

inhibitors, corrosion removers and surface treatments in International Class 3; and industrial lubricants used to clean, sanitize and maintain machinery and machinery parts in International Class 4. The Application was filed on December 7, 2001, and has been designated Application Serial Number 76/347,298. Applicant alleges a first use date of March 2000, and a date of first use in commerce of March 2000. The Application was published for opposition in the *Official Gazette* on October 15, 2002. On November 13, 2002 Opposer filed a Request for Extension of Time to File a Notice of Opposition requesting up to and including December 14, 2002 to file a Notice of Opposition. On December 13, 2002 Opposer filed a Second Request for Extension of Time to File a Notice of Opposition requesting up to and including January 13, 2003 to file a Notice of Opposition.

2. Ecolab is the leading global developer and marketer of premium cleaning, sanitizing, maintenance, and repair products and services for a variety of markets, including but not limited to industrial, institutional, and commercial markets. Ecolab provides a comprehensive array of cleaning, sanitizing, maintenance, and repair products and services to industrial facilities, food and beverage processing plants, dairy farms, pharmaceutical and cosmetic facilities, hospitals, healthcare facilities, nursing homes, restaurants, hotels, motels, convenience stores, schools, supermarkets, military facilities, prisons, athletic facilities, spas, office buildings, shopping malls, laundries, governmental entities, cruise ships, and other industrial, institutional, and commercial customers. Ecolab provides cleaning, sanitizing, and maintenance products used to keep industrial facilities and machinery, such as processing equipment, sanitary and operational. Ecolab provides industrial lubricants that both lubricate and sanitize equipment found in

processing plants. In addition, Ecolab provides kitchens and other foodservice providers with warewashing equipment, detergents, detergent dispensing systems, grease containment products and equipment, water filtration systems, floor mats, dish racks, training for foodservice employees, and equipment repair services, among other things. Ecolab offers comprehensive restroom cleaning products, equipment, and services including, cleaners, sanitizers, dispensers, touchless flushing systems, continuous urinal and toilet cleaners, and odor neutralizers. Ecolab offers the hospitality industry a full line of housekeeping products including bathroom cleaners, sanitizers, and advanced cleaner dispensing systems. Ecolab is also a leading supplier of commercial, institutional, and industrial laundry products, equipment, and services. Further, Ecolab offers pest elimination products and services, pool and spa products and services, vehicle care products and services, and water care products and services, among others. Opposer's annual worldwide sales were more than \$3 billion in 2001.

3. Opposer adopted the corporate trade name Ecolab Inc. in 1986 and has been using the Ecolab name and ECOLAB mark for virtually all of the various goods and services it offers since at least as early as 1986. Ecolab, through its related companies and predecessors-in-interest, has continuously provided a wide variety of goods and services under its various ECO-based marks from at least as early as November 1964, when Opposer began using the mark ECO-VAC in connection with detergent dispensers. Virtually all of Ecolab's products are labeled with the well-known and famous ECOLAB house mark. Virtually all of Ecolab's services are marketed and provided in connection with the well-known and famous ECOLAB house mark.

4. Opposer is the owner of numerous federal trademark and service mark registrations for marks containing the distinctive ECO formative or prefix. Many of these marks are used on cleaning, sanitizing, maintenance, and repair products used by people who and entities that could be interested in Applicant's goods. The table set forth below includes several members of Ecolab's Family of ECO-based marks:

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
1,073,420	ECO-KLENE	Liquid warewashing detergent for institutional use.	May 1976	September 20, 1977
1,097,987	ECO-TEMP	Dispenser for institutional dishwashing machines which electrically dispenses volumetrically measured amounts of detergents, sanitizers or rinse agents.	January 1977	August 1, 1978
1,119,076	ECO-SAN	Sanitizer and destainer for mechanical spray ware-washing machines.	February 1978	May 29, 1979
1,166,341	ECO-VAC	Dispenser Operating on Water Pressure, which Automatically Adds a Measured Amount of Liquid Detergents, Sanitizing Compounds and Rinse Additives to Water Supply and Maintains a Constant Concentration.	November 1964	August 25, 1981
1,225,370	ECOTEMP	Rental of Institutional Dishwashing Equipment to Others.	January 1977	January 25, 1983
1,335,023	ECOTEMP	Automatic Dishwashing Detergents, Sanitizer/Destainers, and Rinse Additives for Use Therewith, for Commercial and Institutional Use.	March 14, 1984	May 14, 1985
1,480,715	ECO-SPRAY	Pre-rinse and pre-flush unit for use at sinks.	February 9, 1987	March 15, 1988
1,497,423	ECOLAB	Insect, rodent and pest extermination and control services; janitorial services; leasing of dishwashing machines and related equipment Laundry and warewashing machines; parts and accessories therefor.	December 5, 1986	July 26, 1988
1,504,682	ECO-LINE	Detergent reservoir and dispenser	March 1987	September

