

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

Schlumberger Technology Corporation, Opposer	§ § §	Opposition No.	91151110
v.	§	Application No.	76/209,851
Halliburton Energy Services, Inc., Applicant	§ §	Publication date:	Dec. 18, 2001

To: Box TTAB NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513



04-26-2002  
U.S. Patent & TMO/TM Mail Rcpt Dt. #58

**APPLICANT'S MOTION TO DISMISS**

I. RELIEF SOUGHT

Halliburton Energy Services, Inc. ("Applicant") moves to dismiss the Opposition of Schlumberger Technology Corporation ("Opposer") under Rule 12(b)(6) of the Federal Rules of Civil Procedure.

II. GROUNDS FOR MOTION

The grounds for the motion are that, even if the allegations of the Opposition are true, the Opposition to the registration of Application Serial No. 76/209,851 fails to state a claim for which relief may be granted, since the effective filing date of Applicant's Trademark Application precedes that of Opposer's Application Serial No. 76/209,433.

III. INTRODUCTION

On February 13, 2001, Applicant submitted an intent-to-use Application to the United States Patent and Trademark Office (USPTO) for registration of the mark DRILLVISION and

received Application Serial No. 76/209,851 (Applicant's Application). On the same day, Opposer submitted an intent-to-use Application for registration of the mark DRILLVIZ and received Application Serial No. 76/209,433 (Opposer's Application). Apparently, the Examining Attorney rejected Opposer's Application on the basis that Opposer's DRILLVIZ mark was likely to be confused with Applicant's mark DRILLVISION, and that Applicant's Application for the mark DRILLVISION had an earlier effective filing date. See Notice of Opposition, paragraph 2.

Opposer filed a Notice of Opposition on January 16, 2002. In its opposition, Opposer alleges that it will be damaged by the registration of Applicant's DRILLVISION mark. Specifically, Opposer alleges a likelihood of confusion between the two marks and a superior right to use and register its mark DRILLVIZ.

There is no dispute over the likelihood of confusion issue. The question at issue is whether Opposer can show a superior right to the mark DRILLVIZ. Because Opposer does not have superior rights to his mark, The Trademark Trial and Appeal Board (TTAB) should grant Applicant's Motion to Dismiss the Opposition, and allow Applicant's mark DRILLVISION to register.

#### IV. ARGUMENT

Even though both marks were filed on the same day, Applicant's Application Serial No. 76/209,851 precedes Opposer's filing date, because the declaration in Applicant's Application was signed prior to the declaration in Opposer's Application. It is a well settled policy in trademark case law that, if conflicting applications have the same effective filing date, the application with the earliest date of execution will be published for opposition or issued on the

Supplemental Register. See 37 C.F.R. § 2.83(b). Moreover, under the Trademark Manual of Examining Procedures (TMEP), it is clear that Applicant's Effective Filing Date precedes that of Opposer's Application. See TMEP § 1208.01(b).

Opposer does not dispute the fact that Applicant's filing date precedes Opposer's filing date. Moreover, it is clear that Opposer is aware that Applicant deserves priority as the issue has already been raised by an Examining Attorney in an Office Action to Opposer dated May 16, 2001. In addition, Opposer acknowledges the similarity of the respective marks as applied to the goods and services of the respective parties and the likelihood for confusion, mistake, or deception.

Nevertheless, Opposer claims superior rights to use and register the mark based on its use of the mark DRILLVIZ in commerce at least as early as June 6, 2001. Opposer argues that although Applicant's filing date precedes Opposer's filing date, their use of the mark precedes Applicant's use of the mark, and therefore, they have superior rights based on their prior use. Even if this were true, however, under section 7(c) of the Trademark Act (15 UCS 1057(c)), as amended<sup>1</sup>, the filing of an intent-to-use application constitutes "constructive use" of Applicant's

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<sup>1</sup> Section 7(c) reads:

Contingent upon the registration of a mark on the principal register provided by this Act, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing --

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under Section 44(d) to register the mark which is pending or has resulted in registration of the mark.

mark. Therefore, Applicant is entitled to a constructive use date as of February 13, 2001, which precedes Opposer's alleged use date by almost 4 months.

The same issue was presented to and decided by the TTAB in *Zirco Corp. v. American Telephone and Telegraph Co.* 21 U.S.P.Q. 2D (BNA) 1542 (November 5, 1991). In *Zirco*, American Telephone and Telegraph Co. (hereinafter "ATT") filed an intent-to-use application to register the mark DATACEL, which received a filing date of January 11, 1990. Zirco Corp. (herein after "Zirco") opposed the application alleging, inter alia, that Zirco had been the user of mark DATACEL for cellular adapters since about April 15, 1990.

In *Zirco*, the Board ruled that Zirco's allegation of common law rights in its mark as of April 15, 1990, a date subsequent to ATT's constructive use date, was inadequate to support priority of use and dismissed the Opposition, finding that Zirco failed to set forth a claim upon which it can prevail. *Id.* at 4. The board reasoned that under the Lanham Act's constructive use provision, Section 7(c)<sup>2</sup> was intended to foster the filing of intent-to-use applications, to give an intent-to-use applicant a superior right over anyone adopting a mark after applicant's filing date (providing the applicant's mark is ultimately used and registered), and to prevent a third party from acquiring common law rights in a mark after the filing date of the intent-to-use application. *Id.* at 4.

