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

Proceeding	91194706
Party	Plaintiff 1047406 Ontario Ltd. and Purifics ES, Inc.
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<b>1047406 Ontario Ltd. and</b>	)	
<b>Purifics ES, Inc.,</b>	)	
	)	
<b>Opposers</b>	)	<b>Opposition No.: 91,194,706</b>
	)	
<b>v.</b>	)	
	)	
<b>UVCleaning Systems, Inc., dba Puralytics</b>	)	
<b>Corporation,</b>	)	
	)	
<b>Applicant.</b>	)	

**MAIN BRIEF OF  
OPPOSERS 1047406 ONTARIO LTD. AND PURIFICS, ES, INC.**

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## **I. SUMMARY OF OPPOSERS' ARGUMENT**

- Applicant did not limit its description of goods in the Application.
- Applicant did not limit its description of trade channels in the Application.
- Applicant did not limit its description of classes of consumers in the Application.
- "PURIFICS" and "PURALYTICS" marks are similar in overall commercial impression.

## **II. INTRODUCTION**

Opposers 1047406 Ontario Ltd. and Purifics ES, Inc. (collectively, "Opposers" or "Purifics") have operated in the water treatment industry for more than twenty years. Opposers focus exclusively on water purification goods and services, and they have received numerous awards and accolades over the years for their water purification devices and related services. Opposers offer their water purification goods and services to a variety of customers, including universities, industrial manufacturers, retail customers and individuals. Opposers own U.S. Registration No. 2,062,935 (the "Registration") for the "PURIFICS" mark with water purification services in International Class 40. Opposers also own the common-law mark "PURIFICS" for water purification goods that they manufacture and sell. Opposers have used their "PURIFICS" mark with their water purification goods and services in interstate commerce since at least December 1993.

Applicant UVCleaning Systems, Inc. d/b/a Puralytics ("Applicant" or "Puralytics") is a newcomer to the water purification industry, with alleged commercial use beginning only in 2009. Applicant owns U.S. Application Serial No. 77/861,438 for the mark "PURALYTICS" with water purification goods in International Class 11 (the "Application"). Applicant filed the intent-to-use Application in October 2009 with no limitation in the description of goods, channels of trade, or classes of consumers.

Based on the arguments and evidence discussed below, Opposers respectfully request that the Board refuse to register Applicant's mark "PURALYTICS" for water purification goods based on a likelihood of confusion with Opposers' water purification goods and services offered under the "PURIFICS" mark.

### **III. PROCEDURAL HISTORY**

Opposers filed an application to register the mark "PURIFICS" for environmental remediation services, including waste and water treatment services in International Class 40 and received the Registration on May 20, 1997.

More than a decade after Opposers registered their mark, Applicant filed its Application seeking to register the "PURALYTICS" mark for water purification goods. On April 30, 2010, Opposers timely filed their Notice of Opposition against Puralytics' Application (Opposition No. 91,194,706).

### **IV. EVIDENTIARY OBJECTIONS**

Applicant offers inadmissible documents and testimony in support of registering its "PURALYTICS" mark for water purification goods. The Board should reject Applicant's documents and testimony because neither are admissible in this proceeding. Specifically, Applicant has submitted no proof that the documents its counsel downloaded from the Internet are **publicly available** and **independently verifiable**, as required by the Board for documents obtained from a website. Further, the testimony of Applicant's counsel's paralegals (the "Paralegals") does not satisfy: (1) the three-part test for the introduction of evidence regarding alleged use of third-party marks; or (2) the Federal Rules of Evidence.

#### **A. Applicant's Inadmissible Third-Party Website Documents**

Applicant relies on a number of inadmissible documents (*e.g.*, website screenshots) that allegedly depict use of the prefix "PUR" and/or the suffix "ICS" on websites for third-parties'

goods and/or services. To satisfy the authentication requirements for introducing third-party website information as **publicly available** evidence, the Applicant must include: (1) the date of publication/access; **and** (2) the source of access on the document sought to be admitted (*i.e.*, the URL). Applicant's failure to satisfy both evidentiary requirements (publication/access **and** the URL) is fatal to the admissibility of the website information. *See* TBMP 704.08(b); *see also*, *Safer Inc. v. OMS Investments Inc.*, 94 U.S.P.Q. 2d 1031, 1039 (T.T.A.B. 2010) (opposer's Internet evidence **excluded** as documents were not authenticated with date and URL and were not authenticated by testimony). The Board has noted that this two-part requirement is critical to allow the "non-offering party the opportunity to verify the documents." *Safer*, 94 U.S.P.Q.2d at 1039.