		for dispensing measured amounts of warewashing, laundry and janitorial detergents and cleaners.		20, 1988
1,510,624	ECOLAB	Cleaning compound having water softening properties; cleaning compound for wall washing, paint cleaning, and general use; cleaning compound for windows, mirrors, painted and varnished woodwork, dishes, enamelware, kitchen utensils, glassware, silverware; and for a washing and cleaning compound used alone and in addition to soap for the cleaning of clothes.	January 28, 1988	November 1, 1988
1,524,340	ECOLAB	Dispensers for dispensing liquid, powder, or solid chemicals, detergents, cleansing, and rinsing agents in premeasured amounts.	April 1987	February 14, 1989
1,525,025	ECOLAB	Bleaching agents, starch and detergent for laundry use; all-purpose cleaning, polishing, scouring and abrasive preparations; stain, paint and varnish removing preparations; toilet soaps; dishwashing detergent; fabric softener for laundry use; rinsing agents for laundry use; solvent cleaning preparations for household use; all-purpose detergents; and degreasers for household and industrial use; preparations for destroying vermin, namely, fungicides, parasiticides, bactericides, germicides, insecticides and slimicides; all-purpose disinfectants and sanitizing preparations; insect repellants; air fresheners and deodorants for institutional/commercial, residential/consumer, and veterinary use Dispensers for dispensing liquid, powder, or solid chemicals, detergents, cleansing, and rinsing agents in premeasured amounts; Chemical products used in laundry and warewashing processes; water treatment chemicals; chemicals for treating fabrics.	October 5, 1986	February 21, 1989

1,527,356	ECOLAB	Insect, rodent and pest extermination and control services; laundry management; china, glassware, silverware and kitchen cleaning management and services; leasing of dishwashing machines and related equipment; maintenance of swimming pools, spas, cooling towers, boilers and other equipment to heat and cool buildings.	April 1, 1987	February 28, 1989
1,538,458	ECOLAB	Consulting services in the field of laundry, dishwashing, and industrial cleaning methods and equipment; and insect, pest and rodent extermination services.	May 31, 1987	May 9, 1989
1,538,718	ECOLAB	Chemical products, namely, anti-static and anti-fog preparations, surfactants, metal conditioners, and brightening and etching preparations, for use in restaurants, hotels, schools, health care and other institutions, the food, dairy and beverage processing industries, the manufacturing industry, the agricultural industry, the textile industry, the wholesale and retail trade industries, the sanitary services industry, and private households; organic intermediate chemicals for use in the manufacturing industry; chemical products used in laundry and warewashing processes; water treatment chemicals; chemicals for treating fabrics; chemical oil and fuel additives for use in the transportation, manufacturing and utilities industries; industrial solvents; chemical machining fluids; phosphatizing preparations; water softening salts; and fertilizers for agricultural, commercial and residential use.	April 1987	May 16, 1989
1,538,785	ECOLAB	Cleaning compound having water softening properties; cleaning compound for wall washing, paint cleaning, and general use; cleaning compound for windows, mirrors, painted and varnished woodwork, dishes, enamelware, kitchen utensils, glassware, silverware; and	May 31, 1988	May 16, 1989

		for a washing and cleaning compound used alone and in addition to soap for the cleaning of clothes.		
1,538,857	ECOLAB	Preparations for destroying vermin, namely, fungicides, parasiticides, bactericides, germicides, insecticides and slimicides; all-purpose disinfectants and sanitizing preparations; insect repellants; air fresheners and deodorants for institutional/commercial, residential/consumer, and veterinary use.	April 1987	May 16, 1989
1,539,982	ECOLAB	Bleaching agents, starch and detergent for laundry use; all-purpose cleaning, polishing, scouring and abrasive preparations; stain, paint and varnish removing preparations; toilet soaps; dishwashing detergent; fabric softener for laundry use; rinsing agents for laundry use; solvent cleaning preparations for household use; all-purpose detergents; and degreasers for household and industrial use.	April 1987	May 23, 1989
1,607,681	ECOSYSTEM	Pest extermination services; laundry management; china, glassware, silverware and kitchen cleaning management and services.	October 16, 1989	July 24, 1990
1,628,146	ECO-ALERT	Apparatus to monitor levels of detergents and rinse additives in reservoirs of institutional warewashing machines.	June 30, 1978	December 18, 1990
1,664,595	ECOTAINER	Plastic-lined cardboard containers for transporting, storing and dispensing a variety of cleaning products.	July 17, 1990	November 12, 1991
1,730,526	ECO-STAR	Laundry detergents, bleaches and fabric softeners for institutional and commercial laundry use.	September 1, 1988	November 10, 1992
1,750,698	ECOSHINE	Stainless steel polish for commercial and institutional use.	June 24, 1992	February 2, 1993
1,906,238	ECOPOWER	Cleaning preparations for commercial, institutional and household use.	September 6, 1994	July 18, 1995
1,943,805	ECOTEMP	Dispenser for institutional dishwashing machines which electronically dispense	October 1990	December 26, 1995

