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Filing date: **07/22/2005**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|----------------|---|--------------------|----------|
| Name | Ecolab Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 370 Wabasha Street North St. Paul, MN 55102 UNITED STATES | | |

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|-----------------------------|---|
| Attorney information | Philip R. Mahowald Winthrop & Weinstine, P.A. 225 South Sixth Street Suite 3500 Minneapolis, MN 55402 UNITED STATES pmahowald@winthrop.com, trademark@winthrop.com, charrigan@winthrop.com Phone:612-604-6400 |
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Registration Subject to Cancellation

| | | | |
|------------------------|---|--------------------------|------------|
| Registration No | 2371074 | Registration date | 07/25/2000 |
| Registrant | Melaleuca, Inc. 3910 South Yellowstone Highway Idaho Falls, ID 83402 UNITED STATES | | |

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| Goods/Services Subject to Cancellation | Class 003. First Use: 19990101, First Use In Commerce: 19990101 Goods/Services: All-purpose household cleansers; fabric softeners; spot and stain removing preparations; laundry detergent; laundry bleach alternative; glass cleaning preparations; bathroom cleaning preparations; furniture polish; and dishwashing detergents |
| | Class 005. First Use: 19990101, First Use In Commerce: 19990101 Goods/Services: Air fresheners |

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|--------------------|---|
| Attachments | PetitionCancel_Melaleuca.pdf (10 pages) |
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|------------------|----------------------|
| Signature | /Philip R. Mahowald/ |
| Name | Philip R. Mahowald |
| Date | 07/22/2005 |

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

ECOLAB INC.,

Petitioner,

v.

Cancellation No. _____

MELALEUCA, INC.,

Respondent.

PETITION TO CANCEL

Ecolab Inc. (“Petitioner”), a Delaware corporation having a principle place of business at 370 Wabasha Street North, St. Paul, Minnesota, 55102, believes that it is and will continue to be damaged by the registration of the mark ECOSENSE, Registration No. 2,371,074, and hereby petitions to cancel the same pursuant to the provisions of 15 U.S.C. § 1064.

The grounds for cancellation are as follows:

1. Melaleuca, Inc.. (“Respondent”) is the record owner of U.S. Reg. No. 2,371,074 for the mark ECOSENSE (“Respondent’s ECOSENSE mark”).
2. The goods listed in U.S. Reg. No. 2,371,074 are “All-purpose household cleansers; fabric softeners; spot and stain removing preparations; laundry detergent; laundry bleach alternative; glass cleaning preparations; bathroom cleaning preparations; furniture polish; and dishwashing detergents” in International Class 03 and “Air fresheners” In International Class 05 (“Respondent’s Products”).

3. Respondent has alleged that it first used the mark depicted in U.S. Reg. No. 2,371,074 in connection with Respondent's Products on January 1, 1999.

4. On information and belief, Respondent did not use Respondent's ECOSENSE mark prior to January 1, 1999.

5. On information and belief, Respondent has no basis for claiming a first use date earlier than January 1, 1999.

6. U.S. Registration No. 2,371,074 was issued on July 25, 2000, within five years of the date of this Petition to Cancel.

7. Petitioner is the leading global developer and marketer of premium cleaning, sanitizing, maintenance and repair products and services for a variety of markets, including but not limited to the hospitality, commercial, institutional, industrial, and retail consumer markets. Petitioner provides a comprehensive array of cleaning, sanitizing, maintenance and repair products and services to restaurants, hotels, motels, convenience stores, schools, supermarkets, hospitals, health care facilities, nursing homes, military facilities, prisons, athletic facilities, spas, office buildings, shopping malls, industrial facilities, food and beverage processing plants, dairy farms, pharmaceutical and cosmetic facilities, laundries, governmental entities, cruise ships, and other hospitality, commercial, institutional, and industrial customers. Petitioner also sells cleaning products through mass retail merchandisers such as Sam's Club. Petitioner provides kitchens and other food service providers with ware-washing equipment, detergents, detergent dispensing systems, grease containment products and equipment, water filtration systems, floor mats, dish racks, training for food service employees, and equipment repair services, among other things. Petitioner offers comprehensive restroom cleaning products, equipment and services, including cleaners, sanitizers, dispensers, touchless flushing systems, continuous urinal

and toilet cleaners, and odor neutralizers. Petitioner offers the hospitality industry a full line of housekeeping products including bathroom cleaners, sanitizers, and advanced cleaner dispensing systems. Petitioner offers food and beverage processing plants with a full line of cleaning and sanitizing products, including hand sanitizers. Petitioner is also a leading supplier of commercial, institutional and industrial laundry products, equipment and services. Further, Petitioner offers insect, rodent and pest extermination and control products and services, pool and spa products and services, vehicle care products and services, and water care products and services, among others. Petitioner's annual worldwide sales were more than \$4.2 billion in 2004.

