

ESTTA Tracking number: **ESTTA539671**

Filing date: **05/23/2013**

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

Proceeding	91194706
Party	Defendant UVCleaning Systems, Inc. dba Puralytics Corporation
Correspondence Address	DAVID P PETERSEN KLARQUIST SPARKMAN LLP 121 SW SALMON ST STE 1600 PORTLAND, OR 97204-2927 UNITED STATES ptotmdocket@klarquist.com, salumeh.loesch@klarquist.com
Submission	Brief on Merits for Defendant
Filer's Name	Salumeh R. Loesch
Filer's e-mail	ptotmdocket@klarquist.com, salumeh.loesch@klarquist.com
Signature	/Salumeh R. Loesch/
Date	05/23/2013
Attachments	Main Brief.pdf(577389 bytes)

TABLE OF CONTENTS

	Page
I. SUMMARY OF APPLICANT’S ARGUMENT	1
II. DESCRIPTION OF THE RECORD	1
III. STATEMENT OF THE ISSUES.....	3
IV. RECITATION OF THE FACTS	4
A. The \$600 Billion “Water Industry”.....	4
B. Applicant’s Mark Is Unique And Its Trademark Application Is Narrow	5
C. Opposers’ Registration Is For Environmental Remediation Services	8
D. Applicant And Opposers Are Both In Industries That Involve Water, But Their Marks And Goods Are Dissimilar	10
E. PUR Marks Are Common.....	10
F. Opposers Have Not Actively Policed Their Mark	15
V. RESPONSE TO EVIDENTIARY OBJECTIONS	16
VI. EVIDENTIARY OBJECTIONS	18
A. Opposers’ Alleged Evidence Of Actual Confusion Is Inadmissible.....	18
1. Opposers’ Inadmissible Testimony.....	18
2. Opposers’ Discovery Responses State That There Is No Actual Confusion.....	19
B. Opposers Have Not Provided Evidence Of Common Law Rights	21
VII. ARGUMENT AND AUTHORITIES.....	23
A. The Marks Are Dissimilar	24
1. There Are Many Similar “PUR” Marks On Water-Related Goods And Services	27
2. PUR Is Suggestive And PUR Marks Are Less Likely To Cause Confusion.....	28
3. PURIFICS Does Not Merit Broad Protection.....	29
4. PURIFICS Is Not Famous	30

B.	The Registration And Application Are For Dissimilar Goods And Services Sold In Different Channels Of Trade.....	31
C.	Opposers And Applicant Have Sophisticated Customers.....	33
D.	Even After Nearly Four Years Of Concurrent Use, There Is No Evidence Of Actual Confusion.....	34
VIII.	CONCLUSION.....	35

TABLE OF AUTHORITIES

Cases	Page
<i>Application of E.I. DuPont De Nemours & Co.</i> , 476 F.2d 1357 (C.C.P.A. 1973)	passim
<i>Application of Franklin Press, Inc.</i> , 597 F.2d 270 (C.C.P.A. 1979)	17
<i>Blue Man Prods., Inc. v. Tarmann</i> , 75 U.S.P.Q.2d 1811 (T.T.A.B. 2005)	30
<i>Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.</i> , 174 F.3d 1036 (9th Cir. 1999)	34
<i>Citigroup Inc. v. Capital City Bank Group, Inc.</i> , 637 F.3d 1344 (Fed. Cir. 2011).....	23
<i>Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce</i> , 228 U.S.P.Q.2d 689 (T.T.A.B. 1986)	26
<i>Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.</i> , 954 F.2d 713 (Fed. Cir. 1992).....	32, 33
<i>Goldring, Inc. v. Town-Moor, Inc.</i> , 228 F.2d 254 (C.C.P.A. 1955)	29
<i>Hewlett-Packard Co. v. Human Performance Measurement, Inc.</i> , 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991)	32, 33
<i>In re Nat'l Data Corp.</i> , 753 F.2d 1056 (Fed. Cir. 1985).....	26
<i>Jim Dandy Co. v. Martha White Foods, Inc.</i> , 458 F.2d 1397 (C.C.P.A. 1972)	22
<i>Keebler Co. v. Murray Bakery Prods.</i> , 866 F.2d 1386 (Fed. Cir. 1989).....	25
<i>Keebler Co. v. Partners, A Tasteful Choice Co.</i> , 2007 WL 1022712 (T.T.A.B. Mar. 27, 2007).....	28
<i>Kellogg Co. v. Pack'em Enters., Inc.</i> , 951 F.2d 330 (Fed. Cir. 1991).....	25

<i>Kramer Trenton Co. v. Walcutt</i> , 408 F.2d 479 (C.C.P.A. 1969)	28
<i>Lauritzen & Co. v. Borden Co.</i> , 239 F.2d 405 (C.C.P.A. 1956)	29
<i>Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC</i> , 82 U.S.P.Q.2d 1901 (T.T.A.B. 2007)	30, 34
<i>Lebanon Seaboard Corp. v. R&R Turf Supply Inc.</i> , 101 U.S.P.Q.2d 1826 (T.T.A.B. 2012)	26
<i>Miguel Torres, S.A. v. Bodegas Muga, S.A.</i> , 176 F. App'x 124 (Fed. Cir. 2006)	27
<i>Minn. Mining & Mfg. Co. v. McDonnell</i> , 163 F.2d 557 (C.C.P.A. 1947)	23
<i>Packard Press, Inc. v. Hewlett-Packard Co.</i> , 227 F.3d 1352 (Fed. Cir. 2000).....	24, 25, 30
<i>PC Club v. Primex Techs., Inc.</i> , 32 F. App'x 576 (Fed. Cir. 2002)	passim
<i>Plus Prods. v. Plus Discount Foods, Inc.</i> , 722 F.2d 999 (2d Cir. 1983).....	28
<i>Presto Prods., Inc. v. Nice-Pak Prods., Inc.</i> , 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988)	26
<i>Sears, Roebuck & Co. v. Hofman</i> , 258 F.2d 953 (C.C.P.A. 1958)	28
<i>Seven-Up Co. v. Tropicana Prods., Inc.</i> , 356 F.2d 567 (C.C.P.A. 1966)	24, 26
<i>Stoller v. Sutech U.S.A., Inc.</i> , 199 F. App'x 954 (Fed. Cir. 2006)	22
<i>Tzu Wei Chen Food Co. v. Chia-Chi Enters., Inc.</i> , 73 F.3d 379 (Fed. Cir. Dec. 5, 1995)	22
<i>Wet Seal Inc. v. FD Management Inc.</i> , 82 U.S.P.Q.2d 1629 (T.T.A.B. 2007)	26

Statutes

15 U.S.C. § 1052..... 3, 23

Other Authorities

2 J. THOMAS MCCARTHY,
MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2013)..... 27, 29

3 J. THOMAS MCCARTHY,
MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2006)..... 22

3 J. THOMAS MCCARTHY,
MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2013)..... 33

4 J. THOMAS MCCARTHY,
MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2013)..... 28, 35

I. SUMMARY OF APPLICANT'S ARGUMENT

There is no likelihood of confusion between Applicant's PURALYTICS mark and Opposers' PURIFICS mark. The only thing these marks have in common is that each begins with "PUR" and relate, in some general way, to water. Yet there are well over 45 federal trademark registrations that begin with "PUR" and relate to water, making clear that no single party can credibly claim rights in water-related marks that start with PUR. Rather, at least where the goods and services are as different as they are here (PURIFIC for "environmental remediation services" and PURALYTICS for "water purification units"), and where the second portions of the marks are so different (IFICS v. ALYTICS), the relevant public can distinguish the marks as a whole, resulting in no likelihood of consumer confusion. The water purification *goods* listed on Applicant's intent-to-use application differ from Opposers' list of environmental remediation *services* in its registration on which this Opposition is based. These differences also mean that the parties sell their respective goods and services in different channels of trade. In addition, and importantly, Opposers have sophisticated customers who are not likely to be confused. Finally, there is no evidence of actual confusion, despite the opportunity for it to have arisen over the nearly four years of concurrent use. Accordingly, Opposers have not and cannot meet their burden to prove a likelihood of confusion, and the Board should deny this Opposition.