Applicant included only the URL for the third-party websites. Applicant did not include the date of publication or the date of access. Further, Applicant offered no testimony regarding the date of access or publication of the third-party website information. Accordingly, Applicant's Internet documents of alleged third-party use of marks containing the prefix "PUR" and/or the suffix "ICS" are inadmissible. Opposers, therefore, object to Applicant's introduction and reliance on the third-party website information offered by Applicant and attached or referred to as Exhibit 127 to the oral depositions of Marla Beier and Heidi Van Baalen.

**B. Applicant's Hearsay And Speculative Testimony Regarding Third-Party Use Or Documents**

Applicant also relies on testimony from the Paralegals working for Applicant's counsel regarding third-party websites. The Paralegals' testimony is inadmissible on relevance and hearsay grounds pursuant to the Federal Rules of Evidence. As instructed by Applicant's counsel, the Paralegals' sole function was to view certain trademark registrations and try to locate

websites showing use of the respective marks.<sup>1</sup> The Paralegals did not testify about the date(s) of publication of the websites or the date(s) they accessed the third-party websites. Moreover, the Paralegals made no calls or inquiries to any third parties about the websites. The Paralegals' duties were limited to trying to match alleged marks on websites with registrations. *Id.*

To be relevant, Applicant's alleged third-party evidence regarding use of Opposers' mark (or alleged lack thereof) must satisfy the following three-part test: (1) third parties actually used the identified marks; (2) the third parties promoted the marks well; and (3) consumers recognized the marks. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 U.S.P.Q. 2d 1689, 1693 (Fed. Cir. 2005). Applicant's counsel's Paralegals offered no testimony about the alleged third-party use. The Paralegals' task was merely clerical (not substantive): attempting to match a trademark registration with a website screenshot of an unknown date.<sup>2</sup> As argued above, Applicant did not meet any element of the three-part test set forth in *Palm Bay Imports*.

Further, the Paralegals' testimony is not admissible because the testimony is hearsay and violates the Federal Rules of Evidence. The Paralegals cannot testify about, and have no knowledge of, whether the goods associated with the third-party marks are sold; when the goods were first sold, if ever; whether any other trade channels or forms of advertising were used with the third-party goods; or whether consumers recognized the third-party marks or the extent of their recognition of the marks.<sup>3</sup> Applicant's alleged third-party use is at best rank speculation, hearsay and not trustworthy, as required by the Federal Rules of Evidence. *See Fed R. Evid.* 402, 602, 701, 802 and 807.

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<sup>1</sup> Deposition of Marla Beier, January 7, 2013 ("Beier Depo.") 10:2-23; Deposition of Heidi Van Baalen, January 7, 2013 ("Van Baalen Depo.") 9:12-25; 10:1-2.

<sup>2</sup> Beier Depo. 10:2-23; Van Baalen Depo. 9:12-25; 10:1-2.

<sup>3</sup> Beier Depo. 10:24-25; 11:1-18; Van Baalen Depo. 10:7-25; 11: 1-19.

Accordingly, Purifics objects to the entirety of the Paralegals' Marla Beier and Heidi Van Baalen testimony and Exhibit 127 to their depositions regarding any third-party marks or documents, the existence of goods and/or services associated with the third-party marks, and the channels of trade and/or consumers' recognition of the third-party marks.

## **V. DESCRIPTION OF THE RECORD**

The record consists of Testimony and Discovery Depositions and their exhibits, and Applicant's Notice of Reliance as set forth below.

1. Transcript of discovery deposition (Fed. R. Civ. P. 30 (b)(6)) of Applicant's corporate representative Mark Owen dated September 20, 2012 and Exhibits 1-11 to that deposition.

2. Transcript of discovery deposition (Fed. R. Civ. P. 30 (b)(6)) of Purifics' corporate representative Brian Butters dated October 10, 2012 and Exhibits 12-28 and 100-118 to that deposition.

3. Transcript of testimony deposition of Applicant's corporate representative Mark Owens dated January 7, 2013 and Exhibits 119-126 to that deposition.

4. Transcript of testimony deposition of Applicant's counsel's paralegal Marla Beier dated January 7, 2013 and Exhibit 127 (Bates# PUR1496-1530) to that deposition. **(Purifics maintains its evidentiary objections to Exhibit 127, and to the entirety of Ms. Beier's deposition).**

5. Transcript of testimony deposition of Applicant's counsel's paralegal Heidi Van Baalen dated January 7, 2013. **(Purifics maintains its evidentiary objections to Exhibit 127 to the extent Ms. Van Baalen referred to it, and to the entirety of her deposition).**

6. Applicant's Notice of Reliance filed on January 8, 2013, which includes the following discovery: Opposers' Responses to Applicant's First Set of Request for Admissions dated February 23, 2011; Opposers' Answers to Applicant's Interrogatories dated February 23, 2011; Opposers' Responses to Applicant's Second Set of Request for Admissions dated June 22, 2012.

