TTAB

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

Certificate of Mail Under § 1.8
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: BOX TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on the date shown below.

Paul W. Fulbright — 10/28/2005
October 28, 2005

In re Service Mark Application of:	Nutek International, Inc.
Application Serial No.:	76,610,358
Filing Date:	September 7, 2004
Mark:	CRISPAIR
Published for Opposition:	August 30, 2005
Law Firm File Ref. No.:	00077.0005

BOX TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Commissioner:

1. **Notice of opposition / identity of opposer**: Conseal International Incorporated ("Conseal" or "Opposer"), a Florida corporation, with a principal place of business of 90 Kerry Place Suite 2, Norwood MA 02062, through its attorney, hereby provides notice that it opposes registration of the application identified below.

11-01-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #64

2. **Application opposed**: U.S. Trademark Application Serial Number 76/610,358 (the "'358 application" or the "Application") filed 09/07/2004 for the word mark "CRISPAIR" (the "Mark" or "Mark in dispute in this proceeding") for the following goods and services in International Class 11: "Ozone air purification system comprising ionization tubes and power supplies, all sold as a unit." (the "Goods"). Alleged date of first use: 01/17/1997. Alleged date of first use in commerce: 01/17/1997. The '358 application was published for opposition on 08/30/2005.

3. **Identity of applicant**: Nutek International, Inc. ("Nutek-Edgewater"), a Florida corporation, 704-1 West Park Avenue / Edgewater FL 32132.

4. **Timeliness of *Notice of Opposition***: The '358 application was published for opposition on 08/30/2005. Pursuant to, *inter alia*, Lanham Act § 13(a), 15 U.S.C. § 1063(a), a *Request For A 30-Day Extension Of Time To File A Notice Of Opposition* was filed, and it was granted on 09/29/2005; this grant conferred the right to file a *Notice of Opposition* until 10/29/2005. As such, this Notice is timely filed.

5. **Goods / Services affected by the opposition**: All goods / services listed in International Class 11 are opposed; namely, "Ozone air purification system comprising ionization [sic: ozonation] tubes and power supplies, all sold as a unit." (the "Goods").

6. **Fee**: Pursuant to 37 C.F.R. § 2.101(a), the fee specified pursuant to 37 C.F.R. § 2.6(a)(17) of $300.00 is enclosed.

STANDING

7. **Applicant**: Nutek International, Inc. ("Nutek-Edgewater"), a Florida corporation, 704-1 West Park Avenue / Edgewater FL 32132 filed U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") on 09/07/2004 for the

word mark "CRISPAIR" for the following goods and services in International Class 11: "Ozone air purification system comprising ionization tubes and power supplies, all sold as a unit." (the "Goods"). In its '358 application, Nutek alleged a date of first use of 01/17/1997 and a date of first use in commerce of 01/17/1997. The '358 application was published for opposition on 08/30/2005.

8. **Opposer**: Conseal began its use in commerce of the "CRISPAIR" trademark for the Goods at least as early as 1988, and it has used its distinctive mark continuously in commerce since its first use for the Goods. As such, Opposer Conseal, and not Applicant Nutek-Edgewater, has priority of use.

9. **Standing**: Pursuant to Lanham Act §§ 13-14, 15 U.S.C. §§ 1063-64, Opposer Conseal asserts in good faith that it has standing as it believes that it is, and will continue to be, damaged by the application for registration of the mark "CRISPAIR" as shown in the '358 application, and it hereby opposes same.

10. **Damage**: The sources of actual, potential, and further damage are numerous and include the following: (a) Opposer Conseal's own Trademark Application No. 76/615,509 (the "'509 application") for registration of the Mark "CRISPAIR" has been suspended pending the disposition of the '358 application upon which this opposition is based (the Examiner of the '509 application stating that she may cite any registration resulting from the '358 application against the '509 application); and (b) if the Examiner of the '509 application is correct, the likelihood of confusion between the Mark sought to be registered by Applicant and Opposer's prior mark given the associated Goods.

