

ESTTA Tracking number: **ESTTA122120**

Filing date: **01/29/2007**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Zurn Industries, Inc.
Granted to Date of previous extension	01/28/2007
Address	1801 Pittsburgh Avenue Erie, PA 16514 UNITED STATES

Name	Zurco, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	300 Delaware Avenue Suite 1704 Wilmington, DE 19801 UNITED STATES		

Attorney information	John W. McIlvaine The Webb Law Firm 700 Koppers Building 436 Seventh Avenue Pittsburgh, PA 15219 UNITED STATES webblaw@webblaw.com Phone:412-471-8815
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Applicant Information

Application No	78799221	Publication date	08/01/2006
Opposition Filing Date	01/29/2007	Opposition Period Ends	01/28/2007
Applicant	American Standard International Inc. 33rd Floor 1370 Avenue of the Americas New York, NY 10019 UNITED STATES		

Goods/Services Affected by Opposition

Class 011. All goods and services in the class are opposed, namely: Faucets, bath and shower valves
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Attachments	w0332797.pdf (4 pages)(32209 bytes)
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Signature	/JWMc/
Name	John W. McIlvaine
Date	01/29/2007

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

In the matter of	:	
	:	Opposition No.
ZURN INDUSTRIES, INC. and	:	
ZURCO, INC.	:	
	:	Application Serial No. 78/799,211
Opposers,	:	
	:	
v.	:	
	:	
AMERICAN STANDARD	:	
INTERNATIONAL, INC.	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

Zurn Industries, Inc. (“Zurn”) has its principal place of business at 1801 Pittsburgh Avenue, Erie, PA 16514 and believes that it will be damaged by the registration of the alleged mark “ONE” to American Standard International, Inc. (referred to hereinafter as “Applicant”) shown in Application Serial No. 78/799,221 (referred to hereinafter as “the Application”). Zurn hereby opposes the Application under the provisions of 15 U.S.C. §1063.

Zurco, Inc. (“Zurco”) has its principal place of business at 300 Delaware Avenue, Suite 1704, Wilmington, DE 19801 and believes that it will be damaged by the registration of the alleged mark “ONE” to American Standard International, Inc. (referred to hereinafter as “Applicant”) shown in Application Serial No. 78/799,221 (referred to hereinafter as “the Application”). Zurco hereby opposes the Application under the provisions of 15 U.S.C. §1063.

As grounds for opposing the Application, Zurn and Zurco (“Opposers”) aver as follows:

1. Upon information and belief, Applicant is a corporation located at 33rd Floor 1370 Avenue of the Americas, New York, NY 10019.

2. Applicant filed an Application for registration of the mark “ONE” on January 25, 2006, Application Serial No. 78/799,221, for the following services in International Class 011 “Faucets, bath and shower valves” (“the Application”). Applicant’s alleged mark was published in the August 1, 2006 issue of the Trademark Official Gazette of the U.S. Patent and Trademark Office.

3. Zurco is the owner of U.S. Trademark Registration No. 3,030,515 for the mark “ZURN ONE” registered December 13, 2005, for “Plumbing fixtures sold in package form for industrial and commercial use, namely toilets, sinks, urinals, hand dryers and automatic hand dryers, and corresponding flush valves and automatic flush valves, faucets and automatic faucets, traps, supply stops, carrier mountings and fittings therefor, and toilet closet flanges” in International Class 011 and is also the owner of U.S. Registration No. 3,077,424 for the mark “ZURN ONE SYSTEMS” registered April 4, 2006 for “Plumbing fixtures sold in package form for industrial and commercial use, comprising faucets, sensors, flush valves, traps, supply stops, tubing for drains, traps and fixtures, carrier mountings and fittings therefor, toilet closet flanges, and corresponding toilets, sinks and urinals” in International Class 011 (“the Marks”).

4. Zurn is licensed by Zurco to make use of the Marks, and Zurn has made use of the Marks under license from Zurco continuously since at least as early as 2003. Zurn and Zurco are related companies.

5. Zurn is engaged in the manufacture and sale of goods as set forth in connection with the Marks, above, and related services.

6. Zurn spends substantial sums to advertise and otherwise promote its products under the Marks.

7. Because of the long and extensive use made of the Marks by Zurn in connection with the aforementioned goods, the Marks enjoy strong name recognition and goodwill in the relevant markets.

8. The continued strength of the Marks is crucial to the continued success of the business of Zurn and Zurco.

9. To the extent they have been used to date, Applicant commenced the use of the alleged mark in the Application in the United States after the date of registration by Zurco for the Marks.

10. Applicant's proposed use of the mark "ONE" under Application Serial No. 78/799,221 for "Faucets, bath and shower valves" which will be sold and promoted in the same channels of trade, is likely to be confused with Zurn's use of the Marks, in that consumers would believe that Applicant's services are sponsored by, affiliated with or approved by Zurn.

11. The registration of the mark "ONE" by Applicant on the Principal Register of the U.S. Patent and Trademark Office would be inconsistent with Opposers' rights in the Marks and would damage Opposers.

12. 15 U.S.C. §1052(d) bars Applicant's mark from registration.

13. By making use of the alleged mark "ONE" and seeking registration thereof, Applicant has attempted to appropriate the goodwill associated with the Marks.

WHEREFORE, Opposers pray that this Opposition be decided in their favor and that the Application be rejected, and that no registrations be issued for or in connection with the Application.

The undersigned hereby authorizes the U.S. Patent and Trademark Office to charge any additional fees to Deposit Account No. 23-0650 and refund any overpayment in the form of a check.

Respectfully submitted,

Dated: January 29, 2007

By 
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