

ESTTA Tracking number: **ESTTA431593**

Filing date: **09/21/2011**

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	Michael Brandt Family Trust d/b/a Eco-Safe Industries, Inc.
Granted to Date of previous extension	09/21/2011
Address	3001 Wheelock Street Dallas, TX 75220-2944 UNITED STATES
Attorney information	Barth X. deRosa Dickinson Wright PLLC 1875 Eye Street NWSuite 1200 Washington, DC 20006 UNITED STATES bderosa@dickinsonwright.com, cholder@dickinsonwright.com, trademark@dickinsonwright.com

**Applicant Information**

Application No	77960950	Publication date	05/24/2011
Opposition Filing Date	09/21/2011	Opposition Period Ends	09/21/2011
International Registration No.	NONE	International Registration Date	NONE
Applicant	Istituto Italiano Sicurezza dei Giocattoli S.r.l. Via Europa, 28 Cabiato (COMO), 22060 ITALY		

**Goods/Services Affected by Opposition**

Class 022. All goods and services in the class are opposed, namely: Ropes, string, fishing nets, tents, awnings, tarpaulins, sails, sacks and bags for the transportation or storage of materials in bulk; padding and stuffing materials not of rubber, paper or plastic; raw fibrous textile materials
Class 023. All goods and services in the class are opposed, namely: Yarns and threads, for textile use
Class 024. All goods and services in the class are opposed, namely: Textile fabrics for use in making clothing and household furnishings; knitted fabrics, curtains, pillow cases, bed quilts, quilt covers, duvets, duvet covers, bed sheets, bed spreads, bed blankets, comforters for bed, table cloths not of paper, textile napkins, towels, textile place mats
Class 025. All goods and services in the class are opposed, namely: Clothing, namely, coats, mantles, raincoats, dusters, fur coats, dresses, suits, skirts, jackets, knitwear shirts, trousers, shorts sets, Bermuda

shorts, jeans, waistcoats, shirts, t-shirts, tops, blouses, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, brassiere, underpants, night-gowns, shifts, pajamas, nightwear, outerwear coats, hosiery, overalls, salopettes, dungarees, bonnet, clogs, bathrobes, bathing suits, beach-wraps, sun suits, sport jackets, waterproof jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, mufflers, foulards, caps, hats, hoods, gloves, sashes, belts; footwear, beach footwear, athletic footwear, boots, shoes and slippers

Class 027.

All goods and services in the class are opposed, namely: Carpets, rugs, mats and matting, linoleum for covering existing floors, Floor coverings of rubber and synthetic rubber, Hard surface coverings for floors, Non-textile wall hangings

Class 042.

All goods and services in the class are opposed, namely: Testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1749733	Application Date	09/25/1991
Registration Date	02/02/1993	Foreign Priority Date	NONE
Word Mark	ECO-SAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 carpet freshening preparations in dust and powder forms; liquid hand soap</p> <p>Class 005. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 insecticides in spray, powder, or liquid forms for domestic, commercial and industrial use</p> <p>Class 021. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 pest control traps for rats, roaches, and other pests</p> <p>Class 025. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 apparel; namely, tee shirts and hats</p> <p>Class 026. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 cloth patches for shirts</p> <p>Class 037. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 organic pest control services</p>		

U.S. Registration No.	1631876	Application Date	10/26/1988
Registration Date	01/15/1991	Foreign Priority Date	NONE
Word Mark	ECO-SAFE		

Design Mark	 <b>eco-safe</b>
Description of Mark	NONE
Goods/Services	Class 037. First use: First Use: 1972/08/10 First Use In Commerce: 1972/08/18 PEST CONTROL SERVICES; JANITORIAL SERVICES

U.S. Registration No.	1303116	Application Date	09/26/1983
Registration Date	10/30/1984	Foreign Priority Date	NONE
Word Mark	ECO-SAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1972/08/10 First Use In Commerce: 1972/08/18 Pest Control Services		

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### Certificate of Service

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

Signature	/Barth X. deRosa/
Name	Barth X. deRosa
Date	09/21/2011



**Likelihood of Confusion Under Section 2(d)**

1. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer has, through its predecessor, been and is now engaged in the offering and selling of pest control and janitorial related services and also in the manufacture, distribution and sale of pet related products, pest control and sanitary related products, including, but not limited to, carpet freshening preparations, flea control agents, liquid hand soaps, insecticides in spray, powder or liquid forms for domestic, commercial and industrial use, and pest control traps for rats, roaches and other pests, and has continuously used in interstate commerce in connection with such products and services the "ECO-SAFE" mark and name.

2. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer did, through its various licensees, trade as Eco-Safe and presently trades under said name.

3. Since long prior to March 17, 2010, Applicant's alleged constructive use date, Opposer did sell the products and services identified in paragraph 1 herein to customers in the United States in connection with the "ECO-SAFE" mark and name, and is presently using said mark and name in commerce.

4. Opposer relies upon and is the owner of the following registrations, all of which are valid, subsisting, unrevoked and, where applicable, incontestable.

Registration No. 1,749,733  
"ECO-SAFE" in International Classes 3, 5, 21, 25, 26, and 37  
Dated: February 2, 1993  
Renewed: March 26, 2003

Registration No. 1,631,876  
"ECO-SAFE and Design" in International Class 37  
Dated: January 15, 1991  
Renewed: March 21, 2001

Registration No. 1,303,116  
"ECO-SAFE" in International Class 37  
Dated: October 20, 1984  
Renewed: August 7, 2004

Certified status and title copies of the above registrations will be provided at a later date.

5. The products of Applicant, namely, Ropes, string, fishing nets, tents, awnings, tarpaulins, sails, sacks and bags for the transportation or storage of materials in bulk; padding and stuffing materials not of rubber, paper or plastic; raw fibrous textile materials; Yarns and threads, for textile use; Textile fabrics for use in making clothing and household furnishings; knitted fabrics, curtains, pillow cases, bed quilts, quilt covers, duvets, duvet covers, bed sheets, bed spreads, bed blankets, comforters for bed, table cloths not of paper, textile napkins, towels, textile place mats; Clothing, namely, coats, mantles, raincoats, dusters, fur coats, dresses, suits, skirts, jackets, knitwear shirts, trousers, shorts sets, Bermuda shorts, jeans, waistcoats, shirts, t-shirts, tops, blouses, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, brassiere, underpants, night-gowns, shifts, pajamas, nightwear, outerwear coats, hosiery, overalls, salopettes, dungarees, bonnet, clogs, bathrobes, bathing suits, beach-wraps, sun suits, sport jackets, waterproof jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, mufflers, foulards, caps, hats, hoods, gloves, sashes, belts; footwear, beach footwear, athletic footwear, boots, shoes and slippers; Carpets, rugs, mats and matting, linoleum for covering existing floors, Floor coverings of rubber and synthetic rubber, Hard surface coverings for floors, Non-textile wall hangings; and Testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification, are apt to move within similar channels of trade as the goods and services offered by Opposer and as described in paragraphs 1-4 herein. Many of the products and services distributed and sold by Opposer under the ECO-

SAFE mark and name are likely to be purchased and used by the same class of persons who are likely to purchase Applicant's various products and services set forth in paragraph 5 herein.

6. Applicant's mark "ECO-SAFE & Leaf Design" is so confusingly similar in all respects to Opposer's "ECO-SAFE" mark and name, which the public and the trade have long associated and recognized with Opposer, as to be likely, when applied to the goods of the Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the products of the Applicant emanate from, are offered for sale, or are sold under Opposer's approval, sponsorship, or control all to the great damage of Opposer. Said use by Applicant is also apt to create reverse confusion or confusion as to sponsorship and certification by leading purchasers to believe that Opposer's products are sponsored or certified by Applicant or vice versa when they are in fact not so sponsored or certified, leading such potential purchasers to believe that Opposer is in fact an unauthorized user of the ECO-SAFE mark for its products and services, when in fact it is the lawful owner.

7. On information and belief, Applicant has made no use of the mark "ECO-SAFE & Leaf Design" in the United States for any product or service prior to March 17, 2010, which is Applicant's alleged constructive use date for the mark listed in International Classes 22, 23, 24, 25, 27 and 42.

