

ESTTA Tracking number: **ESTTA561148**

Filing date: **09/24/2013**

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

Proceeding	92057366
Party	Plaintiff 1047406 Ontario Ltd. and Purifics ES, Inc.
Correspondence Address	LISA H MEYERHOFF BAKER & MCKENZIE LLP 700 LOUISIANA, SUITE 3000 HOUSTON, TX 77002 UNITED STATES HouUSPTO@bakermckenzie.com, lisa.meyerhoff@bakermckenzie.com, myall.hawkins@bakermckenzie.com, tan.pham@bakermckenzie.com, ryan.hales@bakermckenzie.co
Submission	Other Motions/Papers
Filer's Name	Virginia Perry
Filer's e-mail	lisa.meyerhoff@bakermckenzie.com, millie.weiss@bakermckenzie.com, ginny.perry@bakermckenzie.com , myall.hawkins@bakermckenzie.com
Signature	/s/ Lisa H. Meyerhoff
Date	09/24/2013
Attachments	Opposition_to_Motion_to_Stay.pdf(19632 bytes)

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

1047406 Ontario Ltd. and)	
Purifics ES, Inc.,)	
)	
Petitioners)	Cancellation No. 92,057,366
)	
v.)	
)	
UVCleaning Systems, Inc., d/b/a Puralytics)	
Corporation,)	
)	
Registrant.)	

PETITIONERS' OPPOSITION TO REGISTRANT'S MOTION TO STAY

Petitioners 1047406 Ontario Ltd. ("Ontario Ltd.") and its wholly-owned subsidiary, Purifics ES, Inc. ("Purifics") (collectively, "Petitioners") oppose Registrant's Motion to Stay. The Board should deny the Motion in view of (1) Registrant's ever-changing positions; and (2) the delay and associated prejudice that will result if this cancellation proceeding is stayed pending the outcome in the opposition proceeding.

I.

INTRODUCTION AND PROCEDURAL HISTORY

To appropriately understand the context of Registrant's motion to stay the cancellation proceeding, the Board should also consider what has transpired in the opposition proceeding. This cancellation proceeding and the opposition proceeding (Opposition No. 91/194,706) are pending before the Board. Petitioners filed their Notice of Opposition on April 30, 2010. During the subsequent 3½ years, Puralytics has filed numerous requests for extensions of time. The parties have filed all of their briefs in the opposition, and Puralytics (as applicant) has requested an oral hearing. As of this date, no oral hearing has occurred or even been scheduled, which will postpone a determination by the Board to the indefinite future.

II.

ARGUMENT

A. Registrant's Mixed Message Regarding the Parallel Proceedings

Registrant seeks to tie this cancellation proceeding with the parallel opposition proceeding only when convenient.

1. Registrant treats the two proceedings separately.

After years of litigating the opposition proceeding, Registrant failed to (1) disclose the surreptitiously-filed application (that is the subject of the cancellation) in response to Petitioners' specific document requests seeking that information; and/or (2) even supplement its discovery responses with that material information. Registrant contended that the latest application (now registration) had little connection with its first application (which is the subject of the opposition proceeding). *See* Petitioners' Petition for Cancellation. Registrant has not stated why it surreptitiously filed a narrower application in the same broad class of goods (water purification) during the opposition proceeding. However, it can be surmised that the opposition proceeding was not going well for Puralytics, and it sought an end-run around being bound to its first application.

2. Registrant now argues that the two proceedings are one.

Regarding the same registration that was not even worthy of disclosure to Petitioners in the opposition proceeding, Registrant now declares that the opposition and cancellation proceedings are inextricably tied and "will moot this Cancellation." Moreover, Registrant declares as a certainty that the Board will rule "in favor of Registrant", "when Registrant wins the Opposition", and that the "Board is likely to rule in favor of Registrant." Noticeably absent from Registrant's discussion is even an acknowledgement of an adverse ruling in the hotly-contested, multi-year opposition. Moreover, since Registrant's arguments change depending on

the day, it can be presumed that Registrant will distance itself from the expected adverse ruling and declare that the opposition is not dispositive of the cancellation.

