

ESTTA Tracking number: **ESTTA487457**

Filing date: **08/06/2012**

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

Proceeding	91202732
Party	Defendant Ecolab USA Inc.
Correspondence Address	DEAN KARAU FREDRIKSON & BYRON PA 200 S 6TH ST STE 4000 MINNEAPOLIS, MN 55402 1425 UNITED STATES ip@fredlaw.com, lfriedemann@fredlaw.com, lmyers@fredlaw.com, dkarau@fredlaw.com
Submission	Answer and Counterclaim
Filer's Name	Laura L. Myers
Filer's e-mail	lmyers@fredlaw.com
Signature	/Laura L. Myers/
Date	08/06/2012
Attachments	Ecolab Answer.pdf (26 pages)(1485643 bytes)

Registrations Subject to the filing

Registration No	3268985	Registration date	07/24/2007
Registrant	Ecowater Systems, Inc. 1890 Woodlane Drive Woodbury, MN 55125 UNITED STATES		

Goods/Services Subject to the filing

Class 011. First Use: 2006/11/27 First Use In Commerce: 2006/11/27 All goods and services in the class are requested, namely: Water filters and distilling units

Registration No	1710954	Registration date	09/01/1992
Registrant	ECOWATER SYSTEMS, INC 1890 WOODLANE DRIVE WOODBURY, MN 55125 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 001. First Use: 1982/01/26 First Use In Commerce: 1982/01/26 All goods and services in the class are requested, namely: precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment

Registration No	1585509	Registration date	03/06/1990
Registrant	EcoWater Systems LLC 1890 Woodlane Drive Woodbury, MN 55125 UNITED STATES		

Grounds for filing	The registered mark has been abandoned.
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Goods/Services Subject to the filing

Class 011. First Use: 1989/05/24 First Use In Commerce: 1989/05/24 All goods and services in the class are requested, namely: WATER PURIFICATION AND FILTRATION UNITS FOR DOMESTIC AND COMMERCIAL USE
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Registration No	1771108	Registration date	05/18/1993
Registrant	Ecowater Systems, Inc. 1890 Woodlane Drive Woodbury, MN 55125 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 007. First Use: 1990/06/00 First Use In Commerce: 1990/06/00 All goods and services in the class are requested, namely: water pumps, as machine parts, for use in domestic and commercial water treatment applications

Registration No	1771860	Registration date	05/18/1993
Registrant	EcoWater Systems, Inc. 1890 Woodlane Drive Woodbury, MN 55125 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 037. First Use: 1988/02/25 First Use In Commerce: 1988/02/25 All goods and services in the class are requested, namely: 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

Registration No	1613312	Registration date	09/11/1990
Registrant	ECOWATER SYSTEMS LLC 1890 WOODLANE DRIVE WOODBURY, MN 551252980 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 042. First Use: 1988/02/25 First Use In Commerce: 1988/02/25 All goods and services in the class are requested, namely: RETAIL OUTLET SERVICES AND RENTAL SERVICES IN THE FIELD OF DOMESTIC AND COMMERCIAL WATER CONDITIONERS AND PURIFIERS
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Registration No	2279118	Registration date	09/21/1999
Registrant	Ecowater Systems LLC 1890 Woodlane Drive Woodbury, MN 551252980 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 035. First Use: 1996/03/01 First Use In Commerce: 1996/03/01
All goods and services in the class are requested, namely: RETAIL DISTRIBUTORSHIPS
FEATURING DOMESTIC AND COMMERCIAL WATER CONDITIONERS AND PURIFIERS, AND
BOTTLED DRINKING WATER

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

EcoWater Systems LLC,

Opposition No. 91202732

Opposer,

v.

Ecolab USA Inc.,

Applicant,

and

Ecolab USA Inc.,

Petitioner,

v.

EcoWater Systems LLC,

Registrant.

