

This Decision is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: June 18, 2003

Opposition No. 91151110

SCHLUMBERGER TECHNOLOGY
CORPORATION

v.

HALLIBURTON ENERGY SERVICES,
INC.

Before Sams, Hohein, and Rogers,
Administrative Trademark Judges.

Rogers, Administrative Trademark Judge:

Now ready for consideration is applicant's motion to dismiss the opposition under Fed. R. Civ. P. 12(b)(6), for the asserted failure of opposer to state a claim upon which relief can be granted.

To survive a motion to dismiss under Rule 12(b)(6), a notice of opposition need only allege such facts as would, if proven, establish opposer's standing to maintain the proceeding and a ground or grounds for refusing registration to applicant. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), and *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985).

By its motion, applicant does not dispute the sufficiency of opposer's allegations relating to its

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standing,¹ but argues that even if all pleaded facts were proven opposer would not have established any ground for refusing registration. Therefore, applicant's motion to dismiss requires us to examine the notice of opposition to determine whether it contains any set of allegations which, if proven, would allow opposer to prevail. See *Delta Tire Corp. v. Sports Car Club of America, Inc.*, 186 USPQ 431 (TTAB 1975). As the notice of opposition is brief, we set forth virtually its entire contents below:²

1. Application No. 76/209,851 was filed on February 13, 2001 by Halliburton Energy Services, Inc. ... [for] the mark DRILLVISION for use in connection with "providing drilling simulation services in the oil and gas industry" in Class 42 and was published for opposition on December 18, 2001. Application No. 76/209,851 alleges that Applicant intends to use that mark in commerce in connection with the services listed in the application and was therefore filed under the provisions of § 1(b) of the Act (15 U.S.C. 1051(b)).

2. Opposer is the owner of Application No. 76/209,433 for registration of the mark DRILLVIZ for use in connection with computer

¹ We note, in any event, that opposer has sufficiently alleged its standing by asserting that the Examining Attorney reviewing its application has indicated that registration of opposer's mark may be refused if applicant's mark is registered.

² During examination, the identification of services in applicant's opposed application was amended to read "providing information in the field of oil and gas drilling using computer simulations," in International Class 37, and "providing computer simulation services for others in the field of oil and gas drilling," in International Class 42. It is unclear whether opposer intended to oppose both classes in the application. Accordingly, opposer is allowed until 30 days from the date of this order to clarify its intentions by filing an amended notice of opposition and, if in such amended opposition it opposes both classes, it must also tender an additional opposition fee.

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software for use in connection with oil and/or gas exploration and production, in Class 9, also filed on February 13, 2001. Since at least as early as June 6, 2001, Opposer has been, and is now, using in commerce the mark DRILLVIZ in connection with these goods, and such use has been valid and continuous since at least said date and has not been abandoned. In an Official Action mailed in Opposer's application No. 76/209,433 on May 16, 2001, it was indicated that registration of Opposer's mark may be refused under §2(d) of the Trademark Act if a registration issues in Applicant's Application No. 76/209,851, even though both applications were filed on the same date, because Application No. 76/209,851 was deemed in the Official Action "to precede the applicant's filing date because the declaration from the referenced application was signed prior to [the declaration of] applicant's [application]." It is therefore apparent that Opposer may not be able to register its mark if a registration issues in Application No. 76/209,851.

3. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive. Further, Opposer's use of its DRILLVIZ mark in commerce as regulated under the Act precedes any use of Applicant's mark such that this opposition is based not only on the likelihood of confusion between the two marks but also on Opposer's superior right to use and register its mark.

In their briefing of applicant's motion to dismiss, each party has based its position on a misunderstanding as to applicable procedural rules. In short, applicant misapprehends the import of Trademark Rule 2.83 and TMEP Section 1208.01(b) and opposer misapprehends our task when

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faced with a motion to dismiss under Federal Rule 12(b)(6).

