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

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

06-27-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

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

REPLY TO OPPOSER'S RESPONSE
TO APPLICANT'S MOTION TO DISMISS

On April 26, 2002, Halliburton Energy Services, Inc. ("Applicant") moved to dismiss the Opposition of Schlumberger Technology Corporation ("Opposer") under Rule 12(b)(6) of the Federal Rules of Civil Procedure. On June 14, 2002, Opposer filed a response to Applicant's Motion to Dismiss. Applicant hereby replies as follows:

I. REPLY

In its response, Opposer does not contest the fact that Applicant has already received priority in its application for a mark that is admittedly confusingly similar to a mark for which Opposer has also sought registration. Thus, the priority issue has already been determined by the trademark examining attorney who granted Applicant's application priority over Opposer's

application under 37 C.F.R. § 2.83(b). Moreover, Opposer does not challenge or even address the issue of constructive use that has been conferred on Applicant by benefit of Applicant's § 1(b) filing. Finally, while Opposer urges that Applicant's Motion to Dismiss be denied, it does not challenge the use of Rule 12(b)(6) Motion as an appropriate vehicle for disposing of the instant matter.

Instead, Opposer asks the Trademark Trial and Appeal Board (the "TTAB") to set new precedent in the granting of priority between two § 1(b) applications filed on the same date. Specifically, Opposer asks the TTAB to draw a distinction between *ex parte* and *inter partes* proceedings in deciding whether to apply § 2.83(b) to determine priority between two applications having the same effective filing date. According to Opposer, public policy favors the adoption of a new criteria for breaking a tie between two § 1(b) applications.

Opposer's distinction between *ex parte* and *inter partes* proceedings is nonsensical and flies against the great weight of statutory and historical case law precedent in the prosecution of trademark applications through the United States Trademark Office. By definition, *inter partes* involves a situation with at least two parties. See Black Law Dictionary, 6th Ed. 1991 at page 817. Therefore, it is inconceivable how § 2.83(b) would have application in any situation except those, such as the present, where at least two conflicting applications by two different parties are involved. Moreover, nowhere in § 2.83(b) does the statute make a such distinction nor has Opposer cited a single case for support that such a distinction is appropriate and should be made in this instance. On that basis alone, Applicant's Motion to Dismiss should be granted.

Nevertheless, the strong and clear public policy considerations and statutory scheme of granting priority among conflicting applications favor the granting of Applicant's Motion to Dismiss. Contrary to Opposer's allegation that priority of use should be used to determine priority following the effective filing date of a § 1(b) application, the system of intent-to-use applications under § 1(b) assures an applicant a priority against all *except* a party who has used the mark prior to an opponent's constructive use date or who has previously filed an application themselves. See Lanham Act § 7(c), 15 U.S.C.A. § 1057(c). Opposer has not shown or alleged that it fits into either one of these categories. Moreover, to adopt the tie-breaking mechanism proposed by Opposer would render meaningless the intent-to-use provision of the Act and the benefits of the Act's constructive use provision.

For example, should Opposer's new criteria standard be adopted, a third party could simply rush to adopt a mark after a § 1(b) applicant's constructive use date but before the applicant files its verified statement of use. Thus, a party could simply monitor the trademark filings of its competitor (via the web, for example, as applications are now published), proceed to adopt a mark for which an application has already been filed and, if the adopting parties' allegation of use precedes the Applicant's statement of use, frustrate the applicant by defeating the applicant's constructive use priority date. Under Opposer's new criteria, no Applicant could rely on the intent-to-use application as a way of establishing priority to marks for which it has a bona fide intention of using as subsequent use by a third party before registration would always be superior.

II. CONCLUSION

Only a party who alleges a use prior to an opponent's constructive use date, and who can prove its priority under traditional rules of common law trademark priority will have a superior right to a mark. See Lucent Information Management, Inc. v. Lucent Technologies, Inc., 986 F. Supp 253, 45 U.S.P.Q.2d 1019 (D. Del. 1997). Opposer has not shown or alleged prior use or application. Opposer's new criteria standard has no support in the law or case law precedent and, as such, should be rejected by the TTAB.

For all the reasons stated above, Applicant respectfully requests that the TTAB grant Applicant's Rule 12 (b)(6) Motion and dismiss the Opposition.

Respectfully submitted,

Date: 6-24-02

By: Carolyn S. Waldo

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CERTIFICATE OF MAILING

I certify that this paper is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to Box TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on June 24, 2002.

Date 6-24-02

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 June 24, 2002.

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ATTORNEY FOR SCHLUMBERGER
TECHNOLOGY CORPORATION

Date 6-24-02

By Carolyn S. Waldo
Carolyn Sue Waldo

TTAB

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Arlington, VA 22202-3513

Dear Sir:

Transmitted herewith are the following:

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

HALLIBURTON ENERGY SERVICES, INC.

6-24-02
Date

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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 "First Class 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

6-24-02
Date