8. Opposer has expended considerable time, effort and money in advertising and otherwise promoting the sale of its goods and services and encouraging the public and trade to recognize its "ECO-SAFE" mark and name, that unless refused, the registration obtained by Applicant will enable the Applicant to reap the benefits of such good will attached to Opposer's mark and name, and Opposer will suffer irreparable damage and injury as a result of the confusion that is likely to arise from its inability to control its reputation, as well as its inability

to control the ill effects associated with the likelihood of reverse confusion and confusion as to sponsorship and improper certification.

**Fraud and/or Violation of the Anti-Use by Owner Rule for Certification Marks**

9. On information and belief, Applicant is an institution based in Italy that certifies various products manufactured by others as to whether such product meets unspecified standards of quality for “environmentally friendly” products.

10. Applicant, in fact, proposed during prosecution of its application that it be permitted to amend its description of services in class 42 to read “testing, analysis and evaluation of the goods and services of others for the purpose of certification, all the aforesaid services related to above mentioned lists of products belonging to classes 22, 23, 24, 25 and 27.”

11. Insofar as Applicant has declared a *bona fide* intention to use the “ECO-SAFE & Leaf Design” mark with the products belonging to classes 22, 23, 24, 25 and 27 in commerce in connection with the sale or offering of such products, said *bona fide* intention is, as a matter of law, inconsistent with the anti-use by owner rule for certification marks under 15 U.S.C. §1054, and Applicant’s Serial No. 77/960,950 is therefore *void ab initio*.

12. Insofar as Applicant cannot as a matter of law have, on the one hand, a *bona fide* intent to provide testing, analysis and evaluation of the goods and services of others for the purposes of certification, and on the other hand, the *bona fide* intent to affix its certification mark to goods it actually intends to offer or sell in commerce as defined in 15 U.S.C. §1127, Applicant has fraudulently misrepresented and falsely represented to the United States Patent and Trademark Office its true *bona fide* intention with regard to the use of said mark in commerce with the United States, and the application should be refused by reason of Applicant’s fraud,

misrepresentation, and false representation before the U.S.P.T.O., upon which the Examining Attorney relied.

13. In the alternative, in the event Applicant has committed a mistake and does not have a *bona fide* intent to use the marks for the class 42 services, then, based on information and belief, Applicant lacks a *bona fide* intent to use the mark for all the goods and services listed in classes 22, 23, 24, 25 and 27, and the application should be again declared *void ab initio*.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant be refused and the Notice of Opposition be sustained.

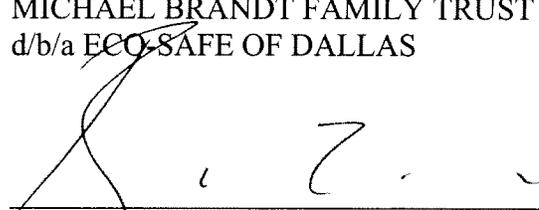
The \$1,800.00 government fee (International Classes 22, 23, 24, 25, 27 and 42) is submitted herewith. Please charge any deficiency or credit any overpayment to Deposit Account No. 04-1061.

Please recognize Barth X. deRosa, Samuel D. Littlepage, Nicole M. Meyer, Jonathan Redway, Steven D. Lustig and Melissa Alcantara, all members of a Bar, and the firm of Dickinson Wright PLLC, 1875 Eye Street, N.W., Suite 1200, Washington, D.C. 20006, as attorneys for Opposer.

Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST  
d/b/a ECO-SAFE OF DALLAS

Dated: September 21, 2011

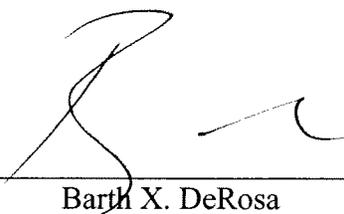


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*Counsel for Opposer*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the Notice of Opposition has been served upon Applicant this 21<sup>st</sup> day of September, 2011, via first class mail, postage prepaid, as identified below:

Mark Lebow  
Young & Thompson  
209 Madison Street  
Suite 500  
Alexandria, VA 22314-1764

A handwritten signature in black ink, appearing to read 'Barth X. DeRosa', is written over a horizontal line. The signature is stylized and cursive.

Barth X. DeRosa