11. As support for the grounds for the opposition, Conseal alleges as follows, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

THE FOUR "CRISPAIR" TRADEMARK APPLICATIONS APPEARING ON THE PRINCIPAL REGISTER.

12. A cursory check of the Principal Register reveals no less than four (4) trademark applications, including the '358 application, which have been filed relating to the mark "CRISPAIR" and ozone-based air purification systems. A brief review of these applications is helpful to an understanding of the facts of this case. The four (4) applications, in order of filing date, are:

13. First, **U.S. Trademark Application No. 78/042,176** (the "'176 application") was filed 01/08/2001 by Nutek International ("Nutek-Wilmington"), a Delaware corporation, 1220 North Market Street Suite 606, Wilmington Delaware 19801, for "CRISPAIR" for "Ozone air purification system comprising ionization tubes and power supplies, all sold as a unit." The '176 application alleged a first use date of 2/1/1989 and a first use in commerce date of 2/1/1989. This application matured on 06/04/2002 into the U.S. Trademark Registration No. 2,576,285 (the "'285 registration").

14. However, the '285 registration was cancelled very recently on 04/13/2005 when its owner failed to respond to a cancellation proceeding filed by Nutek-Edgewater. Because this registration was cancelled, the '285 Registrant and the '285 Registration are *not directly relevant* to this proceeding. However, the cancellation proceeding for the '285 registration was instituted by petitioner Nutek-Edgewater, *the Applicant in this proceeding*. Conseal notes that, in Nutek-Edgewater's Petition for Cancellation of the '285 registration, *Nutek-Edgewater itself alleged, on several occasions*, that "Petitioner

[Nutek-Edgewater] and Conseal were the true source of the 'Ozone Air Purification Systems' which [the '285] Registrant sought to register improperly in Registrant's own name." (bracketed material added for clarification).

15. As will be seen further below, *it is indeed proper to characterize Conseal as the "true source" of ozone – based air purification systems marketed under the "CRISPAIR" mark in the United States*. However, *any* suggestion (as in the '358 application at issue in this opposition proceeding) that Nutek-Edgewater is a proper, first, or co-owner of rights in the "CRISPAIR" mark for ozone – based air purification systems is patently false.

16. Second, **U.S. Trademark Application No. 78/072,467** (the "'467 application") was filed 07/05/2001 by Conseal International, Inc. ("Conseal"), a Florida corporation, 728 Industry Road, Longwood Florida 32750, for "CRISPAIR" for "Electrically operated ozone generation systems for purifying and deodorizing air." The '467 application alleged a first use date of 4/11/1993 and a first use in commerce date of 4/11/1993. This application was abandoned for the inadvertent failure to respond to a non-final office action. As such, it too is *not directly relevant* to this proceeding; however, the application is cited as evidence buttressing Conseal's use of the "CRISPAIR" mark at least as early as the early 1990's (in contrast to Nutek-Edgewater's alleged date of first use of 01/17/1997).

17. Third, **U.S. Trademark Application No. 76/610,358** (the "'358 application" or the "Application"), the application that is the subject of this proceeding, was filed by Nutek International, Inc. ("Nutek-Edgewater"), *the Applicant in this proceeding*, a Florida corporation, 704-1 West Park Avenue / Edgewater FL 32132 on

09/07/2004 for the word mark "CRISPAIR" for the following goods and services in International Class 11: "Ozone air purification system comprising ionization tubes and power supplies, all sold as a unit." In its '358 application, Nutek alleged a date of first use of 01/17/1997 and a date of first use in commerce of 01/17/1997. The '358 application was published for opposition on 08/30/2005.

