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Filing date: **01/09/2012**

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, LORA FRIEDEMANN, LAURA MYERS FREDRIKSON & BYRON, P.A. 200 S 6TH ST STE 4000 MINNEAPOLIS, MN 55402-1425 UNITED STATES ip@fredlaw.com, lfriedemann@fredlaw.com, lmyers@fredlaw.com
Submission	Answer and Counterclaim
Filer's Name	Laura L. Myers
Filer's e-mail	lmyers@fredlaw.com
Signature	/Laura L. Myers/
Date	01/09/2012
Attachments	20120109102835.pdf (18 pages)(1496912 bytes)

Registrations Subject to the filing

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	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

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 NOTICE OF OPPOSITION AND
COUNTERCLAIM PETITION TO CANCEL**

Applicant, Ecolab USA Inc., for its answer to the 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 Notice of Opposition and therefore denies same.
2. Applicant denies the allegations contained in Paragraph 2 of the Notice of Opposition, and Applicant further states that by separate motion it has moved to dismiss the claim by Opposer that there is a likelihood of confusion based on an alleged family of marks.
3. Applicant denies the allegations contained in Paragraph 3 of the 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 Notice of Opposition and therefore denies same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition and therefore denies same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition and therefore denies same.

7. Applicant admits the allegations contained in Paragraph 7 of the Notice of Opposition.

8. Applicant repeats its answers in paragraphs 1 through 7 above in response to the allegations contained in Paragraph 8 of the 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 Notice of Opposition and therefore denies same.

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

11. Applicant denies the allegations contained in Paragraph 11 of the Notice of Opposition.

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

SEPARATE DEFENSES

1. Opposer has failed to state claims upon which relief can be granted.
2. Opposer's mark ECOSORB in U.S. Registration No. 1585509 has been abandoned through non-use of the mark for the identified goods and without any intention to resume such use.
3. Opposer has unclean hands by filing a declaration in connection with the renewal application for the mark ECOSORB in U.S. Registration No. 1585509, declaring that it was using the mark in commerce on or in connection with the identified goods when in fact it was not using the mark in commerce on or in connection with all of the identified goods.
4. Opposer has committed fraud on the United States Patent and Trademark Office by filing a declaration in connection with the renewal application for the mark ECOSORB in U.S. Registration No. 1585509, declaring that it was using the mark in commerce on or in connection with the identified goods when in fact it was not using the mark in commerce in connection with any of the identified goods.

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. 1710954 and 3268985, 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

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 good will 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 ~~ecopure~~, 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.

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, Registrant alleged, among other things, (1) that it owns a family 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.

Registration No. 1710954

9. 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.

10. 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.

11. 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.

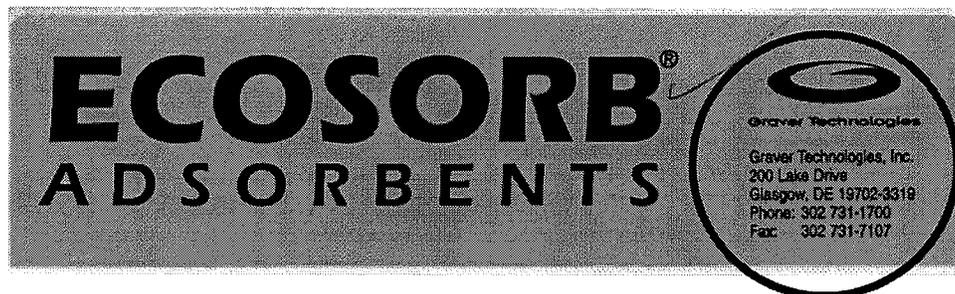
12. On January 30, 2002, Ecowater Systems, Inc. filed a Combined Declaration of Use in Commerce/Application for Renewal of Registration of Mark Under §§ 8 and 9 (15 U.S.C. §§ 1058 & 1059), in which Ecowater Systems, Inc. declared as follows:

[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.

13. 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.

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



See Exhibit B.

15. 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.

16. 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.

17. 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.

18. Petitioner is being damaged by the continued existence of Reg. No. 1710954 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 ECOSORB 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 Friedemann, and Laura Myers, Fredrikson & Byron, P.A., Suite 4000, 200 South Sixth Street, Minneapolis, Minnesota, 55402-1425.

Dated: January 9, 2012

/s/ Laura L. Myers

Dean R. Karau

Lora Friedemann

Laura Myers

FREDRIKSON & BYRON, P.A.

200 Sixth Street South, Suite 4000

Minneapolis, MN 55402-1425

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lmyers@fredlaw.com

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

CERTIFICATE OF SERVICE

I hereby certify that a true copy of ECOLAB USA INC.'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM PETITION TO CANCEL was served by United States mail on the attorney of record for Opposer, Caroline Stevens, Leydig, Voit & Mayer, Ltd., 1420 Fifth Ave., Suite 3670, Seattle, WA 98101, by mailing it to her address of record by first class mail, postage prepaid, this 9th day of January, 2012.

5047945_1.DOC

/s/ Laura L. Myers

EXHIBIT A



01-30-2002

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

U.S. 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
Phone: 302 731-1700
Fax: 302 731-7107

ECOSORB[®]

ADSORBENTS



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01-30-2002

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Thomas W. Ryan

January 30, 2002

VIA EXPRESS MAIL

BOX POST REG FEE
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.
Piper Marbury Rudnick & Wolfe
P.O. Box 64807
Chicago, Illinois 60664-0807

Respectfully submitted,

PIPER MARBURY RUDNICK & WOLFE

Thomas W. Ryan

Enclosures

21613/848249

mas

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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