such an absurd result is why the Board used the wording “*substantially* the same” and not “*exactly* the same”. The goods are **overwhelmingly identical and are certainly *substantially* the same**. There is simply no doubt that Shurjoint’s prior incontestable registration and application are substantially the same.

It could not be more clear that Victaulic has filed this proceeding against a competitor who it knows has been using the SHURJOINT house mark in direct competition with Victaulic for forty (40) years for *all of the goods* set forth in the application and incontestable registration. The proceeding is outright frivolous, and the Board should not issue a ruling that forces the parties to litigate to that only logical, inevitable conclusion. This background makes clear that Victaulic and its counsel have engaged in an abuse of the Board’s process, and the Board should not condone such conduct. The opposition is barred by laches under settled law and should be dismissed.

For the foregoing reasons, Shurjoint respectfully requests that its Motion for Judgment on the Pleadings be granted.

Respectfully submitted,

**Shurjoint Piping Products, Inc.**

Date November 28, 2012

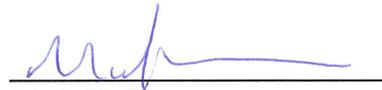
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the foregoing APPLICANT'S REPLY IN SUPPORT OF MOTION FOR JUDGMENT ON THE PLEADINGS was served by first-class mail, postage pre-paid on this 28<sup>th</sup> day of November, 2012 to Opposer's counsel at the following address:

Bryan P. Sugar  
Ungaretti & Harris  
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Chicago, IL 60602-4224

By:



Mark H. Tidman