


ESTTA Tracking number: **ESTTA1129858**

Filing date: **04/27/2021**

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

|                        |                                                                                                                                                                                                                                                                                                          |
|------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Proceeding             | 91268246                                                                                                                                                                                                                                                                                                 |
| Party                  | Defendant<br>BAKER HUGHES HOLDINGS LLC                                                                                                                                                                                                                                                                   |
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| Submission             | Answer                                                                                                                                                                                                                                                                                                   |
| Filer's Name           | Tyson D. Smith                                                                                                                                                                                                                                                                                           |
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| Signature              | /Tyson Smith/                                                                                                                                                                                                                                                                                            |
| Date                   | 04/27/2021                                                                                                                                                                                                                                                                                               |
| Attachments            | Answer Mobius Opposition.pdf(288322 bytes )                                                                                                                                                                                                                                                              |

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|                            |   |                                                                                           |
|----------------------------|---|-------------------------------------------------------------------------------------------|
| BMC SOFTWARE, INC.,        | § |                                                                                           |
|                            | § |                                                                                           |
| Opposer,                   | § |                                                                                           |
|                            | § |                                                                                           |
| v.                         | § | Opposition No. 91268246                                                                   |
|                            | § | Application No. 88/643,061                                                                |
|                            |   |                                                                                           |
| BAKER HUGHES HOLDINGS LLC, | § | Mark:  |
|                            | § |                                                                                           |
| Applicant.                 | § |                                                                                           |

**ANSWER TO NOTICE OF OPPOSITION**

Pursuant to Federal Rule of Civil Procedure 8(b) and 37 C.F.R. § 2.106, Applicant Baker Hughes Holdings LLC (“Applicant”), answers the Notice of Opposition as follows. The paragraph numbers below correspond to those in the Notice of Opposition. Applicant reserves the right to amend or supplement its Answer as appropriate.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.
2. Admitted.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.
5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph, and therefore denies them.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph, and therefore denies them.

14. Applicant admits that it announced a new logo that is the subject of the pending application on or about October 8, 2019, and that it uses the mark in combination with the words “Baker Hughes” and in certain instances standing alone. Applicant denies any remaining allegations and subjective claims in this paragraph.

15. Applicant admits that it is an energy technology company and currently offers certain software-related products and services in connection with its business. Applicant denies any remaining allegations and subjective claims in this paragraph.

16. Applicant admits that it has a marketing alliance with c3.ai and Microsoft Corporation that was announced on or about November 19, 2019. Applicant is without

knowledge or information sufficient to form a belief as to the truth of the allegations regarding Opposer's announcements, and denies any remaining allegations in subjective claims in this paragraph.

17. Denied.

18. Applicant admits that it filed the referenced application and that this paragraph appears to recite the current goods and services in the application.

19. Applicant admits that it became aware of certain of the BMC Helix Marks prior to its commencing public use of the Baker Marks, but denies any suggestion that choosing and using the Baker Marks was in any way improper. Applicant denies any remaining allegations in this paragraph.

20. Denied.

21. Denied.

22. Denied.

23. Denied.

24. Denied.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense: Unclean Hands**

1. BMC's claims are barred, in whole or in part, by the doctrine of unclean hands. BMC's registrations for the BMC Marks, specifically U.S. Registration Nos. 4,759,874, 4,759,872, 4,759,870, and 4,759,869, each describe the helix design element of the respective BMC Mark covered by these registrations as a "stylized double helix," with no reference to a "mobius." The applications for these registrations containing this "stylized

double helix” description were filed by BMC on October 31, 2014, well before Applicant’s adoption of its in new Mobius Arrow logos or the date Applicant filed the Application.

2. Applicant filed the Application (U.S. Ser. No. 88/643,061) on October 4, 2019. This application includes the following description of the mark: “The mark consists of a stylized design of a mobius twist in green.”





3. On October 10, 2019, BMC contacted Applicant and expressed concerns over the alleged similarities between the BMC Marks and the mark in the Application. The next day, Applicant responded with numerous reasons why the marks are not confusingly similar, including that the Baker Hughes mark “is a Mobius,” which is “a unique shape” that “does not exist with the BMC logo.” After Applicant filed the Application including the term “mobius” in the mark description, and after Applicant pointed out this distinction between the parties’ marks, BMC for the first time began referring to its marks as “mobius” designs, and filed a new application on November 27, 2019, for its double helix mark (U.S. Ser. No. 88/708,723), this time with the following description of the mark: “The mark consists of stylized mobius strip in the shape of a helix in orange” (underlining added). On information and belief, BMC included these references to “mobius” solely in an attempt to improve its position against Applicant, in litigation both in federal court and in the USPTO. Such conduct by BMC constitutes unclean hands, and its claims should therefore be barred.