II. DESCRIPTION OF THE RECORD

The evidence of record consists of:

1. Opposers' Registration No. 2,062,935;
2. Applicant's Application No. 77/861,438;
3. The discovery deposition of Opposers' corporate representative Brian Butters, dated October 10, 2012, with exhibits 12-28 and 100-118;

4. The discovery deposition of Applicant's corporate representative Mark Owen, dated September 20, 2012, with exhibits 1-11;
5. The discovery deposition of Applicant's corporate representative Mark Owen, dated January 7, 2013, with exhibits 119-126;
6. The discovery deposition of Marla Beier, dated January 7, 2013, with exhibit 127;
7. The discovery deposition of Heidi Van Baalen, dated January 7, 2013, with exhibit 127;
8. Applicant's Notice of Reliance, dated January 8, 2013, submitting: (a) Opposers' Responses to Applicant's First Set of Requests for Admission, dated February 23, 2011; (b) Opposers' Objections and Responses to Applicant's Second Set of Requests for Admission Nos. 75-181, dated June 22, 2012; and (c) Opposers' Answers to Applicant's First Set of Interrogatories, dated February 23, 2011; and
9. Applicant's Notice of Reliance, dated January 8, 2013, submitting copies of certificates of registration for the following marks:

Mark	Reg. No.
PURIFEX	3845717
PURIFICA	3666172
PURIFITE	3131065
PUR	1756655
PURATIVE	4079429
PURONICS	3473558
PURICORE	3350098
PURICORE	3562610
PURIFICUP	4010575
PURATRON	3570869
PURONICS	3383438
PUREFIT	3341641
PURION	3364913
PURAM	4006374
PURATOR	4058040
PUROSERVE	3703485
PUR	3493649

Mark	Reg. No.
PURITECH	3934473
PURITEC	3927771
PURICA	3490868
PUROCLEAN	2977204
PURETEC	3779811
PUROFLO	3510468
PUREFECTA	2971408
PURAMAX	4006373
PURLOGIX	3113550
PURIFICARE	3329960
PURICOM	2842423
PURE	2587850
PURA	2317449
PURA-TECH	1500440
PURITAP	1083381
PURAFLO	1953921
PURICLEAN	2258041
UV PURE	3720404
PURWATER	2683656
PURI5	4065083
PUR	3880999
PUREDAK	4016579
PURI5	4036750
PURIFITE LIGHTPATH TECHNOLOGY	3121849
P PUREON	3909708
PURIFIRE	3848266
PUREGEN	2788368
PURIHOME	3187212
PURE T	3513812

III. STATEMENT OF THE ISSUES

The issue in this Opposition is whether there is a likelihood of confusion, under 15 U.S.C. § 1052(d), between Applicant's PURALYTICS mark for "Waste water purification units; Water purification and filtration apparatus; Water purification units," and Opposers' PURIFICS mark for "environmental remediation services, namely, soil, waste and water treatment services and air purification services."

IV. RECITATION OF THE FACTS

Applicant UVCleaning Systems, Inc., dba Puralytics (“Applicant” or “Puralytics”) filed its intent-to-use Application Number 77/861,438 for the PURALYTICS mark on October 30, 2009 (“Application”). The Application lists the following goods in International Class 11: “Waste water purification units; Water purification and filtration apparatus; Water purification units.” (U.S. Trademark App. No. 77/861,438.)

Opposers 1047406 Ontario Ltd. and Purifics ES, Inc. (collectively “Opposers” or “Purifics”) filed this Opposition Number 91194706 on April 30, 2010 (“Opposition”). Opposers base the Opposition solely on their PURIFICS registration, in International Class 40, for “environmental remediation services, namely, soil, waste and water treatment services and air purification services” (“Registration”). (U.S. Trademark Reg. No. 2,062,935.) Opposers’ Notice of Opposition alleges only that Applicant’s PURALYTICS mark “is likely to result in confusion, mistake, or deception” with Opposers’ PURIFICS mark. (Notice of Opp’n ¶ 12.)

A. The \$600 Billion “Water Industry”

Opposers and Applicant serve different and distinct needs in different sectors of the \$600 billion so-called “water industry.” The “water industry” refers to a conglomeration of different industries, including utilities, infrastructure, processing, construction, services operations, residential services, and much more. (Owen Dep. 28:6-18, 72:25-73:4, Sept. 20, 2012; Owen Dep. 14:6-15:10, Jan. 7, 2013.¹) Of course, people and companies use water in a wide variety of ways to serve a multiplicity of needs. For example, servers and data centers may need water to cool their systems, different water systems to clean the used water, and different water for irrigation or drinking. Thus, one company’s water needs might be met by several different

¹ Citations to Owen’s September 20, 2012 Deposition will be referred to as “Owen Sept. 20 Dep.” and citations to Owen’s January 7, 2013 Deposition will be referred to as “Owen Jan. 7 Dep.”

water-related companies that do not compete with one another and that provide different products and services, albeit all somewhat related to water. Just like the food industry is a vast industry—from the farmers who grow the crops, to the shippers who transport the crops, to the grocery stores that sell the products, to the restaurants who prepare the meals, and all the companies in between—the “water industry” is a plethora of different industries, with tens of thousands of players in tens of thousands of different niches. (Owen Sept. 20 Dep. 92:2-13; Owen Jan. 7 Dep. 16:1-9, 26:2-22; Butters Dep. 53:25-54:7, Oct. 10, 2012.)

B. Applicant’s Mark Is Unique And Its Trademark Application Is Narrow

Applicant is a small Oregon company that has developed and now markets and sells water purification products. Puralytics’s products are powered by the sun or by LEDs to destroy contaminants in water without creating any hazardous waste disposal products. Based on this technology, Applicant developed its PURALYTICS Shield and SolarBag® products. Neither product requires any services and Puralytics does not perform any services for its customers. (Owen Sept. 20 Dep. 53:22-24; Owen Jan. 7 Dep. 10:24.)

The SolarBag product uses sunlight to activate a five-photochemical process that purifies water to potable water standards. (Owen Sept. 20 Dep. Exs. 4, 5, 9.) It primarily is used by aid organizations in the developing world, by campers and backpackers, and for emergency preparedness kits, to remove contaminants in water sources and turn the water into safe drinking water. (Owen Sept. 20 Dep. 31:13-32:2, 73:7-10; Owen Jan. 7 Dep. 11:22-12:1, 12:21-25, 19:2-9.) The SolarBag product is intended for individual use, retails for \$75-\$80, can be reused hundreds of times, and needs no maintenance services from Puralytics. (Owen Sept. 20 Dep. Exs. 6, 7, 9.)

The Shield product uses LEDs to activate a five-photochemical process that purifies water for ultrapure water systems. (Owen Sept. 20 Dep. Exs. 1, 4, 8; Owen Jan. 7 Dep. 11:12-21.) It is used for laboratory water purification applications, but not for heavy industrial or municipal applications. (Owen Sept. 20 Dep. 32:3-21; Owen Jan. 7 Dep. 18:6-20.) The Shield is used by industrial customers, such as semiconductor or pharmaceutical companies, in their process flow of their products. (Owen Jan. 7 Dep. 11:12-21.) It is easy to use and install and does not require any services from Puralytics. (Owen Sept. 20 Dep. 53:14-24; Owen Jan. 7 Dep. 10:24.)

Applicant began developing these two products in 2007. (Owen Sept. 20 Dep. 75:24-25.) In 2009, Mark Owen, Puralytics's CEO, and his team of engineers and marketers came up with the name PURALYTICS. Their goal was to find a unique name, one that was not previously used and one that would not result in any hits using Internet search tools, such as Google. (*Id.* 14:22-15:2.) They also wanted something that was "vaguely associated with water purification and analytics, photocatalytics, but not too specific." (*Id.* 15:3-6; *see also id.* 15:7-13 ("I think the best marks are ones that don't say anything specifically, like Apple and Nike and things. And so we were targeting something that sounded technical and analytical. Didn't specify exactly what market or space we were in, but did give the idea that it was something to do with purification and technology.")) They tried several dozen names, ran Internet and trademark searches on the names, and finally came up with PURALYTICS. (Owen Sept. 20 Dep. 15:24-16:14; Owen Jan. 7 Dep. Exs. 121-125.)

This process took patience, time, and creativity. There are a lot of marks that start with PUR or AQUA or have to do with water in some way. (Owen Jan. 7 Dep. Exs. 121-125.) Applicant, in this brainstorming process, eliminated many names because of potential similarities

with existing names. (Owen Sept. 20 Dep. 15:14-16:11.) PURALYTICS, however, survived all the tests. (*Id.* 16:12-14.) It conveys a subtle message about the technology, which purifies through action.

After creating the name PURALYTICS, Applicant filed the challenged Application for “Waste water purification units; Water purification and filtration apparatus; Water purification units.” The Application is narrow in scope, focused on water purification units—“equipment that could be used in industrial and drinking water applications for purification of water.” (Owen Jan. 7 Dep. 9:13-16.) The Application is not for environmental remediation services, which concerns the remediation of environmental sites, such as contaminated ponds, waste dumps, industry, and the like. Instead, the mark of the Application is for equipment that makes purer water the PURALYTIC way, for drinking or for industrial processes that require ultrapure water. (*Id.* 10:24-11:7.)

