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

Proceeding	92059733
Party	Defendant Meth Lab Cleanup LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,662,396
Registered: August 4, 2009
For Mark: METH LAB CLEANUP LLC

-----X	:	
BIO CLEAN, INC.,	:	
	:	
Petitioner,	:	Cancellation No. 92059733
	:	
METH LAB CLEANUP, LLC,	:	
	:	
Registrant.	:	
-----X	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

REGISTRANT’S REQUEST FOR SHOW CAUSE ORDER

Pursuant to the Trademark Trial and Appeal Board Manual of Procedure 510.02(b), Registrant Meth Lab Cleanup, LLC (“Registrant”) hereby requests that the Board issue a show cause order as to why judgment on the identified issues should not be entered in favor of the Registrant as a result of the disposition of the civil action, styled *Meth Lab Cleanup, LLC v. Bio Clean, Inc.*, C14-1259RAJ, U.S. District Court, Western District of Washington at Seattle in favor of Registrant and against Petitioner Bio Clean, Inc. (“Petitioner”). On December 15, 2015, the District Court entered an Order granting Registrant’s Motion for Partial Summary Judgment, a copy of which is attached hereto as Exhibit A. Pursuant to the District Court’s Order, judgment was granted in favor of Registrant and against Petitioner as to Petitioner’s claim for

“Cancellation and Declaration of Invalidity” of Registrant’s federal trademark registrations. (*See* Exhibit A, ¶ IV(b)(i)) (*See also* Exhibit A, ¶ V(2)(c)).

Accordingly, pursuant to TBMP 510.02(b), Registrant requests that the Board issue a show cause order as to why judgment on the identified issues should not be entered in favor of the Registrant.

Dated: February 15, 2016.

Respectfully submitted,

/s/ Mark F. Warzecha

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of Registrant’s Request was served upon Petitioner’s counsel, Robert R. Waters by electronic mail to:

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/s/ Mark F. Warzecha

Mark F. Warzecha, Esq.

Exhibit A

HONORABLE RICHARD A. JONES

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

METH LAB CLEANUP, LLC,

Plaintiff,

v.

BIO CLEAN, INC., et al.,

Defendants.

CASE NO. C14-1259RAJ

ORDER

I. INTRODUCTION

This matter comes before the Court on consideration of Plaintiff Meth Lab Cleanup, LLC's ("Plaintiff" or "MLC") Motion for Discovery Sanctions (Dkt. # 38) and Motion for Partial Summary Judgment (Dkt. # 42). Defendants Bio Clean, Inc. ("Bio Clean") and Theresa Borst (collectively, "Defendants") did not file an opposition to the Motion for Discovery Sanctions, but did file an opposition to Plaintiff's Motion for Partial Summary Judgment. *See* Dkt. # 47. Although Defendants request oral argument, the Court does not find oral argument necessary for disposition of this matter.

II. BACKGROUND

Plaintiff has sued Defendants for violations of the federal Lanham Act and Washington unfair competition and trademark law. *See* Compl. ¶¶ 49-72.

Plaintiff dispatches and trains contractors nationwide to clean properties that have been used to manufacture or traffic in illegal drugs. *See* Dkt. # 43 (Mazzuca Decl.) ¶¶ 3-4. It also provides training for contractors who wish to engage in similar services. *Id.* ¶¶

1 5-6. Plaintiff also operates in Washington, and is recognized, approved, and certified by
2 the Washington Department of Health in the field of clandestine drug lab testing and
3 decontamination services. *See id.* ¶¶ 7-9.

4 In connection with its training, evaluation, and consulting services, Plaintiff
5 obtained federal trademark registrations for both “Meth Lab Cleanup” and “Meth Lab
6 Cleanup LLC”. *See* Compl. ¶ 12, Ex. A; *see also* Dkt. # 43 (Mazzuca Decl.) ¶¶ 29-30.¹

7 Defendant Bio Clean, Inc. (“Bio Clean”) is a Washington corporation who
8 provides a host of cleanup services in Washington. *See* Compl. ¶¶ 27-32; Dkt. # 43
9 (Mazzuca Decl.) ¶ 11. Ms. Borst is Bio Clean’s sole owner, principal, and moving force.
10 *See* Dkt. # 43 (Mazzuca Decl.) ¶ 12; Dkt. # 48 (Borst Decl.) ¶¶ 1, 6. Among those
11 services is the cleanup of properties that have been used to manufacture or traffic in
12 illegal drugs. *See* Dkt. # 43 (Mazzuca Decl.) ¶ 13; Dkt. # 48 (Borst Decl.) ¶ 2. Bio Clean
13 (including at least four of its employees) attended MLC trainings in March 2009. *See id.*
14 ¶¶ 14-15; *see also* Dkt. # 1-4 (Compl.) Ex. D. Although it had not previously done so,
15 beginning in June 2013, Bio Clean began advertising its drug cleanup services using a tab
16 on its website entitled “METH LAB CLEANUP.” *See* Dkt. # 43 (Mazzuca Decl.) ¶ 16,
17 Ex. A. It also uses a “meth lab cleanup” metatag (among others) to identify its website to
18 internet search engines. *Id.* ¶¶ 17-22, Ex. B. It has continued that conduct despite the
19 receipt of cease-and-desist letters from MLC in July 2013 and February 2014. *See id.* ¶¶
20 17, 24; Dkt. # 1-5 (Compl.) Ex. E.

