

ESTTA Tracking number: **ESTTA443367**

Filing date: **11/28/2011**

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	EcoWater Systems LLC
Granted to Date of previous extension	11/27/2011
Address	1890 Woodlane Drive Woodbury, MN 55125 UNITED STATES

Attorney information	Caroline Stevens Leydig, Voit & Mayer, Ltd. 1420 Fifth Ave. Suite 3670 Seattle, WA 98101 UNITED STATES cstevens@leydig.com Phone:(206) 428-3111
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Applicant Information

Application No	85094582	Publication date	05/31/2011
Opposition Filing Date	11/28/2011	Opposition Period Ends	11/27/2011
Applicant	Ecolab USA Inc. ESC-F7610 370 Wabasha Street North Saint Paul, MN 55102 UNITED STATES		

Goods/Services Affected by Opposition

Class 011. First Use: 1998/02/11 First Use In Commerce: 1998/02/11 Opposed goods and services in the class: electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; water filtration and purification units; water filtering units for commercial, institutional or industrial use; water filtering apparatus; water purification tanks; water filters
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1710954	Application Date	05/14/1990
Registration Date	09/01/1992	Foreign Priority Date	NONE
Word Mark	ECOSORB		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1982/01/26 First Use In Commerce: 1982/01/26 precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment

U.S. Registration No.	1071709	Application Date	10/12/1976
Registration Date	08/23/1977	Foreign Priority Date	NONE
Word Mark	ECODEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1976/08/00 First Use In Commerce: 1976/08/00 FILTERING MATERIAL FOR REMOVAL OF DISSOLVED/SUSPENDED SOLIDS		

U.S. Registration No.	1071708	Application Date	10/12/1976
Registration Date	08/23/1977	Foreign Priority Date	NONE
Word Mark	ECOCOTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1976/08/00 First Use In Commerce: 1976/08/00 FILTERING MATERIAL FOR REMOVAL OF DISSOLVED/SUSPENDED SOLIDS		

U.S. Registration No.	929556	Application Date	11/19/1969
Registration Date	02/22/1972	Foreign Priority Date	NONE
Word Mark	ECODYNE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U031 (International Class 011). First use: First Use: 1969/10/00 First Use In Commerce: 1969/10/00 FILTERS [, ION EXCHANGERS, AND DEGASIFIERS FOR TREATING LIQUIDS AND PARTS THEREOF]		

U.S. Registration No.	1585509	Application Date	07/31/1989
Registration Date	03/06/1990	Foreign Priority Date	NONE
Word Mark	ECO PURE		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 011. First use: First Use: 1989/05/24 First Use In Commerce: 1989/05/24 WATER PURIFICATION AND FILTRATION UNITS FOR DOMESTIC AND COMMERCIAL USE

U.S. Registration No.	1555661	Application Date	05/23/1988
Registration Date	09/12/1989	Foreign Priority Date	NONE
Word Mark	ECOWATER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1988/02/25 First Use In Commerce: 1988/02/25 WATER TREATMENT EQUIPMENT AND PARTS THEREOF, NAMELY - RESIDENTIAL WATER CONDITIONERS, DOMESTIC REVERSE OSMOSIS WATER PURIFIERS, AND FILTERS, ION EXCHANGERS AND DEGASIFIERS FOR TREATING LIQUIDS		

U.S. Registration No.	2145816	Application Date	08/22/1996
Registration Date	03/24/1998	Foreign Priority Date	NONE
Word Mark	ECOWATER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 bottled drinking water Class 035. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 distributorships in the field of bottled drinking water		

U.S. Registration No.	1771108	Application Date	05/20/1992
Registration Date	05/18/1993	Foreign Priority Date	NONE
Word Mark	ECOWATER SYSTEMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 1990/06/00 First Use In Commerce: 1990/06/00 water pumps, as machine parts, for use in domestic and commercial water treatment applications		

