

Goodman

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: November 8, 2012

Opposition No. **91201442**
Opposition No. 91203935
Opposition No. 91203936
Opposition No. 91203938
Opposition No. 91203939
Opposition No. 91206885

Schlumberger Technology
Corporation

v.

Halliburton Energy Services,
Inc.

By the Trademark Trial and Appeal Board:

This case now comes up on the following motions:

- 1) opposer's motion, filed June 28, 2012, for leave to amend, in consolidated Opposition No. 91201442 (parent case); and
- 2) opposer's motion, filed October 31, 2012, in Opposition No. 91206885 for default judgment which applicant has opposed¹; and
- 3) applicant's request (in conjunction with its response to motion for default judgment), filed November 2, 2012, that the Board consolidate Opposition No. 911206885 with the already consolidated opposition proceedings (parent case Opposition No. 91201442).

¹ Answer was due in Opposition No. 91206885 on October 16, 2012. The Board issued a notice of default on October 31, 2012 which crossed in the mail with opposer's motion for default judgment. Applicant responded to the notice of default on October 31, 2012, and filed its answer concurrently therewith. Applicant responded to the motion for default judgment on November 2, 2012.

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Motion for Default Judgment (Opposition No. 91206885)

The Board turns first to the motion for default judgment.

Good cause for discharging default is generally found if (1) the delay in filing is not the result of willful conduct or gross neglect, (2) the delay will not result in substantial prejudice to the opposing party, and (3) the defendant has a meritorious defense. *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 21 USPQ2d 1556 (TTAB 1991). When considering these factors, the Board keeps in mind that the law strongly favors determination of cases on their merits. *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r Pat. 1990).

In support of its motion, opposer argues that default judgment should be entered against applicant due to applicant's failure to file an answer in Opposition No. 91206885. Opposer further notes that applicant must establish good cause for setting aside default.

The Board will now consider applicant's arguments that it has established good cause for setting aside default.

Meritorious Defense

Applicant argues that it has a meritorious defense to the notice of opposition as it is defending multiple oppositions consolidated under parent Opposition No. 91201442 and that it has a valid basis to defend the present

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opposition based on its answer, filed concurrently with its response to the notice of default.

The Board finds that applicant has set forth a meritorious defense by the filing of its answer. See *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (plausible response to allegations in notice of opposition all that required for meritorious defense); *Mathon v. Marine Midland Bank, N.A.*, 875 F. Supp. 986, 993 (E.D.N.Y. 1995) ("A meritorious defense is established by Rule 55 standards by setting forth denials and defenses in an answer").

Prejudice to Opposer

Applicant argues that opposer will not be substantially prejudiced by the delay as the parties have consented to consolidation of Opposition No. 91206885 with the earlier consolidated oppositions, parent Opposition No. 91201442, which consolidated proceeding is "on hold" pending the Board's consideration of a motion for leave to amend the notices of opposition.

The Board finds that setting aside default will not cause substantial prejudice to opposer inasmuch as mere delay alone does not establish prejudice. *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d at 1222; see also *Capital Yacht Club v. Vessel AVIVA*, 228 F.R.D. 389, 394 (D.D.C. 2005) (It is well established, however, that "delay

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and legal costs are part and parcel of litigation and typically do not constitute prejudice for the purposes of Rule 55(c)"). See also 10 C. Wright, A. Miller, M. Kane & R. Marcus, Federal Practice and Procedure Civil 3d Section 2699 (Westlaw 2012) (substantial prejudice is demonstrated by some actual harm to plaintiff's ability to litigate the case).

Willfulness or Gross Neglect

Applicant argues that default was not willful as its failure to timely answer was the result of its belief that the opposition would be consolidated with parent Opposition No. 91201442, as the parties had consented to consolidation as noted in Paragraph 9 of opposer's notice of opposition. Additionally, applicant advises that there was confusion by applicant's counsel as to the docketing of the answer deadline in view of what applicant's counsel believed was the pending consolidation.

Under the circumstances, the Board finds that applicant's failure to answer was not willful nor the result of gross neglect.

In view of the above, the Board finds good cause for setting aside default. Opposer's motion for default judgment is denied. The notice of default is discharged, default is set aside, and applicant's answer is accepted.

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Motion to Amend, parent Opposition No. 91201442

The Board now turns to the motion to amend the notices of opposition² to add a contractual estoppel claim based on the parties' cease and desist correspondence,³ to correct a typographical error in paragraph 4, and to add additional details in paragraph 5 regarding its correspondence with applicant in 2011 subsequent to the filing of the various RAPID applications.

Applicant has not opposed the motion.

Accordingly, the motion to amend is granted as conceded and the amended (consolidated) notice of opposition is accepted. Trademark Rule 2.127(a).