**ECOLAB USA INC.'S ANSWER TO AMENDED NOTICE OF OPPOSITION
AND COUNTERCLAIM PETITION TO CANCEL**

Applicant, Ecolab USA Inc., for its answer to the Amended Notice of Opposition filed by Opposer, EcoWater Systems LLC, states and alleges as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Amended Notice of Opposition and therefore denies same.

2. Applicant denies the allegations contained in Paragraph 2 of the Amended Notice of Opposition, and puts Opposer to its strict burden of proof to the extent it is continuing to allege that it owns a family of "ECO-" marks.

3. Applicant denies the allegations contained in Paragraph 3 of the Amended Notice

of Opposition.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Amended Notice of Opposition and therefore denies same.

5. Applicant denies the allegations contained in Paragraph 5 of the Amended Notice of Opposition and therefore denies same.

6. Upon information and belief, Applicant denies the allegations contained in Paragraph 6 of the Amended Notice of Opposition.

7. With respect to the allegations contained in Paragraph 7 of the Amended Notice of Opposition, Applicant states that the goods identified in Application Serial No. 85094582 are “washing machine water treatment device installed in the rinse modules of the tunnel washer to clean and reduce water consumption and the volume of discharged wastewater by re-circulating wastewater; Dispensing units for air fresheners and room deodorants; Swimming pool and spa chlorinating units; water treatment equipment, namely, dispensing units for delivering water treatment chemicals to treat scale and corrosion in boilers and cooling tower steam and water systems; electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; flashlights; portable electric fans; air filtering installations for use in operating clean rooms; chemically activated light sticks; incandescent light sticks; LED luminaires; light bulbs; water filtration and purification units; ultraviolet lamps not for medical purposes; bioreactors for use in the treatment of wastewater; water filtering units for commercial, institutional or industrial use; water filtering apparatus; water purification tanks; water filters,” and Applicant denies the remaining allegations contained in Paragraph 7 of the Amended Notice of Opposition.

COUNT I: LIKELIHOOD OF CONFUSION

8. Applicant repeats its answers in the preceding paragraphs in response to the allegations contained in Paragraph 8 of the Amended Notice of Opposition.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Amended Notice of Opposition and therefore denies same.

10. Applicant denies the allegations contained in Paragraph 10 of the Amended Notice of Opposition.

**COUNT II: RESTRICTION OF GOODS UNDER
TRADEMARK ACT § 18, 15 U.S.C. § 1068**

11. With respect to the allegations contained in Paragraph 11 of the Amended Notice of Opposition, Applicant states that it is using its mark with all of the goods identified in Application Serial No. 85094582.

12. Applicant denies the allegations contained in Paragraph 12 of the Amended Notice of Opposition.

13. Applicant denies the allegations contained in Paragraph 13 of the Amended Notice of Opposition.

14. With respect to the allegations contained in Paragraph 14 of the Amended Notice of Opposition, Applicant states that it is using its mark with all of the goods identified in Application Serial No. 85094582.

15. Applicant denies the allegations contained in Paragraph 15 of the Amended Notice of Opposition.

COUNT III: NO BONA FIDE USE IN COMMERCE

16. Applicant repeats its answers in in the preceding paragraphs in response to the

allegations contained in Paragraph 16 of the Amended Notice of Opposition.

17. With respect to the allegations contained in Paragraph 17 of the Amended Notice of Opposition, Applicant states that it is using its mark with all of the goods identified in Application Serial No. 85094582.

18. With respect to the allegations contained in Paragraph 18 of the Amended Notice of Opposition, Applicant admits that it submitted an application for the ECOLAB mark under Section 1(a) of the Trademark Act based on use in commerce, Applicant states that its January 28, 2011, Office Action Response speaks for itself, Applicant states that it is using its mark with all of the goods identified in Application Serial No. 85094582, and Applicant denies the remaining allegations contained in Paragraph 18 of the Amended Notice of Opposition.