U.S. Registration No.	1771860	Application Date	02/28/1992
Registration Date	05/18/1993	Foreign Priority Date	NONE
Word Mark	ECOWATER SYSTEMS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 037. First use: First Use: 1988/02/25 First Use In Commerce: 1988/02/25 repair and maintenance services in the field of domestic and commercial water treatment equipment; namely, water conditioners, softeners, deionizers, distillers, filters, and related water treatment units

U.S. Registration No.	1613312	Application Date	09/26/1988
Registration Date	09/11/1990	Foreign Priority Date	NONE
Word Mark	ECOWATER SYSTEMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1988/02/25 First Use In Commerce: 1988/02/25 RETAIL OUTLET SERVICES AND RENTAL SERVICES IN THE FIELD OF DOMESTIC AND COMMERCIAL WATER CONDITIONERS AND PURIFIERS		

U.S. Registration No.	2279118	Application Date	05/28/1998
Registration Date	09/21/1999	Foreign Priority Date	NONE
Word Mark	ECOWATER DRINKING WATER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 BOTTLED DRINKING WATER Class 035. First use: First Use: 1996/03/01 First Use In Commerce: 1996/03/01 RETAIL DISTRIBUTORSHIPS FEATURING DOMESTIC AND COMMERCIAL WATER CONDITIONERS AND PURIFIERS, AND BOTTLED DRINKING WATER		

Attachments	75492829#TMSN.gif (1 page)(bytes) 309950 Notice Opposition.pdf (6 pages)(62963 bytes)
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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	/Caroline Stevens/
Name	Caroline Stevens
Date	11/28/2011

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

In re Serial No. 85/094,582
Mark: ECOLAB
Published: May 31, 2011

ECOWATER SYSTEMS LLC,)	
)	
Opposer,)	
)	Opposition No.: _____
v.)	
)	Mark: ECOLAB
ECOLAB USA INC.,)	
)	
Applicant.)	

U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

ECOWATER SYSTEMS LLC, a Delaware limited liability company located at 1890 Woodlane Drive, Woodbury, Minnesota 55125 (hereinafter, the “Opposer”), believes that it would be damaged by registration of the mark shown in Application Serial No. 85/094,582 (“the ‘582 Application”), filed on July 28, 2010, by Ecolab USA Inc. (hereinafter “Applicant”), published in the Official Gazette of the United States Patent and Trademark Office on May 31, 2011.

As grounds for the Opposition, it is alleged that:

1. Opposer develops and manufactures residential and commercial water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services.

2. Since well before the filing date of the ‘582 Application, Opposer has continuously used a family of “ECO-” marks, including the marks ECOSORB, ECODEX, ECOCOTE, ECODYNE, ECO PURE, ECOWATER, ECOWATER SYSTEMS, and

ECOWATER DRINKING WATER & Design (“Opposer’s Marks”) in interstate commerce in connection with a variety of water treatment products and other goods and services.

3. When used in connection with Opposer’s goods and services, Opposer’s Marks are inherently distinctive.

4. Moreover, Opposer is the owner of numerous United States Trademark Registrations for Opposer’s Marks and variations thereof, including but not limited to the following:

Mark	Reg. No.	Goods and Services	Appl. Date	Reg. Date
ECOSORB	1710954	precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment	5/14/1990	9/1/1992
ECODEX	1071709	filtering material for removal of dissolved/suspended solids	10/12/1976	8/23/1977
ECOCOTE	1071708	filtering material for removal of dissolved/suspended solids	10/12/1976	8/23/1977
ECODYNE	929556	filters	11/19/1969	2/22/1972
ECO PURE	1585509	water purification and filtration units for domestic and commercial use	7/31/1989	3/6/1990
ECOWATER	1555661	water treatment equipment and parts thereof, namely - residential water conditioners, domestic reverse osmosis water purifiers, and filters, ion exchangers and degasifiers for treating liquids	5/23/1988	9/12/1989
ECOWATER	2145816	bottled drinking water; distributorships in the field of bottled drinking water	8/22/1996	3/24/1998
ECOWATER SYSTEMS	1771108	water pumps, as machine parts, for use in domestic and commercial water treatment applications	5/20/1992	5/18/1993
ECOWATER SYSTEMS	1771860	repair and maintenance services in the field of domestic and commercial water treatment equipment; namely, water conditioners, softeners, deionizers, distillers, filters, and related water treatment units	2/28/1992	5/18/1993
ECOWATER SYSTEMS	1613312	retail outlet services and rental services in the field of domestic and commercial water conditioners and purifiers	9/26/1988	9/11/1990