In the drinking water application, water purification units are used to treat water from a river, well, or other source so that the water becomes safe drinking water. (Owen Jan. 7 Dep. 12:21-25.) In the industrial process, water purification units are incorporated into the process line in the facility and are one of the steps in the manufacturing process, much like cutting the widget would be one of the steps in the manufacturing process. (*Id.* 13:7-11.) The water purification equipment industry is a very small subset—roughly 1/200th—of the extensive \$600 billion water industry. (Owen Sept. 20 Dep. 28:11-18.) The challenged Application has a narrow description of goods that is limited to this niche in the water industry.

Applicant has been marketing its goods under the PURALYTICS mark since 2009. (Owen Sept. 20 Dep. 76:1-5.) Applicant markets and advertises its goods and technology through press releases, through resellers, sales agents, and distributors, by going to trade shows,

and by preparing and presenting papers at trade shows and conferences. (*Id.* 54:21-23, 55:2-7, 56:12-17.)

Applicant markets these water purification units to three types of customers: (1) individuals purchasing the SolarBag for personal use; (2) foreign governments and aid organizations; and (3) industrial customers. (Owen Sept. 20 Dep. 31:13-33:4.) All three of these classes of customers know what they are purchasing and are specifically looking for a particular product. For example, individuals purchasing the SolarBag have a unique need to purify water—either for their hiking and camping needs or for their emergency kits. (Owen Jan. 7 Dep. 18:24-19:9.) Governments and aid organizations purchasing the SolarBag have a specific intended use and are conscientious about what they purchase. Shield customers are even more sophisticated, needing water for a particular purpose and seeking out water purification units that meet their specific needs. (*Id.* 19:10-21:17; *see, e.g., id.* 20:2-7 (“So [the industrial customers are] looking for something very specific to solve a particular problem that they’ve detected when using competitors’ products to solve the problem, trying to address that. So they’re very sophisticated at looking at the product.”). Applicant either sells directly to its industrial customers or uses resellers to market and sell its products. (Owen Sept. 20 Dep. 41:4-6; 55:2-56:8; Owen Jan. 7 Dep. 25:13-22.)

C. Opposers’ Registration Is For Environmental Remediation Services

Opposers’ Registration is for “environmental remediation services, namely, soil, waste and water treatment services and air purification services.” (U.S. Trademark Reg. No. 2,062,935.) Nowhere in this description of services is the phrase “water purification.” Nowhere in this description are the terms “photochemical” or “photocatalytic.” (Butters Dep. 100:3-10.) Nowhere in this description is a unit or product. The Registration is limited to “environmental

remediation services,” and further is limited to environmental remediation services that are “waste and water treatment services” and “air purification services.” (U.S. Trademark Reg. No. 2,062,935.) The definition does not include “water purification units.” Environmental remediation involves cleaning something in the environment. (Owen Jan. 7 Dep. 10:24-11:3; Butters Dep. 65:1-67:1 (“[Wastewater treatment is] upgrading the sewage to a reuse standard.... Industrial market involves, you know, cleaning up the water that’s discharged from industry.... [Remedial services or remedial markets] involves cleaning up groundwater for surface water discharge, reinjection, discharge to wastewater treatment plants.... It means we clean up the contaminated groundwater such that it’s clean enough that it can be discharged back into the environment directly.... [Waste water treatment plant use] involves cleaning up the wastewater for discharge or for reuse.”).)

Opposers claim that their mark is for “*inter alia*, water purification services.” (Opposers’ Main Brief at 7.) This is wrong. The Registration recites “waste and water treatment services” and mentions air purification, but makes no reference to “water purification.” (See U.S. Trademark Reg. No. 2,062,935.) The Registration does not define “environmental remediation services” as “water purification services.” Opposers cannot modify their Registration by misquoting it. “Environmental remediation services” has a specific meaning upon which both Applicant’s CEO and Opposers’ President agree. (Owen Jan. 7 Dep. 10:24-11:3; Butters Dep. 65:1-67:1.) Without adding to or changing Opposers’ Registration, “environmental remediation services” does not include “water purification units.”

Opposers’ environmental remediation services are for “municipal applications, industrial applications, and remedial applications.” (Butters Dep. 64:8-10, 67:8-12.) The municipal applications are for municipalities to clean up water so it can be reused for drinking water or

other residential uses. (*Id.* 64:24-65:12.) The industrial applications are for the government and large companies to clean up the water that they discharge. (*Id.* 65:15-66:3.) Finally, the remedial applications are for municipalities and industries to clean up contaminated groundwater so that it can be discharged back to the environment. (*Id.* 66:4-67:7.) Opposers typically sell their services using consultants or representatives, who resell to the end user. These consultants often have civil engineering degrees and understand Opposers’ services and the technology behind them. (*Id.* 43:22-44:17, 77:17-80:14, 126:12-127:6.)

D. Applicant And Opposers Are Both In Industries That Involve Water, But Their Marks And Goods Are Dissimilar

Puralytics and Purifics are not competitors. (Owen Jan. 7 Dep. 29:4-10.) They do not address the same water needs of any potential customer. Instead, they co-exist as two separate businesses in the vast array of businesses and industries loosely termed the “water industry.” (Owen Jan. 7 Dep. 26:6-22, 29:4-23, 52:16-17.) The fact that their respective businesses both involve water in some way does not make them competitors, or make the recited goods of the Application in any way similar to the recited services of Opposers’ Registration. (Owen Sept. 20 Dep. 91:23-93:1.)

E. PUR Marks Are Common

A search on the Trademark Office’s Trademark Electronic Search System (“TESS”) for marks with “PUR” in it that also have “water” listed in the goods and services returns over 1,800 records. The following is a table listing a subset of these marks that start with PUR, are more similar to PURIFICS than PURALYTICS is, and list “water” in their goods and services:

Mark	Reg. No.	Goods/Services
PURIFEX	3845717	IC 011: Filter media available as components of water purifiers and water filtering units for domestic and commercial use
PURIFICA	3666172	IC 011: Water filtration dispenser systems, namely, water filtering units for domestic and commercial use

Mark	Reg. No.	Goods/Services
PURIFITE	3131065	IC 011: Water purification apparatus
PUR	1756655	IC 011: antimicrobial water purification units
PURATIVE	4079429	IC 011: Water purification and filtration apparatus
PURONICS	3473558	IC 011: Water conditioning units; water purifiers; water softening units; water sterilizing units; water filtering units for domestic use; water filtering units for commercial use; water filtering units for industrial use; water treatment equipment, namely, acid neutralizing units, faucets, faucets which meter the flow of water, membrane filtration units, reverse osmosis units, ion exchange units; Air filtration units
PURICORE	3350098	IC 042: Development of new technology for others in the field of biocide sterilizing systems with medical, dental, pharmaceutical, industrial, manufacturing, water treatment and public safety applications
PURICORE	3562610	IC 011: Sterilization and disinfection apparatus, generators and instruments for non-medical use; apparatus, generators and instruments for producing all-purpose sterilizing and disinfection solution, super-oxidised water and rinse water, namely, bacteria-free water used to remove sterilizing and disinfecting solutions without recontamination by bacteria; apparatus and instruments for producing all-purpose sterilizing and disinfection solutions, super-oxidised water and rinse water, namely, bacteria-free waters used to remove sterilizing and disinfecting solutions without recontamination by bacteria, for use in food processing, water treatment, agriculture and other non-medical environments, namely, laboratories, crops, working surfaces, food processing areas, drinking fountains, residential settings and at home, and for eliminating bacteria in the pipework of industrial cooling towers; parts and fitting for all of the aforesaid goods
PURIFICUP	4010575	IC 011: Portable water purification drinking cups sold empty
PURATRON	3570869	IC 011: Air purifiers; Water purifiers
PURONICS	3383438	IC 011: Water conditioning units; water purifiers; water softening units; water sterilizing units; water filtering units for domestic use; water filtering units for commercial use; water filtering units for industrial use; water treatment equipment, namely, acid neutralizing units, faucets, faucets which meter the flow of water, membrane filtration units, reverse osmosis units, ion exchange units
PUREFIT	3341641	IC 011: Water purification units
PURION	3364913	IC 011: Environmental Control Apparatus, Namely, Magnetic Apparatus for Conditioning Water for Use in Homes, Buildings, Boilers, Automobiles and Industry
PURAM	4006374	IC 011: Wastewater treatment and purification units, namely, systems for the treatment and purification of waste water and