19. With respect to the allegations contained in Paragraph 19 of the Amended Notice of Opposition, Applicant states that it is using its mark with all of the goods identified in Application Serial No. 85094582, and Applicant denies the remaining allegations contained in Paragraph 19 of the Amended Notice of Opposition.

20. Except as expressly admitted or otherwise answered, Applicant denies each and every allegation contained in the Amended Notice of Opposition.

SEPARATE DEFENSES

1. Opposer has failed to state claims upon which relief can be granted.

WHEREFORE, Applicant respectfully requests the Board to dismiss the Opposition with prejudice and permit registration of Applicant's mark.

COUNTERCLAIM

Petitioner, Ecolab USA Inc. a corporation organized under the laws of Delaware, with a principal place of business located at ESC-F7610, 370 Wabasha Street North, Saint Paul, Minnesota 55102, believes that it is or will be damaged by Registration Nos. 3268985, 1710954, 1585509, 1771108, 1771860, 1613312, and 2279118 and hereby petitions to cancel the same. The grounds for cancellation are as follows:

1. Upon information and belief, Registrant is a Delaware corporation with its principal place of business located at 1890 Woodlane Drive, Woodbury, Minnesota.

Registration No. 3268985 for ECO|PURE

2. Petitioner has extensively and continuously used its ECOLAB mark in commerce in connection with water filtration and water treatment products since at least as early as the mid-1990s.

3. Petitioner's ECOLAB mark has been extensively and continuously used in advertising and promotional materials, and in other ways customary in the trade, to promote its water filtration and water treatment products throughout the United States, and Petitioner has developed enormous and widespread goodwill through ownership and use of its ECOLAB mark in connection with those products. By reason of such advertising, promotion, and widespread use, the public has come to recognize Petitioner's ECOLAB mark as signifying its water filtration and water treatment products, the mark is inherently distinctive and is a strong mark, and should be accorded the broad protection given to strong marks.

4. On July 28, 2010, Petitioner filed an application to register its ECOLAB mark for use in connection with, among other things, water filtration and water treatment products, and the application was given Serial No. 85094582.

5. On September 9, 2003, Registrant filed an application for registration of the trademark ~~eco~~pure, and the application was given Serial No. 78297793. The mark was registered on July 24, 2007, as Registration No. 3268985, for goods identified as water filters and distilling units in International Class 011, with an alleged date of first use of November 27, 2006. The registration is not incontestable.

6. On November 28, 2011, Registrant filed a Notice of Opposition, opposing the registration of Petitioner's application for ECOLAB, Serial No. 85094582 for use in connection with Petitioner's water filtration and water treatment products.

7. In the Notice of Opposition and the Amended Notice of Opposition, Registrant alleged, among other things, (1) that it owns a number of "ECO-" marks, including the mark ECO PURE in U.S. Reg. No. 1585509 for use in connection with water filtration and water treatment products; (2) that Petitioner's ECOLAB mark in Application Serial No. 85094582 should be denied registration on the grounds of Registrant's priority in rights in, among others, its ECO PURE mark in U.S. Reg. No. 1585509; and (3) that use of the ECOLAB mark by Petitioner in connection with water filtration and water treatment products is likely to cause confusion or mistake in the minds of the public and lead the public and prospective purchasers to believe that Petitioner's water filtration and water treatment products are those of Registrant, or are endorsed, sponsored or otherwise affiliated or connected with Registrant, or that Registrant's water filtration and water treatment products are associated with Petitioner, all to the damage and injury of the purchasing public and to the damage and injury of Registrant.

8. If Petitioner's ECOLAB mark in Serial No. 85094582 for water filtration and water treatment products is found to be confusingly similar to Registrant's ECO PURE mark in Reg. No. 1585509 for water filtration and water treatment products, then the continued

registration of Registrant's ecopure mark in Reg. No. 3268985 for water filtration and water treatment products is likely to cause confusion, deception and mistake with Petitioner's ECOLAB mark in Serial No. 85094582 and for which Petitioner has priority of use, all to Petitioner's damage.