ECOWATER DRINKING WATER & Design	2279118	bottled drinking water; retail distributorships featuring domestic and commercial water conditioners and purifiers, and bottled drinking water	5/28/1998	9/21/1999
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5. All of Opposer's foregoing registrations for Opposer's Marks are valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065.

6. Opposer has used and is using Opposer's Marks in interstate commerce in connection with the goods and services described in Opposer's trademark registrations.

7. Applicant filed the '582 Application for the ECOLAB mark on July 28, 2010. The '582 application covers various goods, including, but not limited to: electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; water filtration and purification units; water filtering units for commercial, institutional or industrial use; water filtering apparatus; water purification tanks; and water filters ("Applicant's Goods").

COUNT I: LIKELIHOOD OF CONFUSION

8. Opposer repeats and realleges paragraphs 1 through 7 of the Notice of Opposition as if fully set forth herein.

9. Opposer's use and registration of Opposer's Marks long pre-dates the filing date of the '582 Application.

10. The grant of a registration to Applicant for the ECOLAB mark as sought in the '582 Application to the extent it covers Applicant's Goods should be denied on the grounds of Opposer's priority of rights in Opposer's Marks. The mark sought to be registered by Applicant is confusingly similar to Opposer's Marks, and the use of the ECOLAB mark by Applicant in connection with Applicant's Goods is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's Goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer,

or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

11. The grant of a registration to Applicant for the ECOLAB mark as sought in the '582 Application in connection with Applicant's Goods should be denied based on likelihood of confusion under Section 2(d) of the Lanham Act.

WHEREFORE, Opposer files this Notice of Opposition and prays that the aforesaid application of Ecolab USA Inc. herein opposed be rejected to the extent it covers electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; water filtration and purification units; water filtering units for commercial, institutional or industrial use; water filtering apparatus; water purification tanks; and water filters, and that no registration be issued to Applicant for the ECOLAB mark in connection with such specified goods, and for such other and further relief as may be deemed just and proper.

The Deposit Account No. 12-1216 will be charged the amount of \$300.00 to cover the filing fee of this Notice of Opposition against the Application. Please charge any additional fees to Deposit Account No. 12-1216, and address all correspondence regarding this Opposition to:

Mark J. Liss
Caroline L. Stevens
LEYDIG, VOIT & MAYER, LTD.
1420 Fifth Ave., Suite 3670
Seattle, WA 98101
T: (206) 428-3111
F: (312) 616-5700
cstevens@leydig.com

Dated: November 28, 2011

Respectfully submitted,

ECOWATER SYSTEMS LLC

By: Caroline Stevens
Mark J. Liss
Caroline L. Stevens

Notice of Opposition
Serial No. 85/094,582
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LEYDIG, VOIT & MAYER, LTD.
1420 Fifth Ave., Suite 3670
Seattle, WA 98101
T: (206) 428-3111
F: (312) 616-5700
mliss@leydig.com
cstevens@leydig.com

CERTIFICATE OF ELECTRONIC FILING AND SERVICE

I hereby certify that the above document was filed electronically with the Trademark Trial & Appeal Board on the date indicated below, and that a copy was served on the Applicant's counsel of record, who is designated to receive correspondence relative to this application, on the date indicated below, via U.S. First Class Mail in an envelope addressed as follows:

Dean R. Karau
Fredrikson & Byron, P.A.
200 S. 6th St., Suite 4000
Minneapolis, MN 55402-1425

Caroline Stevens
Signature

November 28, 2011
Date of Signature