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

Proceeding	91166550
Party	Defendant Halliburton Energy Services, Inc. Halliburton Energy Services, Inc. 2601 Beltline Road Carrollton, TX 75006
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Attachments	Reply to opposition to amend.PDF ( 8 pages )(397540 bytes ) Selected Rog answers.PDF ( 6 pages )(239065 bytes )

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

In the Matter of:      Registration No. 2560464  
   for the mark CELVOL

HALLIBURTON ENERGY  
SERVICES, INC.

Applicant

v.

CELANE' E INTERNATIONAL  
CORPORATION

Opposer.

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Opposition No. 91166550

**REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR  
LEAVE TO AMEND ANSWER AND FILE COUNTERCLAIM FOR  
CANCELLATION**

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

Applicant Halliburton Energy Services, Inc. (hereinafter sometimes referred to as either "Halliburton" or "Applicant" or "Applicant") files this Reply to Registrant's Opposition To Applicant's Motion For Leave To Amend Answer And File Counterclaim For Cancellation. In response to Opposer's Opposition to Applicant's Motion For Leave To Amend Answer And File Counterclaim For Cancellation, Applicant states as follows:

1. Applicant filed this motion on December 13, 2006 primarily to add a counterclaim to cancel one of Opposer's registrations, U.S. Registration No. 2560464 for the mark CELVOL, which Opposer pleaded in its Notice Of Opposition as one of the registrations which Opposer alleged would likely be confused with Applicant's CELLEX

mark. Opposer has alleged in its response to the motion that it will be “unduly prejudiced” if the amendment would be allowed at this time. Applicant submits that Opposer’s response shows just the opposite, that it *will not* be unduly prejudiced by the amendment to add the counterclaim, however, it would be manifestly unjust to Applicant if the amendment were not to be allowed.

2. Applicant has not abandoned or completely changed its primary defense to the opposition. Applicant has and still maintains that there is or will not be any likelihood of consumer confusion with any of Opposer’s registrations including the CELVOL registration. However, the amendment was made necessary when Opposer’s one and only testimonial witness stated in his testimonial deposition that the CELVOL product is an additive for drilling muds. See page 35 of the Michael George deposition transcript attached as Exhibit 1 to Applicant’s Motion to Amend, and that Opposer had only recently become active in the oilfield business over the past two or three years. See page 43 of the Michael George deposition transcript attached as Exhibit 1 to Applicant’s Motion to Amend. This deposition was taken on September 26, 2006. The transcript was not submitted to Applicant until early November 2006. Trademark Rule 2.106(b)(2)(i) states that where the grounds for alleging a counterclaim are learned during the course of the proceeding, the counterclaim shall be pleaded promptly, after the grounds therefor are learned. In this case, the motion to amend was filed about a month after receiving the Michael George deposition transcript.

3. The primary issue to be determined is whether to grant Applicant’s Motion to Amend to Add the Counterclaim is whether the non-moving party, in this case Celanese, will be “unduly prejudiced” by the timing of the amendment. See e.g.,

*Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990); TBMP Section 507.02(b). In order to determine whether Opposer would be unduly prejudiced, one must focus on what harm will Opposer incur if the amendment is allowed? One could argue that Opposer was not afforded an opportunity to conduct discovery on the issues related to priority in the mark or that it had no previous notice that priority in the mark might be an issue. However, Applicant would show that neither of these concerns are applicable in this case.

4. First of all, as to no prior notice, Opposer was put on notice of Applicant's possible priority in the mark in Paragraph 14 of the original Answer to the Notice of Opposition. This was pleaded, at the time, as an affirmative defense to show that Opposer was aware of the CELLEX mark and its previous registrations when the CELVOL application was filed and that CELLEX had been in use by Applicant for over 40 years. Further, Opposer never contacted Applicant about likelihood of confusion during this time, nor did it allege any facts or produce any evidence of actual consumer confusion during this time period. This affirmative defense was made mainly to support Applicant's claim that Opposer should be barred from the relief requested because it failed to take timely action to put Applicant on notice that it was claiming infringement of its marks due to the fact that it was aware of Applicant's use of the CELLEX mark for many years. The affirmative defense was also consistent with Applicant's position that no likelihood of confusion between the CELLEX and CELVOL marks. However, no counterclaim was made at the time the answer was filed because it was, and still is, Applicant's primary contention that there is no likelihood of confusion between the

CELLEX and CELVOL marks. Applicant had no reason to know at that time that Opposer was using the CELVOL product as an additive to drilling muds or that it was even selling products for oilfield applications until Michael George was deposed in September 2006. Its registration certificate for CELVOL did not indicate that it had any use in connection with drilling muds or oil and gas drilling. While Opposer states in its Response to Applicant's Motion To Amend that the identification stated that CELVOL *could be* used as an emulsifier, stabilizer or dispersant, its identification of goods in the registration certificate actually states that it *is an ingredient* that could be used *in the manufacture* of emulsifiers, stabilizers or dispersants *not that it is* an emulsifier, stabilizer or dispersant. Nor does it state that it had any application to oil and gas well drilling products. If one is selling a product to others for use *as an ingredient* in making something else that is not specifically related to oil and gas drilling muds, how should Applicant have known merely from the pleaded registration that Opposer was actually using product for some other purpose? In short, it was not until Michael George was deposed that it became apparent that there may be a possibility that the CELLEX and CELVOL products may be used for the same purpose.

