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

Proceeding	91206026
Party	Plaintiff Victualic Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

	)	
Victaulic Company,	)	
Opposer,	)	
	)	Opposition No. 91206026
	)	Serial No. 85/502,864
	)	Mark: SHURJOINT
v.	)	
	)	
	)	
Shurjoint Piping Products, Inc.,	)	
Applicant	)	
	)	
	)	

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**OPPOSER'S RESPONSE TO  
MOTION FOR JUDGMENT ON THE PLEADINGS**

Opposer, VICTAULIC COMPANY, by its attorneys, hereby submits this Response to Respondent's Motion for Judgment on the Pleadings.

**STANDARD OF REVIEW**

In deciding this Motion, all of Opposer's well-pled factual allegations must be accepted as true and all inferences drawn therefrom are to be viewed in a light most favorable to Opposer. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992) (stating that for purposes of a motion for judgment on the pleadings, "all well-pleaded factual allegations of the nonmoving party are assumed to be true and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party"). Further, Applicant's Motion cannot be granted if there is a genuine issue of material fact to be resolved. *Id.* (stating that a motion for judgment on the pleadings "will be granted only if the moving party clearly establishes that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law."); *see also* 5C Fed. Pac. & Proc. Civ.3d § 1367 (2008).

**ARGUMENT**

Applicant relies solely on the argument that the instant action is barred by laches. Applicant's Motion must be denied because: (1) laches is not an appropriate basis for a motion for judgment on the pleadings in this case; (2) the facts in this case do not qualify for the narrow laches period exception for prior registered marks; and (3) the central facts in this Opposition are in dispute.

**1. Laches Is Not An Appropriate Basis For A Motion For Judgment On The Pleadings In This Case Because The Opposition Was Timely Filed.**

Opposer has not delayed in opposing the Applicant's mark. The Federal Circuit's *ACE Awards* case made clear that in an opposition proceeding, the laches period cannot begin to run until the mark is published. *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 U.S.P.Q.2d 1424, 1431 (Fed. Cir. 1991). The Board has strongly echoed this point, stating that "it [is] clear that in an opposition proceeding, laches cannot begin to run until the mark is published for opposition." *DAK Industries, Inc. v. Daiichi Kosho Co.*, 25 U.S.P.Q.2d 1622, 1624 (TTAB 1992). The court in *DAK Industries* added that the court in the *ACE Awards* case, "could not have been clearer: the period which we consider in determining whether a plaintiff unduly delayed in bringing an [opposition] action before the Board begins with the publication of the mark in the Official Gazette. Before then, no opposition is possible." *Id.*

The Application at issue (Serial No. 85/502,864) was published for opposition on May 29, 2012. On June 19, 2012, Opposer filed a Motion for Extension of Time to Oppose for a Period of thirty (30) days, which was granted. Opposer properly filed the instant Opposition on July 11, 2012. Simply put, Opposer in no way delayed in bringing this Opposition.

**2. The Facts In This Case Do Not Qualify For The Narrow Laches Period Exception For Prior Registered Marks.**

The Applicant cites a narrow exception to the well-established rule explained above, namely, "the laches period may run from the date of a prior registration because of the failure of opposer to object to applicant's earlier registration of the same mark for the same goods." MCCARTHY, § 20:35.50 (emphasis added). Under this standard, if one of these two conditions is not satisfied, the exemption does not apply. Applicant fails to meet both conditions.

First, the logo design applied for by the Applicant is not the same as the design in Applicant's prior registration (Reg. No. 1,996,123). See *Respondent's Motion for Judgment on the Pleadings*, at p. 3 for a comparison of the different logo designs. Accordingly, the first condition for the exception is not satisfied.

Second, the goods applied for by the Applicant are not the same as those identified in the Applicant's prior registration. As explained by Applicant, the very heart of Opposer's objection to the instant application is that Applicant's application contains the words "pipe coupling", which is absent from Reg. No. 1,996,123. *Respondent's Motion for Judgment on the Pleadings*, at p. 2, fn2. ("Opposing counsel has repeatedly indicated that Victaulic's only objection is limited to the inclusion of "pipe couplings" in the opposed application . . ."). In fact, while the identification of goods of Reg. No. 1,996,123 was limited to only "pipe fittings of metal", the opposed application has the following paragraph of ten (10) additional goods:

Elbows of metal for pipes, metal junctions for pipes, metal pipe clips, metal pipe collars, metal pipe connectors, metal pipe couplings and joints, metal pipe fittings for compressed air pipes, metal pipe fittings for rigid pipes, metal pipes and metal fittings therefor, pipe fittings of metal.

Accordingly, the second condition for the Applicant to qualify for the narrow laches exception is also not satisfied. As neither condition is met, and both are required, Applicant's motion should be denied.

### **3. Applicant's Motion Must Be Denied Because Material Facts Are In Dispute.**

Concurrently with filing its Motion For Judgment on the Pleadings, Applicant served Opposer with a laundry list of Interrogatories, Document Requests, and Requests for Admission, which is a tacit admission of the material facts that must be uncovered in the discovery process. It is hornbook law that a judgment on the pleadings may be granted **only** where there is no material issue of fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Baroid Drilling*, 24 USPQ2d at 1049; *see also* 5C Fed. Prac. & Proc. Civ.3d § 1367 (2008).

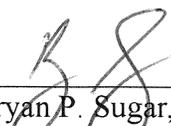
While there are multiple issues of fact in dispute, perhaps the most central fact alleged in the Opposition, namely, that Applicant's mark so resembles Opposer's previously used and registered mark as to be likely, when applied to pipe couplings, to cause confusion, mistake, or deception, is vehemently denied in Applicant's Answer. *See* Answer, para. 3 ("The allegation of likelihood of confusion herein is wholly knowingly unsupported"). Despite Applicant's strong denial, Opposer's well-pled factual allegations must be accepted as true and Applicant's denial of this allegation is a critical question of fact in dispute. *Baroid Drilling*, 24 USPQ2d at 1049.

Furthermore, to the extent Applicant seeks to avail itself of the laches exception (described above), the essential facts relating to this claim are in dispute, namely, (1) whether the mark covered by its prior registration (Reg. No. 1,996, 123) is the same as the mark covered in the application at issue (Ser. No. 85/502, 864) and (2) whether the goods covered by Applicant's prior registration (Reg. No. 1,996, 123) are the same as the goods covered in the application at issue. As the core facts in this Opposition are in dispute, Applicant's motion must be denied

### **CONCLUSION**

Applicant is not entitled to a judgment on the pleadings because the laches exception does not apply and critical issues of fact are in dispute. Applicant's motion must be denied.

VICTAULIC COMPANY

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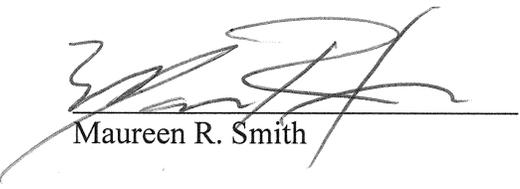
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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing OPPOSER'S RESPONSE TO MOTION FOR JUDGMENT ON THE PLEADINGS in Opposition No. 91206026 was served upon Applicant by sending a true and correct copy thereof, by first class mail, postage prepaid, to the following attorney of record:

Mark H. Tidman, Esq.  
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on this, the 5<sup>th</sup> day of November, 2012.

  
Maureen R. Smith