

ESTTA Tracking number: **ESTTA377298**

Filing date: **11/08/2010**

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	Sensocon, Inc.		
Entity	Corporation	Citizenship	Florida
Address	P.O. Box 518 Highland, FL 33846 UNITED STATES		

Attorney information	Clifford W. Browning Krieg DeVault LLP One Indiana Square, Suite 2800 Indianapolis, IN 46204 UNITED STATES cbrowning@kdlegal.com Phone:317-238-6203		
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Registration Subject to Cancellation

Registration No	3397050	Registration date	03/18/2008
Registrant	Dwyer Instruments, Inc. 102 Indiana Highway 212 Michigan City, IN 46361 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 1962/00/00 First Use In Commerce: 1962/00/00 All goods and services in the class are cancelled, namely: Pressure gages and differential pressure gages

Grounds for Cancellation

The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
The mark is merely descriptive	Trademark Act section 2(e)(1)

Related Proceedings	Case No. 3:09-cv-00010-TLS-CAN in the United States District Court for the Northern District of Indiana, South Bend Division
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Attachments	PetitionToCancel.pdf (6 pages)(151723 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 Overnight Courier on this date.

Signature	/cwb/
Name	Clifford W. Browning
Date	11/08/2010

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

In the matter of U.S. Registration No. 3,397,050
For the trademark: PRODUCT CONFIGURATION DESIGN
Date Registered: March 18, 2008

SENSOCON, INC.

Petitioner

v.

DWYER INSTRUMENTS, INC.

Registrant-Respondent

PETITION TO CANCEL
U.S. TRADEMARK REGISTRATION NO. 3,397,050

Petitioner, Sensoccon, Inc., for its Petition to Cancel U.S. Trademark Registration No. 3,397,050, alleges as follows:

PARTIES

1. Registrant-Respondent Dwyer Instruments, Inc., is believed to be the current Registrant of U.S. Trademark Registration No. 3,397,050.
2. Petitioner Sensoccon, Inc., a Florida corporation with its principal place of business at P. O. Box 518, Highland City, Florida 33846, is being damaged by the continued Registration of U.S. Trademark Registration No. 3,397,050, as Registrant-Respondent claims that Petitioner is counterfeiting the alleged mark of this Registration.

BACKGROUND STATEMENT

3. Under 15 U.S.C. §1052(e)(5) of the U.S. Trademark (Lanham) Act,

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused

registration on the principal register on account of its nature unless it –

...
(e)(5) comprises any matter that, as a whole, is functional.

4. The U.S. Supreme Court held in Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210, 213-214, 54 USPQ 2d 1065, 1068-1069 (2000) that any mark that consists of a product design or of features of a product design can never be inherently distinctive and thus can never be inherently protectible under the common law or inherently registerable on the Principal Register of the U.S. Trademark (Lanham) Act; and any such marks only become protectible under the common law and only become registerable on the Principal Register of the U.S. Trademark (Lanham) Act upon an evidentiary showing that they have acquired distinctiveness under 15 U.S.C. §1052(f) of the U.S. Trademark (Lanham) Act. The U.S. Supreme Court also held in Wal-Mart that the evidence of acquired distinctiveness adduced must relate to the promotion and recognition of the specific configuration embodied in the proposed mark, and not to the goods in general. Wal-Mart, 529 U.S. at 211, 54 USPQ 2d at 1068.

COUNT I

THE PRODUCT DESIGN MARK OF U.S. TRADEMARK REGISTRATION NO. 3,397,050 IS FUNCTIONAL

5. Petitioner repeats and realleges the allegations contained in paragraphs 1 through 4 of this Petition.

6. The features of the product design that is the mark of U.S. Registration No. 3,397,050, a copy of which is attached hereto as Exhibit A, are described in words as “A PLURALITY OF HORIZONTAL LINES AND A RAISED RECTANGULAR PORTION ON THE LENS OF A PRESSURE GAUGE.” These features of the product design are functional. Their functionality includes totally obscuring the mechanical workings of the product pressure

gauge that are located directly behind these features of the product design. The functionality of the raised rectangular portion of these features of the product design includes providing a functionally convenient location for the product pressure gauge's "zero adjustment screw" to make accessible without the functional necessity of removing the entire lens cover of the pressure gauge, and to provide a functionally rectangular-shaped substrate upon which to place a correspondingly sized, rectangular-shaped, stick-on user cautionary label.