5. Opposer has made much of the fact that Applicant did not conduct any discovery and that if it had it might have found this information out sooner. However, the primary reason for not taking discovery was that Applicant and Opposer had been engaged in settlement negotiations during most of this time and in fact had a good faith belief that the negotiations would be fruitful. When there was a misunderstanding between the parties as to the specific terms of the settlement, the negotiations broke down and the discovery period had closed. In any event, the fact that Applicant did not take

any discovery is not a factor in determining whether *Opposer will be prejudiced* by the amendment to add the counterclaim.

6. Opposer took the opportunity, and in fact did, conduct discovery into Applicant's prior use of the mark and Applicant's potential priority. Opposer submitted an excerpt of Applicant's response to Interrogatory No. 1 in its response to the Motion to Amend. That answer clearly indicated that CELLEX had been in use by Applicant for about 40 years prior to filing its application subject to this opposition. Applicant is further adding as exhibits hereto excerpts from Interrogatory No. 2 which specifically inquired as to the Applicant's first use of the CELLEX mark,<sup>1</sup> and Interrogatories Nos. 10 and 15. In response to Interrogatory No. 10, Opposer was advised of Applicant's prior registrations for CELLEX (TESS printouts for these registrations were supplied in Applicant's Response to Opposer's Request For Production). In Interrogatory No. 15, Opposer asked for advertising expenditures relative to the CELLEX mark *since 1967*. The fact that it asked for information dating back to 1967 shows that it had knowledge of Applicant's prior use of the mark dating back at least that far in time. Further, one of the documents attached as an exhibit to Opposer's Response to Applicant's Motion To Amend, which was produced to Opposer by Applicant during discovery, was from *Petroleum Engineer* magazine dated January 1967. In short, Opposer will not be prejudiced from conducting discovery into the issue of priority in the mark because Opposer has already conducted such discovery and obtained the answers relative thereto. Opposer has stated in Section 2 of its Response to Applicant's Motion To Amend, that to

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<sup>1</sup> Applicant is only submitting the first sentence of its answer to Interrogatory No. 2. The remaining portion of the answer has been designated as "Confidential" under the Protective Order in this case. Further, the omitted information is not relevant toward the issue of determining priority in the mark or that Opposer had no notice that Applicant may have priority in the mark.

allow the amendment to add the counterclaim would effectively roll back the case to October 12, 2005 when the answer was originally served. Applicant submits that would not be the case because it would not be necessary for any further discovery to be taken by Opposer. Opposer has further conceded in its response that it has no intention of conducting any rebuttal testimony when its rebuttal testimony period opens later this month. See Page 6 of Opposer's Response to Applicant's Motion to Amend. If Opposer sees no need to offer rebuttal evidence, then it obviously believes there is nothing to rebut on the issue of priority of use.

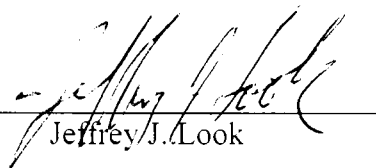
7. Finally, Applicant would show that Opposer would not be unduly prejudiced by allowing the amendment to add the counterclaim at this time because the amendment is only offered *in the alternative* to a finding of likelihood of confusion in order to conform to the evidence that has been offered at trial. See Rule 15(b) of the Federal Rules of Civil Procedure. Applicant maintains that there is no likelihood of confusion between the CELLEX and CELVOL marks because they are not similar in overall commercial impressions. If the Board ultimately determines that the marks are not similar in overall commercial impression then the counterclaim becomes moot. Opposer keeps its CELVOL registration and Applicant's CELLEX application will be approved and Opposer will not suffer any harm or prejudice. However, in the event that there is similarity in the marks, then the issue ultimately becomes who used the mark in commerce first? Assuming for the sake of argument that the marks are similar and the goods are related, it is clear that the evidence offered in this case will show that Applicant has used its CELLEX mark for more than 40 years while Opposer has only used its mark for 2 or 3 years.