18. Fourth, **U.S. Trademark Application No. 76/615,509** (the "'509 application"), was filed by Conseal International, Inc., *the Opposer in this proceeding*, a Florida corporation, 90 Kerry Place Suite 2, Norwood Massachusetts 02062, on 10/12/2004 for the word mark "CRISPAIR" for the following goods and services in International Class 11: "Ozone-based or ozonator-based air and water purification systems, equipment, and related supplies." In its '509 application, Conseal alleged a date of first use of 1991 and a date of first use in commerce of 1991; however, it is Opposer Conseal's intention to amend the dates of first use in due course so as to reflect the fact that it first used the Mark for the Goods (and first used the Mark in commerce for the Goods) at least as early as 1988. The '509 application is in suspension awaiting the results of this opposition proceeding.

GROUNDS FOR OPPOSITION

19. Opposer Conseal respectfully opposes registration of the Mark shown in the '358 application on the following separate and independent grounds:

COUNT I – LIKELIHOOD OF CONFUSION

20. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

21. Conseal began its use in commerce of the "CRISPAIR" trademark for the Goods at least as early as 1988.

22. Since 1988, Conseal has used its distinctive "CRISPAIR" mark continuously in commerce for the Goods. Conseal has sold its CRISPAIR air purification systems in substantial numbers throughout the United States, and many of these sales were consummated in commerce *prior* to January 17, 1997 (Applicant's alleged date of first use in the application at issue in this proceeding).

23. Applicant's CRISPAIR *word mark is identical* to Opposer's mark, and, as such, is clearly intended to trade upon the goodwill associated with Opposer's famous, valuable, prior trademark.

24. Because Applicant's mark is identical to Opposer's, and because it is used *for identical goods*, it is extremely likely that the Applicant's use of Opposer's mark will cause confusion, mistake, and / or deception in United States commerce in violation of the Lanham Act.

25. Therefore, based upon, *inter alia*, Lanham Act § 2(d), 15 U.S.C. § 1052(d), Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

COUNT II – APPLICATION VOID DUE TO LACK OF A *BONA FIDE* USE OF THE MARK

26. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

27. Conseal's use of its CRISPAIR mark, which commenced at least as early as 1988, began prior to the corporate creation of Applicant in 1996.

28. The owner of Opposer Conseal is Mr. Stephen C. Perry ("Perry"). He and Mr. Douglas A. Moxley ("Moxley") are two of the original co-owners of Applicant Nutek-Edgewater. As such, Perry has intimate personal knowledge of the details surrounding the operation of Nutek-Edgewater at the time of its inception and during the year or two that followed.

29. The evidence in this proceeding will demonstrate conclusively that, at the time Applicant was created, and at the time of its alleged first use of the Mark in dispute in this proceeding, *only Opposer Conseal* was engaged in a *bona fide* use of the "CRISPAIR" mark for the Goods in commerce.

30. The evidence will also demonstrate that Moxley was fully aware of Conseal's senior trademark rights in the "CRISPAIR" mark for the Goods at all times from its alleged date of first use (a fabrication) through to and including the filing date of the Application in suit, the '358 application.

31. Opposer Conseal has never assigned rights in the "CRISPAIR" mark, or any portion thereof, to Applicant Nutek-Edgewater, either expressly or by implication.

32. Opposer Conseal has never licensed Applicant Nutek-Edgewater, either expressly or by implication, to use the "CRISPAIR" mark for the Goods or, indeed, for any purpose or for any goods or services whatsoever. In fact, Opposer Conseal has never even sold Goods bearing the "CRISPAIR" mark to Applicant Nutek-Edgewater for distribution (even though such pass-through sales would be insufficient to confer trademark rights in Applicant in the first place).

33. Thus, at a minimum, Applicant Nutek-Edgewater had not built, marketed, offered for sale, or sold Goods under the "CRISPAIR" mark until *after* being introduced to Conseal, the true owner of the "CRISPAIR" mark for the Goods.

34. Thus, Applicant did not commence a *bona fide* use in commerce of the "CRISPAIR" mark for the Goods on or before January 17, 1997 as represented in its '358 application for registration (the application in suit).