Applicant argues that Trademark Rule 2.83(b) and the TMEP make it clear that applicant has an earlier effective filing date and, therefore, priority over opposer. Further, applicant appears to have concluded that the Office has already made a determination, through the actions of the examining attorney reviewing opposer's application, that applicant has priority.³

As to the latter point, the examining attorney made clear in his only written office action in regard to opposer's application that both applicant's and opposer's respective applications "have the same effective filing date."⁴ It is true that a suspension form subsequently issued by the examining attorney states that opposer's effective filing date is subsequent to applicant's effective filing date. As with most if not all forms, however, the suspension form is useful because it covers recurring situations. It does not cover all situations and, in regard

³ We do not have jurisdiction over opposer's application, which is in suspended status before the trademark examining attorney. We discuss the question of jurisdiction in more detail, *infra*. Nonetheless, as both parties clearly are aware of and have discussed in their briefs what has transpired in that application, we too make reference to its contents in our effort to dispose of applicant's motion.

⁴ Even a cursory reading of Trademark Rule 2.83(b) and TMEP Section 1208 make clear that "effective filing date" is a term of art which recognizes that some applications are deemed filed on a date other than the date they arrive in the Office's mailroom or in the Office's queue of electronically-filed applications.

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to the instant case, does not accurately reflect the nature of the conflict between applicant's and opposer's applications. In short, the parties should not place any reliance on the examining attorney's use of the suspension form, other than to accept that the examining attorney determined that it was appropriate to suspend opposer's application until applicant's application is resolved one way or the other, i.e., either results in issuance of a registration or is abandoned. Certainly, there can be no question that the examining attorney's use of the suspension form does not decide the priority dispute presented by this case.

As to applicant's initial point, specifically, that Trademark Rule 2.83(b) and TMEP Section 1208 dictate a conclusion that applicant has an earlier effective filing date and priority over opposer, applicant is mistaken.

While it is true that Trademark Rule 2.83(b) is intended to be used as a tiebreaker to determine which of two conflicting applications with the same effective filing date will be published for opposition first, it does not and cannot be used to decide the substantive issue of priority in an inter partes proceeding. See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1552, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) ("As we have previously held, the broadest of the PTO's rulemaking powers -- 35 U.S.C. §6(a) -- authorizes the

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Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does not grant the Commissioner the authority to issue substantive rules.").

In addition, the TMEP is a compendium of examination practices; and though it may recognize and recite provisions of substantive law established by the Lanham Act or precedential decisions interpreting the act as the basis for particular aspects of examination practice, it cannot itself establish substantive law. See *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1035 (TTAB 1996) and authorities cited therein.⁵

One final point raised by applicant remains. Opposer, in its notice of opposition, relies on its asserted actual use of its mark in commerce prior to applicant, because applicant apparently has not yet begun use of its mark or made any use which would be sufficient to establish priority in applicant.⁶ Applicant, however, relying on the *Zirco* decision, argues that opposer cannot prevail on proof only

⁵ While we have explained that neither Trademark Rule 2.83(b) nor the TMEP dictate that substantive priority rests with applicant, the Board may yet decide to place substantive importance on the execution date of an application in circumstances such as those presented by this case.

⁶ We say "apparently," because applicant filed its application under the intent to use provision of the Lanham Act and did not file an amendment to allege use of its mark prior to approval for publication. Of course, the mere fact that applicant filed under intent to use does not preclude applicant, if appropriate, from claiming and attempting to prove, in this proceeding, that it has in fact made use in commerce, or any other type of use sufficient to establish priority.

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of actual use in commerce that commenced after applicant's effective filing date. See *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

We agree with applicant that, under *Zirco*, proof by opposer only of actual use subsequent to applicant's effective filing date would not aid opposer. On the other hand, that is not all opposer is alleging. It is alleging that it has the same effective filing date and actual use in commerce prior to any use by applicant. Such a set of circumstances presents an issue of first impression and *Zirco* may not be controlling. Moreover, even without resort by opposer to proof of actual use in commerce, proof that the parties have the same effective filing date may result in the opposition being sustained. See *Girard Polly-Pig, Inc. v. Polly-Pig by Knapp, Inc.*, 217 USPQ 1338, 1344 (TTAB 1983) ("a registration may be cancelled if a petitioner can show that the existence of the registration is inimical to an equal or superior right to use the same or similar term in connection with goods or services which are similar to or commercially related to those of respondent").