		volumetrically measured amounts of detergents, sanitizers or rinse additives Automatic dishwashing machines for commercial and institutional use.		
1,970,407	ECOSTAR	Dishwashing detergents, pot and pan detergents, rinse additives for use in automatic dishwashing machines; all for commercial and institutional use.	March 23, 1994	April 23, 1996
2,119,990	ECOPRO	Specialized pest extermination services rendered for specific markets.	August 17, 1996	December 9, 1997
2,253,131	ECOHEAT	Wastewater reclamation units for use in institutional and industrial laundries.	August 14, 1997	June 15, 1999
2,295,878	ECOFLO	Waste treatment services, namely, a service program for grease elimination for food service operations Biological grease digestant.	August 5, 1998	November 30, 1999
2,526,181	ECO-PORT	Software application tool that provides detailed reporting and comprehensive surveys of institutional and industrial laundries	September 13, 2001	January 1, 2002

5. In addition to its federally registered marks, Opposer possesses valuable common law rights in additional marks adopted by Opposer long prior to Applicant's claimed first use date of ECOPREP. Opposer's common law marks include, but are not limited to, the following marks: ECO CARE used in connection with personal hygiene systems used in food and beverage processing plants, ECO-STAR, which, in addition to the goods covered by Opposer's Reg. No. 1,730,526, is used in connection with hospitality laundry consulting services, training, and support services; automatic dispensing systems used to inject cleaning products into washers; and other laundry related products; ECOJET, used in connection with, among other things, a system and software used to dispense laundry liquids into washers and monitor the wash process;

ECOMAX for a warewashing control system; ECODAPTER for water filter retrofits; ECOCENTER for a warewashing detergent and rinse additive dispenser; ECOSPHERE for odor control systems. In addition, since at least as early as 1985 Opposer has used the mark ECOLINK for customer information and support services in the field of providing cleaning preparations and equipment. Since at least as early as January 1995 Opposer has used the mark ECO-CLEAN for, among other things, a line of cleaning products, including laundry detergents and dispensing systems, for use in the institutional and hospitality industries. Since at least as early as May 18, 1998 Opposer has used the mark 1-877-ECOWASH for telephone sale services. In 2002, Ecolab expanded the scope of its ECO-CARE mark and began using of the mark ECO-CARE in connection with a full line of laundry systems and cleaning products.

6. Opposer has expended considerable time, effort, and expense in promoting, advertising, and popularizing a family of ECO marks, including all the marks listed above (collectively "Opposer's Family of ECO Marks"), as well as the goods and services offered under Opposer's Family of ECO Marks, with the result that the purchasing public has come to know, rely upon, and recognize Opposer's Family of ECO Marks as indicators of the source of the goods and services so marked. Opposer has established valuable goodwill in Opposer's Family of ECO Marks.

7. Opposer's Family of ECO Marks is comprised of numerous marks containing the recognizable and distinctive ECO component. Opposer's Family of ECO Marks is advertised, promoted, and used as an entire family thereby giving common exposure to the entire family of ECO marks. Consequently, customers associate the common ECO component, as well as the individual marks in the family, with Opposer.

8. Opposer's Family of ECO Marks is distinctive, well known, and famous and has been so before Applicant claims to have first used the ECOPREP mark. The individual marks comprising Opposer's Family of ECO Marks are distinctive and well known and have been so before Applicant claims to have used the ECOPREP mark. Opposer's ECOLAB house mark is famous and became famous before Applicant claims to have first used the ECOPREP mark. Opposer's Family of ECO Marks has priority over Applicant's ECOPREP mark, as do the individual marks comprising Opposer's Family of ECO Marks that are specified above.