Consolidation

Opposer indicated in paragraph 9 of the notice of opposition in Opposition No. 91206885 that the parties have

² The amended notice of opposition is a consolidated notice of opposition with respect to all previously consolidated proceedings (Opposition Nos. 91201442, 91203935, 91203936, 91203938, and 91203939). The notice of opposition in Opposition No. 91206885 includes the 1995 date in paragraph 4 (as provided in the amended consolidated notice of opposition), does not include the expanded allegations in paragraph 5 (as provided in the amended consolidated notice of opposition), and while this notice of opposition also includes a contractual estoppel claim in paragraph 7, the allegation differs from the amended consolidated notice of opposition as it does not clearly state that the August 22, 2000 communication from applicant is a response to a cease and desist letter from opposer.

³ See *MWS Wire Industries, Inc. v. California Fine Wire Co.*, 797 F.2d 799, 230 U.S.P.Q. 873 (9th Cir. 1986) (contractual estoppel based on an attorney's letter in response to a cease and desist letter). The allegation in the consolidated notice of opposition states that the August 22, 2000 representation from Applicant was made "in response to a cease and desist letter from Applicant."

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agreed to consolidate proceedings with the already consolidated proceedings (parent Opposition No. 91201442) after answer was filed, and opposer will file a motion to that effect. Applicant has requested in response to the motion for default judgment in Opposition No. 91206885 that Opposition No. 91206885 be consolidated with the earlier consolidated opposition proceedings under parent Opposition No. 91201442.

The Board has reviewed Opposition No. 91206885, and determined that it involves similar marks, similar goods and similar questions of law and fact as the already consolidated proceedings.

Accordingly, Opposition No. 91206885 is hereby consolidated with the already consolidated proceedings: Opposition Nos. 91201442, 91203935, 91203936, 91203938, 91203939. The consolidated cases may be presented on the same record and briefs, although each case retains its separate character. The record will be maintained at the Board in Opposition No. 91201442 as the "parent" case, but all papers filed in these cases should include all proceeding numbers in ascending order.⁴

Applicant is allowed until **November 29, 2012** to file its answer to the amended consolidated notice of opposition.

(emphasis added) This appears to be a typographical error, which opposer may wish to correct.

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As for scheduling, discovery is closed in Opposition No. 91201442 as of May 8, 2012, and discovery is open in in Opposition Nos. 91203935, 91203936, 91203938 and 91203939 as of May 1, 2012, but all the cases shall nevertheless be tried together. Accordingly, Opposition No. 91201442 remains SUSPENDED while the parties complete discovery in the other consolidated oppositions.

The parties have already proceeded to their discovery conference in Opposition Nos. 91203935, 91203936, 91203938, and 91203939 and as stated above, discovery is now open with respect to these consolidated proceedings; the parties shall proceed to their discovery conference in Opposition No. 91206885 on the date set forth below. The Board otherwise resets the discovery, disclosure and trial schedule for the consolidated proceedings based on the most junior case, Opposition No. 91206885 which is in accord with Board practice.

Following the completion of discovery in Opposition Nos. 91203935, 91203936, 91203938, 91203939 and 91206885, these consolidated cases shall converge for trial, pursuant to the schedule set forth below.

Deadline for Discovery Conference Opposition No. 91206885	12/8/2012
Discovery Opens for 91206885	12/8/2012

⁴ The parties are ordered to advise the Board of any additional related inter partes proceedings at the Board.

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Discovery CLOSED as of May 8, 2012 -
Opposition No. 91201442; Discovery Open
as of May 1, 2012 - Opposition Nos.
91203935, 91203936, 91203938, 91203939

Initial Disclosures Due Opposition Nos. 91203935, 91203936, 91203938, 91203939, and 91206885⁵ **1/7/2013**

Expert Disclosures Due Opposition Nos. 91203935, 91203936, 91203938, 91203939 and 91206885 **5/7/2013**

Discovery Closes Opposition Nos. 91203935, 91203936, 91203938, 91203939 and 91206885 **6/6/2013**

Plaintiff's Pretrial Disclosures Due (all opposition proceedings) **7/21/2013**

Plaintiff's 30-day Trial Period Ends (all opposition proceedings) **9/4/2013**

Defendant's Pretrial Disclosures Due (all opposition proceedings) **9/19/2013**

Defendant's 30-day Trial Period Ends (all oppositions) **11/3/2013**

Plaintiff's Rebuttal Disclosures Due (all opposition proceedings) **11/18/2013**

Plaintiff's 15-day Rebuttal Period Ends (all opposition proceedings) **12/18/2013**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

⁵ In view of the motion to amend, initial disclosure dates are reset for Opposition Nos. 91203935, 91203936, 91203938, 91203939; it is unclear if the parties served initial disclosures in Opposition Nos. 91203935, 91203936, 91203938, and 91203939 during the pendency of the motion for leave to amend. See TBMP Section 316 (3d ed. rev. 2012) (various pleading motions may stay the parties' obligation to make initial disclosures).

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Briefs shall be filed in accordance with Trademark
Rules 2.128(a) and (b). An oral hearing will be set only
upon request filed as provided by Trademark Rule 2.129.

***By the Trademark Trial
and Appeal Board***