## VI. ARGUMENT AND AUTHORITIES

Opposers object to registration of Applicant's mark "PURALYTICS" for water purification goods. As the party in the position of plaintiff, Opposers must prove, by only a preponderance of the evidence, that Applicant is not entitled to register the mark "PURALYTICS" for the goods recited in the Application. *See* 15 U.S.C. § 1052(d); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951, 55 U.S.P.Q. 2d 1842, 1844 (Fed. Cir. 2000). If there is any doubt whether there is a likelihood of confusion between the parties' marks for the identified goods and services, the Board must resolve that doubt in Opposers' favor, as the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 U.S.P.Q. 2d 1687 (Fed. Cir. 1993) (doubt resolved against newcomer because he has opportunity to avoid confusion and is charged with obligation to do so); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 U.S.P.Q. 2d 1025 (Fed. Cir. 1988).

To prevail in this opposition, Opposers must establish: (1) they have standing to oppose because they are likely to be damaged by registration of Applicant's mark; and (2) valid grounds regarding why Applicant cannot register the mark, *e.g.*, a likelihood of confusion between Opposers' mark and Applicant's mark with the associated goods and services. *See* 37 C.F.R. § 2.104; 15 U.S.C. § 1052(d). Here, Opposers have standing by virtue of their ownership and prior use of their "PURIFICS" mark with water purification goods and services.<sup>4</sup> Further, there exists a likelihood of confusion between Opposers' "PURIFICS" mark and Applicant's "PURALYTICS" mark when used with water purification goods and services. Accordingly, the Board should refuse to register Applicant's "PURALYTICS" mark for water purification goods.

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<sup>4</sup> 15 U.S.C. § 1052(d); *Fossil, Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998) (opposer not limited to relying solely on marks for which it has registrations; opposer can rely on other forms of its marks or other marks for which it lacks registration, provided opposer is prior user).

### **A. Opposers Senior Mark Confers Standing**

Opposers began using their "PURIFICS" mark with their water purification goods and services in December 1993.<sup>5</sup> On March 21, 1996, Opposers filed an application under 15 U.S.C. § 1051(a) for, *inter alia*, water purification services.<sup>6</sup> The United States Trademark Office registered the mark on the Principal Register for those services on May 20, 1997.<sup>7</sup> Pursuant to 15 U.S.C. § 1057(c), Opposers' registration is *prima facie* evidence of the validity of their "PURIFICS" mark and their ownership of the mark. Since 1993, Opposers have continuously used their "PURIFICS" mark with their goods and services throughout the United States.<sup>8</sup>

Applicant, on the other hand, did not enter the water purification industry until at least 2007.<sup>9</sup> Applicant only recently filed the Application for its "PURALYTICS" mark and began offering goods in connection with the mark in 2009.<sup>10</sup> Accordingly, Opposers have priority in the "PURIFICS" mark for water purification goods and services.

### **B. Registering Applicant's Mark For Water Purification Goods Would Create A Likelihood Of Confusion With Opposers' Senior Mark**

#### **1. *DuPont* Factors Favor Likelihood Of Confusion**

Opposers can show that confusion is likely if Applicant's "PURALYTICS" mark is allowed to register for water purification goods. The factors relevant to determining whether a likelihood of confusion exists are set forth in *In re DuPont*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). While no single factor is dispositive, the key considerations include: (1) similarity of the goods or services described in an application or in connection with which the senior mark is in

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<sup>5</sup> Deposition of Brian Butters, October 10, 2012 ("Butters Depo.") 8:22-25; 9:1-25; 10:1-6, 20-25; 11:1-25; 12:1-3.

<sup>6</sup> U.S. Trademark Application Serial No. 75/076,222.

<sup>7</sup> U.S. Trademark Registration No. 2,062,935.

<sup>8</sup> Butters Depo. 16:20-25; 17:1.

<sup>9</sup> Deposition of Mark Owen, September 20, 2012 ("Owen September Depo.") 8:1-2.

<sup>10</sup> Owen September Depo. 13:24-25; 14:1-4.

use; (2) similarity of trade channels; (3) similarity of consumers; and (4) similarity of the marks in terms of appearance, sound, connotation and commercial impression. *See id.*; *see also, In re SL & E Training Stable, Inc.*, 88 U.S.P.Q.2d 1216, 1217-19 (T.T.A.B. 2008) (refusing to register mark because goods were closely related, same trade channels and consumers presumed, and marks similar in appearance, sound, connotation and commercial impression). Additional relevant considerations include: (5) the number and nature of similar marks in use on similar goods; and (6) the fame of the marks. *DuPont*, 476 F.2d at 1361.

