

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

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Mailed: February 27, 2012

Opposition No. 91202732

EcoWater Systems LLC

v.

Ecolab USA Inc.

Before Grendel, Mermelstein and Lykos,
Administrative Trademark Judges.

By the Board:

Ecolab USA Inc. ("applicant") filed an application to register the mark ECOLAB (standard characters) for the following International Class 11 goods:

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.¹

EcoWater Systems LLC ("opposer") opposes registration of the following identified goods:

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

on the grounds of priority and likelihood of confusion under Trademark Act § 2(d), and pleads ownership of eleven registrations for, collectively, the following marks: ECOSORB, ECODEX, ECOCOTE, ECODYNE, ECO PURE, ECOWATER, and ECOWATER SYSTEMS. The pleaded registrations cover water, various water purification, filtration and treatment parts and equipment, as well as repair, maintenance, retail and distributorship services related thereto.

Applicant filed an answer denying all salient allegations in the notice of opposition, set forth counterclaims to cancel two of opposer's pleaded registrations, and concurrently moved to dismiss the notice of opposition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief may be granted.

¹ Application Serial No. 85094582, filed July 28, 2010, based on use of the mark under Trademark Act § 1(a), asserting a date of first use anywhere, and date of first use in commerce, of February 11, 1998.

Opposer filed a brief in opposition to the motion. Accordingly, this proceeding is before the Board for consideration of applicant's motion to dismiss.

Motion to dismiss

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. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). *See also* TBMP § 503.02 (3d ed. 2011).

Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of inter partes proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556. The factual allegations "must be enough to raise a right to relief above

the speculative level." See *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Dismissal for insufficiency is appropriate only if it appears certain that opposer is entitled to no relief under any set of facts that could be proved in support of its claim. The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed. R. Civ. P. 8(e). See also *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007).

To state a claim under Trademark Act § 2(d), opposer must sufficiently allege that 1) it has standing,² 2) it has registered or previously used a mark; and 3) contemporaneous use of the parties' respective marks on or in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). As part of a § 2(d) claim, opposer may plead likelihood of confusion with respect to its individual pleaded marks as well as pleading that it owns a family of marks. See, e.g., *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007).

² Applicant does not challenge opposer's standing in its motion to dismiss. Moreover, by way of pleading ownership of eleven registrations, each of which is for a mark that begins with the letters "ECO-," opposer has set forth factual allegations which, if proven, establish that it has a real interest in this proceeding and a reasonable belief of damage in the event of registration of applicant's mark, ECOLAB.

Applicant moved "to dismiss the claim by Opposer that there is a likelihood of confusion based on an alleged family of marks" (answer, para. 2). Specifically, applicant moved to dismiss on the basis that opposer "has only alleged that its marks contain a common surname, 'ECO,'" that opposer "has neither alleged, nor provided any facts that suggest, that its marks are used in such a way that the public associates both the individual marks and the common characteristics of the purported 'family' with EcoWater," and that opposer has not alleged "that the alleged family's common characteristic, 'ECO,' is distinctive on its own" (applicant's brief, p. 3).

Turning to the notice of opposition, opposer alleges the following, in pertinent part:

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...

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.

...

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 that 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.

We find that, by way of these allegations, opposer has pled with sufficient factual particularity that a certain feature of its marks, namely, "ECO," is common to each of the marks in which it asserts ownership of separate rights, that this feature renders its pleaded marks to be a "family of marks," and that this is relevant to the issue of likelihood of confusion. For pleading purposes, opposer has set forth facts which sufficiently allege its ownership of a family of marks, and which adequately place applicant on notice that this

assertion forms a basis for opposer's claim of likelihood of confusion.³

For completeness, we note that by way of paragraphs 2 and 9 of its pleading, opposer sufficiently sets forth its allegation of priority of use of its pleaded marks. Moreover, by way of paragraph 10, opposer sufficiently sets forth its allegation that there is a likelihood of confusion with respect to the source of opposer's goods and services, and the goods identified in applicant's application which are subject to this opposition.

Based on these findings, we conclude that opposer has

³ As stated above, a motion to dismiss is directed to only the sufficiency of a pleading. Thus, the Board has made no analysis of the merit or evidentiary weight of opposer's allegation that its pleaded marks constitute a family of marks. In determining likelihood of confusion, the Board considers the various evidentiary factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The relevance and weight to be given the various factors differs from case to case, and whether opposer pleads and proves that it owns a family of marks is only one factor in this analysis. See *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567 (setting forth "[T]he variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)" as a factor that may be considered in determining likelihood of confusion). Opposer need not establish ownership of a family of marks in order to prove likelihood of confusion.

The parties are advised that, as our primary reviewing court has stated, "[S]imply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods." See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). See also *Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1337 (TTAB 2006). Whether opposer's marks are used in such a way that the public associates both the individual marks and the common characteristics of the alleged family with opposer, and whether "ECO" is distinctive, are matters for proof.

sufficiently pled standing, as well as a statutory ground for opposing registration of the mark ECOLAB pursuant to Trademark Act § 2(d). In view thereof, applicant's motion to dismiss for failure to state a claim upon which relief may be granted is hereby denied.

Schedule

Proceedings are resumed. Opposer is allowed until thirty (30) days from the mailing date of this order in which to file an answer to the counterclaim to cancel Registration Nos. 1710954 and 3268985. Conferencing, disclosure, discovery and trial dates, including dates for the counterclaims, are reset as follows:⁴

Deadline for REQUIRED Discovery Conference	April 27, 2012
Discovery Opens	April 27, 2012
Initial Disclosures Due	May 27, 2012
Expert Disclosures Due	September 24, 2012
Discovery Closes	October 24, 2012
Plaintiff's Pretrial Disclosures	December 8, 2012
30-day testimony period for plaintiff's testimony to close	January 22, 2013
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	February 6, 2013
30-day testimony period for defendant and plaintiff in the counterclaim to close	March 23, 2013
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 7, 2013

⁴ At any time in this proceeding, should the parties file a motion to suspend or extend any of these dates, said motion should include a proposed schedule, as set forth above.

30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	May 22, 2013
Counterclaim Plaintiff's Rebuttal Disclosures Due	June 6, 2013
15-day rebuttal period for plaintiff in the counterclaim to close	July 6, 2013
BRIEFS SHALL BE FILED AS FOLLOWS:	
Brief for plaintiff due	September 4, 2013
Brief for defendant and plaintiff in the counterclaim due	October 4, 2013
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	November 3, 2013
Reply brief, if any, for plaintiff in the counterclaim due	November 18, 2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.