8. Applicant submits that under Rule 8(c) of the Federal Rules of Civil Procedure that it should be allowed to amend its answer to add a counterclaim. Specifically, this rule states that "when a party has mistakenly designated a defense as a counterclaim or a counterclaim as a defense, the court on terms, if justice so requires, shall treat the pleading as if there had been a proper designation. Rule 15(b) of the Federal Rules of Civil Procedure also indicates that amendments to pleadings should be allowed when "the presentation of the merits of the action will be subserved thereby and the objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's action or defense upon the merits." Here, it would be manifestly unjust to allow a junior user of a mark with only 2 or 3 years use of a mark to effectively foreclose a senior user from using or registering a mark it has continuously used in commerce for over 40 years. Opposer has not shown that it will be unduly prejudiced with the amendment to add the counterclaim as it has been on notice from the filing of the Answer that Applicant has or may have priority in the mark and it has conducted and obtained discovery relative thereto. The counterclaim will only be considered in the event of a finding of likelihood of confusion between the marks. If there is no likelihood of confusion, Opposer will not be harmed as it will keep the CELVOL registration and the counterclaim will be moot. If there should be a finding of likelihood of confusion, then priority comes into play and all evidence relative to this issue has already been made of record by the parties through their testimony periods. Applicant renews its request to grant its Motion To Amend Answer And File Counterclaim For Cancellation and for all other just and proper relief.



Respectfully submitted.

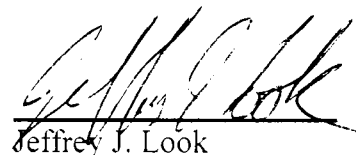
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By:   
Jeffrey J. Look

ATTORNEYS FOR APPLICANT  
HALLIBURTON ENERGY  
SERVICES, INC.

**CERTIFICATE OF SERVICE**

I hereby certify that on January 10, 2007 a true and correct copy of the forgoing REPLY TO OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S MOTION TO AMEND ANSWER AND TO FILE COUNTERCLAIM was served via first class mail, postage prepaid, on the following counsel and persons: Peter Ferrell, Esq., FERRELLS PLLC, P.O. Box 312, Clifton, VA 20124

  
Jeffrey J. Look

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

<b>CELANESE INTERNATIONAL CORPORATION</b>	)	
<b>OPPOSER</b>	)	
	)	
<b>V.</b>	)	<b>OPPOSITION NO. 91166550</b>
	)	
	)	
<b>HALLIBURTON ENERGY SERVICES, INC.</b>	)	
<b>APPLICANT</b>	)	

**APPLICANT’S ANSWERS TO OPPOSER’S INTERROGATORIES**

Applicant, Halliburton Energy Services, Inc., by its attorneys, files these answers to the Interrogatories of Opposer Celanese International Corporation pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice.

**DEFINITIONS**

1. The Definitions, Rules, and Instructions set forth in Fed. R. Civ. P. 26 to 37 are incorporated herein by reference.
2. “And” and “or” shall be construed conjunctively or disjunctively, whichever makes the request most inclusive.
3. “Any” or “each” shall be construed to include and encompass “all”.
4. “Petitioner” or “Celanese” means Celanese International Corporation, its affiliates, subsidiaries and divisions, any predecessor companies or proprietorships, any joint venture to which it may be a party, and each of its present and former employees, agents, officers, directors, representatives, consultants, accountants, experts, and

attorneys, or other persons under its control or purporting to act on its behalf.

5. "Date" means the exact date, month and year, if ascertainable, or, if not, the best approximation thereof.

6. "Entity" or "Entities" includes natural persons; proprietorships; partnerships; firms; corporations; public corporations; municipal corporations; governments, including foreign national governments, the government of the U.S. or any state or local government, and all departments and agencies thereof; political subdivisions; groups; associations; or organizations.

7. "Including" means including without limitation.

8. "Applicant" or "Halliburton", "you" or "your" mean Halliburton Energy Services, Inc., its affiliates, subsidiaries and divisions, any predecessor companies or proprietorships, any joint venture to which it may be a party and each of its present and former employees, agents, officers, directors, representatives, consultants, accountants, experts, and attorneys, or other persons under its control or purporting to act on its behalf

9. "Person" means any natural person, legal entity, or business entity, including any corporation, partnership, unincorporated association, joint venture, sole proprietorship, or any and/or all other organization or group of individuals.

10. Any word not specifically defined herein shall be given its ordinary meaning.

**INTERROGATORY NO. 1:** State whether any searches or investigations were conducted by Applicant or any person on its behalf (including its attorneys) to determine whether the term "CELLEX" was available as a trademark or trade name in the United States and, if so, identify each such search or investigation, as well as each document

located or generated in connection with such search or investigation.