## **2. Applicant Is Bound By The Contents Of Its Application Regardless Of Extrinsic Evidence**

In evaluating *DuPont* factors (1)-(3) above, the Board must consider only Applicant's description of its good and services in the Application, and limitations, if any, to the trade channels and classes of consumers. The Federal Circuit has stated:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

*See Octocom Sys., Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 941-42, 16 U.S.P.Q. 2d 1783 (Fed. Cir. 1990) (citations omitted). In *Octocom*, the Federal Circuit held the applicant to its description of goods in its application, despite the applicant's extrinsic evidence indicating that the applicant actually offered a more limited subset of those goods. *Id.* at 939. In addition, because the application did not contain any limitation on the types of trade channels or customers, the Federal Circuit held that the Board must consider all reasonable trade channels and customers. *Id.* at 941-42. Accordingly, an applicant cannot submit broad descriptions of goods and services, trade channels and classes of consumers in an application and then later attempt to limit those descriptions.

The goods listed in Applicant's Application and Opposers' Registration are closely related. Here, Applicant did not limit its goods in its Application to a subset of water purification goods. Further, Applicant did not limit the trade channels or classes of consumers in its Application. Accordingly, the Board must presume that Applicant's and Opposers' closely-related goods move in all channels of trade normal for those goods and that the goods are available to all classes of purchasers of those goods.

In addition, Opposers' mark is very similar in sound, appearance and connotation to Applicant's "PURALYTICS" mark. Accordingly, Applicant's "PURALYTICS" mark used with water purification goods is likely to create confusion with Opposers' "PURIFICS" mark for water purification goods and services.

### **3. Similarity Of Goods/Services – Applicant's Goods And Services Are Closely Related To Opposers' Goods And Services**

When comparing the Parties' goods and services, the Board must look to the **goods and services actually recited** in Applicant's Application. *See Cunningham*, 222 F.3d at 948, 55 U.S.P.Q. 2d at 1846 (must look to applicant's recited goods and services); *Octocom*, 918 F.2d at 942. The Board has confirmed this black-letter trademark law on numerous occasions.

For example, in *Jamison Bedding, Inc. v. The Spring Air Company*, 2005 T.T.A.B. LEXIS 399, \*4 (T.T.A.B. Sept. 15, 2005), the trademark owner opposed an application to register "TOTAL BALANCE" for mattresses and box springs, alleging likelihood of confusion based on its mark "TRUE BALANCE" for mattresses and box springs. The Board noted that the applicant's identified goods were "mattresses and box springs" with no restrictions. *Id.* The applicant argued that the Board should consider that it offered a subset of the identified goods (*e.g.*, only mattresses and box springs below a certain price threshold). *Id.* The Board rejected the applicant's argument. The Board stated that the goods identified in the application and

opposer's registration were identical for purposes of the likelihood of confusion analysis and refused to register the applicant's mark for the similar goods. *Id.*

In *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983), the Federal Circuit stated that the description of goods in an application controls, despite an applicant's later claim that it actually offers more limited goods. The court reasoned that business practices may change at any time, resulting in a registered mark used with goods and services different than those identified in the application. *Id.* In particular, the court noted that, "although a registrant's current business practices may be quite narrow, they may change at any time from, for example, industrial sales to individual consumer sales." *Id.* (citing *San Fernando Electric Manufacturing Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 685, 196 U.S.P.Q. 1, 2 (C.C.P.A. 1977)). The court was not persuaded by the applicant's extrinsic evidence that it would always refrain from offering its goods through particular trade channels and to particular consumers. *Id.* Accordingly, the court held the applicant to the unrestricted description in the application itself. *Id.*

In this proceeding, the Board must base any comparison on the goods actually recited in Applicant's Application (*e.g.*, "Waste water purification units; Water purification and filtration apparatus; Water purification units."). Applicant's description encompasses all goods capable of water purification and filtration, not just a particular subset of such goods. Likewise, Opposers' Registration recites, *inter alia*, "water treatment services," without limitation. Accordingly, when comparing the Parties' identified goods and services, the Board should conclude that they are closely related, if not effectively identical.<sup>11</sup>

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<sup>11</sup> See *In re Rexel Inc.*, 223 U.S.P.Q. 830 (T.T.A.B. 1984) (not necessary that respective goods and services be identical or even competitive to find they are related for likelihood of confusion purposes).