8. Petitioner is the owner of numerous federal trademark and service mark registrations for marks containing the distinctive ECO formative or prefix ("Petitioner's Family of ECO Marks"). Many of these marks are used in connection with various cleaning products and services used by people who and entities that could be interested in Respondent's products.

9. The table set forth below includes several members of Petitioner's Family of ECO Marks:

| U.S. Reg. No. | Mark | Goods/Services | Date of First Use | Date of Registration |
|----------------------|-------------|--|--------------------------|-----------------------------|
| 1,073,420 | ECO-KLENE | Liquid ware-washing detergent for institutional use. | May 1976 | September 20, 1977 |
| 1,097,987 | ECO-TEMP | Dispenser for institutional dishwashing machines which electrically dispenses volumetrically measured amounts of detergents, sanitizers or rinse agents. | January 1977 | August 1, 1978 |
| 1,119,076 | ECO-SAN | Sanitizer and destrainer for mechanical spray ware-washing machines. | February 1978 | May 29, 1979 |
| 1,166,341 | ECO-VAC | Dispenser operating on water pressure, which automatically adds a measured amount of liquid detergents, sanitizing compounds and rinse additives to water supply and maintains a constant concentration. | November 1964 | August 25, 1981 |

| U.S. Reg. No. | Mark | Goods/Services | Date of First Use | Date of Registration |
|----------------------|-------------|--|--------------------------|-----------------------------|
| 1,225,370 | ECOTEMP | Rental of institutional dishwashing equipment to others. | January 1977 | January 25, 1983 |
| 1,335,023 | ECOTEMP | Automatic dishwashing detergents, sanitizer/destainers, and rinse additives for use therewith, for commercial and institutional use. | March 14, 1984 | May 14, 1985 |
| 1,480,715 | ECO-SPRAY | Pre-rinse and pre-flush unit for use at sinks. | February 9, 1987 | March 15, 1988 |
| 2,691,203 | ECOSPHERE | Air fresheners and deodorizers. Dispensing unit for air fresheners and deodorizers. | August 12, 1998 | February 25, 2003 |
| 1,497,423 | ECOLAB | Insect, rodent and pest extermination and control services; janitorial services; leasing of dishwashing machines and related equipment. Laundry and ware-washing machines; parts and accessories therefore. | December 5, 1986 | July 26, 1988 |
| 1,504,682 | ECO-LINE | Detergent reservoir and dispenser for dispensing measured amounts of ware-washing, laundry and janitorial detergents and cleaners. | March 1987 | September 20, 1988 |
| 1,510,624 | ECOLAB | Cleaning compound having water softening properties; cleaning compound for wall washing, paint cleaning, and general use; cleaning compound for windows, mirrors, painted and varnished woodwork, dishes, enamelware, kitchen utensils, glassware, silverware; and for a washing and cleaning compound used alone and in addition to soap for the cleaning of clothes. | January 28, 1988 | November 1, 1988 |
| 1,524,340 | ECOLAB | Dispensers for dispensing liquid, powder, or solid chemicals, detergents, cleansing and rinsing agents in premeasured amounts. | April 1987 | February 14, 1989 |