9. After Petitioner filed its Answer and Counterclaims, and with full knowledge of Petitioner's priority of use for water filtration and water treatment products, Registrant amended its Notice of Opposition, deleting reliance on its ecopure mark in Reg. No. 3268985.

10. Petitioner is being damaged by the continued existence of Reg. No. 3268985 in that, having already asserted it once, Registrant can assert it again in future proceedings against Petitioner, and thus Petitioner's continued and legal use of its mark will be impaired by the continued registration of the ecopure mark of Registrant.

Registration No. 1710954 for ECOSORB

11. In its Notice of Opposition, Registrant alleged, among other things, (1) that it owns a family of "ECO-" marks, including the mark ECOSORB in U.S. Reg. No. 1710954 for use in connection with precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment, in International Class 1; (2) that Petitioner's ECOLAB mark in Application Serial No. 85094582 should be denied registration on the grounds of Registrant's priority in rights in, among others, its ECOSORB mark in U.S. Reg. No. 1710954; and (3) that use of the ECOLAB mark by Petitioner in connection with water filtration and water treatment products is likely to cause confusion or mistake in the minds of the public and lead the public and prospective purchasers to believe that Petitioner's water filtration and water treatment products are those of Registrant, or are endorsed, sponsored or otherwise affiliated or connected with Registrant, or that Registrant's

water filtration and water treatment products are associated with Petitioner, all to the damage and injury of the purchasing public and to the damage and injury of Registrant.

12. On May 14, 1990, The Graver Company filed an application to register the mark ECOSORB, Application Serial No. 74058960, and the USPTO issued a registration for the mark, U.S. Reg. No. 1710954, on September 1, 1992, for goods identified as precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment in International Class 1.

13. In an assignment executed on August 27, 1998, The Graver Company assigned its entire interest in the ECOSORB mark and Reg. No. 1710954 to Graver Technologies, Inc.

14. In an assignment executed on March 26, 1999, Graver Technologies, Inc. assigned its entire interest in the ECOSORB mark and Reg. No. 1710954 to Ecowater Systems, Inc., which in 2004 converted to Registrant Ecowater Systems, LLC.

15. On January 30, 2002, Ecowater Systems, Inc. filed a Combined Declaration of Use in Commerce/Application for Renewal of Registration of Mark Under §§ 8 and 9 (15 U.S.C. §§ 1058 & 1059), in which Ecowater Systems, Inc. declared as follows:

[Ecowater Systems, Inc.] is using the mark in commerce on or in connection with all goods and/or services in the existing registration. The Trademark Assignment from Graver Technologies, Inc. to Ecowater Systems, Inc. was recorded on April 2, 1999, Reel/Frame 1881/0363.

Section 8: Declaration of Use in Commerce

[Ecowater Systems, Inc.] is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as currently used in commerce.

16. The specimen Ecowater Systems, Inc. submitted in support of the Combined Declaration evidenced the mark being used by Graver Technologies, Inc., not Ecowater Systems, Inc.:



See Exhibit A.

17. Registrant's website located at www.ecowater.com, reveals no current use of the ECOSORB mark by Registrant:



See Exhibit B.

18. After Petitioner filed its Answer and Counterclaims, and with full knowledge of Petitioner's priority of use for water filtration and water treatment products, Registrant amended its notice of opposition, deleting reliance on its ECOSORB mark in U.S. Reg. No. 1710954.

19. Registration No. 1710954 should be canceled because, upon information and belief, on the date on which it filed its renewal application, Registrant was not using the mark in commerce on or in connection with any of the goods in the registration.

20. Registration No. 1710954 should be canceled because, upon information and belief, Registrant abandoned its ECOSORB mark in Reg. No. 1710954 by discontinuing use of the mark for a period of years with no intent to resume use.

21. Registration No. 1710954 should be canceled because Registrant knowingly made

false, material representations of fact in maintaining Reg. No. 1710954 with, upon information and belief, the intent to defraud the USPTO.