That Applicant's Application lists goods and Opposers' Registration lists services does not affect this conclusion. It is well recognized that confusion is likely to occur from the use of similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 U.S.P.Q. 2d 1025 (Fed. Cir. 1988) ("BIGG'S" (stylized) for retail grocery and general merchandise store services likely to be confused with BIGGS & Design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 U.S.P.Q. 347 (C.C.P.A. 1961) ("SEILER" for catering services likely to be confused with "SEILER'S" for smoked and cured meats).<sup>12</sup>

Applicant's goods are closely related, if not effectively identical to, Opposers' goods and services. This factor weighs heavily in favor of finding a likelihood of confusion.

#### **4. Similarity Of Trade Channels - Opposers And Applicant Have The Same Or Overlapping Trade Channels**

Similarly, Puralytics' Application has no restrictions on the proposed trade channels for the goods. Therefore, any testimony or evidence that Applicant offers regarding a potential restriction of trade channels is irrelevant and the Board must reject it. *Octocom Systems, Inc.*, 918 F.2d at 943, 16 U.S.P.Q. 2d at 1787-88 ("an application with an identification of goods having **no** restriction on trade channels obviously is not narrowed by testimony") (emphasis added); *In re Davey Products Pty Ltd.*, 92 U.S.P.Q. 2d 1198, 1203 (T.T.A.B. 2009) ("[b]ecause

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<sup>12</sup> *See also, In re U.S. Shoe Corp.*, 229 U.S.P.Q. 707 (T.T.A.B. 1985) ("CAREER IMAGE" (stylized) for retail women's clothing store services and clothing likely to be confused with "CREST CAREER IMAGES" (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 U.S.P.Q. 237 (T.T.A.B. 1986) (design for distributorship services in field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949 (T.T.A.B. 1986) (21 "CLUB" for various items of men's, boys', girls' and women's clothing likely to be confused with "THE '21' CLUB" (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 U.S.P.Q. 433 (T.T.A.B. 1983) ("STEELCARE INC." for refinishing furniture, office furniture, and machinery likely to be confused with "STEELCASE" for office furniture and accessories); *Corinthian Broadcasting Corporation v. Nippon Electric Co., Ltd.*, 219 U.S.P.Q. 733 (T.T.A.B. 1983) ("TVS" for transmitters and receivers of still television pictures likely to be confused with "TVS" for television broadcasting services); *In re Industrial Expositions, Inc.*, 194 U.S.P.Q. 456 (T.T.A.B. 1977) ("POLLUTION ENGINEERING EXPOSITION" for programming and conducting industrial trade shows likely to be confused with "POLLUTION ENGINEERING" for periodical magazine).

neither applicant's identification of goods nor registrant's identification of [services] includes any restrictions or limitations as to trade channels, we presume that the respective goods [and services] are or would be marketed in all normal trade channels").

In *Octocom*, the applicant argued that the Board overlooked facts, *e.g.*, extrinsic evidence, material to its trade channels. The Board rejected the applicant's argument. The Federal Circuit affirmed, holding that if an applicant does not restrict the trade channels in the description of goods in an application, the applicant cannot later restrict the trade channels using later extrinsic evidence. *Octocom*, 918 F.2d at 943, 16 U.S.P.Q. 2d at 1787-88.

Here, Applicant did not restrict the description of goods or the proposed trade channels in its Application. Likewise, Opposers did not restrict the description of services or the trade channels in their Registration. Therefore, the Board must presume that the parties' goods and services travel in the same trade channels. *Octocom*, 918 F.2d at 943, 16 U.S.P.Q. 2d at 1787-88; *In re Davey Products*, 92 U.S.P.Q. 2d at 1203.

The same is true for Opposers' common-law mark and goods. Opposers advertise, offer for sale and sell their water purification goods bearing their "PURIFICS" mark at trade shows and conferences, through distributors and consultants and via the Internet.<sup>13</sup> As Applicant has not restricted its trade channels in the Application, the Board can presume the same trade channels as Opposers' trade channels. Accordingly this factor weighs in favor of finding a likelihood of confusion.

##### **5. Similarity of Consumers - Opposers And Applicant Have The Same Or Overlapping Customers**

As with its description of goods and trade channels, Applicant did not limit in its Application the types of customers that might purchase its goods. As such, the Board has held

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<sup>13</sup> Butters Depo 16:16-19.

that the proposed goods are available to all classes of purchasers. *See, e.g., In re Jump Designs, LLC*, 80 U.S.P.Q. 2d 1370, 1374 (T.T.A.B. 2006) (when there is no limitation on class of purchasers in description of goods, Board may presume that goods "would be purchased by all potential buyers thereof"); *In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981). Indeed, when seeking "an *unrestricted* registration, such evidence as there is of a specific class of customers did not relate to a material fact." *Octocom*, 16 U.S.P.Q. 2d at 1787 (emphasis in original).

