

ESTTA Tracking number: **ESTTA73415**

Filing date: **03/29/2006**

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

Name	Ecolab Inc.
Granted to Date of previous extension	03/29/2006
Address	370 Wabasha Street N.ESC/F7 St. Paul, MN 55102 UNITED STATES

Correspondence information	Edward R. Courtney Ecolab Inc. 370 Wabasha Street N.ESC/F7 St. Paul, MN 55102 UNITED STATES edward.courtney@ecolab.com Phone:651-795-5978
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Applicant Information

Application No	76632160	Publication date	11/29/2005
Opposition Filing Date	03/29/2006	Opposition Period Ends	03/29/2006
Applicant	NSDC, LLC 715 Branch Avenue Suite 101 Providence, RI 02904 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Pet odor removers
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Attachments	Notice of Opposition 2006 03 29.pdf (14 pages)
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Signature	/erc/
Name	Edward R. Courtney
Date	03/29/2006

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

In the matter of Application Serial No. 76/632,160
Filed February 25, 2005
For the mark ECOSETS & Design
Published in the *Official Gazette* (Trademarks) on November 29, 2005
Attorney Docket No. OPP-76/632,160

ECOLAB INC.,

Opposer,

v.

NSDC, LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Ecolab Inc. (“Ecolab” or “Opposer”), a Delaware corporation having a principal place of business at 370 Wabasha Street North, Saint Paul, Minnesota 55102, believes that it will be damaged by registration of the mark ECOSETS & Design shown in Application Serial No. 76/632,160 (“Application”) for goods identified in International Class 3, filed by NSDC, LLC (“Applicant”), on February 25, 2005, and hereby opposes the same.

The grounds for opposition are as follows:

1. By the Application herein opposed, Applicant is seeking to obtain under provisions of the Trademark Act of 1946, as amended, registration on the Principal Register of the design mark ECOSETS for “pet odor removers” in International Class 3.
2. Applicant’s mark was published for opposition in the *Official Gazette* on November 29, 2005. Opposer filed subsequent extension of time to oppose that the TTAB granted until March 29, 2006. This Notice of Opposition is timely filed.
3. Founded in 1923, Ecolab is the leading global developer and marketer of premium cleaning, sanitizing, pest elimination, maintenance and repair products and services for a variety

of markets, including but not limited to the agricultural, commercial, food service, healthcare, hospitality, institutional and industrial markets. Opposer's annual worldwide sales were more than \$4.1 billion in 2004.

4. 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.

5. Opposer is the owner of Registration No. 1,525,025 for the mark ECOLAB for "chemical products used in laundry and ware-washing processes; water treatment chemicals; chemicals for treating fabrics" in International Class 1; "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" in International Class 3; "preparations and destroying vermin, namely, fungicides, parasiticides, bactericides, germicides, insecticides and slimicides; all-purpose disinfectants and sanitizing preparations; insect repellents; air fresheners and deodorants for institutional/commercial, residential/consumer, and veterinary use" in International Class 5; and "dispensers for dispensing liquid, powder, or solid chemicals, detergents, cleansing, and rinsing agents in premeasured amounts" in International Class 9. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the

registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 115.

6. Opposer is the owner of Registration No. 1,538,857 for the design mark ECOLAB for "preparations 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" in International Class 5. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 115.

7. Opposer is the owner of Registration No. 1,504,682 for the mark ECO-LINE for "detergent reservoir and dispenser for dispensing measured amounts of ware-washing, laundry and janitorial detergents and cleaners" in International Class 9. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 115.

8. Opposer is the owner of Registration No. 2,691,203 for the mark ECOSPHERE for "air fresheners and deodorizers" in International Class 5; and "dispensing unit for air fresheners and deodorizers" in International Class 11.

9. Opposer is the owner of Application Serial No. 78/418,345 for the mark ECOLOGIC for "cleaning preparations; namely, all-purpose cleaners, bathroom cleaners, bleaches, carpet cleaners, dishwashing detergents, drain cleaners, fabric softeners, glass cleaners, floor cleaners, furniture polishes, heavy duty degreasers, laundry detergents, laundry sour, metal polishes,

multi-purpose degreasers, oven cleaners, presoaks, rinse additives, soaps, spot removers, tile cleaners and toilet bowl cleaners” in International Class 3; “all-purpose disinfectants, odor neutralizing preparations for use on carpets, clothes, textiles and hard surfaces, and sanitizers for commercial, household, institutional and industrial use” in International Class 5; “manual cleaning preparation dispensers and soap dispensers” in International Class 21; and “educational services, namely, conducting programs in the proper selection, installation, and use of cleaning products, disinfecting products, sanitizing products and dispensers” in International Class 41.

10. Opposer is the owner of numerous federal trademark and service mark registrations for a family of marks containing the distinctive ECO formative or prefix. Many of these marks are identify as air fresheners, cleaners and deodorizers that are used by the same class of customer or entities that could be interested in Applicant’s products.