Thus, insofar as applicant is arguing that if opposer proves that it (1) has the same effective filing date as applicant and (2) opposer's actual use in commerce began after that shared filing date, then opposer cannot prevail, applicant again is mistaken. Opposer has pleaded facts

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which, if proven, may establish that its right to use the DRILLVIZ mark in commerce is at least equal to the right of applicant to use the DRILLVISION mark in commerce.

Accordingly, applicant's motion to dismiss is denied.⁷

We now turn to the misapprehension of opposer as to our task when deciding a motion to dismiss under Federal Rule 12(b)(6). Opposer correctly recognizes that Trademark Rule 2.83(b) does not establish applicant's substantive priority. However, opposer incorrectly assumes that we can, at this juncture in the opposition, decide that substantive issue; and opposer advances numerous policy arguments in support of its conclusion that we should find, under the circumstances at hand, that opposer has substantive priority. This, of course, goes beyond our task in deciding a motion to dismiss. Moreover, to the extent that opposer desires a ruling that it is entitled to obtain a registration based on its application, we note that this is an opposition involving only the question of whether applicant is entitled to a registration, not an interference proceeding in which both parties' respective applications are before us and we

⁷ We say that opposer, if it proves what it has pleaded, may thereby prove an equal right and this may result in the opposition being sustained. Neither party, in briefing the motion to dismiss, has argued the applicability of the *Polly-Pig* case and whether, under the circumstances of this case, we should follow *Polly-Pig*. Thus, we reserve judgment on that question. Nonetheless, it is clear that, if we apply *Polly-Pig* to this case and if opposer proves what it has pleaded, then it would prevail. We cannot, therefore, grant applicant's motion to dismiss.

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can decide each party's right. See *Giant Food Inc. v. Malone & Hyde, Inc.*, 522 F.2d 1386, 187 USPQ 374, 380 (CCPA 1975) (Court stated its agreement with Board's statement in underlying interference proceeding that "trademark interferences are not limited to the issue of priority of use" and the Board may, in such a proceeding, determine each party's right to registration); see also, *Dynamet Technology, Inc. v. Dynamet Incorporated*, 197 USPQ 702, 712 (TTAB 1977).

The Commissioner for Trademarks recently has denied a petition by opposer that sought waiver of the application of Trademark Rule 2.83(b) and, in essence, argued why public policy dictates that opposer, not applicant, should be entitled to a registration if only one is to issue. In that petition, opposer asked that the petition be considered in the alternative as a petition showing the "extraordinary circumstances" necessary for declaration of an interference. The Commissioner's decision on opposer's petition denied waiver of Trademark Rule 2.83(b) but did not address the question of whether the circumstances recited in the petition would meet the standard necessary for declaration of an interference.

The Board will not institute an interference proceeding unless the Commissioner has first declared that extraordinary circumstances warrant such a proceeding.

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While, by this order, we deny applicant's motion to dismiss, we will not now reset discovery and trial dates. Rather, the suspension of proceedings herein is continued in order to allow the parties time to discuss whether there are any arrangements that can be made to allow for settlement of this matter and, failing settlement, to allow either party time to petition the Commissioner for declaration of an interference, in view of the unique circumstances and question of first impression presented by the conflict between the parties' applications.

As noted earlier, in footnote 2, opposer is allowed until 30 days to either pay an additional opposition fee or clarify which of the two classes in the involved application it is opposing. The parties are allowed until 45 days from the date of this order to discuss possible settlement. If no settlement is reached, the parties are allowed an additional 15 days in which to petition the Commissioner for declaration of an interference.⁸ If the case is not settled, the parties should inform the Board whether either

⁸ If the Commissioner agrees that the circumstances of this conflict are extraordinary and declares an interference, the Board will not immediately institute such a case. Instead, opposer's mark would first have to be published for opposition. See TBMP Section 1003. If unopposed by any third party, the Board would then be ready to commence an interference in which opposer would be plaintiff. See TBMP Section 1005. However, in view of the pendency of this opposition in which opposer already is in position of plaintiff, the Board would simply make opposer's application a part of the proceeding and conduct the opposition as it would if the case had commenced as an interference. See TBMP Section 1003.

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has petitioned for declaration of an interference; if neither does, proceedings will be resumed and discovery and trial dates will be reset. Proceedings herein remain otherwise suspended.