In *In re Davey Products*, the Board reiterated that extrinsic evidence cannot narrow an otherwise unrestricted description of goods. In that case, the applicant attempted to restrict the conditions of purchase by submitting a price list showing that the registrant's goods were more expensive than the applicant's. *In re Davey Products*, 92 U.S.P.Q. 2d at 1204. The Board ignored the price list and held that the applicant's extrinsic evidence was nothing more than a "legally **irrelevant** fact that registrant's [products] might be quite expensive." *Id.* (emphasis added).

Here, Applicant did not restrict its proposed class of customers in the description of goods in its Application. Applicant cannot now rely on the testimony of its President Mark Owen or any other extrinsic evidence that would attempt to restrict the goods described in its Application to a particular class or type of customer. Applicant's testimony is both contrary to the Applicant's written description and legally irrelevant. *Id.* Thus, the Board should presume that Applicant's class of purchasers is the same as, and/or overlaps with, Opposers' class of purchasers. This factor also weighs in favor of a finding of likelihood of confusion.

**6. Similarity Of Marks - Applicant's "PURALYTICS" Mark Conveys The Same Commercial Impression As Opposers' "PURIFICS" Mark**

Marks are typically compared in their entireties in terms of appearance, sound, and connotation to determine whether they are similar in their overall commercial impressions for

likelihood of confusion purposes. *Time Warner Entertainment Co. v. Jones*, 65 U.S.P.Q. 2d 1650, 1660 (T.T.A.B. 2002). However, the Board does not evaluate whether the marks in question could be distinguished if they were placed side by side for comparison. *Envirotech Corp. v. Solaron Corp.*, 211 U.S.P.Q. 724, 733 (T.T.A.B. 1981). The relevant inquiry is “whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. In addition, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *Id.*

As discussed above, Opposers and Applicant recites closely related goods and services and did not limit the types of trade channels or classes of consumers. When marks are associated with closely related goods and services, trade channels and consumers, a **lesser** degree of similarity between the marks is typically required to support a finding of likely confusion. *See, e.g., id.; In re Microsoft Corp.*, 68 U.S.P.Q. 2d 1195, 1197 (T.T.A.B. 2003); *INB Nat’l Bank v. Metrohost, Inc.*, 22 U.S.P.Q. 2d 1585, 1587-88 (T.T.A.B. 1992); *Jamison Bedding*, 2005 T.T.A.B. LEXIS 399 at \*4.

**a. Sight/Sound - The Marks Begin And End With The Same Components**

The Board has held that the first part of a mark is “most likely to be impressed upon the mind of a purchaser and remembered.” *See, e.g., Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q. 2d 1895, 1897 (T.T.A.B. 1988) (finding likelihood of confusion between “KID STUF” and “KIDWIPES”). Recently, the Board confirmed this precedent, finding a likelihood of confusion between the marks “ARDEN B” and “ARDENBEAUTY.” *Wet Seal Inc. v. FD Management Inc.*, 82 U.S.P.Q. 2d 1629, 1639 (T.T.A.B. 2007). The Board, citing *Presto Products*, stated that the “ARDEN name is the first word purchasers will see or hear when

encountering either mark and it is therefore more likely to have a greater impact on purchasers.”

*Id.*

Here, “PUR” is the first feature of both Applicant's "PURALYTICS" mark and Opposers' "PURIFICS" mark that a purchaser sees or hears. As in *Wet Seal*, the beginning of each mark has a “greater impact on purchasers.” *See Wet Seal*, 82 U.S.P.Q. 2d at 1639. This greater impact supports a finding of likelihood of confusion.

Furthermore, it is proper to give more weight to significant features of marks in determining the commercial impressions the marks create. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (finding similar overall commercial impression where marks contained same dominant feature -- "CASH MANAGEMENT" -- despite other differences between marks). The significant features in Applicant's and Purifics' marks are "PUR" and "ICS." Applicant acknowledges that these are the significant features of the "PURIFICS" and "PURALYTICS" marks because the third-party registrations Applicant submitted contain either the "PUR" prefix or "ICS" suffix.<sup>14</sup> On numerous occasions, the Board has found a likelihood of confusion between marks having the same beginning and ending significant features.