11. 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
0,415,960	ECONO SOUR (Stylized)	Laundry sour.	June 3, 1940	February 24, 1945
1,046,367	ECONO-BAGS	Plastic trash can liners.	September 9, 1975	August 17, 1976
1,073,420	ECO-KLENE	Liquid ware-washing 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

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
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 ware-washing machines; parts and accessories therefore.	December 5, 1986	July 26, 1988
1,504,682	ECO-LINE	Detergent reservoir and dispenser for dispensing measured amounts of ware-washing, laundry and janitorial detergents and cleaners.	March 1987	September 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

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
1,525,025	ECOLAB	Chemical products used in laundry and ware-washing processes; water treatment chemicals; chemicals for treating fabrics”; 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 and destroying vermin, namely, fungicides, parasiticides, bactericides, germicides, insecticides and slimicides; all-purpose disinfectants and sanitizing preparations; insect repellents; air fresheners and deodorants for institutional/commercial, residential/consumer, and veterinary use; and Dispensers for dispensing liquid, powder, or solid chemicals, detergents, cleansing, and rinsing agents in premeasured amounts.	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

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
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, healthcare 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 ware-washing 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 for a washing and cleaning compound used alone and in addition to soap for the cleaning of clothes.	May 31, 1988	May 16, 1989
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

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
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 determine; 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 ware-washing 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
1,750,698	ECOSHINE	Stainless steel polish for commercial and institutional use.	June 24, 1992	February 2, 1993
1,943,805	ECOTEMP	Dispenser for institutional dishwashing machines which electronically dispense volumetrically measured amounts of detergents, sanitizers or rinse additives. Automatic dishwashing machines for commercial and institutional use.	October 1990	December 26, 1995
1,970,407	ECOSTAR (Stylized)	Dishwashing detergent, pot and pan detergents, rinse additives for use in automatic dishwashing machines; all for commercial and institutional use.	March 23, 1994	April 23, 1996
2,199,990	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
2,691,203	ECOSPHERE	Air fresheners and deodorizers. Dispensing unit for air fresheners and deodorizers.	August 12, 1998	February 25, 2003

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
2,768,068	ECOSURE	Conducting inspections regarding food safety; providing consulting services in the field of food safety, food manufacturing and food manufacturing recalls; designing food safety programs for others. Preparing business reports in the field of food safety; business auditing in the field of food manufacturing; business evaluation of food manufacturing recalls.	November 9, 2000	September 23, 2003
2,810,490	ECONET	Computer network information system comprising computer hardware, computer software, network hardware and network software all for use in allowing users to remotely access company documents and information; Business information management; namely, providing company documents and information to users through remote computer access.	September 1, 2001	February 3, 2004
2,879,478	ECOCARE	Full line of laundry cleaning products; namely, bleaches, detergents, fabric conditioners, fabric softeners, laundry alkalis, laundry sours and water conditioners.	August 1, 2002	August 31, 2004
2,879,556	ECOSHIELD	Providing quality assurance services in the field of cleaning, disinfecting, sanitizing, personal hygiene and pest elimination for the beverage, dairy and food processing industry.	July 1, 2003	August 31, 2004
2,942,042	ECONO-HIGH	Vehicle car preparations, namely, presoaks, detergents, surfactant, polishes and drying agents.	March 30, 2004	April 19, 2005
2,942,043	ECONO-LOW	Vehicle car preparations, namely, presoaks, detergents, surfactant, polishes and drying agents.	March 30, 2004	April 19, 2005
2,946,126	ECONO-FOAM	Vehicle car preparations, namely, presoaks, detergents, surfactant, polishes and drying agents.	March 30, 2004	May 3, 2005
2,947,938	ECONO-TIRE	Vehicle car preparations, namely, presoaks, detergents, surfactant, polishes and drying agents.	March 30, 2004	May 10, 2005
2,965,156	ECONO-DRY	Vehicle car preparations, namely, presoaks, detergents, surfactant-based cleaning preparations, polishes and drying agents.	March 30, 2004	July 5, 2005
3,001,035	1-877-ECOWASH	Customer support services, namely, processing telephone inquires regarding advertised goods and services, and order fulfillment; Telephone information services featuring information regarding cleaning products and equipment for car wash facilities.	May 18, 1998	September 27, 2005