Mark	Reg. No.	Goods/Services
		effluent liquids comprised primarily of membrane filtration units, aerobic treatment units, trash or septic or primary tanks, filter beds, clarifiers, blowers, electrical panels, instrumentation, pipes, and structural parts therefor, all for single house or cluster or community or commercial or municipal or industrial wastewater or effluent liquid treatment use only
PURATOR	4058040	... IC 011: Water supply utensils for water purifying installations and bath installations, namely, faucets, water faucet spouts; water purification installations, namely, sewage drainage systems, waste water handling systems excluding waste water filters, infiltration and retention systems for rain water, and building drainage systems; sewage treatment plants; sewage disposal plants; sewage purification plants; sewage purification installations and sewage purification apparatuses excluding filters for sewage treatment and excluding air filters for use in pollution control areas and sewage disposal and waste management plant offices ...
PUROSERVE	3703485	IC 040: Rental of water treatment equipment; Water treatment and purification
PUR	3493649	IC 001: Flocculants for water treatment and remediation of substances from water; chemical substances for treating, purifying, and cleaning water for personal drinking and cleaning
PURITECH	3934473	IC 007: Machines for filling bottles and containers with drinking water for domestic and commercial use
PURITEC	3927771	IC 009: Industrial radiation apparatus for laboratory use, namely, radiation devices for the detection, analysis and treatment of fluid-borne pathogens by application of radiation in the 180-800 nanometer wavelength range, and component parts of the aforesaid goods, namely, 180-800 nanometer light sources, submerging radiation units and UV sterilization units for water disinfection
PURICA	3490868	...IC 035: Retail store services offering cosmetics, skin care and hair care products, health food and health food supplements, light fixtures, namely, full spectrum lights, household cleaning products, filters, namely, air filters and water filters, home care products, home accessories, books, pre-recorded compact discs and DVDs
PUROCLEAN	2977204	IC 037: Property restoration services, namely, cleaning and restoring of commercial, industrial and residential buildings and personal property contained therein to remove smoke, odor, water, chemical contamination, mold and other bio-hazardous substances and to dehumidify and dry building interiors and contents; commercial, industrial and residential

Mark	Reg. No.	Goods/Services
		building restoration, emergency response in the field of real property and contents, damage, namely, stabilization of property, damage containment and immediate mitigation
PURETEC	3779811	IC 040: industrial water treatment and purification
PUROFLO	3510468	IC 011: Water purification system and accessories components therefor sold as a unit with the system, namely, countertop water filtering unit, under sink water filtering unit, counter top reverse osmosis unit, under sink reverse osmosis unit, commercial reverse osmosis unit, water cooler, water softener unit, flow meter, pressure regulator, auto shut off, high pressure regulator, flow restrictor, membrane vessel, filter housing, high capacity filter housing, push-in filtering, carbon block, reverse osmosis storage tank, filter cartridge
PUREFACTA	2971408	IC 011: water conditioning and purifying systems for domestic use, comprised of water filters, sterilizing filters, membrane filters, and reverse osmosis purifiers; drinking water filters
PURAMAX	4006373	IC 011: Wastewater treatment and purification units, namely, systems for the treatment and purification of waste water and effluent liquids comprised primarily of fixed film and suspended media aerobic treatment units, trash or septic or primary tanks, filter beds, clarifiers, blowers, electrical panels, instrumentation, pipes and structural parts therefor, all for single house or cluster or community or commercial or municipal or industrial wastewater or effluent liquid treatment use only
PURLOGIX	3113550	IC 011: bottleless water purification system consisting of water purification unit, water dispenser, programmable microprocessor, operating software, and water filters that produces potable water for domestic and commercial point of use
PURIFICARE	3329960	IC 011: Water treatment and filtration units, namely, water purification units and water filtering units for domestic use, and parts and fittings therefor
PURICOM	2842423	IC 011: water purification units; water purifiers; reverse osmosis filtration units; reverse osmosis water purification units; water filters; reverse osmosis drinking water machines; water treatment equipment, namely, ultraviolet sterilization units
PURE	2587850	IC 011: Water Purification Units
PURA	2317449	IC 011: Water purification units
PURA-TECH	1500440	IC 011: water distiller and a water conditioner including reverse osmosis filtration
PURITAP	1083381	IC 011: domestic tap water purification and dispensing units
PURAFLO	1953921	IC 011: systems for the treatment and purification of waste water and effluent liquids and gases comprising peat fiber

Mark	Reg. No.	Goods/Services
		filtration units, septic tanks, filter beds, gas scrubbers, pipes, fittings and parts therefor, all for domestic use only
PURICLEAN	2258041	IC 011: water filters and water filter cartridges for use with refrigerator ice makers and water dispensers
UV PURE	3720404	IC 011: Water purification units; water purification systems comprising radiation emitting lamps and a liquid treatment chamber for domestic, commercial and industrial use; wastewater treatment units for domestic and industrial wastewater; process water treatment units for treatment of fresh and recycled water; potable water treatment units for treatment of surface water and ground water; water purification units for pools and spas; and parts and components for all of the above
PURWATER	2683656	IC 011: reverse osmosis water purification unit for commercial and domestic use
PURI5	4065083	IC 011: water systems, namely, water purifying units for domestic and commercial use, water conditioning units for domestic and commercial use, water filtering units for domestic and commercial use, and water coolers
PUR	3880999	IC 011: Antimicrobial water purification units, water filter cartridges, water purification units for domestic use, and household appliances, namely, water filters for domestic use and water dispensers
PUREDAK	4016579	IC 011: Water purification units
PURI5	4036750	IC 011: water systems, namely, water purifying units for domestic and commercial use, water conditioning units for domestic and commercial use, water filtering units for domestic and commercial use, and water coolers
PURIFITE LIGHTPATH TECHNOLOGY	3121849	IC 011: Water purification apparatus
P PUREON	3909708	...IC 011: Gas purifier; electric heaters for gas filter; water filters, filter cartridges, and filter housings, said water filters, filter cartridges and filter housings not for use with hollow fiber filtration membranes and membrane modules used in filtration of wastewater, membrane bioreactor (MBR) applications, or surface water treatment
PURIFIRE	3848266	IC 009: Combination firefighting and water purification apparatus and systems, consisting primarily of pump and water purification units for integrated use with a fire apparatus IC 011: Combination water purification and firefighting apparatus and systems, consisting primarily of water purification units and a pump for use independently of fire apparatus; water purification units
PUREGEN	2788368	IC 011: Water Purification system and accessories components therefor sold as a unit with the system, namely, countertop

Mark	Reg. No.	Goods/Services
		water filtering unit, under sink water filtering units, counter top reverse osmosis unit, under sink reverse osmosis unit, commercial reverse osmosis unit, water cooler, water softener unit, flow meter, pressure regulator, auto shut off, high pressure regulator, flow restrict or, membrane vessel, filter housing, high capacity filter housing, push-in filtering, carbon block, reverse osmosis storage tank, filter cartridge
PURIHOME	3187212	IC 011: commercial and residential water conditioning and purification units, namely, water softeners and reverse osmosis purification units
PURE T	3513812	IC 011: Reverse osmosis filtration units, water purification units, waste water purification units, water conditioning units, and replacement parts for all the above

(Regs. Not Subject of Proceedings Owned by Third Parties.)

Simple Internet searches for these marks show that many of these marks are in use today. (Beier Dep. Ex. 127; Van Baalen Dep. Ex. 127.) At a minimum, it is clear that these marks are easy to find on the Internet and that people readily distinguish between an array of PUR marks relating to water. Marks like PURE and PURA are registered for “water purification units,” and PUR itself is registered for “antimicrobial water purification units.” (*See* Regs. Not Subject of Proceedings Owned by Third Parties, at Reg. Nos. 2,587,850, 2,317,449, and 3,880,999.).

F. Opposers Have Not Actively Policed Their Mark

Opposers have challenged the use of three marks: (1) Purificare; (2) Purific Water Solutions; and (3) Purific. (Butters Dep. 46:14-23, 47:6-7, 48:3, 93:4-96:6.) Each of these marks includes the entire PURIFICS mark except for the “S” at the end. (*Id.* 93:4-96:6.)