**ANSWER:** Applicant objects to the above interrogatory to the extent that it seeks information and documents that are subject to the attorney client privilege as well as the attorney work product doctrine. Applicant further objects on relevance grounds as it is not likely to lead to the discoverability of admissible documents. Subject to the above objections Applicant states that no new searches were conducted prior to filing the subject application since Applicant has used its CEI.LEX mark for approximately 40 years.

**INTERROGATORY NO. 2:** Identify and describe all the goods and/or services for which Applicant has used its trademark CEI.LEX, and for each supply the date of first use of the trademark or trade name on the goods or services; the geographic areas in which the goods or services have been marketed or distributed; the companies, individuals or other purchasers to whom the goods or services were sold; and the last date on which said goods or services were marketed or sold.

**ANSWER:** Applicant objects to the above interrogatory on the grounds that it is overbroad in that it is not possible to identify all purchasers who have ever purchased the Applicant's goods over the past 40 years that the goods have been sold. Pursuant to

**ANSWER:** Not applicable. See Applicant's response to Interrogatory No. 7.

**INTERROGATORY NO. 9:** Describe any court or Patent and Trademark Office actions, not previously identified, filed by Applicant in connection with the use of the alleged trademark CELLEX, identify each such action and identify and locate all documents relating thereto.

**ANSWER:** Applicant objects to the above interrogatory on the grounds that it is vague and ambiguous. Subject to the above objection Applicant received an Office Action relating to the current application requesting a change to the identification of goods as well as an Examiner's Amendment making the change. Opposer can obtain the file record pertinent to the prosecution of this application from the USPTO's TDR database at [www.uspto.gov](http://www.uspto.gov).

**INTERROGATORY NO. 10:** Identify all of Applicant's registrations and applications for registration of the trademark CELLEX or any variants thereof in the United States and any refusal of registration or opposition filed in connection with any such registration or application, other than the current proceeding, including the names of opposers and without regard to the final disposition of any opposition.

**ANSWER:** Applicant claims ownership of the following registrations and applications: U.S. Registration No. 1490725 (cancelled); 0822600 (expired); and the present pending application Serial No. 78/471625. To the best of Applicant's knowledge, Applicant has not received any refusal of registration or oppositions filed, other than the current one subject to this proceeding.

**ANSWER:** In catalogs, sales data sheets, and trade journals. See the representative sample of documents attached as pages 00008-00041 to Applicant's Responses To Opposer's Request For Production.

**INTERROGATORY NO. 15:** State or reasonably estimate Applicant's annual expenditures since 1967 for advertising and promoting Applicant's goods or services under its alleged CELLEX trademark.

**ANSWER:** Applicant's CELLEX trademark was predominately advertised and promoted in connection with other goods of Applicant. Therefore, Applicant does not have a breakdown of specific expenditures for advertising relating solely to its CELLEX product.

**INTERROGATORY NO. 16:** Identify the documents upon which Respondent intends to rely in this proceeding.

**ANSWER:** See the documents attached as pages 00000-00063 to Applicant's Responses To Opposer's Request For Production. Additionally, Applicant reserves the right to rely on any documents produced or relied upon by Opposer in connection with this case. Applicant will supplement if additional documents are discovered.

**INTERROGATORY NO. 17:** Identify the witnesses Applicant intends to call to testify on its behalf in connection with this proceeding and state the facts or subject matter concerning which they are each expected to testify.

**ANSWER:**

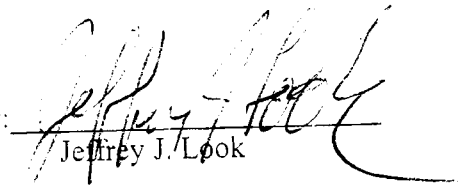
Jeff Kirsner, Strategic Business Manager, Baroid

Robert W. Pike -- Global Quality Leader, Baroid

Any witness designated by Opposer

Respectfully submitted,

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By:   
Jeffrey J. Look

ATTORNEYS FOR APPLICANT  
HALLIBURTON ENERGY  
SERVICES, INC.

**VERIFICATION**

I, DAVE MIRSNER, have read and reviewed each of the answers to the above Interrogatories. The responses are based on my best personal knowledge and belief and the facts stated therein are true and statements made on information and belief are believed to be true.

Dated: 5-1-06

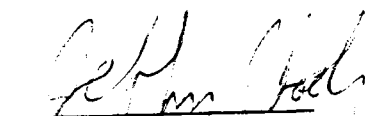
  
Signature

STRATEGIC BUSINESS MGR  
Title

**CERTIFICATE OF SERVICE**

I hereby certify that on May 19, 2006 a true and correct copy of the forgoing was served via first class mail, postage prepaid, on the following counsel and persons:

Peter Ferrell, Esq.  
FERRELLS PLLC  
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Jeffrey J. Look