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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,

Petitioner,

v.

Shurjoint Piping Products, Inc.

Respondent.

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

**RESPONDENT’S MOTION FOR JUDGMENT ON THE PLEADINGS**

Respondent, Shurjoint Piping Products, Inc. (hereinafter “Shurjoint”), by and through its undersigned counsel, moves, pursuant to TMBP §504, to dismiss Cancellation No. 91206026 filed by Petitioner, Victaulic Company of America, (“Victaulic”) on the grounds that there exists no genuine issue as to any material fact and that Shurjoint is entitled to judgment as a matter of law.

Victaulic’s opposition is so lacking in merit, and the parties have co-existed under their respective entirely different SHURJOINT and SNAP-JOINT marks for so long (many decades), that the only conclusion that can be drawn is that this proceeding was brought merely to harass a long-time competitor and is an abuse of process. Certainly, a more clear case of a proceeding being barred by laches is difficult to contemplate<sup>1</sup>. The pertinent and undisputed facts are as follows:

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<sup>1</sup> The decades long delay leading to laches is truly an admission by Opposer of the frivolous nature of the proceeding.

1. The parties have co-existed using their respective trademarks SHURJOINT and SNAP-JOINT for nearly *forty (40) years*, since 1974, during which Shurjoint and Victaulic both sold pipe couplings<sup>2</sup> under those marks with Victaulic's knowledge.

2. The fact of *forty (40) years* of co-existing use of the marks on the goods of concern was known or should have been known<sup>3</sup> to Victaulic and its counsel prior to filing of the Notice of Opposition.

3. Throughout *forty (40) years* of co-existence, there has been *no actual confusion or assertion of infringement* by Victaulic.

4. In addition to the decades of co-existence of the parties, Shurjoint owns an *incontestable registration, no. 1,996,123 for the mark SHURJOINT for "pipe fittings of metal"*.

5. This opposition relates to an application to register SHURJOINT for, *inter alia*, pipe couplings despite Victaulic's knowledge of the sale of pipe couplings under SHURJOINT for decades without objection by Victaulic or consumer confusion and *an incontestable registration for SHURJOINT for pipe fittings of metal*.

6. The marks in Shurjoint's incontestable registration and the opposed application are virtually identical as shown:

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<sup>2</sup> Opposing counsel has repeatedly indicated that Victaulic's only objection is limited to the inclusion of "pipe couplings" in the opposed application, despite that SHURJOINT pipe couplings have been sold for decades with Victaulic's knowledge, no objection, and no confusion.

<sup>3</sup> It is unfathomable that Victaulic could credibly deny such knowledge given the parties' direct competition and knowledge of each other in the marketplace for so many years, Shurjoint being a house mark.



7. Registration no. 1,996,123 was published for opposition on **August 8, 1995** and registered *without opposition whatsoever from Victaulic* or any other party.

8. Shurjoint's ownership of its incontestable registration was *known to Victaulic and its counsel* prior to the filing of the Notice of Opposition.

This proceeding is beyond the pale.

Generally, in the opposition context, the laches period begins upon publication of the application being opposed. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1992). However, an established exception to the general rule dictates that the laches period runs from the publication date of a substantially similar prior registration based on the opposing party's failure to object to the applicant's earlier registration. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §20:35.50 (4<sup>th</sup> ed. 2012); *see also, Aquion Partners L.P. v. Envirogard Prods. Ltd.*, 43 USPQ 1371 (TTAB 1997)<sup>4</sup>; *see also, Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992). Thus, the laches period began on August 8, 1995, and Victaulic has allowed seventeen (17) years

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<sup>4</sup> The court allowed applicant to assert the defense of laches based on prior registration which existed from 1971 until 1991, despite its expiration due to applicant's inadvertent failure to renew.

to lapse since the publication of registration no. 1,996,123 before commencing action against Shurjoint.

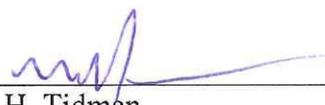
This opposition relates to the virtually identical mark for virtually identical goods as covered in prior incontestable Registration No. 1,996,123, published seventeen (17) years ago. Vitaulic's filing of this proceeding is baseless, abusive and wasteful of the Board's resources.<sup>5</sup>

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

Respectfully submitted,

**Shurjoint Piping Products, Inc.**

Date October 16, 2012

By:   
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<sup>5</sup>See Fed. R. Civ.P.11; see also 37 CFR §2.116(a) and TBMP §527.02.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the foregoing MOTION FOR JUDGMENT ON THE PLEADINGS was served by first-class mail, postage pre-paid on this 16<sup>th</sup> day of October, 2012 to Petitioner's counsel at the following address:

Bryan P. Sugar  
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By:

  
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Mark H. Tidman