

ESTTA Tracking number: **ESTTA355453**

Filing date: **06/29/2010**

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

Notice of Opposition

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

Opposer Information

Name	Ecolab Inc.
Granted to Date of previous extension	07/04/2010
Address	370 Wabasha Street North St. Paul, MN 55102 UNITED STATES

Attorney information	Scott W. Johnston Merchant & Gould P.C. P.O. Box 2910 Minneapolis, MN 55402-0910 UNITED STATES sjohnston@merchantgould.com, slindemeier@merchantgould.com Phone:(612) 332-5300
----------------------	---

Applicant Information

Application No	79063604	Publication date	01/05/2010
Opposition Filing Date	06/29/2010	Opposition Period Ends	07/04/2010
International Registration No.	0988731	International Registration Date	11/10/2008
Applicant	Aseptix Research BV Bredestraat 11 NL-3632 AX LOENEN AAN DE VECHT NETHERLANDS		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Bleaching preparations; cleaning preparations; soaps; cosmetics (with exception of suntan substances)
Class 005. All goods and services in the class are opposed, namely: Sanitary preparations for medical purposes; hard surface disinfectants; preparations for destroying noxious animals; fungicides; disinfecting substances for hygiene purposes

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2346748	Application Date	11/23/1998
Registration Date	05/02/2000	Foreign Priority Date	NONE
Word Mark	ULTRA SAN		
Design Mark	ULTRA SAN		
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1991/04/15 First Use In Commerce: 1991/04/15 Liquid sanitizer for use in commercial and institutional dish washing machines		

Attachments	75594234#TMSN.gif (1 page)(bytes) 2010 06 29 Notice of Opposition 79063604.PDF (10 pages)(301918 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/SWJ/
Name	Scott W. Johnston
Date	06/29/2010

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

Ecolab Inc.,)	Opposition No. _____
)	
Opposer,)	Mark: ULTRASAN
)	
v.)	Serial No.: 79/063,604
)	
Aseptix Research BV,)	Filing Date: November 10, 2008
)	
Applicant.)	Publication Date: January 5, 2010
)	

NOTICE OF OPPOSITION

Ecolab Inc. (hereinafter “Opposer”), a Delaware corporation, located at Ecolab Center, 370 North Wabasha Street, St. Paul, Minnesota 55102, believes it will be damaged by the registration of the mark shown in Application Serial No. 79/063,604, filed November 10, 2008, by Aseptix Research BV (hereinafter “Applicant”), and hereby opposes registration of the mark. The grounds for opposition are as follows:

1. Applicant’s mark published for opposition on January 5, 2010. Opposer filed and the Board approved extensions of time to oppose Applicant’s mark until July 4, 2010. This Notice of Opposition is timely filed.

2. Applicant is seeking to register the mark ULTRASAN in connection with “bleaching preparations; cleaning preparations; soaps; cosmetics (with exception of suntan substances),” in International Class 3 and “sanitary preparations for medical purposes; hard surface disinfectants; preparations for destroying noxious animals; fungicides; disinfecting substances for hygiene purposes,” in International Class 5.

3. Ecolab is the leading global developer and marketer of premium cleaning, sanitizing, maintenance and repair products and services for a variety of markets, including but not limited to the healthcare, hospitality, commercial, institutional, and industrial markets. Ecolab offers air treatment and water care products, comprehensive restroom cleaning products, equipment and services, including cleaners, sanitizers, dispensers, and odor neutralizers. Ecolab also offers the hospitality industry a full line of housekeeping products including bathroom cleaners, sanitizers, and advanced cleaner dispensing systems. In addition, Ecolab provides a full line of laundry products and services, including detergents, dispensing systems, heat exchange units, tunnel washing and water reuse systems.

4. Since at least as early as 1991, Opposer has been using the mark ULTRA SAN in connection with liquid sanitizer for use in commercial and institutional dish washing machines.

5. Opposer owns U.S. Registration No. 2,346,748, issued May 2, 2000, for the mark ULTRA SAN for "liquid sanitizer for use in commercial and institutional dish washing machines," in International Class 5. A current printout of information from the electronic database records of the USPTO showing the current status and title of the registration is attached hereto as Exhibit A.

6. Opposer's U.S. Registration No. 2,346,748 for ULTRA SAN has not been canceled, is valid, and is now in full force and effect.

7. Opposer's U.S. Registration No. 2,346,748 for ULTRA SAN is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. Consequently, this registration is conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

8. Opposer has advertised and promoted its ULTRA SAN mark continuously and extensively, and made substantial sales of products under said mark. As a result of such continuous use and promotion, the ULTRA SAN mark has developed and represents valuable goodwill inuring to the benefit of Opposer.

9. There is no issue of priority concerning Application Serial No. 79/063,604 since Opposer used and registered its ULTRA SAN mark prior to Applicant's November 10, 2008, filing date. Opposer adopted and commenced use of Opposer's ULTRA SAN mark as a trademark long before Applicant adopted or used the ULTRASAN mark. Opposer's usage of the term ULTRA SAN as a trademark commenced at least as early as April 15, 1991, nearly seventeen (17) years prior to the filing date of Applicant's application for its ULTRASAN mark. Opposer therefore has priority over Applicant with respect to the marks at issue.