| U.S. Reg. No. | Mark | Goods/Services | Date of First Use | Date of Registration |
|---------------|--------|---|-------------------|----------------------|
| 1,525,025 | ECOLAB | Bleaching agents, starch and detergent for laundry use; all-purpose cleaning, polishing, scouring and abrasive preparations; stain, paint and varnish removing preparations; toilet soaps; dishwashing detergent; fabric softener for laundry use; rinsing agents for laundry use; solvent cleaning preparations for household use; all-purpose detergents; and degreasers for household and industrial use; preparations for destroying vermin, namely, fungicides, parasiticides, bactericides, germicides, insecticides and slimicides; all-purpose disinfectants and sanitizing preparations; insect repellants; air fresheners and deodorants for institutional/commercial, residential/consumer, and veterinary use. Dispensers for dispensing liquid, powder or solid chemicals, detergents, cleansing and rinsing agents in premeasured amounts; chemical products used in laundry and ware-washing processes; water treatment chemicals; chemicals for treating fabrics. | October 5, 1986 | February 21, 1989 |
| 1,527,356 | ECOLAB | Insect, rodent and pest extermination and control services; laundry management; china, glassware, silverware and kitchen cleaning management and services; leasing of dishwashing machines and related equipment; maintenance of swimming pools, spas, cooling towers, boilers and other equipment to heat and cool buildings. | April 1, 1987 | February 28, 1989 |
| 1,538,458 | ECOLAB | Consulting services in the field of laundry, dishwashing, and industrial cleaning methods and equipment; and insect, pest and rodent extermination services. | May 31, 1987 | May 9, 1989 |

| U.S. Reg. No. | Mark | Goods/Services | Date of First Use | Date of Registration |
|---------------|--------|--|-------------------|----------------------|
| 1,538,718 | ECOLAB | Chemical products, namely, anti-static and anti-fog preparations, surfactants, metal conditioners, and brightening and etching preparations, for use in restaurants, hotels, schools, health care and other institutions, the food, dairy and beverage processing industries, the manufacturing industry, the agricultural industry, the textile industry, the wholesale and retail trade industries, the sanitary services industry, and private households; organic intermediate chemicals for use in the manufacturing industry; chemical products used in laundry and ware-washing processes; water treatment chemicals; chemicals for treating fabrics; chemical oil and fuel additives for use in the transportation, manufacturing and utilities industries; industrial solvents; chemical machining fluids; phosphatizing preparations; water softening salts; and fertilizers for agricultural, commercial and residential use. | April 1987 | May 16, 1989 |
| 1,538,785 | ECOLAB | Cleaning compound having water softening properties; cleaning compound for wall washing, paint cleaning and general use; cleaning compound for windows, mirrors, painted and varnished woodwork, dishes, enamelware, kitchen utensils, glassware, silverware; and for a washing and cleaning compound used alone and in addition to soap for the cleaning of clothes. | May 31, 1988 | May 16, 1989 |

| U.S. Reg. No. | Mark | Goods/Services | Date of First Use | Date of Registration |
|----------------------|-------------|--|--------------------------|-----------------------------|
| 1,538,857 | ECOLAB | Preparations for destroying vermin, namely, fungicides, parasiticides, bactericides, germicides, insecticides and slimicides; all-purpose disinfectants and sanitizing preparations; insect repellants; air fresheners and deodorants for institutional/commercial, residential/consumer, and veterinary use. | April 1987 | May 16, 1989 |
| 1,539,982 | ECOLAB | Bleaching agents, starch and detergent for laundry use; all-purpose cleaning, polishing, scouring and abrasive preparations; stain, paint and varnish removing preparations; toilet soaps; dishwashing detergent; fabric softener for laundry use; rinsing agents for laundry use; solvent cleaning preparations for household use; all-purpose detergents; and degreasers for household and industrial use. | April 1987 | May 23, 1989 |
| 1,607,681 | ECOSYSTEM | Pest extermination services; laundry management; china, glassware, silverware and kitchen cleaning management and services. | October 16, 1989 | July 24, 1990 |
| 1,628,146 | ECO-ALERT | Apparatus to monitor levels of detergents and rinse additives in reservoirs of institutional ware-washing machines. | June 30, 1978 | December 18, 1990 |
| 1,664,595 | ECOTAINER | Plastic-lined cardboard containers for transporting, storing and dispensing a variety of cleaning products. | July 17, 1990 | November 12, 1991 |
| 1,750,698 | ECOSHINE | Stainless steel polish for commercial and institutional use. | June 24, 1992 | February 2, 1993 |
| 1,943,805 | ECOTEMP | Dispenser for institutional dishwashing machines which electronically dispense volumetrically measured amounts of detergents, sanitizers or rinse additives. Automatic dishwashing machines for commercial and institutional use. | October 1990 | December 26, 1995 |

