

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

In the Matter of Application Serial No. 78/257,063

Published in the OFFICIAL GAZETTE on February 10, 2004

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CARL-ZEISS-STIFTUNG, d/b/a CARL ZEISS, :

Opposer, :

v. : Opposition No.

HEXAGON METROLOGY AB, :

Applicant. :



04-09-2004

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

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NOTICE OF OPPOSITION

CARL-ZEISS-STIFTUNG, d/b/a CARL ZEISS, a corporation organized and existing under the laws of Germany, located and doing business at 73446 Oberkochen, Germany, believes it will be damaged by registration of the mark shown in application Serial No. 78/257,063, and hereby opposes that application, the time for filing this Notice of Opposition

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having been duly extended until April 10, 2004.

The grounds of this opposition are as follows:

1. (a) On June 2, 2003, Applicant filed intent-to-use application Serial No. 78/257,063 to register the mark FAST PROBE for "computer software for controlling a probe of a coordinate measuring machine", in Class 9 ("the Opposed Application").

(b) Applicant, in the Opposed Application, has disclaimed the exclusive right to use PROBE apart from the mark as shown.

(c) Upon information and belief, the opposed mark FAST PROBE was not used in the United States by Applicant before June 2, 2003.

2. Opposer is, and has long been, one of the world's leading manufacturers in the field of optics, opto-electronics and metrology. For many decades, Opposer, through its U.S. affiliates, has marketed throughout the United States a broad line of optical, opto-electronic, metrology and related products including coordinate measuring machines, their probes, and related software, surgical, research and industrial microscopy and imaging systems, ophthalmic instruments and systems, binoculars,

telescopes, camera and eyeglass lenses, and other optical products. Opposer is a leading seller in the United States of a line of coordinate measuring machines, their probes and related software.

3. Since 1995, Opposer has continuously used the designation VAST to identify coordinate measuring machines and their probes.

4. Opposer's VAST coordinate measuring machines and probes are and have long been used for form testing and size and location measurement in connection with the manufacture of a wide variety of parts and products. Opposer's VAST coordinate measuring machines and probes permits high-speed, high-accuracy measurements of the complete geometry of a product on the factory floor. The VAST probe's variable scanning speed and accuracy are controlled by software, depending on the requirements of the part or product to be measured. These features have been substantially promoted as selling points of Opposer's VAST coordinate measuring machines and probes.

5. Opposer's VAST trademark has been registered on the Principal Register in the United States Patent and Trademark Office under No. 1,983,667 of July 2, 1996. A copy of said registration is annexed hereto as Exhibit A. Said registration is valid, subsisting, and incontestable. Opposer is the owner of said registration, the VAST mark shown therein, and the good will of the business connected with and symbolized by said mark.

6. Many millions of dollars worth of Opposer's coordinate measuring machines featuring VAST probes have been sold in the United States. Substantial sums have been spent in advertising and promoting Opposer's coordinate measuring machines and their VAST probes in the United States.

7. By reason of such activities, and the excellence and superior quality of Opposer's goods, Opposer's VAST trademark is well known in the United States in the industrial metrology field.

8. The goods identified in the Opposed Application, "computer software for controlling a probe of a

coordinate measuring machine," are closely related to, and capable of conjoint use with, Opposer's VAST coordinate measuring machines and probes. Moreover, the parties' said goods can be (a) sold to, or used by, the same customers, (b) used for the same types of product or part measurements, (c) advertised in the same trade publications, and (d) promoted at the same trade shows.

9. The mark FAST PROBE shown in the Opposed Application so closely resembles Opposer's prior trademark VAST as to be likely, when applied to Applicant's goods, to cause confusion, or to cause mistake, or to deceive.

10. All the acts complained of herein by Opposer have occurred without its consent.

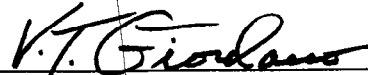
11. If Applicant were granted registration of the opposed mark FAST PROBE, it would obtain the prima facie right to use that mark and all marks likely to be confused therewith, for the goods specified in the opposed application and all related goods. Such registration would thus be a source of damage and injury to Opposer.

12. Opposer cannot control the quality of Applicant's goods. The use of the opposed mark FAST PROBE would, therefore, place in jeopardy Opposer's valuable reputation symbolized by Opposer's VAST trademark.

WHEREFORE, Opposer prays that application Serial No. 78/257,063 be rejected and that the registration of the opposed mark FAST PROBE for the goods therein specified be refused and denied.

VON MALTITZ, DERENBERG, KUNIN,
JANSSEN & GIORDANO

By



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Attorneys for Opposer

April 8, 2004

Int. Cl.: 9

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

United States Patent and Trademark Office **Reg. No. 1,983,667**
Registered July 2, 1996

**TRADEMARK
PRINCIPAL REGISTER**

VAST

CARL-ZEISS-STIFTUNG (FED REP GERMANY
CORPORATION), DBA CARL ZEISS
73446 OBERKOCHEN, FED REP GERMANY

FOR: THREE-COORDINATE MEASURING
MACHINES AND PROBES USED THEREWITH,
IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

PRIORITY CLAIMED UNDER SEC. 44(D) ON
FED REP GERMANY APPLICATION NO.
Z12004/9, FILED 9-3-1994, REG. NO. 2902470,
DATED 2-23-1995, EXPIRES 9-30-2004.

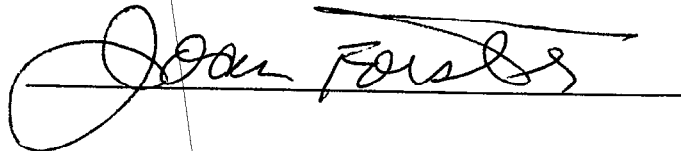
SER. NO. 74-630,669, FILED 2-6-1995.

ANDREW BAXLEY, EXAMINING ATTORNEY

Notice of Opposition by CARL-ZEISS-STIFTUNG,
d/b/a CARL ZEISS Against Application Serial No.
78/257,063 Filed by HEXAGON METROLOGY AB

"Express Mail" Mailing Label Number EL910671226US
Date of Deposit: April 8, 2004

I hereby certify that this Notice of Opposition and fee,
are being deposited with the United States Postal Service "Express
Mail Post Office to Addressee" service under 37 CFR 1.10 on the
date indicated above and is addressed to Box TTAB/FEE, Assistant
Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA
22202-3514.



VON MALTITZ, DERENBERG, KUNIN, JANSSEN & GIORDANO

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April 7, 2004

VIA EXPRESS MAIL

Box TTAB/FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514



04-09-2004
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Sir:

In the matter of the Opposition by CARL-ZEISS-STIFTUNG, d/b/a CARL ZEISS against Application Serial No. 78/257,063 filed by HEXAGON METROLOGY AB and published in the Official Gazette on February 10, 2004, we enclose the following:

- (1) Original and duplicate original of the opposition;
- (2) Our check in the amount of \$300.00 in payment of the statutory fee; and
- (3) Acknowledgment postcard.

Please stamp and return the postcard as your acknowledgment of safe receipt.

Also, please charge our Patent and Trademark Office Deposit Account No. 22-0560 for any additional fees that may be required.

All correspondence or communications concerning this application should be directed to the undersigned.

Very truly yours,

V. T. Giordano

VTG/jf
Enc.