For example, in *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 U.S.P.Q. 2d 1826 (T.T.A.B. 2012), the Board found a likelihood of confusion between the applicant's "TURFECTA" mark for grass seed and the opposer's "TRIFECTA" mark for lawn seed. *Id.* at 1827. The Board noted that the marks are "clearly similar in appearance in that they have a similar structure and length, beginning with the letter 'T' and ending with the identical element 'FECTA.'" *See id.* at 1832 (emphasis added).

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<sup>14</sup> *See* Deposition of Mark Owen, January 7, 2013 ("Owen January Depo."), Exs. 121-124, 126.

Similarly, in *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 228 U.S.P.Q. 689 (T.T.A.B. 1986), the Board found a likelihood of confusion between the applicant's "COMM CASH" mark for banking services and the opposer's "COMMUNICASH" mark for banking services. *Id.* at 689. Again, the Board focused its similarity analysis on the fact that the beginning ("COMM") and ending ("CASH") of both marks was identical.

Here, the appearance and sound of the "PURIFICS" and "PURALYTICS" marks convey the same commercial impression to consumers. In fact, the present situation is virtually identical to the *Lebanon Seaboard* and *Crocker National Bank* cases where the Board found a likelihood of confusion between the parties' marks. Indeed, both Applicant's and Opposers' marks begin with the identical prefix "PUR" and end with the identical suffix "ICS." The prefix and suffix are unquestionably the significant features of both marks. In addition, the marks are of similar length. The only minor difference in appearance is the interior of the marks. Like both *Lebanon Seaboard* (TRIFECTA/TURFECTA) and *Crocker National Bank* (COMM CASH/COMMUNICASH), this minor interior difference is of little importance where the beginning and end of the marks are identical. Accordingly, the marks are very similar in appearance and sound.

**b. Connotation - The Marks Suggest Water Purification And Processing To Consumers**

The Tenth Circuit Court of Appeals has held that marks may also cause likely confusion because they convey the same idea to consumers. *Standard Oil Co. v. Standard Oil Co.*, 252 F.2d 65, 73-74, 116 U.S.P.Q. 176 (10th Cir. 1958). Indeed, "it is not necessary for similarity to go only to the eye or to the ear" to find a likelihood of confusion. *Id.*

Here, both marks suggest the idea of water purification goods and services. In fact, each party's representative testified that they selected their marks to suggest water purification to

consumers. In coming up with their respective marks, the parties used the same mental process to select features of the marks to suggest specific and particular ideas to consumers. For example, when selecting the "PURIFICS" mark, Opposers wanted a mark that would suggest what their goods and services were intended to do, *i.e.*, purify water.<sup>15</sup> Similarly, Applicant selected a mark that would suggest purification of water.<sup>16</sup> As a result, each Party selected a mark beginning with the significant feature "PUR" to convey this idea to consumers. Further, Opposers wanted a mark that suggested to consumers the idea that purification was accomplished using photocatalytic means.<sup>17</sup> Likewise and importantly, the mental process Applicant employed in identifying its purification process with photocatalysis was virtually identical to Opposers'.<sup>18</sup> As a result, both Parties ended their mark with the prominent feature "ICS."

The evidence is clear that the "PURIFICS" and "PURALYTICS" marks convey very similar commercial impressions to consumers. This factor favors a finding of likelihood of confusion.

## **7. Additional Considerations**

### **a. Opposers' Mark Is More Famous Than Applicant's Mark**

Opposers' "PURIFICS" mark used with their water purification goods and services is well known in the industry and undeniably more famous than Applicant's "PURALYTICS" mark. For likelihood of confusion purposes, the fame of marks varies along a spectrum. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374, 73 U.S.P.Q. 2d 1689, 1694 (Fed. Cir. 2005) (unlike a fame analysis for dilution purposes,

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<sup>15</sup> Butters Depo. 10:21-25, 11:1-11.

<sup>16</sup> Owen September Depo. 18: 3-18.

<sup>17</sup> Butters Depo. 10:21-25, 11:1-11.

<sup>18</sup> Owen September Depo. 18: 3-18.

where mark is either famous or it is not). The fame or notoriety of a mark is measured relative to the particular customers of goods or services, not to the general public. *See id.* at 1375. The Federal Circuit has held that the notoriety of a mark may be measured, indirectly, by the volume of sales and advertising expenditures of the goods and services traveling under the mark and by the length of time those indicia of commercial awareness have been evident. *See Bose Corp v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 U.S.P.Q. 2d 1303 (Fed. Cir. 2002).

