UNITED STATES DEPARTMENT OF COMMERCE
**Patent and Trademark Office**
**Trademark Trial and Appeal Board**
2900 Crystal Drive
Arlington, Virginia 22202-3513

07-01-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

Mailed: June 23, 2004

**Opposition No 91160997**
**Serial No. 78245632**

**TTAB**

NORMAN J.K. BISHOP
BISHOP & MCKENZIE
2500, 10104 - 103 AVENUE
EDMONTON T5J 1V3 CAX - CAN, AD

**Ace Duraflo Systems, LLC**

v.

**CURAFLO TECHNOLOGIES INC.**

Jeff C. Risher
RUTAN & TUCKER, LLP
611 Anton Blvd.; Suite 100
Placentia, CA 92870

**Helen Johnson, Legal Assistant**

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12,

2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available at www.uspto.gov.

**The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.**

**Discovery and testimony periods are set as follows:**

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| Discovery period to open: | **July 13, 2004** |
| Discovery period to close: | **January 09, 2005** |
| 30-day testimony period for party in position of plaintiff to close: | **April 09, 2005** |
| 30-day testimony period for party in position of defendant to close: | **June 08, 2005** |
| 15-day rebuttal testimony period for plaintiff to close: | **July 23, 2005** |

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

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

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled *"Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board,"* 1235 TMOG 68 (June 20, 2000). The notice is available at http://www.uspto.gov. Interlocutory matters which the Board agrees to discuss or decide by phone conference may

be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

**New Developments at the Trademark Trial and Appeal Board**

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABVue at http://ttabvue.uspto.gov.

ESTTA Tracking number: **ESTTA10512**
Filing date: **06/22/2004**

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

# Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

## Opposer Information

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|---|---|
| **Name** | Ace Duraflo Systems, LLC |
| **Granted to Date of previous extension** | 08/08/2004 |
| **Address** | Ace Duraflo Systems, LLC<br>711 W. Kimberly Avenue Suite 100<br>Placentia, CA 92870<br>UNITED STATES |
| **Attorney information** | Jeff C. Risher<br>RUTAN & TUCKER, LLP<br>611 Anton Blvd., Suite 1400<br>Costa Mesa, CA 92626<br>UNITED STATES<br>jrisher@rutan.com, dharbottle@rutan.com Phone:(714) 338-1853 |

## Applicant Information

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|---|---|---|---|
| **Application No** | 78245632 | **Publication date** | 02/10/2004 |
| **Opposition Filing Date** | 06/22/2004 | **Opposition Period Ends** | 08/08/2004 |
| **Applicant** | CURAFLO TECHNOLOGIES INC. | | |

**Goods/Services Affected by Opposition**

Class 040. First Use: 20010312 First Use In Commerce: 20010312
All goods and sevices in the class are opposed, namely: Lining of inside of pipes to prevent corrosion and cure leaks, a diagnostic service on water pipes to determine pipe strength and water flow characteristics

Curaflo Technologies, Inc. v. Ace Duraflo Systems, LLC, United States District Court, Western District of Washington, Case No. CV03-1214P

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|---|---|
| **Attachments** | Opposition_CURAFLO.txt ( 2 pages ) |

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|---|---|
| **Signature** | /jeff risher/ |
| **Name** | Jeff C. Risher |
| **Date** | 06/22/2004 |

Ace Duraflo Systems, LLC ("Opposer"), a Nevada limited liability company, whose business address is 711 W. Kimberly Avenue, Suite 100, Placentia, CA 92870, UNITED STATES, hereby opposes registration of the mark CURAFLO (Serial Number 78/245632) in International Class 40, as applied for by Curaflo Technologies, Inc. ("Applicant"), which application was published for opposition in the Official Gazette on February 10, 2004.

As grounds for opposition, it is alleged that:

1. Opposer is a Nevada limited liability company having a principal place of business in California.

2. On information and belief, Applicant is a British Columbia corporation having its principal office at 202-6200 Darnley Street, Burnaby, British Columbia, CANADA V5B 3B1, Canada and/or 502-595 Howe Street Vancouver, British Columbia CANADA V6C 2T5.

3. Opposer is the exclusive licensee of the ACE DURAFLO mark, U.S. Trademark Registration No. 2,484,383, in the United States. The ACE DURAFLO mark is registered in, among others, International Class 40 for "the treatment of materials, namely the mechanical cleaning and treatment of pipes and tubes for the purpose of repair, restoration, renovation and preservation of such installations." The registration for the ACE DURAFLO mark is valid and subsisting, and Opposer has been using the mark ACE DURAFLO in connection with the goods and services identified therein, including cleaning and repairing piping systems, continuously since at least as early as 1999.

4. Through substantial expenditures of time, money, labor and other efforts to develop and market goods and services under the ACE DURAFLO Mark, Opposer has created a distinctive means of identifying itself as the source of the goods and services offered under the the ACE DURAFLO Mark. Opposer has established substantial public recognition and usage of the ACE DURAFLO Mark, which symbolizes Opposer's valuable goodwill. Opposer has both common law and statutory rights in the ACE DURAFLO Mark.

5. The pending CURAFLO mark, as applied for by Applicant, is likely to be confused with Opposer's mark ACE DURAFLO, which Opposer has been using prior to Applicant's alleged first use. Opposer's first use of the mark ACE DURAFLO dates as early as May 1999, while Applicant's first use of its confusingly similar mark is reported as March 2001. Hence, Applicant is not entitled to adopt, use or seek registration of its mark based upon well established trademark principles set forth in the Lanham Act, which states that priority of similar or confusing marks goes to the first user of the mark.

6. Applicant's mark CURAFLO is sufficiently similar to Opposer's mark ACE DURAFLO in sight, connotation, pronunciation, and commercial impression that use of the respective marks will create a likelihood of confusion among members of the trade and public.

7. The services described in Applicant's application are of the same nature as those services offered by Opposer, such that the trade and purchasing public would reasonably anticipate that such services would

originate from the same source. In fact, Applicant now competes directly with Opposer in the marketplace for cleaning and lining piping systems in commercial and residential structures.

8. Applicant and Opposer both market, advertise and undertake promotional activities concerning the serviced provided under their respective marks through the same channels, including without limitation the internet, trade shows, direct mailings and magazine advertisements.

9. Applicant competes for business in the same geographic markets a s Opposer throughout the United States, including without limitation California, Florida, Texas, Maryland, Virginia and West Virginia.

10. Applicant was aware of Opposer's ACE DURAFLO at the time that Applicant selected the mark CURAFLO, and Opposer is informed and believes that Applicant did so to capitalize on the similarities in sight, sound and connotation between the marks and to exploit a likelihood of confusion with Opposer's senior mark.

11. Because Applicant's and Opposer's services are extremely similar and compete directly in the marketplace, and are offered and provided through similar channels of trade to the same types of customers in the same geographic markets, and because Applicant's CURAFLO mark, which was selected after Opposer's ACE DURAFLO mark, is substantially similar in sight, connotation, pronunciation, and commercial impression to ACE DURAFLO, any problems or lack of quality of service on behalf of Applicant will reflect adversely on Opposer and its established goodwill and reputation, unless this opposition is sustained.

12. Applicant's use of the CURAFLO mark will dilute or impair Oppose r's rights, and will eventually result in a loss of distinctiveness and exclusivity of Opposer's mark. Confusion and mistake by members of the trade and public will occur, and indeed has already occurred, as between Opposer's and Applicant's marks and as to the origin of similar services, with resulting damage to Opposer. Thus, this Opposition should be sustained.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that the registration of Applicant's mark CURAFLO (Serial No. 78/245632) be refused.

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