| U.S. Reg. No. | Mark | Goods/Services | Date of First Use | Date of Registration |
|----------------------|-------------|---|--------------------------|-----------------------------|
| 2,199,990 | ECOPRO | Specialized pest extermination services rendered for specific markets. | August 17, 1996 | December 9, 1997 |
| 2,253,131 | ECOHEAT | Wastewater reclamation units for use in institutional and industrial laundries. | August 14, 1997 | June 15, 1999 |
| 2,295,878 | ECOFLO | Waste treatment services, namely, a service program for grease elimination for food service operations biological grease digestant. | August 5, 1998 | November 30, 1999 |
| 2,526,181 | ECO-PORT | Software application tool that provides detailed reporting and comprehensive surveys of institutional and industrial laundries. | September 13, 2001 | January 1, 2002 |
| 2,768,068 | ECOSURE | Conducting inspections regarding food safety; providing consulting services in the field of food safety, food manufacturing and food manufacturing recalls; designing food safety programs for others. Preparing business reports in the field of food safety; business auditing in the field of food manufacturing; business evaluation of food manufacturing recalls. | November 9, 2000 | September 23, 2003 |

10. In addition to its federally registered marks, Petitioner possesses valuable common law rights in additional marks adopted by Petitioner including the following marks: ECO CARE used in connection with personal hygiene systems used in food and beverage processing plants, ECO-CARE used in connection with a full line of laundry systems and cleaning products; ECO-STAR used in connection with hospitality laundry consulting services, training, and support services; automatic dispensing systems used to inject cleaning products into washers; and other laundry related products; ECOJET, used in connection with, among other things, a system and software used to dispense laundry liquids into washers and monitor the wash process; ECODAPTER for water filter retrofits; ECOCENTER for a ware-washing

detergent and rinse additive dispenser; and ECO2000 used in connection with a cockroach elimination program and related products. In addition, since at least as early as 1985, Petitioner has used the mark ECOLINK for customer information and support services in the field of providing cleaning preparations and equipment. Since at least as early as January 1995, Petitioner has used the mark ECO-CLEAN for, among other things, a line of cleaning products, including laundry detergents and dispensing systems, for use in the institutional and hospitality industries. Since at least as early as 1998, Petitioner has used the mark 1-877-ECOWASH for telephone sale services in the field of cleaning preparations.

11. Petitioner has expended considerable time, effort, and expense in promoting, advertising, and popularizing Petitioner's Family of ECO Marks, as well as the goods and services offered under Petitioner's Family of ECO Marks ("Petitioner's Products"), with the result that the purchasing public has come to know, rely upon, and recognize Petitioner's Family of ECO Marks as very strong indicators of the source of its goods and services and Petitioner's Products so marked. Petitioner has established valuable goodwill in Petitioner's Family of ECO Marks.

12. On information and belief, Petitioner's Products and Respondent's Products are overlapping, closely related, and in some cases, identical.

13. Respondent's ECOSENSE mark is confusingly similar to Petitioner's Family of ECO Marks as to be likely, when used in connection with the goods listed in U.S. Reg. No. 2,371,074 to cause confusion, or to cause mistake, or to deceive.

14. On information and belief, purchasers and prospective purchasers are likely to mistakenly believe that Respondent's Products offered under the ECOSENSE mark are sponsored, endorsed, or approved by Petitioner, or are in some way affiliated, connected, or associated with

Petitioner, all to the detriment of Petitioner. Registration of Respondent's ECOSENSE mark should therefore be cancelled under 15 U.S.C. §§ 1052(d) and 1064.

15. On information and belief, the continued existence of U.S. Registration No. 2,371,074 for the mark ECOSENSE further damages Petitioner, as the registration confers upon Respondent various statutory presumptions to which it is not entitled in view of Petitioner's long prior use of Petitioner's Family of ECO Marks, and Petitioner's long prior registration and use of many of the individual marks in Petitioner's Family of ECO Marks.

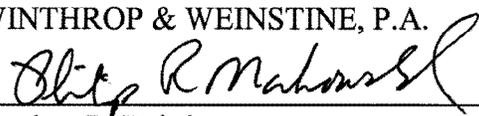
WHEREFORE, pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064, Petitioner respectfully requests that U.S. Registration No. 2,371,074 be canceled and that this Petition to Cancel be sustained.

Petitioner will be utilizing the corporate credit account of Winthrop & Weinstine, P.A. for payment of the requisite \$600 fee as required by 37 C.F.R. §§ 2.6(a)(17) and 2.104(a).

Respectfully Submitted,

Date: July 22, 2005

WINTHROP & WEINSTINE, P.A.



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