

ESTTA Tracking number: **ESTTA286718**

Filing date: **05/29/2009**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Brunson Instrument Company		
Entity	Corporation	Citizenship	Missouri
Address	8000 East 23rd Street Kansas City, MO 64129 UNITED STATES		

Attorney information	Rebecca Stroder Sonnenschein Nath & Rosenthal LLP P.O. Box 061080 Wacker Drive Station, Sears Tower Chicago, IL 60606-1080 UNITED STATES trademarks@sonnenschein.com
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Registration Subject to Cancellation

Registration No	3531432	Registration date	11/11/2008
Registrant	Hubbs Machine & Manufacturing Inc. 6282 Rocky Grove P.O. Box 540 Cedar Hill, MO 63016 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 1990/00/00 First Use In Commerce: 1990/00/00 All goods and services in the class are cancelled, namely: Surveying laser tracker target mount used to hold in place a spherical mounted retro reflector and a theodolite sphere or photogrammetry sphere
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Grounds for Cancellation

The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Hubbs Petition to Cancel.pdf (5 pages)(16947 bytes)
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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	/Rebecca Stroder/
Name	Rebecca Stroder
Date	05/29/2009

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

In the matter of Registration No.: 3531432)	
Registration Date: November 11, 2008)	
Mark: SM)	
)	
BRUNSON INSTRUMENT COMPANY,)	
)	
Petitioner,)	Cancellation No. _____
)	
v.)	
)	
HUBBS MACHINE & MANUFACTURING, INC.,)	
)	
Registrant.)	

PETITION FOR CANCELLATION

Brunson Instrument Company (“Petitioner”), a corporation formed under the laws of Missouri, with a principal place of business at 8000 East 23rd Street, Kansas City, Missouri, 64129, believes it is being and will continue to be damaged by Registration No. 3531432, issued November 11, 2008 (the “Hubbs Registration”), and pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111, through its undersigned attorneys, petitions to cancel the same.

As grounds therefor, Petitioner alleges that:

1. Petitioner is a leading supplier of scientific and measuring equipment used in industrial applications for three dimensional spatial alignment and angular and linear measurement. Petitioner has marketed and sold products and services in the United States since at least 1946. Petitioner uses generic and descriptive terms relevant to its products and the Petitioner’s industry in its marketing, advertisement and promotion of its products and services.

2. On December 26, 2006, Hubbs Machine & Manufacturing, Inc. (“Registrant”) filed U.S. Trademark Application Serial No. 76670729, on an intent to use basis, for the letters SM to be used in connection with “surveying laser tracker target mount used to hold in place a spherical mounted retro

reflector and a theodolite sphere or photogrammetry sphere.” This application matured into the Hubbs Registration.

3. The letters SM are generic of and merely descriptive of the goods recited in the Hubbs Registration, because “SM” stands for “sphere mount,” which describes a characteristic of the products with which those letters are used. The letters SM immediately convey to the relevant market that the product with which the letters are associated is a sphere mount type product. Registrant did not bring the significance of the letters “SM” to the attention of the USPTO during the examination process.

4. The letters “SM” have not become distinctive in commerce for the goods set forth in the Hubbs Registration or any other goods or services offered or sold by Registrant.

5. Petitioner has used the letters “SM” in its part numbering system.

6. Registrant has accused Petitioner of infringing its alleged trademark rights in the letters “SM” through Petitioner’s use of those letters.

7. Registrant filed a lawsuit in the United States District Court for the Eastern District of Missouri, seeking damages for alleged trademark infringement and false designation of origin.

8. Petitioner has a present and prospective right to use the letters “SM” to describe and refer to the goods and services offered by Petitioner as a part of its numbering system.

9. Accordingly, the Hubbs Registration must be cancelled in its entirety, on the grounds that the letters “SM” are generic and descriptive of the goods recited in the Hubbs Registration.

10. In addition, in the examination and issuance process, the Registrant submitted specimens of use showing the letters “SM” embedded within various part numbers, on a “pressure-sensitive sticker” that is allegedly “applied to the usually polyethylene bag, or packaging, in which the target mounts are shipped to the customer.” This does not constitute use in commerce sufficient to support a trademark registration. Accordingly, the letters “SM” as shown in the Hubbs Registration have not been used in commerce, and therefore, the Hubbs Registration is subject to cancellation on the basis that the registered mark has not been used in commerce.

11. Further, when Registrant filed its Statement of Use on August 20, 2008, it declared, under penalty of perjury, that the mark shown in the application was being used in commerce on or in connection with all of the goods and/or services listed in the Notice of Allowance. Because the letters “SM” were not being used in commerce at the time of the Statement of Use and supporting declaration, the declaration was false, and the Hubbs Registration is therefore subject to cancellation on the grounds that the Registrant committed fraud on the United States Patent and Trademark Office by falsely stating the subject mark was in use on the recited goods, when it was not.

12. Upon knowledge and belief, the Registrant knew the statements made in its Statement of Use were false at the time the Registrant made those statements and supporting declaration.

13. The Registrant knew the significance of the letters “SM,” but failed to bring that significance to the attention of the USPTO examiner during the examination process, as any applicant is required to do. Therefore, the Hubbs Registration is subject to cancellation on the grounds that the Registrant committed fraud on the USPTO when it filed its application, by failing to explain the significance of the letters “SM.”

14. Petitioner has been and will continue to be harmed by the continued registration of the Hubbs Registration, in that Petitioner (and others in the industry) will be, and will believe that they may be, subject to suit by Registrant if they were to use the generic and descriptive letters “SM” or similar terms and phrases. Further, continued registration of the Hubbs Registration confers upon Registrant statutory rights and presumptions under the Lanham Act to which Registrant is not entitled, with resulting harm to Petitioner.

WHEREFORE, Petitioner prays that Registration No. 3531432, issued on November 11, 2008, be canceled with prejudice, on the grounds that the phrase SM is generic and descriptive of the goods listed in the Hubbs Registration, and that the mark has not been used as a trademark in commerce, and that the registration was procured by fraud, and for such other and further relief as the Board deems just and proper.

Petitioner hereby appoints Edward Marquette, Rebecca Stroder, and Sonnenschein Nath & Rosenthal, LLP, P.O. Box #061080, Wacker Drive Station, Sears Tower, Chicago, IL 60606-1080, as its representative upon whom notices and process in proceedings affecting this proceeding may be served.

Respectfully Submitted,

SONNENSCHN NATH & ROSENTHAL LLP

Date: May 29, 2009

/s/ Rebecca Stroder

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Attorneys for Petitioner, Brunson Instrument Company

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing PETITION FOR CANCELLATION to be served upon:

Hubbs Machine & Manufacturing, Inc.
c/o Paul M. Denk
763 S New Ballas Rd., Ste. 170
St. Louis, MO 63141-8711

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 29th day of May, 2009

/s/ Rebecca Stroder
Rebecca Stroder, Attorney for Petitioner

Filed with the TTAB via
ESSTA on May 29, 2009