22. In its Notice of Opposition, Registrant stated that it “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.”

23. In its Amended Notice of Opposition, Registrant stated that it “develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services,” deleting any reference to commercial water treatment equipment.

24. Upon information and belief, Registrant no longer develops and manufactures commercial water treatment equipment and no longer provides installation, cleaning, repair, and rental services related to said water treatment equipment.

25. Upon information and belief, Registrant has abandoned its ECOSORB mark for the goods in U.S. Reg. No. 1710954, namely, precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment.

26. Petitioner is being damaged by the continued existence of Reg. No. 1710954 in that, having already asserted it once, Registrant can assert it again in future proceedings against Petitioner, and thus Petitioner’s continued and legal use of its mark will be impaired by the continued registration of the ECOSORB mark of Registrant.

Registration No. 1585509 for ECO PURE

27. The goods in Registrant’s Registration No. 1585509 for ECO PURE are identified

as “water purification and filtration units for domestic and commercial use,” in International Class 011.

28. In its Notice of Opposition, Registrant stated that it “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.”

29. In its Amended Notice of Opposition, Registrant stated that it “develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services,” deleting any reference to commercial water treatment equipment.

30. Upon information and belief, Registrant no longer develops and manufactures “water purification and filtration units for domestic and commercial use,” in International Class 011.

31. Upon information and belief, Registrant has abandoned its ECO PURE mark for certain goods in U.S. Reg. No. 1585509, namely, precoat filter materials consisting of powdered activated carbon, ion exchange resin and fibrous material, for use in industrial water and waste water treatment.

32. Petitioner is being damaged by the continued existence of Reg. No. 1585509 in that it is unable to obtain registration of the mark in Application Serial No. 85094582, and Petitioner’s continued and legal use of its mark will be impaired by the continued registration of the ECO PURE mark of Registrant.

Registration No. 1771108 for ECOWATER

33. The goods in Registrant’s Registration No. 1771108 for ECOWATER SYSTEMS

are identified as “water pumps, as machine parts, for use in domestic and commercial water treatment applications,” in International Class 007.

34. In its Notice of Opposition, Registrant stated that it “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.”

35. In its Amended Notice of Opposition, Registrant stated that it “develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services,” deleting any reference to commercial water treatment equipment.

36. Upon information and belief, Registrant no longer develops and manufactures “water pumps, as machine parts, for use in commercial water treatment applications,” in International Class 007.

37. Upon information and belief, Registrant has abandoned its ECOWATER SYSTEMS mark for certain the goods in U.S. Reg. No. 1771108, namely, water pumps, as machine parts, for use in commercial water treatment applications.

38. Petitioner is being damaged by the continued existence of Reg. No. 1771108 in that it is unable to obtain registration of the mark in Application Serial No. 85094582, and Petitioner’s continued and legal use of its mark will be impaired by the continued registration of the ECOWATER SYSTEMS mark of Registrant.

Registration No. 1771860 for ECOWATER SYSTEMS

39. The services in Registrant’s Registration No. 1771860 for ECOWATER SYSTEMS are recited as “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,” in International Class 037.

40. In its Notice of Opposition, Registrant stated that it “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.”

41. In its Amended Notice of Opposition, Registrant stated that it “develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services,” deleting any reference to commercial water treatment equipment.

42. Upon information and belief, Registrant no longer provides repair and maintenance services in the field of commercial water treatment equipment; namely, water conditioners, softeners, deionizers, distillers, filters, and related water treatment units, in International Class 037.

43. Upon information and belief, Registrant has abandoned its ECOWATER SYSTEMS mark for the services in U.S. Reg. No. 1771860, namely, repair and maintenance services in the field of commercial water treatment equipment; namely, water conditioners, softeners, deionizers, distillers, filters, and related water treatment unit.