Opposers offer no credible explanation for not taking action against marks and services that are more similar to PURIFICS than Applicant’s PURALYTICS Application. Opposers’ President, Brian Butters, conceded that marks such as PURIFICA and PURIFEX are “similar” to the PURIFICS mark (Butters Dep. 96:20-21, 101:14-15), but the registrations (both filed in 2008) coexist without objection from Opposers (*id.* Exs. 100-101). Mr. Butters also testified that

the mark PURONICS (*id.* Exs. 104-105 (registered in class 11 for “water conditioning units”) is *not* similar to PURIFICS:

Q. Okay. Can we go to Exhibit 104, please? What is the mark there?

A. Puronix. [sic, Puronics]

Q. Would you say that’s similar to your mark Purifics?

A. No.

(*id.* 107:5-10; *see also id.* Exs. 100-116, 96:19-124:11 (discussing similar marks)). Mr. Butters admitted that Opposers have not policed their PURIFICS mark against any of these other PUR marks. (*Id.* 98:21-126:8.)

V. RESPONSE TO EVIDENTIARY OBJECTIONS

Opposers challenge Applicant’s evidence of website screenshots that show use of PUR marks registered with the Trademark Office.² This evidence meets the Board’s evidentiary requirements for publicly-available website evidence. The evidence has been submitted by Applicant’s Notice of Reliance; the evidence is publicly available on the Internet; and Applicant identified the date the evidence was accessed and printed, and the source (URL) of the evidence. Both the date of the access and the URL of the websites were authenticated. Opposers challenge the evidence on the ground that there is no testimony regarding the date of access. Opposers are wrong. Ms. Marla Beier testified that she accessed the websites on June 20, 2012. (Beier Dep. 8:18-9:11.) Ms. Heidi Van Baalen testified that she accessed the websites on June 21, 2012. (Van Baalen Dep. 7:9-8:3.)

Opposers also challenge this evidence on hearsay and relevance grounds. The evidence is not hearsay because it is not offered to prove the truth of the fact asserted. Rather, the

² Contrary to Opposers’ statement, Applicant’s evidence of other third party registrations focuses on marks starting with PUR, and not on marks ending in ICS (although there may be other marks that start with PUR and end with ICS). At present, a search on the TESS for marks ending with “ICS” that also have “water” in the description of goods and services results in over 3,000 records.

evidence is intended to show (1) that “PUR” has appealed to others for use as a trademark element, and (2) that Opposers have been on constructive notice of this information, to police their PURIFICS mark or not. Evidence of third party usage of similar marks on similar goods is admissible and relevant to show that a mark is relatively weak and entitled to a narrower scope of protection. *See, e.g., PC Club v. Primex Techs., Inc.*, 32 F. App’x 576, 580 (Fed. Cir. 2002) (affirming use of websites to show use of similar marks: “PC Club asserts that the web page printouts, which were used by the Board to determine that the ENPOWER mark was weak, were inadmissible hearsay. The Board used printouts from web pages to show that the marks have appealed to others as a trademark element, not to prove the truth of the statements contained in the websites.”). Likewise, evidence of failure to police a mark is relevant to the strength of the mark and to the likelihood of confusion analysis. Failure to police can result in a loss of distinctiveness of a mark: if there are numerous products in the marketplace bearing the alleged mark, then purchasers may learn to ignore the “mark” as a source identifier. When that occurs, the conduct of the former owner, by failing to police its mark, can be said to have caused the mark to lose its significance as a mark. *See Application of Franklin Press, Inc.*, 597 F.2d 270, 274 (C.C.P.A. 1979) (“[T]his case supports placing the burden on the owners of marks to take appropriate action via oppositions or cancellation proceedings to police their own marks.”).

The website screenshots simply show that the registered marks have appealed to others as a trademark element. The websites also show that, had Opposers chosen to, they could have policed their mark by investigating (by, for example, a simple Internet search) the use of other registered marks.

The evidence of the websites (Beier and Van Baalen Deps. Ex. 127) therefore meets the Board’s evidentiary requirements and is not inadmissible hearsay.

VI. EVIDENTIARY OBJECTIONS

A. Opposers' Alleged Evidence Of Actual Confusion Is Inadmissible

Opposers offer inadmissible testimony in support of alleged actual confusion. The Board should reject this testimony. First, this testimony is vague, uncorroborated, and hearsay. Second, this testimony contradicts Opposers' discovery responses affirmatively stating that there was no evidence of actual confusion.

1. Opposers' Inadmissible Testimony

Opposers' President, Brian Butters, testified that he was aware of an instance of confusion between Purifics and Puralytics:

Recently we hired an individual to support the marketing, and during the interview phase and after he came on board he did internet searches, that was his forte, and he came across Puralytics. And after we hired him, he informed us that he thought they were the same company.

(Butters Dep. 44:23-45:3; *see also id.* 82:23-83:6.)³ The testimony of the employee himself is not in evidence, although the alleged confusion occurred during the pendency of this Opposition. Mr. Butters testified that he found out about this alleged confusion during a June 2012 meeting: Mr. Butters does not recall anything else that occurred during this meeting, does not recall any other conversations or information conveyed about this alleged confusion, does not know the reasons for the alleged confusion, and does not recall whether there was anyone else in the room during the conversation. (*Id.* 83:19-86:6.) Mr. Butters admitted that he did not know what the individual was thinking. (*Id.* 83:8-11.) Mr. Butters admitted that he did not ask the individual any questions about this alleged confusion, even though the alleged confusion occurred during the pendency of this Opposition. (*Id.* 83:12-18.) Mr. Butters was deposed in October 2012, only

³ Opposers do not cite this testimony in their Main Brief or argue that there was any actual confusion.

four months after this alleged instance of actual confusion. Further, the individual was fired after only two or three months working for Opposers because “He wasn’t able to do the job.” (*Id.* 84:20.) Mr. Butters testified that he is not aware of any customer confusion or any other instance of confusion. (*Id.* 86:7-87:8.)

Mr. Butters’s testimony is inadmissible hearsay. The evidence is uncorroborated: Mr. Butters testified that he does not recall if anyone else knows of the alleged conversation. The evidence is vague: Mr. Butters testified that he does not know any of the circumstances surrounding the alleged confusion, and that he did not take any action or ask any questions to learn more about the alleged confusion. (Butters Dep. 83:19-86:6.) Mr. Butters’s testimony on this point goes to another individual’s alleged state of mind, yet Mr. Butters admits that he does not know what the individual was thinking, the circumstances around that alleged thought, or the reasons for that alleged thought. This testimony of alleged actual confusion is inadmissible and therefore should be given no weight.

2. Opposers’ Discovery Responses State That There Is No Actual Confusion

Applicant asked Opposers for any evidence of actual confusion in Applicant’s First Set of Interrogatories, dated November 9, 2010, and in Applicant’s First Set of Requests for Admission, dated November 9, 2010. Opposers responded that they are not aware of any actual confusion:

INTERROGATORY NO. 3

Describe all instances or occurrences known to Opposers in which anyone has indicated any confusion or mistake as to whether any entity’s goods or services are affiliated, connected, or associated with, or sponsored or endorsed by Opposers and/or the PURIFICS Mark.

ANSWER

Opposers object to this interrogatory as overly broad and unduly burdensome in seeking “all instances or occurrences” known to Opposers in which anyone has indicated confusion or mistake

between Opposers or their PURIFICS mark and Applicant or its PIJRALYTICS mark. Subject to and without waiving the foregoing general and specific objections, Opposers state that, having not yet taken full discovery, *Opposers are not aware of any instances of actual confusion at this time*; however, Opposers reserve their right to supplement this response as discovery continues.

(Opposers' Answers Applicant's First Set Interrogs., at 3 (emphasis added).)

REQUEST NO. 2

Admit that Opposers are not aware of any specific instances of actual consumer confusion between services offered under the PURIFICS Mark and Applicant's Goods offered under Applicant's PURALYTICS Mark.

ANSWER

Opposers object on the ground that Applicant defines the term "PURIFICS Mark" as referring only to U.S. Registration No. 2,062,935, which excludes other rights asserted in this opposition. Subject to and without waiving the foregoing general and specific objections, *Opposers admit that, without having yet taken full discovery, they are not aware at this time of any instances of actual consumer confusion or mistake that have resulted from Applicant's PURALYTICS mark*. Opposers otherwise deny this request and reserve the right to amend this response as discovery continues.

...

REQUEST NO. 9

Admit that Opposers are unaware of any specific instances of actual consumer confusion between its environmental remediation services, namely, soil, waste, and water treatment services and air purification services - offered under the PURIFICS Mark, and Applicant's Goods offered under the '438 Application.

ANSWER

Opposers admit that, without having yet taken full discovery, they are not aware at this time of any instances of actual consumer confusion or mistake that have resulted from Applicant's use of the PURALYTICS mark. Opposers otherwise deny this request and reserve the right to amend this response as discovery continues.

