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

Proceeding	91202732
Party	Plaintiff EcoWater Systems LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ECOWATER SYSTEMS LLC,)	
)	
Opposer,)	
)	Opposition No.: 91202732
v.)	
)	Mark: ECOLAB
ECOLAB USA INC.,)	
)	
Applicant.)	

**OPPOSER’S RESPONSE TO APPLICANT’S RULE 12(b)(6)
MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM**

Opposer, EcoWater Systems LLC (“Opposer”), responds to Applicant’s, Ecolab USA Inc. (“Applicant’s”), Rule 12(b)(6) Motion to Dismiss for Failure to State a Claim (the “Motion”) as follows:

1. Applicant moved to dismiss Opposer’s opposition for failure to state a claim “to the extent it is based on an alleged family of marks.” (Motion, p. 1). Contrary to Applicant’s Motion, Opposer’s has stated a claim upon which relief can be granted, and Applicant’s Motion should be denied.

2. “A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought....” TBMP § 503.02 (emphasis added).

3. First, “[a]ny person who believes it is or will be damaged by registration of a mark has standing to file a [Notice of Opposition]. At the pleading stage, all that is required [to show standing] is that a plaintiff allege facts sufficient to show a ‘real interest’ in the proceeding,

and a ‘reasonable basis’ for its belief that it would suffer some kind of damage if the mark is registered....” TBMP §303(b).

4. “A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads (and later proves): A claim of likelihood of confusion that is not wholly without merit, including claims based upon current ownership of a valid and subsisting registration or prior use of a confusingly similar mark....” Id.

5. Here, when construing the Notice of Opposition in a light most favorable to Opposer, it cannot be said that Opposer’s claim of likelihood of confusion is without merit. It is clear from the face of the Notice of Opposition that the ECOLAB and ECOWATER marks are similar because they share the same first three letters, and that Applicant’s goods and Opposer’s goods are identical, similar, or related. (NOO Paras. 2, 4, 5 & 9). In addition, Opposer also plead that it currently owns eleven valid and subsisting registrations, and that it has priority. Thus, Opposer has plead a “real interest” in the proceeding and a “reasonable belief of damage” and has properly plead standing in this case.

6. Second, “[i]n addition to standing, a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition or cancellation.” TBMP § 309.03(c). Here, Opposer specifically cited Trademark Act § 2(d) in the Notice (NOO Para. 11), and Opposer provided sufficient detail concerning a likelihood of confusion and priority (NOO Paras. 9-11, et. al.) so as to put Applicant on notice of the grounds of the Opposition. Thus, Opposer has also properly plead a valid ground for this opposition.

7. Applicant seeks to dismiss, in particular, the “family of marks” claim from the Opposition. “Family of marks” is an argument, not a claim, that a party may make in connection

with a likelihood of confusion analysis. More specifically, it is the argument that Applicant's mark is likely to be perceived as being in the group (i.e., family) of Opposer's marks, and thus likely to cause confusion and mistake. *See McCarthy on Trademarks*, § 23:61, p. 23-299 (Thomson Reuters/West 2011). "Family of marks" is not, however, a claim itself. In fact, the two cases cited by Applicant considered the "family of marks" argument when deciding a likelihood of confusion claim, but they did not consider "family of marks" to be a claim itself. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988). Thus, it cannot be said that Opposer failed to properly plead "family of marks" because "family of marks" is not a claim but an argument, and Opposer is not required to spell out the nuances of its arguments in the Notice of Opposition.

8. Even if "family of marks" is a type of claim, Opposer is required to include only enough detail to give Applicant fair notice of the basis for the claim, which Opposer has done, particularly when construing the Opposition in a light most favorable to Opposer.

9. In conclusion, "whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought." TBMP § 503.02. Opposer's Notice of Opposition alleges such facts as would, if proved, establish that Opposer is entitled to the relief sought, that is, that Opposer has standing to maintain the proceeding, and a valid ground exists for denying the application for ECOLAB.

Accordingly, Opposer respectfully requests that the Board deny Applicant's Rule 12(b)(6) Motion to Dismiss for Failure to State a Claim.

10. While Opposer believes Applicant's Motion should be denied, if the Board is inclined to grant the Motion, Opposer respectfully requests that the Board instead grant Opposer leave to amend the Notice of Opposition to remedy any perceived deficiencies.

Dated: January 23, 2012

Respectfully submitted,

ECOWATER SYSTEMS LLC

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CERTIFICATE OF ELECTRONIC FILING AND SERVICE

I hereby certify that the "Opposer's Response to Applicant's Rule 12(b)(6) Motion to Dismiss for Failure to State a Claim was filed electronically with the Trademark Trial & Appeal Board and that a copy was served on Applicant on the date indicated below, via U.S. First Class Mail, in an envelope addressed as follows:

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Date of Signature