Like *Zirco*, Opposer's allegations of superior rights based on prior common law use of its mark must fail as Opposer's claim of use is preceded by Applicant's constructive use date. Any

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<sup>2</sup> Zirco argued that it is clear from section 7(C) that constructive use does not come into play until the mark has been registered and issued; that, accordingly, ATT does not have conferred upon on it a nationwide right of priority of January 11, 1990 until it uses the mark and registration is completed; that since ATT has not perfected constructive use of its mark, it cannot prevent *Zirco* from acquiring common law rights in its mark; that Zirco exerts these common law rights against parties which are junior to it, until the issuance of a dominating registration.

other interpretation would frustrate the purpose of the intent-to-use provisions of the Lanham Act.

V. CONCLUSION

It is clear from the facts, evidence and law that Opposer has failed to set forth a claim upon which relief can be granted. Therefore, Applicant respectfully requests that the TTAB grant Applicant's Rule 12 (b)(6) Motion and dismiss the Opposition.

Respectfully submitted,

Date 4.26.02

By Carolyn S. Waldo  
Carolyn Sue Waldo  
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ATTORNEY FOR APPLICANT

**CERTIFICATE OF MAILING**

I certify that this paper is being deposited with the United States Postal Service with sufficient postage as Express Mail addressed to Box TTAB, No Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on April 26, 2002.

Date 4.26.02

By Carolyn S. Waldo  
Carolyn Sue Waldo

**CERTIFICATE OF SERVICE**

A true and correct copy of the above and foregoing Applicant's Motion to Dismiss has been sent by United States First Class Mail to the following individual on April 26, 2002.

Mark R. Wisner  
Wisner & Associates  
2925 Briarpark Dr. Ste 930  
Houston, Texas 77042-3728  
Telephone 713-785-0555  
Facsimile 713-785-0561

ATTORNEY FOR SCHLUMBERGER  
TECHNOLOGY CORPORATION

Date 4-26-02

By Carolyn S. Waldo  
Carolyn Sue Waldo

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

Schlumberger Technology Corporation, Opposer	§ § § § § §	Opposition No. 91151110
v.		Application No. 76/209,851
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Arlington, Virginia 22202-3513

**MOTION TO SUSPEND PROCEEDING PENDING DETERMINATION OF MOTION  
TO DISMISS AND TO AMEND SCHEDULING ORDER**

Applicant, Halliburton Energy Services Inc., hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.127(d), 37 C.F.R. sec. 2.127(d). Applicant is filing herewith its Motion to Dismiss, pursuant to Federal Rules of Civil Procedures 12(b)(6), a motion which is potentially dispositive of the proceedings.

Applicant, therefore, requests (1) that this proceeding be suspended pending determination of Applicant's Motion, and (2) that should Applicant's Motion be denied, the Scheduling Order dated March 19, 2002, be amended so that deadlines commence from the date Applicant's Motion is denied.

Respectfully submitted,

Date 4-26-02

By Carolyn S. Waldo  
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Halliburton Energy Services, Inc.  
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ATTORNEY FOR APPLICANT

**CERTIFICATE OF MAILING**

I certify that this paper is being deposited with the United States Postal Service with sufficient postage as Express Mail mail in an envelope addressed to Box TTAB, No Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on April 26, 2002.

Date 4-26-02

By Carolyn S. Waldo  
Carolyn Sue Waldo

**CERTIFICATE OF SERVICE**

A true and correct copy of the above and foregoing Motion to Suspend Proceeding Pending Determination of Motion and to Reset Discovery and Testimony Periods has been sent by United States First Class Mail to the following individual on April 26, 2002.

Mark R. Wisner  
Wisner & Associates  
2925 Briarpark Dr. Ste 930  
Houston, Texas 77042-3728  
Telephone 713-785-0555  
Facsimile 713-785-0561

ATTORNEY FOR SCHLUMBERGER  
TECHNOLOGY CORPORATION

Date 4-26-02

By Carolyn S. Waldo  
Carolyn Sue Waldo

**CERTIFICATE OF CONFERENCE**

This certifies that I, Carolyn Sue Waldo, attorney for Applicant, on April 26, 2002, did confer with Mr. Mark R. Wisner, counsel for Opposer, regarding Applicant's Motion to Suspend Proceedings. Mr. Wisner was unable to either oppose or not oppose Applicant's Motion.

Date 4-26-02

By Carolyn S. Waldo  
Carolyn Sue Waldo

TTAB

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

**Opposition No: 91151110**

**U.S. Serial No.: 76/209851**



**04-26-2002**

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

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Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513**

**Dear Sir:**

**Transmitted herewith are the following:**

- 1) Applicant's Motion to Dismiss**
- 2) Motion to Suspend Proceedings Pending Determination of Motion**
- 3) A self-addressed postcard to acknowledge receipt**
- 4) The Commissioner is authorized to charge our Deposit Account No. 08-0300 in the amount necessary to cover any required fees.**

TRADEMARK TRIAL AND APPEALS BOARD  
02 MAY - P119: 2

**HALLIBURTON ENERGY SERVICES, INC.**

4-26-02

Date

*Carolyn S. Waldo*

Carolyn S. Waldo

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**CERTIFICATE OF MAILING BY "First Class Mail"**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail to Addressee" on the date indicated below and is addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

*Carolyn S. Waldo*  
Signature of Person Mailing

4-26-02  
Date

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