7. Registrant-Respondent at no time during the prosecution of the application that resulted in the issuance of Registration No. 3,397,050, on March 18, 2008, informed the U.S. Trademark Office of the functions performed by these features of the product design that constitute the mark of U.S. Trademark Registration No. 3,397,050. As a direct consequence of this material omission by Registrant-Respondent, U.S. Registration No. 3,397,050 was erroneously issued on the Principal Register of the U.S. Trademark Office in direct contravention of the provisions of by 15 U.S.C. §1052(e)(5). Registration No. 3,397,050 must therefore be cancelled.

COUNT II

THE FEATURES OF THE PRODUCT DESIGN THAT IS THE MARK OF U.S. TRADEMARK REGISTRATION NO. 3,397,050 WAS REGISTERED WITHOUT ANY PROOF THAT THE SPECIFIC FEATURES OF THE PRODUCT DESIGN HAD ACQUIRED DISTINCTIVENESS

8. Petitioner repeats and realleges the allegations contained in paragraphs 1 through 7 of this Petition.

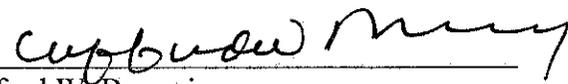
9. The only evidence of acquired distinctiveness of the features of the product design that constitute the mark of U.S. Registration No. 3,397,050, that was ever submitted by Registrant-Respondent to the U.S. Trademark Office to secure issuance of the Registration were

pages from Registrant-Respondent's product pressure gauge catalogs for the years 1963, 1994, and 1998-2007. Yet in all 61 pages of catalog pages there is not one mention of the features of the product design comprising "a plurality of horizontal lines and a raised rectangular portion on the lens of a pressure gauge," as being a trademark of Registrant-Respondent with source-identifying significance. From 1963 to 2007, Registrant-Respondent never even once mentioned the features of the product design that is the mark of U.S. Registration No. 3,397,050 in any context. Therefore, Registrant-Respondent offered evidence that directly contradicts its claim of acquired distinctiveness of the features of the product design that is the mark of U.S. Registration No. 3,397,050, for there is no evidence in Registrant-Respondent's catalogs that it ever promoted or recognized those specific features of the product design as being a source-identifying mark. Under the U.S. Supreme Court's decision in Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210, 213-214, 54 USPQ 2d 1065, 1068-1069 (2000), therefore, U.S. Registration No. 3,397,050 was erroneously issued by the U.S. Trademark Office, and it must now be cancelled.

WHEREFORE, Petitioner prays that U.S. Registration No. 3,397,050 be cancelled, and that this Petition to Cancel be sustained in favor of Petitioner.

The requisite filing fee of \$300.00 under 37 C.F.R. §2.6(a)(16) is enclosed herewith.

Respectfully submitted,

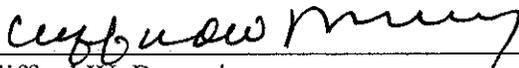
By: 
Clifford W. Browning
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, IN 46204
(317) 238-6203

Attorney for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing, Petition to Cancel was served upon counsel of record for the Registrant-Respondent, by Federal Express, addressed to Jeffrey R. Gray, Barnes & Thornburg LLP, One North Wacker Dr., Suite 4400, Chicago, IL 60606.

This 8th day of November, 2010.



Clifford W. Browning

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Int. Cl.: 9

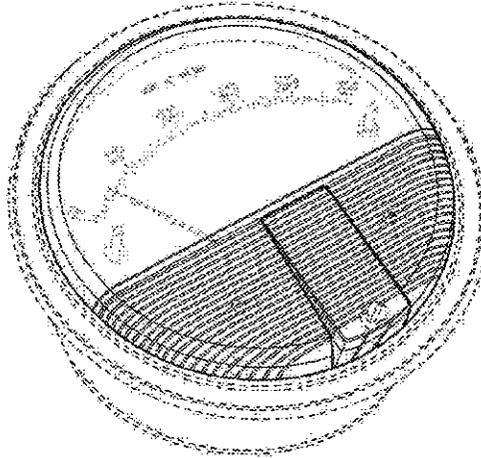
Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 3,397,050

Registered Mar. 18, 2008

**TRADEMARK
PRINCIPAL REGISTER**



DWYER INSTRUMENTS, INC. (INDIANA CORPORATION)

102 INDIANA HIGHWAY 212

MICHIGAN CITY, IN 46361

FOR: PRESSURE GAGES AND DIFFERENTIAL PRESSURE GAGES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 0-0-1962; IN COMMERCE 0-0-1962.

THE MARK CONSISTS OF A PLURALITY OF HORIZONTAL LINES AND A RAISED RECTANGULAR PORTION ON THE LENS OF A PRESSURE GAUGE.

SEC. 2(F).

SER. NO. 77-039,625, FILED 11-8-2006.

REBECCA SMITH, EXAMINING ATTORNEY

EXHIBIT A