...

REQUEST NO. 12

Admit that there is no evidence of actual confusion between the PURIFICS Mark and Applicant's PURALYTICS Mark.

ANSWER

Opposers object to this request on the ground that Applicant defines the term "PURIFICS Mark" as referring only to U.S. Registration No. 2,062,935, which excludes other rights asserted in this opposition. Subject to and without waiving the foregoing general and specific objections, *Opposers admit that, without having yet taken full discovery, they are not aware at this time of evidence of actual consumer confusion between the PURIFICS mark and the PURALYTICS mark.* Opposers otherwise deny this request and reserve the right to amend this response as discovery continues.

REQUEST NO. 13

Admit that there is no evidence of actual confusion between Opposers and Puralytics.

ANSWER

Opposers admit that, without having yet taken full discovery, they are not aware at this time of any evidence of actual consumer confusion between Opposers and Puralytics. Opposers otherwise deny this request and reserve the right to amend this response as discovery continues.

(Opposers' Resps. Applicant's First Set Reqs. Admis., at 2-3, 6-8 (emphasis added).)

Opposers had ample opportunity to supplement these responses but never did. The Interrogatory responses are verified, signed by Mr. Butters. (Opposers' Answers Applicant's First Set Interrogs., at 21.) Mr. Butters's testimony directly conflicts with Opposers' written discovery responses. The written discovery responses are more reliable and further emphasize the speculative, vague, and untrustworthy nature of any alleged actual confusion.

B. Opposers Have Not Provided Evidence Of Common Law Rights

Opposers did not assert common law rights in their Notice of Opposition. (*See* Notice of Opp'n.) Opposers have provided no evidence of any prior use or common law rights in the

PURIFICS mark outside of their Registration. “A party pursuing an opposition on the ground of likelihood of confusion ‘must prove that it has proprietary rights in the term it relies upon to prove likelihood of confusion.’” *Stoller v. Sutech U.S.A., Inc.*, 199 F. App’x 954, 956 (Fed. Cir. 2006) (quoting 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:15 (4th ed. 2006)). That proof must consist either of evidence of ownership of a federally registered mark or of prior use of an unregistered mark. *Id.* Opposers have provided no evidence of prior use of the PURIFICS mark on water purification units or equipment, the geographic region in which the mark was used, or the customers to whom the units were sold. They did not allege common law rights in the Notice of Opposition, they did not submit any evidence through a notice of reliance in support of their purported prior use or common law rights, and they did not provide any direct, clear testimony of prior use. *See, e.g., Tzu Wei Chen Food Co. v. Chia-Chi Enters., Inc.*, 73 F.3d 379, at *2 (Fed. Cir. Dec. 5, 1995) (reversing Board’s finding of prior use, finding “the record in this case is as remarkable for what it does not contain as for what it does.... Chia-Chi did not offer a single shred of direct evidence, through either testimony or documents, to support its claim of prior use. Furthermore, it failed to produce important, easily-procured documents which would have greatly bolstered its claim of prior use.”); *Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 1401 (C.C.P.A. 1972) (finding evidence of prior use insufficient because “witness’ testimony on advertising use of the slogan in 1960-1964 is far from clear and definite” and “the rather limited advertising use which Dandy may have made of the slogan at times in the years 1955-1964 (on a few billboards in 1955-1960, and in some trade journal, radio, newspaper and television advertising in 1960-1964) is not sufficient to defeat White’s right of registration”). Without any such evidence, Opposers cannot claim prior use or common law rights.

VII. ARGUMENT AND AUTHORITIES

Opposers have the burden to show likelihood of confusion between the two different marks, PURIFICS and PURALYTICS, for the two different descriptions of goods and services— basically, “environmental remediation services” for PURIFICS, and “water purification units” for PURALYTICS. Section 2(d) of the Lanham Act states, in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

15 U.S.C. § 1052(d). The determination under Section 2(d) is based on an analysis of all the probative facts in evidence relevant to the factors bearing on the issue of likelihood of confusion.

Application of E.I. DuPont De Nemours & Co., 476 F.2d 1357, 1362 (C.C.P.A. 1973)

(“*DuPont*”). Opposers burden requires that they show likelihood of confusion by a

preponderance of the evidence. *Minn. Mining & Mfg. Co. v. McDonnell*, 163 F.2d 557, 561

(C.C.P.A. 1947). “Whether a likelihood of confusion exists between an applied-for mark and a

previously registered mark is determined on a case-by-case basis, aided by application of the

DuPont factors.” *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1349 (Fed.

Cir. 2011). Not all *DuPont* factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending on the evidence of record. *Id.* at 1355.

Here, the relevant *DuPont* factors weigh against a finding of confusion: (1) PURIFICS and PURALYTICS are dissimilar marks, there are a significant number of similar marks used on similar goods, and PURIFICS is not famous; (2) the goods and services as described in the

Application and Registration are dissimilar, as are the channels of trade; (3) the customers are sophisticated and unlikely to be confused; and (4) there is no supported evidence of actual confusion, despite four years of concurrent use.

A. The Marks Are Dissimilar

The *DuPont* factor assessing the “similarity or dissimilarity of the marks” favors Applicant. In deciding the similarity or dissimilarity of marks, each mark must be considered in its entirety, and all relevant facts pertaining to appearance, sound, and connotation must be considered. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000). “Once all of the features of the mark are considered, however, it is not improper to state that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *Id.*; *see also Seven-Up Co. v. Tropicana Prods., Inc.*, 356 F.2d 567, 568 (C.C.P.A. 1966) (“[E]ach mark must be considered in its entirety, but it does not follow that every part of a mark must be given the same weight.”) (citation omitted).

The marks PURIFICS and PURALYTICS, when viewed in their entirety, are not confusingly similar. The marks differ in appearance and sound, and in commercial impression. Both marks start with PUR, but there are meaningful differences between the marks as a whole. PURALYTICS (ten letters) is longer than PURIFICS (eight letters). PURIFICS is pronounced pur-i-fics and PURALYTICS is pronounced pur-a-ly-tics. “IFICS” and “ALYTICS” are materially different, especially in the context of the over 45 federally-registered PUR marks for water-related goods or services, listed *supra*, that are already on the Principle Register. Opposers try to argue that both marks end in ICS, but that is not how customers pronounce the words: the “F” in “FICS” and the “T” in “TICS” are integral, with the teeth touching the lips to

create the “F” sound in “FICS,” and tongue touching the roof of the mouth to make the “T” sound in “TICS.” There is no emphasis in the pronunciation of either marks on “ICS,” and Opposers’ attempt to isolate those letters seeks to dissect the marks in an artificial manner. Mr. Butters’ admission that PURONICS is *not* similar to PURIFICS (Butters Dep. 107:5-10) further undermines Opposers’ argument.

Because of these differences in look and sound, the two marks also differ in commercial impression. Both marks start with PUR, commonly used in connection with water and water purification. The remaining portions of PURALYTICS—ALYTICS—suggests something analytical or possibly having to do with photocatalytic technology. The PUR and ALYTICS components of the mark each are equally significant to the whole mark and impression thereof. In contrast, the non-PUR portion of PURIFICS—IFICS—does not have a similar commercial impression. *See, e.g., Kellogg Co. v. Pack’em Enters., Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991) (finding dissimilarity in marks FROOT LOOPS and FROOTEE ICE dispositive because, although the marks start with the words FROOT and FROOTEE, the marks sound different and create different commercial impressions); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1390 (Fed. Cir. 1989) (affirming Board finding that PECAN SANDIES and PECAN SHORTEES, ““in their entirety’ do not convey similar commercial impressions”).

Opposers try to ignore the differences in the marks and fail to look at the marks in their entirety. Opposers artificially separate the common first letters PUR and the common last letters ICS, and argue that the marks are similar.⁴ This is not how marks are compared. *See, e.g., Packard Press*, 227 F.3d at 1357 (finding the Board erred by focusing only on the

⁴ Applicant has never suggested or acknowledged that “ICS” is a “significant feature[]” of the marks. (Opposers’ Main Brief at 15.) Applicant has explained repeatedly that “PUR” is the similar feature of the marks, along with many other marks.

“Packard” component of both PACKARD TECHNOLOGIES and HEWLETT-PACKARD marks); *Seven-Up Co.*, 356 F.2d at 567 (“Certainly a 3-letter word cannot be said to ‘resemble’ a 5-letter one just because both begin and end with the same letter. Nor do we think confusing similarity in the marks can be found merely from the concurrently used word ‘up’ ... [when] the average purchaser is so accustomed to seeing [‘up’] used in conjunction with a wide range of other English words that, when it appears in a trade-mark, he would be unlikely to recognize it as signifying source or origin.”).