Opposers have invested substantial time, effort and money to promote and sell its water purification goods and services under the "PURIFICS" mark in the U.S. It is undisputed that Opposers have generated more sales of their water purification goods and services offered under their "PURIFICS" mark than Applicant has made under its "PURALYTICS" mark.<sup>19</sup> Likewise, Opposers also spend a substantial amount of resources promoting the "PURIFICS" mark and their goods and services offered under the mark.<sup>20</sup>

In contrast, Applicant testified that it did not spend any money "advertising" its goods and services under the "PURALYTICS" mark, and refused to disclose any of its marketing and/or sales information.<sup>21</sup> Not only have Opposers outsold and outspent Applicant, they have been engaged in selling and marketing their water purification goods and services in the U.S. for twenty years. In contrast, Applicant only recently began offering its goods under the "PURALYTICS" mark since 2009.<sup>22</sup> Even then, Applicant admittedly sells the overwhelming majority of its goods and services outside of the U.S.<sup>23</sup> *See Tiffany & Broadway v.*

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<sup>19</sup> Butters Depo. 39:12-25; 40:1-2.

<sup>20</sup> Butters Depo. 40:7-16.

<sup>21</sup> Owen September Depo. 54:17-23; 65:4-25; 66:1-17.

<sup>22</sup> Butters Depo. 8:20-25; 11:1-25; 12:1-3; Owen September Depo. 13:24-25; 14:1-4.

<sup>23</sup> Owen September Depo. 44:22-25; 45:1-14.

*Commissioner*, 167 F. Supp. 2d 949 (S.D. Tex. 2001) (in determining fame of mark, court emphasized that majority of applicant's retail stores were located in the U.S.).

Considering Opposers' significant sales and advertising in the U.S. over twenty years, it is clear that Opposers' mark is higher on the fame spectrum and more well known to the relevant consumers than Applicant's newly adopted "PURALYTICS" mark. This factor favors a finding of likelihood of confusion.

**b. Applicant's Evidence Of Third-Party Use Is Inadmissible Or, Alternatively, Should Be Given Little Weight**

As discussed in Section IV above, Applicant's documents and testimony of alleged third-party websites are inadmissible because they are not authenticated and proven to be **publicly available**. In the unlikely event that some of Applicant's third-party use documents and/or testimony can survive Opposers' objections, the Board should give little evidentiary weight to the evidence. Applicant's *evidence* of alleged third-party use is relegated to various goods and services with marks beginning with the prefix "PUR" and ending with the suffix "ICS". However, much of the alleged third-party use is for goods that have no connection with water purification goods and services (*e.g.*, food starch). Applicant also relies on the testimony of the Paralegals. However, the Paralegals did not determine whether the marks were promoted well or even recognized by consumers as they made no inquiries to the third parties.

Other than the naked third-party registrations, Applicant has submitted **no** admissible or relevant evidence. In the absence of any admissible or relevant documents, the Board cannot conclude that the use of "PUR" and "ICS" in a mark is such that consumers have become conditioned to distinguish between the Applicant and Opposers' confusingly similar marks. *See Palm Bay Imports*, 396 F.3d at 1374.

As to the probative value of third-party marks, the Board has established an extremely high bar for evidence submitted in support of third-party use that depends entirely on the usage. *Id.* at 1373. Specifically, Applicant's alleged third-party use evidence must satisfy the following three-part test: (1) third parties actually used the identified trademarks; (2) third parties promoted the marks well; and (3) consumers recognized the marks. *Id.* Without the **extent** of the third-party use, the probative value of third-party use of a mark is minimal. *Id.* at 1373-74. Indeed, the Board has explained that "a printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight we [the Board] will give such website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. Otherwise, it might not have much probative value." *Safer*, 94 U.S.P.Q. 2d at 1039.

Here, Applicant cannot satisfy any element of the three-part test. As discussed in Section IV above, the Paralegals have no knowledge of whether any of the third-party marks are currently used in connection with any goods and/or services, what channels of trade such goods and/or services move in, if such goods and/or services exist, or whether consumers recognize the third-party marks. Accordingly, Applicant has not established that the third-party marks are being promoted (let alone well promoted) or that consumers recognize the marks.

## **VII. CONCLUSION**

Opposers have clearly proven that they have priority regarding the goods and services identified in their Registration and their common-law use. In addition, Opposers have established that a likelihood of confusion exists between their use of the mark "PURIFICS" and Applicant's use of the mark "PURALYTICS" with water purification goods and services. Based on the foregoing, Opposers respectfully request that the Board deny registration of the "PURALYTICS" mark and sustain Opposers' opposition in its entirety.

Respectfully submitted,

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### **CERTIFICATE OF SERVICE**

I hereby certify that on April 22, 2013, a copy of the foregoing “Main Brief of Opposers 1047406 Ontario Ltd. and Purifics, ES, Inc.” was served, by U.S. Mail, First Class, postage prepaid, upon Applicant's counsel of record as follows:

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