35. Therefore, based upon, *inter alia*, Lanham Act § 1(a), 15 U.S.C. § 1051(a), Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

COUNT III – APPLICATION VOID DUE TO FRAUDULENT MISREPRESENTATIONS REGARDING *BONA FIDE* USE

36. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

37. As stated hereinabove, the evidence will demonstrate that Moxley was fully aware of Conseal's senior trademark rights in the "CRISPAIR" mark for the Goods at all times from its alleged date of first use (a fabrication) through to and including the filing date of the Application in suit, the '358 application.

38. Specifically, not only did Applicant Nutek-Edgewater not commence a *bona fide* use in commerce of the "CRISPAIR" mark for the Goods on or before January 17, 1997 as represented in its '358 application for registration (the application in suit), but, in addition, at the time it filed its '358 application for registration, it knew for a fact

that its allegations of a *bona fide* first use in commerce commencing on January 17, 1997 were in fact false.

39. Applicant's representations were clearly fraudulent as Applicant, possessing direct, personal knowledge to the contrary, provided a *verified* statement / declaration at the time of its application for registration that the "CRISPAIR" mark was the subject of a *bona fide* use in commerce *by Applicant* on or in connection with the Goods listed in the application as required by 37 C.F.R. § 2.34(a)(1)(i).

40. Therefore, based upon, *inter alia*, 37 C.F.R. § 2.193(c)(2) and 37 C.F.R. § 10.18(b), Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

COUNT IV – APPLICATION VOID DUE TO MIS-DESIGNATION OF THE RIGHTFUL OWNER OF THE MARK

41. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

42. As stated hereinabove, the evidence in this proceeding will demonstrate conclusively that, at the time Applicant was created, and at the time of its alleged first use of the Mark in dispute in this proceeding, *only Opposer Conseal* was engaged in a *bona fide* use of the "CRISPAIR" mark for the Goods in commerce.

43. As such, only Opposer Conseal, and not Applicant Nutek-Edgewater, could appear *as the rightful trademark owner / applicant* on a trademark application for "CRISPAIR" for the Goods.

44. As further stated hereinabove, Opposer Conseal has never assigned or licensed rights in the "CRISPAIR" mark, or any portion thereof, to Applicant Nutek-Edgewater, either expressly or by implication. Furthermore, Opposer Conseal and Applicant Nutek-Edgewater have never operated, either expressly or by implication, as related companies within the meaning of the Lanham Act.

45. Thus, regardless of whether Applicant Nutek-Edgewater has built, marketed, offered for sale, or sold any Goods under the "CRISPAIR" mark, any such activities only commenced *after* it was introduced to Conseal, the true and rightful owner of and applicant for the "CRISPAIR" mark for the Goods.

46. Therefore, based upon, *inter alia*, 37 C.F.R. § 2.33, 37 C.F.R. § 2.34, and 37 C.F.R. § 2.71(d), Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

COUNT V – APPLICATION VOID DUE TO FRAUDULENT MISREPRESENTATIONS REGARDING THE RIGHTFUL OWNER OF THE MARK

47. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

48. As stated hereinabove, the evidence will demonstrate that Moxley was fully aware of Conseal's senior trademark rights in the "CRISPAIR" mark for the Goods at all times from its alleged date of first use (a fabrication) through to and including the filing date of the Application in suit, the '358 application.

49. Specifically, Applicant Nutek-Edgewater knew, at the time it filed its '358 application for registration, that its statement that it, and not Opposer Conseal, was the

rightful owner of / applicant for the registration of "CRISPAIR" for the Goods was in fact false.

50. Applicant's representations were clearly fraudulent as Applicant, possessing direct, personal knowledge to the contrary, provided a *verified* statement / declaration that it was the rightful owner of / applicant for the registration of "CRISPAIR" for the Goods so as to fraudulently satisfy the statutory strictures of 37 C.F.R. § 2.33, 37 C.F.R. § 2.34, and 37 C.F.R. § 2.71(d).