The cases cited by Opposers do not support their position. For example, in *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 U.S.P.Q.2d 1826, 1832 (T.T.A.B. 2012), the marks were identical except for one letter.⁵ In *Wet Seal Inc. v. FD Management Inc.*, 82 U.S.P.Q.2d 1629, 1639 (T.T.A.B. 2007), the Board emphasized the importance of viewing the marks in their entirety. The Board held that the term ARDEN, which is the beginning of both marks, “makes a surname impression” and is the dominant portion of the marks. *Id.* The Board also found that the B in the mark ARDEN B may be viewed as an abbreviation for the full term ARDENBEAUTY. *Id.*⁶ Here, the common portion of the marks—PUR—is used in over 45 registered marks associated with water. The rest of the marks are indisputably different, and PUR is not the dominant or overwhelming portion of the PURALYTICS mark.

⁵ Opposers inaccurately depict the differences in the marks in dispute in *Lebanon Seaboard*. The Board did not parse out the last four letters, as Opposers suggest. (Opposers’ Main Brief at 15.) Instead, the Board considered the letters “FECTA,” not just “ECTA.” *Lebanon Seaboard*, 101 U.S.P.Q.2d at 1831-22.

⁶ The other cases cited by Opposers are similarly distinguishable. See *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058-60 (Fed. Cir. 1985) (emphasizing importance of viewing marks in their entirety, while giving “less weight to a portion of the mark” if it is descriptive; holding that, even though the similar portions of the marks CASH MANAGEMENT ACCOUNT and THE CASH MANAGEMENT EXCHANGE were descriptive, when viewed in their entireties, the “dissimilar part has been submerged” by the similar); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (finding marks KID STUFF and KID WIPES similar because they have the same syllables and letters and “opposer was the only party using the term ‘KID’ as part of a mark for moist towelettes, or wipes”); *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 U.S.P.Q.2d 689, 690 (T.T.A.B. 1986) (finding marks COMMCASH and COMMUNICASH similar because COMM is an “abbreviation for communications”).

In sum, when viewed in their entireties, PURIFICS and PURALYTICS differ in appearance, sound, and commercial impression, and therefore are not confusingly similar.

1. There Are Many Similar “PUR” Marks On Water-Related Goods And Services

The *DuPont* factor assessing the “number and nature of similar marks in use on similar goods” favors Applicant. It is clear from the record that PUR is an appealing term that has been frequently used by companies in connection with water and water purification. (Regs. Not Subject of Proceedings Owned by Third Parties; Beier Dep. Ex. 127; Van Baalen Dep. Ex. 127.) These third party registrations are relevant to determine the strength of the marks and likelihood of confusion. *Miguel Torres, S.A. v. Bodegas Muga, S.A.*, 176 F. App’x 124, 129 (Fed. Cir. 2006) (affirming Board’s use of evidence of use by third parties: “the sheer number and geographical distribution of Muga’s examples of third-party use give the evidence some probative value” to the likelihood of confusion); *PC Club*, 32 F. App’x at 580 (affirming “Board’s use of third party registrations to determine the strengths of the ... marks”); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:88 (4th ed. 2013) (“Evidence of third party use of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to only a narrow scope of protection.”).

The significant number of marks starting with PUR in the water industry weighs against a finding of likelihood of confusion. Customers in the water industry have become so conditioned by the plethora of similar PUR marks that they have been educated to distinguish between these PUR marks on the basis of minute distinctions. *See, e.g., Miguel Torres*, 176 F. App’x at 128. In such a diluted field, confusion is unlikely.

2. **PUR Is Suggestive And PUR Marks Are Less Likely To Cause Confusion**

In the context of water-related goods or services, PUR suggests purification or purifying. (*See, e.g.*, Butters Dep. 10:22-11:1; Owen Sept. 20 Dep. 15:3-6.). Using PUR in this suggestive manner and in this context is quite common. (*See, e.g.*, Regs. Not Subject of Proceedings Owned by Third Parties; Butters Dep. Exs. 100-116; Beier Dep. Ex. 127; Van Baalen Dep. Ex. 127). As a result, this use of PUR confers little or no distinctiveness to a mark as a whole. *See, e.g., Keebler Co. v. Partners, A Tasteful Choice Co.*, 2007 WL 1022712, Opp'n Nos. 91152728 & 91154926, at *17 (T.T.A.B. Mar. 27, 2007) (finding marks ALL-AMERICAN CRACKERS for crackers and ALL-AMERICAN COOKIES for cookies “very weak marks”); *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1005 (2d Cir. 1983) (finding PLUS weak because it “is an everyday word that indicates something added, and when applied to goods, it merely implies additional quantity or quality” and “third-party use of the word PLUS is extensive”); *see also* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:48 (4th ed. 2013) (“If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.”).

Trademarks ordinarily will not be confusingly similar when they merely share a suggestive or descriptive syllable, word, or prefix. *Sears, Roebuck & Co. v. Hofman*, 258 F.2d 953, 954 (C.C.P.A. 1958) (finding ROYAL PLUMAGE not similar to ROYAL PURPLE). This is because the suggestive portion of the mark is so widely used that the public can distinguish minor differences in marks starting with the suggestive term even if the goods are related. *See, e.g., PC Club*, 32 F. App'x at 579; *see also Kramer Trenton Co. v. Walcutt*, 408 F.2d 479, 480 (C.C.P.A. 1969) (holding no likelihood of confusion to sustain the opposition between marks WINTERIZER and WINTERSTAT because, *inter alia*, the similarity in the marks was limited to

“the use of the suggestive prefix WINTER”); *Lauritzen & Co. v. Borden Co.*, 239 F.2d 405, 407 (C.C.P.A. 1956) (finding syllable “lac” in the marks “has a somewhat descriptive connotation as applied to milk products, and has been commonly used as a portion of trademarks for such products. Accordingly, it should be given little weight in determining whether those marks are confusingly similar.”); *Goldring, Inc. v. Town-Moor, Inc.*, 228 F.2d 254, 255 (C.C.P.A. 1955) (finding no likelihood of confusion between marks TOWN-MOOR and TOWNLEY: “The only similarity between the marks here under consideration resides in the word ‘Town,’ and it is apparent from the record that that word is commonly used as a part of trade-marks or trade-names for various kinds of merchandise, including clothing. Under such circumstances appellant can have no exclusive right to the use of the word ‘Town’ *per se.*”).

Likewise here, Opposers cannot have the exclusive right to use PUR, which is commonly used and suggestive. When the appropriately-diminished weight is given to the PUR portions of the marks at issue, the dissimilarity of the marks is even more apparent.

3. PURIFICS Does Not Merit Broad Protection

Opposers have not actively policed their mark against similar and sometimes even nearly-identical marks. (*See* Butters Dep. 96:17-126:1.) Marks as similar to PURIFICS as PURIFICA, PURONICS, PURIFEX, PURIFITE, PURATIVE, PURATRON, PUREFIT, PURICA, PURETEC, PURAC, PUROFLO, PUREFECTA, PURAMAX, PURLOGIX, PURICOM, and IPURE exist in the water or water purification space, and Opposers have not investigated these marks. (*See id.*) A failure to police a mark may cause a mark to lose its significance as a mark. *See* 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:1. With so many PUR marks and with the term PUR suggestive of purification, PURIFICS cannot now try to preempt

all PUR marks from registering; it has no basis for precluding PURALYTICS from registering when it is so different from the mark PURIFICS.

4. PURIFICS Is Not Famous

PURIFICS is not famous in the water industry, in the environmental remediation services industry, or in the water purification industry. And PURIFICS provides no evidence in support of its conclusory allegations of fame. *See, e.g., Packard Press*, 227 F.3d at 1360 (“That the fame factor is based on underlying factfinding dictates that relevant evidence must be submitted in support of a request for treatment under the fame factor.”). Opposers have not provided evidence of any sales or any customer base, much less significant sales or a vast customer base. Opposers have not provided any evidence of their advertising expenses or efforts. In fact, Mr. Butters testified that their advertising efforts have “fallen to the background.” (Butters Dep. 21:8.) Instead, they “focus more on press releases and through trade shows, through webinars, flyers.” (*Id.* 21:10-11.) Likewise, Applicant’s advertising focuses on press releases and trade shows. (Owen Sept. 20 Dep. 54:9-23.)