9. According to the identification of goods specified in the Application, Applicant's goods are industrial in nature. On information and belief, Applicant's goods (those claimed in International Classes 1, 3, and 4) could be marketed in the industrial channels of trade in which Opposer markets and sells products and offers services under the ECOLAB mark, Opposer's Family of ECO Marks, and individual marks that comprise Opposer's Family of ECO Marks. On information and belief, Applicant's industrial chemicals, cleaners, and lubricants are likely to be purchased and/or used by the same people who purchase and/or use Opposer's products and services. Those accustomed to using products and services sold under the ECOLAB house mark and additional ECO marks could naturally but mistakenly assume that Applicant's ECOPREP products are somehow affiliated with, sponsored by, or connected with Opposer.

10. The ECOPREP mark Applicant seeks to register so resembles Opposer's ECOLAB mark, Opposer's Family of ECO Marks, and the other individual marks comprising Opposer's Family of ECO Marks, as to be likely, when used on or in connection with the goods listed in the Application, to cause confusion, or to cause

mistake, or to deceive. Purchasers, prospective purchasers, and post-sale users are likely to mistakenly believe that the goods of Applicant offered under the mark ECOPREP are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer, all to the detriment of Opposer. Registration of Applicant's mark should, therefore, be refused under 15 U.S.C. §§ 1052(d) and 1063.

11. Registration of the mark ECOPREP would be a further source of damage to Opposer, as the mark Applicant seeks to register is likely to cause dilution of the distinctive quality of Opposer's famous ECOLAB house mark and Opposer's famous Family of ECO Marks, to the detriment of Opposer. Registration of Applicant's mark should, therefore, be refused under 15 U.S.C. §§ 1052(d), 1063 and 1125.

12. Registration of the mark ECOPREP would be a further source of damage to Opposer, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposer's prior use of its ECOLAB mark, as well as its long prior use of Opposer's Family of ECO Marks, and Opposer's long prior registration and use of many of the marks in Opposer's Family of ECO Marks.

WHEREFORE, Opposer Ecolab prays that Application Serial No. 76/347,298 in International Classes 1, 3, and 4 be rejected, and that registration of the mark therein for the goods therein specified be refused.

A duplicate copy of this Notice of Opposition and the fee in the amount of \$900 as required by 37 C.F.R. §§ 2.6(a)(17) and 2.104(a) are enclosed herewith.

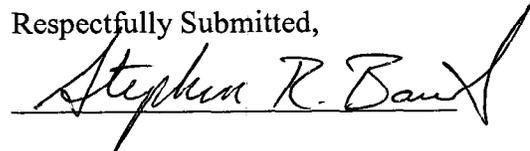
The Commissioner is authorized to draw on the Deposit Account of Fish & Richardson P.C., P.A., Account No. 06-1050/11434/201PP1, if the accompanying check is insufficient or if the check is inadvertently omitted. In the event the check is in excess

of the amount needed for fees, please deposit the excess in Deposit Account No. 06-1050/11434/201PP1. Please return the enclosed postcard to evidence receipt of this Notice of Opposition.

Please return the enclosed postcard to evidence receipt of this Notice of Opposition.

Date: 12/31/02

Respectfully Submitted,



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01-02-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #73

**IN THE UNITED STATES PATENT AND TRADEMA
BEFORE THE TRADEMARK TRIAL AND APPEA**

In the Matter of Trademark Application Serial Nos. 76/347,298
For the mark ECOPREP
Filed: December 7, 2001

ECOLAB INC.,)
) Opposer,)
))
v.)
))
ECOTECH, INC.,)
) Applicant.)

Atty. Docket No. 11434/201PP1

TRANSMITTAL

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Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

01-02-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #73

Sir or Madam:

Transmitted herewith please find the following documents:

1. Notice of Opposition (original and two copies);
2. Check in the amount of \$900.00 to cover filing fee; and
3. Return postcard.

Please date stamp the enclosed postcard and return.

If the check is inadvertently omitted, or should any additional fees be required for any reason relating to the enclosed materials, or should any overpayment be included

CERTIFICATE OF MAILING BY EXPRESS MAIL

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I hereby certify under 37 CFR §1.10 that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee with sufficient postage on the date indicated below and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

December 31, 2002

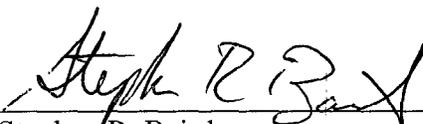
Date of Deposit
Russell Smith
Signature

Russell Smith
Typed or Printed Name of Person Signing Certificate

therein, the Assistant Commissioner is authorized to deduct or credit said fees from Fish and Richardson Deposit Account No. 06-1050/11434/201PP1.

Respectfully submitted,

Dated: December 31, 2002


Stephen R. Baird

SRB:cak
Enclosure

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