44. Petitioner is being damaged by the continued existence of Reg. No. 1771860 in that it is unable to obtain registration of the mark in Application Serial No. 85094582, and Petitioner’s continued and legal use of its mark will be impaired by the continued registration of the ECOWATER SYSTEMS mark of Registrant.

Registration No. 1613312 for ECOWATER SYSTEMS

45. The services in Registrant's Registration No. 1613312 for ECOWATER SYSTEMS are recited as "retail outlet services and rental services in the field of domestic and commercial water conditioners and purifiers," in International Class 042.

46. In its Notice of Opposition, Registrant stated that it "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."

47. In its Amended Notice of Opposition, Registrant stated that it "develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services," deleting any reference to commercial water treatment equipment.

48. Upon information and belief, Registrant no longer provides retail outlet services and rental services in the field of commercial water conditioners and purifiers, in International Class 042.

49. Upon information and belief, Registrant has abandoned its ECOWATER SYSTEMS mark for the services in U.S. Reg. No. 1613312, namely, retail outlet services and rental services in the field of domestic and commercial water conditioners and purifiers.

50. Petitioner is being damaged by the continued existence of Reg. No. 1613312 in that it is unable to obtain registration of the mark in Application Serial No. 85094582, and Petitioner's continued and legal use of its mark will be impaired by the continued registration of the ECOWATER SYSTEMS mark of Registrant.

Registration No. 2279118 for ECOWATER DRINKING WATER & Design

51. The services in Registrant's Registration No. 2279118 for ECOWATER DRINKING WATER & Design are recited as "retail distributorships featuring domestic and commercial water conditioners and purifiers, and bottled drinking water," in International Class 035.

52. In its Notice of Opposition, Registrant stated that it "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."

53. In its Amended Notice of Opposition, Registrant stated that it "develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services," deleting any reference to commercial water treatment equipment.

54. Upon information and belief, Registrant no longer provides retail distributorships featuring commercial water conditioners and purifiers, and bottled drinking water, in International Class 035.

55. Upon information and belief, Registrant has abandoned its ECOWATER DRINKING WATER & Design mark for the services in U.S. Reg. No. 2279118, namely, retail distributorships featuring domestic and commercial water conditioners and purifiers, and bottled drinking water.

56. Petitioner is being damaged by the continued existence of Reg. No. 2279118 in that it is unable to obtain registration of the mark in Application Serial No. 85094582, and Petitioner's continued and legal use of its mark will be impaired by the continued registration of the

ECOWATER DRINKING WATER & Design mark of Registrant.

WHEREFORE,

Petitioner believes that it will be damaged by said registrations and respectfully requests that they be cancelled.

Please address all communication to Dean R. Karau, Lora M. Friedemann, and Laura L. Myers, Fredrikson & Byron, P.A., Suite 4000, 200 South Sixth Street, Minneapolis, Minnesota, 55402-1425.

Dated: August 6, 2012

/s/ Laura L. Myers

Dean R. Karau

Lora M. Friedemann

Laura L. Myers

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**Attorneys for Applicant/Registrant Ecolab USA,
Inc.**

CERTIFICATE OF SERVICE

I hereby certify that a true copy of ECOLAB USA INC.'S ANSWER TO AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIM PETITION TO CANCEL was served by email, pursuant to the parties' agreement, on the attorneys of record for Opposer, Peter T. Holsen, Aaron T. Olejniczak, ANDRUS, SCEALES, STARKE & SAWALL, LLP, 100 East Wisconsin Avenue, Suite 1100, Milwaukee, WI 53202 this 6th day of August, 2012.

/s/ Laura L. Myers

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EXHIBIT A



01-30-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #22

UNITED STATES PATENT AND TRADEMARK OFFICE

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#6

COMBINED DECLARATION OF USE IN COMMERCE/APPLICATION FOR RENEWAL OF REGISTRATION OF MARK UNDER §§ 8 AND 9 (15 U.S.C. §§ 1058 & 1059)

To the Assistant Commissioner for Trademarks:

MARK: ECOSORB

REGISTRATION NO.: 1,710,954

REGISTRATION DATE: September 1, 1992

INTERNATIONAL CLASS NO.: 1

REGISTRANT: Ecowater Systems, Inc.