U.S. Reg. No.	Mark	Goods/Services	Date of First Use	Date of Registration
Pending	ECOPAC (Stylized)	Political action committee services, namely, promoting corporate and employee interests in the field of politics; Providing information regarding political issues.	January 1, 1992	December 13, 2005
Pending	ECOCARE	Hand cleaner for use in food and beverage processing plants; Hand sanitizers for use in food and beverage processing plants; Dispensers used to dispense cleaners and sanitizers in food and beverage processing plants.	December 3, 1998	Pending
Pending	ECOLOGIC	Cleaning preparations; namely, all-purpose cleaners, bathroom cleaners, bleaches, carpet cleaners, dishwashing detergents, drain cleaners, fabric softeners, glass cleaners, floor cleaners, furniture polishes, heavy duty degreasers, laundry detergents, laundry sours, metal polishes, multi-purpose degreasers, oven cleaners, presoaks, rinse additives, soaps, spot removers, tile cleaners and toilet bowl cleaners; All-purpose disinfectants, odor neutralizing preparations for use on carpets, clothes, textiles and hard surfaces, and sanitizers for commercial, household, institutional and industrial use; Manual cleaning preparation dispensers and soap dispensers; Educational services, namely, conducting programs in the proper selection, installation, and use of cleaning products, disinfecting products, sanitizing products and dispensers.	Pending	Pending
Pending	ECOFLEET	Vehicle care preparations, namely, aluminum wheel cleaners, bug removers, carpet cleaners, car waxes, detergents, drying agents, glass cleaners, pre-soaks, soaps, tar removers, tire cleaners and underbody sealants for use on land vehicles; Air fresheners; Business consultation services, namely, conducting surveys, monitoring inventory and providing statistical information to others; Business consultation services, namely, conducting inspections, monitoring inventory and providing statistical information to others.	Pending	Pending
Pending	ECO-WIPE	Sanitizing wipes.	Pending	Pending

12. In addition to its federally registered marks and pending federal applications, Opposer possesses valuable common law rights in additional marks adopted by Opposer prior to the filing date of the Application. Opposer's common law marks include, but are not limited to, the following marks: 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 ware-washing control system; ECODAPTER for water filter retrofits; ECOCENTER for a ware-washing detergent and rinse additive dispenser; ECO2000 used in connection with a cockroach elimination program and related products; ECOLINK for customer information and support services in the field of providing cleaning preparations and equipment; and 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.

13. Opposer has expended considerable time, effort, and expense in promoting, advertising and popularizing a family of ECO marks, including but not limited to all the marks listed in the paragraphs 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.

14. 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 common ECO component, as well as the individual marks in the family, with Opposer.

15. Upon information and belief, Applicant did not commence use of the ECOPETS & Design mark prior to first use of Opposer's Family of ECO Marks, or certain individual marks in the family.

16. Opposer's Family of ECO Marks is distinctive, well known, and famous, and has been so before the filing date of the Application.

17. The individual marks comprising Opposer's Family of ECO Marks are distinctive and well known and have been so before the filing date of the Application.

18. Opposer's ECOLAB house mark is famous and became famous before the filing date of the Application.

19. Opposer's Family of ECO Marks has priority over the ECOPETS & Design mark shown in the Application, as does the ECOLAB house mark and many of the other marks that comprise Opposer's Family of ECO Marks that are specified above.

20. Applicant's ECOPETS & Design mark is similar in sight, sound, and commercial impression to Opposer's Family of ECO Marks.

21. The goods identified in the ECOPETS Application are identical to and/or related to and/or directly competitive with Opposer's air freshening, cleaning and deodorizing products, and related services.

22. Applicant's air freshening, cleaning and deodorizing product could be marketed in the same channels of trade in which Opposer markets and sells products and services under the ECOLAB mark, Opposer's Family of ECO Marks, and individual marks that comprise Opposer's Family of ECO Marks.

23. Applicant's air freshening, cleaning and deodorizing products could be purchased by the same class of customers in the industries who purchase and/or use Opposer's products and services.

24. Registration by Applicant of the design mark ECOPETS for Applicant's goods is likely to cause confusion or to cause mistake and deception in the relevant trade channels, and among the purchasers or potential purchasers, with Opposer's previously used and registered ECOLAB mark and marks within Opposer's Family of ECO Marks.

25. The ECOPETS & Design mark that Applicant seeks to register so resembles Opposer's ECOLAB house 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 Applicant's goods, to cause confusion, mistake, or deception. Purchasers and prospective purchasers are likely to mistakenly believe that Applicant's products offered under the design mark ECOPETS are produced, sponsored, endorsed or approved by Opposer, or are in some way affiliated, connected or associated with Opposer, causing damage to Opposer. Registration of Applicant's mark should, therefore be refused under 15 U.S.C. §§ 1052(d) and 1063.

26. Registration of the ECOPETS & Design mark by Applicant would dilute the distinctive quality of Opposer's famous ECOLAB house mark, Opposer's Family of ECO Marks, and the other individual marks comprising Opposer's Family of ECO Marks, causing further damage to Opposer. Registration of Applicant's mark should, therefore be refused under 15 U.S.C. §§ 1052(d)(f) and 1125.

27. Registration of the ECOPETS & Design mark 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 prior use of Opposer's Family of ECO Marks, and Opposer's prior registration and use of many of the individual marks in Opposer's Family of ECO Marks, resulting in further damage to Opposer.

WHEREFORE, Opposer Ecolab prays that Application Serial No. 76/632,160 in International Class 3 be rejected, and that registration of the marks therein for the goods therein specified be refused.

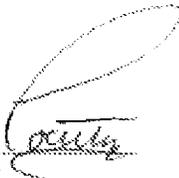
The Commissioner is authorized to draw on the Deposit Account of Ecolab Inc, Deposit Account No. 050450, for payment of the requisite \$300 fee as required by 37 C.F.R. §§ 2.6(a)(17) and 2.104(a).

Respectfully Submitted,

ECOLAB INC.

Date: March 29, 2006

By:



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