51. Therefore, based upon, *inter alia*, 37 C.F.R. § 2.193(c)(2) and 37 C.F.R. § 10.18(b), Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

COUNT VI – APPLICATION VOID DUE TO MIS-DESIGNATION OF DATES OF FIRST USE

52. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

53. As stated hereinabove, Conseal's use of its "CRISPAIR" mark, which commenced at least as early as 1988, began long prior to the corporate creation of Applicant in 1996.

54. In addition, as stated above, the evidence in this proceeding will demonstrate conclusively that, at the time Applicant was created, and at the time of its alleged first use of the Mark in dispute in this proceeding, *only Opposer Conseal* was engaged in a *bona fide* use of the "CRISPAIR" mark for the Goods in commerce.

55. Specifically, Applicant did not commence a *bona fide* use of any kind (including a use affecting commerce) of the "CRISPAIR" mark for the Goods on or before January 17, 1997 as represented in its '358 application for registration (the application in suit).

56. Therefore, based upon, *inter alia*, 37 C.F.R. § 2.33 and 37 C.F.R. § 2.34, Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

COUNT VII – APPLICATION VOID DUE TO FRAUDULENT MISREPRESENTATIONS REGARDING DATES OF FIRST USE

57. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs.

58. As stated hereinabove, the evidence will demonstrate that Moxley was fully aware of Conseal's senior trademark rights in the "CRISPAIR" mark for the Goods at all times from its alleged date of first use (a fabrication) through to and including the filing date of the Application in suit, the '358 application.

59. Specifically, Applicant Nutek-Edgewater knew, at the time it filed its '358 application for registration, that its statement that it had commenced a *bona fide* use (constituting a *bona fide* use in commerce) on 01/17/1997 qualifying it, and not Opposer Conseal, as the rightful owner of / applicant for the registration of "CRISPAIR" for the Goods was in fact false.

60. Applicant's representations were clearly fraudulent as Applicant, possessing direct, personal knowledge to the contrary, provided a *verified* statement /

declaration attesting to its good-faith belief in the accuracy of the dates of first use and first use in commerce so as to fraudulently satisfy the statutory strictures of 37 C.F.R. § 2.33 and 37 C.F.R. § 2.34.

61. Therefore, based upon, *inter alia*, 37 C.F.R. § 2.193(c)(2) and 37 C.F.R. § 10.18(b), Conseal respectfully opposes Applicant's request for registration and requests that Applicant's registration application for "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR" be denied.

CONCLUSION

62. WHEREFORE, Opposer Conseal prays that, based upon the foregoing and the applicable law, the Board deny Applicant's request for registration of "CRISPAIR" in U.S. Trademark Application Serial Number 76/610,358 (the "'358 application") filed 09/07/2004 for the word mark "CRISPAIR."

Respectfully submitted,

CONSEAL INTERNATIONAL INCORPORATED

Paul W. Fulbright, Esq.
Law Office of Paul W. Fulbright, PLLC
2003 J J Pearce Drive
Richardson, Texas 75081-5447
Office tel: 972-907-8679
Office fax: 972-907-8879

ATTORNEY FOR
CONSEAL INTERNATIONAL INCORPORATED

CERTIFICATE OF MAIL UNDER 37 C.F.R. § 1.8

I hereby certify that the papers itemized below are being deposited with the U.S. Postal Service with sufficient postage as first class mail on the date indicated below in an envelope addressed to:

MAIL STOP TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

on October 28, 2005.

Subject Matter:

Trademark Application No.:	76/610,358
Filing Date:	09/07/2004
Mark:	CRISPAIR
Published for Opp'n:	08/30/2005
Law Firm File Ref. No.:	00077.0005

Itemized listing of contents of envelope:

(1) *Notice of Opposition* (14 pages);
(2) Check in the amount of $300.00 (1 check);
(3) Postcard Acknowledgment (1 postcard); and
(4) this Certificate of Mail Under 37 C.F.R. § 1.8 (1 page).

Paul W. Fulbright