#### **Second Affirmative Defense: Acquiescence and Waiver**

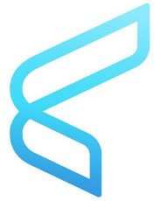
4. Opposer’s claims are barred, in whole or in part, by the doctrines of acquiescence and waiver. Opposer’s actions establish acquiescence through: (1) implicit or explicit assurances by the Opposer that the defendant could use the mark, (2) reliance by the defendant upon those representations, and (3) undue prejudice. Opposer’s actions also

establish waiver because: (1) Opposer held an existing right, benefit, or advantage, (2) Opposer’s actual knowledge of the existence of that right, benefit, or advantage (in this case, Opposer’s own rights in its BMC Marks), and (3) Opposer’s actual intent to relinquish that right, or intentional conduct inconsistent with that right.

5. Opposer has implicitly or explicitly represented that Applicant could use the Baker Marks by failing to police and enforce against extensive third party use of marks similar to Opposer’s BMC Marks in connection with a wide variety of goods and services, including but not limited to marks incorporating a helix or other similar design component, many of which Opposer had knowledge (actual or constructive) or should have had knowledge. In response to Opposer’s concerns, Applicant provided specific examples of such third party marks to Opposer prior to Opposer’s filing of this lawsuit. In addition, subject to further discovery and without limitation, examples of such third party marks are listed directly below:

| MARK                                                                                | REGISTRATION No. | APPLICATION No. | CURRENT OWNER                   |
|-------------------------------------------------------------------------------------|------------------|-----------------|---------------------------------|
|  | 5,773,593        | 88/112,684      | Bundy App<br>S.A.P.I. de C.V.   |
|  | 4,836,493        | 86/569,298      | Rebase Systems<br>Limited       |
|  | N/A              | 88/180,036      | The Common<br>Application, Inc. |
|  | N/A              | 88/180,013      | The Common<br>Application, Inc. |

| MARK                                                                                | REGISTRATION NO. | APPLICATION NO. | CURRENT OWNER                         |
|-------------------------------------------------------------------------------------|------------------|-----------------|---------------------------------------|
|    | N/A              | 88/180,006      | The Common Application, Inc.          |
|    | 4,993,781        | 86/112,979      | Arysta LifeScience North America, LLC |
|    | 5,215,125        | 86/981,800      | Marshawn Lynch                        |
|    | 4,779,839        | 86/005,185      | Delphian Ballistics Limited           |
|   | 5,310,436        | 87/378,365      | Enable Midstream Partners, LP         |
|  | 4,935,536        | 86/676,418      | Bay Dynamics, Inc.                    |

| MARK                                                                                | CURRENT USE                                                                                                                                                | CURRENT OWNER                |
|-------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------|
|  | <a href="https://www.commonapp.org/">https://www.commonapp.org/</a><br><a href="https://www.facebook.com/commonapp">https://www.facebook.com/commonapp</a> | The Common Application, Inc. |

| MARK                                                                              | CURRENT USE                                                                                                                                                             | CURRENT OWNER                   |
|-----------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------|
|  | <a href="https://www.showsuite.com/">https://www.showsuite.com/</a>                                                                                                     | Showsuite Pte Ltd.              |
|  | <a href="https://mobiustrackers.com/">https://mobiustrackers.com/</a>                                                                                                   | Mobius Partners                 |
|  | <a href="http://mobiustechologies.com/">http://mobiustechologies.com/</a>                                                                                               | Mobius Technologies GmbH        |
|  | <a href="http://www.bmcassociates.com/who-we-are/partner-mobius-executive-leadership/">http://www.bmcassociates.com/who-we-are/partner-mobius-executive-leadership/</a> | Mobius Executive Leadership LLC |

Applicant also believes that further investigation or discovery will show that Opposer had knowledge (actual or constructive) or should have had knowledge of additional relevant third-party marks.

6. Opposer’s failure to police and enforce its BMC Marks was intentional and inconsistent with its rights in the BMC Marks or the claims it has asserted against Applicant based on the BMC Marks.

Wherefore, Applicant requests that the Notice of Opposition be rejected, and judgment be entered in favor of Applicant.



Dated: April 27, 2021

Respectfully submitted,

*/Tyson D. Smith/*

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