10. Upon information and belief, Applicant had knowledge of the fact that Opposer used the term ULTRA SAN as a trademark before it adopted the ULTRASAN mark.

11. Applicant's ULTRASAN mark is confusingly and deceptively similar to Opposer's previously used and duly registered ULTRA SAN mark.

12. Applicant's ULTRASAN mark is nearly identical in sight, sound and commercial impression to Opposer's ULTRA SAN mark.

13. Applicant's alleged goods are closely related to Opposer's goods marketed and sold by Opposer in connection with its ULTRA SAN mark.

14. Upon information and belief, Opposer's goods and Applicant's goods are promoted in the same channels of trade to the same consumers or class of consumers.

15. Due to the similarity between Applicant's claimed mark, ULTRASAN, and Opposer's previously used and registered ULTRA SAN mark, the closely related nature of the

goods of the respective parties, customers and potential customers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

16. The use and registration by Applicant of the mark ULTRASAN for Applicant's goods is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used ULTRA SAN mark, again resulting in damage to Opposer.

17. Because of the closely related nature of the goods of the parties, and the similarity of the marks, use and registration of the term ULTRASAN by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer for use with Opposer's goods causing further damage to Opposer.

18. Registration of the mark shown in Application Serial No. 79/063,604 will result in damage to Opposer under the provisions of Section 2 of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of the term ULTRASAN for the services set forth therein be refused.

Please direct all correspondence to:

**Scott W. Johnston
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910**

Opposer herein appoints John A. Clifford, Reg. No. 30,247; Gregory C. Golla; Andrew S. Ehard; Scott W. Johnston, Reg. No. 39,721; Heather J. Kliebenstein; Danielle I. Mattessich; Scott M. Oslick; Christopher J. Schulte; William D. Schultz, and all other attorneys of the firm of

Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

ECOLAB INC.

By its Attorneys,



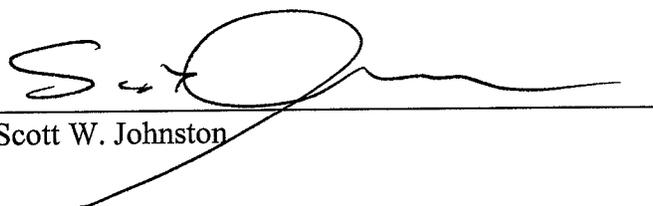
Date: 6-29-10

Scott W. Johnston
MERCHANT & GOULD P.C.
80 South Eighth Street, Suite 3200
Minneapolis, Minnesota 55402-2215
(612) 332-5300

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served upon Applicant by Federal Express, postage pre-paid, this 29th day of June, 2010:

Paul Boeijen
Head of Marketing and Operations
Aseptix Research BV
Bredestraat 11
NL-3632 AX Loenen aan de Vecht
The Netherlands



Scott W. Johnston

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-06-29 12:26:39 ET

Serial Number: 75594234 Assignment Information Trademark Document Retrieval

Registration Number: 2346748

Mark (words only): ULTRA SAN

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2010-01-19

Filing Date: 1998-11-23

Transformed into a National Application: No

Registration Date: 2000-05-02

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2010-01-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Ecolab Inc.

Address:

Ecolab Inc.
370 Wabasha Street N.
St. Paul, MN 551021390
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 005

Class Status: Active

Liquid sanitizer for use in commercial and institutional dish washing machines

Basis: 1(a)

First Use Date: 1991-04-15

First Use in Commerce Date: 1991-04-15

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-01-27 - Review Of Correspondence Complete

2010-01-19 - First renewal 10 year

2010-01-19 - Section 8 (10-year) accepted/ Section 9 granted

2010-01-15 - TEAS Section 8 & 9 Received

2006-09-30 - Section 8 (6-year) accepted & Section 15 acknowledged

2006-09-13 - Assigned To Paralegal

2006-06-30 - Section 8 (6-year) and Section 15 Filed

2006-06-30 - TEAS Section 8 & 15 Received

2006-04-06 - Case File In TICRS

2004-04-26 - TEAS Change Of Correspondence Received

2000-05-02 - Registered - Principal Register

2000-02-08 - Published for opposition

2000-01-07 - Notice of publication

1999-12-08 - Approved for Pub - Principal Register (Initial exam)

1999-11-03 - Examiner's amendment mailed

1999-08-30 - Assigned To Examiner

1999-07-06 - Non-final action mailed

1999-06-14 - Assigned To Examiner

1999-06-09 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Edward R. Courtney, Esq.

Correspondent

Edward R. Courtney, Esq.

Ecolab USA Inc.

ESC-F7610

370 Wabasha Street North

Saint Paul MN 55102-1390

Phone Number: 651.795.5978

Fax Number: 651.204.7522