BUSINESS ADDRESS: 1890 Woodlane Drive
Woodbury, Minnesota 55125

CORPORATION:
State of Incorporation: Delaware

EV 041377919 US
"Express Mail" mailing label no. _____
Date of Deposit: 1-30-02
I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.
Mary T. LaBeau
Name (typed or printed)
<i>Mary T. LaBeau</i>
Signature

The above-identified owner is using the mark in commerce on or in connection with all goods and/or services listed in the existing registration. The Trademark Assignment from Graver Technologies, Inc. to Ecowater Systems, Inc. was recorded on April 2, 1999, Reel/Frame 1881/0363.

Section 8: Declaration of Use in Commerce

The owner is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as currently used in commerce.

Section 9: Application for Renewal

The owner requests that the registration be renewed for the goods and/or services identified

above.

02/04/2002 TSMITH 00000150 1710954

01 FC:372
02 FC:365

100.00 OP
400.00 OP

21018/30084731

Registration No. 1,710,954 – 2

Power of Attorney

Applicant hereby appoints Mark I. Feldman, James P. Ryther, Monica L. Thompson, Keith W. Medansky, Jefferson Perkins, Maxine L. Retsky, Christina L. Martini, David J. Richter, Linda Urbanik Johnson, Thomas W. Ryan, Myla D. Barefield, Micah R. Onixt, Gina L. Durham and Lisa Anderson, all attorneys admitted to practice before the Supreme Court of the State of Illinois, of the law firm of Piper Marbury Rudnick & Wolfe, P.O. Box 64807, Chicago, Illinois 60664-0807, Telephone No. (312) 368-4000, its attorneys, with full power of substitution and revocation, to transact all business in the Patent and Trademark Office in connection therewith.

Fees

The fee of \$500 per class is presented herewith.

Declaration

The undersigned declarant, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. §1001), and that any willful false statements may jeopardize the validity of this document or any registration resulting herefrom, declares that the undersigned is authorized to execute this instrument on behalf of applicant corporation, that all

Registration No. 1,710,954 - 3

statements made herein of declarant's own knowledge are true and all statements made on information and belief are believed to be true.

ECOWATER SYSTEMS, INC.

By: _____


Name: Robert C. Gluth

 Title: Vice President

Date: January 7, 2002

ECOSORB[®]

ADSORBENTS



Graver Technologies

Graver Technologies, Inc.
200 Lake Drive
Glasgow, DE 19702-3319
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Fax: 302 731-7107



**PIPER
MARBURY
RUDNICK
& WOLFE**



01-30-2002
U.S. Patent & TM Office/TM Mail Rcpt. Dt. #22

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Thomas W. Ryan

January 30, 2002

VIA EXPRESS MAIL

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Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: **Application for Renewal Under Sections 8&9
Ecowater Systems, Inc.
Mark: ECOSORB
U.S. Reg. No. 1,710,954
Registration Date: September 1, 1992**

Sir:

Attached please find an Application for Renewal in connection with the above-identified registration. Also enclosed is one specimen per class showing use of the mark and a check in the amount of \$500 in payment of the filing fee. Any additional fees should be charged to our Deposit Account No. 18-2284.

Please direct all correspondence to:

Thomas W. Ryan, Esq. 89
Piper Marbury Rudnick & Wolfe
P.O. Box 64807
Chicago, Illinois 60664-0807

Respectfully submitted,

PIPER MARBURY RUDNICK & WOLFE

Thomas W. Ryan

Enclosures

21018 648240

Registration No. 1,710,954 - 4

Applicant: Ecowater Systems, Inc.

Business Address: 1890 Woodlane Drive
Woodbury, Minnesota 55125

ONE SPECIMEN IS ATTACHED TO THIS PAGE

EXHIBIT B



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