Opposers’ claim to fame is unsubstantiated and has no bearing on the likelihood of confusion analysis. *See, e.g., Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1904 (T.T.A.B. 2007) (finding “the evidence falls far short of establishing that the ... mark is famous” where evidence of advertising expenses was for a single year and not in context, and there was no evidence of number of potential members versus actual). “[I]t is the duty of a plaintiff asserting that its mark is famous to clearly prove it.” *Blue Man Prods., Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1819 (T.T.A.B. 2005) (finding BLUE MAN GROUP mark not famous in likelihood of confusion analysis). Opposers have made no showing of fame.

B. The Registration And Application Are For Dissimilar Goods And Services Sold In Different Channels Of Trade

The *DuPont* factors assessing the “similarity or dissimilarity and nature of the goods or services as described in an application or registration” and the “similarity or dissimilarity of established, likely-to-continue trade channels” favor Applicant. These factors “compare[] the goods in the applicant’s application with the goods in the opposer’s registration[].” *PC Club*, 32 F. App’x at 578. Opposers’ Registration is for “environmental remediation services” as defined by “waste and water treatment services” and “air purification services.” (U.S. Trademark Reg. No. 2,062,935.) In contrast, Applicant’s Application is for “Waste water purification units; Water purification and filtration apparatus; Water purification units.” (U.S. Trademark App. No. 77/861,438.) The key phrase in the Registration is “environmental remediation services” and the key phrase in the Application is “water purification units.” Neither phrase is included in the others’ Registration or Application. And the Registration is for services while the Application is for goods.

Environmental remediation services and water purification units serve different purposes and satisfy different needs. Environmental remediation services clean up waste water for municipalities and industries so it can be reused or discharged. (*See, e.g.*, Butters Dep. 64:8-67:7; Owen Jan. 7 Dep. 10:24-11:3.) Water purification units, however, purify water for drinking purposes or for use in industrial processes. (*See, e.g.*, Owen Jan. 7 Dep. 9:13-21, 11:12-12:1.) Providers of each are not competitors. (Owen Sept. 20 Dep. 91:23-93:1.)

Opposers are attempting to go beyond the scope and language of their Registration by failing to quote the Registration in their Main Brief and claiming that it covers “water purification.” It is not Applicant, but Opposers, who are trying to avoid the language in their Registration. As explained *supra*, Opposers’ Registration is for “water treatment” as part of an

“environmental remediation service.” And “environmental remediation services” is different from “water purification.”

There is no evidence that any buyer thinks the different goods and services of the Application and Registration come from the same source. The fact that both parties may potentially sell Applicant’s goods or Opposers’ services to the same industrial users does not mean that the goods and services are related. *See, e.g., Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 716-17 (Fed. Cir. 1992) (“[I]t is error to deny registration simply because applicant sells some of its goods in some of the same fields in which opposer provides its services, ... without determining who are the relevant persons within each corporate customer.”) (quotation omitted); *PC Club*, 32 F. App’x at 578 (“Goods are not related because they coexist in the same broad industry, but are related if they are marketed and consumed such that buyers are likely to believe that the goods come from the same source, or are somehow connected with or sponsored by a common company.”) (quotations and citation omitted); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 U.S.P.Q.2d 1390, 1395 (T.T.A.B. 1991) (“Consequently, we concur with applicant that the fact that both parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely.... ‘The ‘hospital community’ is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties’ respective products’. The fact, therefore, that there is some overlap in the trade channels is not dispositive in this case.”) (citation omitted). Water purification, on the one hand, and environmental remediation services, on the other, serve different needs, and there is no evidence that any customer would

expect those disparate needs to be met by the same company. As such, the relatedness of the goods and services and the channels of trade are not likely to cause confusion.

C. Opposers And Applicant Have Sophisticated Customers

The *DuPont* factor assessing the “conditions under which and buyers to whom sales are made” favors Applicant. It is inherent in both the Registration and Application that the buyers of the “environmental remediation services” and “water purification units,” respectively, are sophisticated. These respective services and products serve specific needs and would be selected with great care by purchasers familiar with the source and origin of the products. *See, e.g., Elec. Design & Sales*, 954 F.2d at 718 (“Just from the record description of goods and services here one would expect that nearly all of opposer’s and applicant’s purchasers would be highly sophisticated.”).

The goods and different services at issue in this case both are sold to sophisticated purchasers, such as industrial users, municipalities, and aid organizations. (*See Butters Dep.* 64:8-67:12.) These classes of customers are sophisticated, research the products they are purchasing, and familiarize themselves with the products before purchasing. (*See, e.g., Owen Jan. 7 Dep.* 19:10-21:17.) They “plainly are highly educated, sophisticated purchasers who know their equipment needs and would be expected to exercise a great deal of care in its selection.” *Hewlett-Packard*, 23 U.S.P.Q.2d at 1396. Further, both Opposers and Applicant sell through resellers, whose job it is to know the products they are selling and familiarize themselves with the industry. (*See, e.g., Butters Dep.* 43:22-44:17; *Owen Sept. 20 Dep.* 41:4-6; 55:2-56:8.) These consumers are not likely to be confused. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:101 (4th ed. 2013) (“Where the relevant buyer

class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers.”).

To the extent individuals purchase Applicant’s SolarBag product, its high retail price suggests that customers will exercise care and there will be less likelihood of confusion. *See PC Club*, 32 F. App’x at 579 (“Given the amount of money it costs to install Primex’s EMPOWER system, it is clear that a purchaser of Primex’s system will exercise, at a minimum, some degree of care.”). Accordingly, Opposers and Applicant have sophisticated customers who are unlikely to be confused.

D. Even After Nearly Four Years Of Concurrent Use, There Is No Evidence Of Actual Confusion

Opposers and Applicant have concurrently used their marks for nearly four years and there is no evidence of actual confusion. Applicant is unaware of any actual confusion and Opposers’ discovery responses expressly confirm that Opposers are unaware of any actual confusion. (Opposers’ Answers Applicant’s First Set Interrogs., at 3; Opposers’ Resps. Applicant’s First Set Reqs. Admis., at 2-3, 6-8.) *See, e.g., Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1050 (9th Cir. 1999) (“We cannot think of more persuasive evidence that there is no likelihood of confusion between these two marks than the fact that they have been simultaneously used for five years without causing any consumers to be confused as to who makes what.”).

To the extent that the Board entertains Mr. Butters’s testimony that a former employee (employed for only 2-3 months) thought that Purifics and Puralytics were the same company, this single, uncorroborated occurrence is not evidence that the former employee was, in fact, confused. Thus, it cannot be evidence of actual confusion. *See, e.g., Leading Jewelers Guild*, 82 U.S.P.Q.2d at 1905 (finding testimony of individuals asking opposer if opposer and applicant

were the same showed at most that “inquiries were made as to the relationship” and that “[i]t is not clear, however, that the persons were, in fact, confused.”).

Further, weak evidence of actual confusion weighs quite heavily against a finding of likelihood of confusion where, as here, there has been a long period of coexistence in the marketplace. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:14 (“Evidence of only a small number of instances of actual confusion can be dismissed as inconsequential or *de minimis*.”). A single questionable alleged instance that an employee of only 2-3 months, not a customer, may not have understood the industry or the company for which he was working or seeking employment is insufficient evidence of actual confusion. This, at best, is inconsequential. Most importantly, there is no evidence of any actual confusion by a customer or potential customer despite four years of concurrent use.

VIII. CONCLUSION

There is no likelihood of confusion between Opposers’ PURIFICS mark and Applicant’s PURALYTICS mark. The marks are dissimilar; there are many marks relating to water that start with the suggestive letters PUR; PURIFICS is not famous; the parties’ respective services and goods differ and are sold in different channels of trade; the parties have sophisticated customers; and there is no evidence of actual confusion. Accordingly, the Opposition should be denied.

Dated: May 23, 2013

Respectfully submitted,

UVCLEANING SYSTEMS, INC., dba
PURALYTICS CORPORATION

By:  _____

Salumeh R. Loesch

salumeh.loesch@klarquist.com

David P. Petersen

david.petersen@klarquist.com

Klarquist Sparkman, LLP

One World Trade Center, Suite 1600

121 SW Salmon Street

Portland, Oregon 97204

Tel: 503-595-5300

Fax: 503-595-5301

*Attorneys for Applicant UVCleaning Systems, Inc.,
dba Puralytics Corporation*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 23, 2013, the foregoing APPLICANT'S MAIN BRIEF, was served on Opposers' attorneys by email and first class mail, to:

Lisa H. Meyerhoff
Myall S. Hawkins
Tan Pham
William R. Hales
Baker & McKenzie LLP
711 Louisiana, Suite 3400
Houston, Texas 77002



Salumeh R. Loesch