In the interim, however, as discussed below, Petitioners will not be allowed to protect their interests by advancing the cancellation, which will certainly and predictably prejudice Petitioners.

B. Petitioners will be prejudiced by further delay.

1. Registrant acknowledges 500 days of delay, which it now seeks to repeat.

As a professional courtesy, Petitioners acceded to Registrant's unprecedented requests for extension after extension in the opposition. Those requests have delayed a ruling in the opposition for a period of years. Petitioners, therefore, vigorously object to Registrant's latest request to follow the same 500 day delay track in the cancellation proceeding.

As an initial matter, Registrant states that there will not be any harm to the Board or the parties by the proposed stay, and a stay will allow the Board to "conserve its own resources." Harm to the Board is at best a straw argument, as the parties at this stage in the cancellation will be developing the case with little involvement by the Board for many months.

2. Registrant will not curtail its use of Petitioners' mark during a stay.

What is striking in Registrant's Motion is the one-sidedness of staying the cancellation proceeding. Registrant would continue to offer and sell its water purification goods and services without restriction, using a confusingly similar mark to Petitioners' registered mark, through the same trade channels, with overlapping customers, and the same commercial impressions. In essence, through its Motion, Registrant seeks to continue doing business as usual, while effectively benching Petitioners for an indefinite period of time until the opposition proceeding has been resolved. Without the ability to timely pursue their cancellation proceeding, Petitioners

are left with no ability to develop that case until sometime in 2014 at the earliest, and possibly 2015.

Moreover, it is a foregone conclusion that Registrant would use the proposed stay in two manners: (1) to prevent Petitioners from advancing their cancellation; and (2) to argue later that its goods and services have been sold side by side with Petitioners' goods and services without any damage to Petitioners (when the Petitioners were foreclosed from obtaining an earlier resolution from the Board in the opposition proceeding). In essence, the stay would first be used as a shield, then later as a sword, while Petitioners would continue to be damaged.

The Board may deny a motion to suspend where suspending would “unreasonably delay resolution of the ... proceedings and is therefore inappropriate.” *Norac, Inc. v. Elements Specialties Inc.*, 2003 TTAB LEXIS 585 (T.T.A.B. Dec. 12, 2003). Like this case, the *Norac* case involved two proceedings at different stages. The applicant sought to delay the first-filed proceeding until the later-filed application was examined, published and opposed. The Board rejected that argument, finding the proposed stay inappropriate because it would unreasonably delay the first proceeding. Similarly, a stay of the cancellation proceeding here until a ruling on the opposition sometime in 2014 or 2015 would be inappropriate, and unreasonably delay and prejudice Petitioners' rights.

Petitioners therefore respectfully request that the Board deny Registrant's Motion to Stay the Cancellation Proceeding.

Dated: September 24, 2013

Respectfully submitted,

/s/ Lisa H. Meyerhoff

Lisa H. Meyerhoff

Registration No. 36,869

Email: lisa.meyerhoff@bakermckenzie.com

Myall S. Hawkins

Registration No. 50,231

Email: myall.hawkins@bakermckenzie.com

Tan Pham

Registration No. 66,079

Email: tan.pham@bakermckenzie.com

William R. Hales

Registration No. 67,970

Email: ryan.hales@bakermckenzie.com

BAKER & MCKENZIE LLP

700 Louisiana, Suite 3000

Houston, Texas 77002

Telephone: (713) 427-5000

Facsimile: (713) 427-5099

ATTORNEYS FOR PETITIONERS

1047406 ONTARIO LTD. AND

PURIFICS ES, INC.

CERTIFICATE OF SERVICE

I hereby certify that on September 24, 2013 a copy of the attached "Petitioners' Opposition to Registrant's Motion to Stay" was served via U.S. Mail, First Class, postage prepaid, on Registrant's counsel of record as follows:

Salumeh R. Loesch

Email: salumeh.loesch@klarquist.com

Klarquist Sparkman, LLP

One World Trade Center, Suite 1600

121 SW Salmon Street

Portland, Oregon 97204

/s/ Lisa H. Meyerhoff

Lisa H. Meyerhoff