21 Not to be deterred, Bio Clean has also brought several counterclaims against
22 Plaintiff for, generally, cancellation of Plaintiff’s trademark registrations and for
23 violations of the Lanham Act. *See* Dkt. # 17 (Countercl.) ¶¶ 117-141. These
24 counterclaims are largely premised on a theory that Plaintiff or its principals made certain

25 ¹ Three trademark registrations, Reg. Nos. 3,662,396, 3,662,398, and 3,662,399, were registered
26 in August 2009 and cover the mark “METH LAB CLEANUP LLC” (the “2009 Registrations”).
27 *See* Dkt. # 1-1 (Compl.) Ex. A at 2-4. The other three, Reg. Nos. 4,278,724, 4,288,270, and
28 4,288,271, were registered in January and February 2013 and cover the mark “METH LAB
CLEANUP” (the “2013 Registrations”). *Id.* at 5-7.

1 false representations to the United States Patent and Trademark Office when it applied
2 for those trademark registrations. *Id.* ¶¶ 13-93, 106-116.

3 III. LEGAL STANDARD

4 a. Motion for Discovery Sanctions and for Contempt

5 The Court has broad discretion to control discovery. *Avila v. Willits Env'tl.*
6 *Remediation Trust*, 633 F.3d 828, 833 (9th Cir. 2011). That discretion is guided by
7 several principles. Most importantly, the scope of discovery is broad. A party must
8 respond to any discovery request that is not privileged and that is “reasonably calculated
9 to lead to the discovery of admissible evidence.” Fed. R. Civ. P. 26(b)(1). The Court,
10 however, must limit discovery where it can be obtained from some other source that is
11 more convenient, less burdensome, or less expensive, or where its “burden or expense . . .
12 outweighs its likely benefit, considering the needs of the case, the amount in controversy,
13 the parties’ resources, the importance of the issues at stake in the action, and the
14 importance of the discovery in resolving these issues.” Fed. R. Civ. P. 26(b)(2)(C)(i),
15 (iii).

16 In contrast, a party requesting that a court hold another party in contempt must
17 prove by clear and convincing evidence that the alleged contemnor violated a specific
18 order of the court. *FTC v. Affordable Media, LLC*, 179 F.3d 1228, 1239 (9th Cir. 1999).
19 If the party succeeds, the burden shifts to the alleged contemnor to demonstrate that it
20 substantially complied with the order, or complied with a good faith and reasonable
21 interpretation of the order, or was unable to comply with the order. *Id.*; *Go-Video, Inc. v.*
22 *Motion Picture Ass’n of Am. (In re Dual-Deck Video Cassette Recorder Antitrust Litig.)*,
23 10 F.3d 693, 695 (9th Cir. 1993).

24 b. Motion for Partial Summary Judgment

25 Summary judgment is appropriate if there is no genuine dispute as to any material
26 fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P.
27 56(a). The moving party bears the initial burden of demonstrating the absence of a

1 genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986).
2 Where the moving party will have the burden of proof at trial, it must affirmatively
3 demonstrate that no reasonable trier of fact could find other than for the moving party.
4 *Soremekun v. Thrifty Payless, Inc.*, 509 F.3d 978, 984 (9th Cir. 2007). On an issue where
5 the nonmoving party will bear the burden of proof at trial, the moving party can prevail
6 merely by pointing out to the district court that there is an absence of evidence to support
7 the non-moving party's case. *Celotex Corp.*, 477 U.S. at 325. If the moving party meets
8 the initial burden, the opposing party must set forth specific facts showing that there is a
9 genuine issue of fact for trial in order to defeat the motion. *Anderson v. Liberty Lobby,*
10 *Inc.*, 477 U.S. 242, 250 (1986). The court must view the evidence in the light most
11 favorable to the nonmoving party and draw all reasonable inferences in that party's favor.
12 *Reeves v. Sanderson Plumbing Prods.*, 530 U.S. 133, 150-51 (2000).

13 IV. ANALYSIS

14 a. Motion for Discovery Sanctions

15 Plaintiff filed this motion in the wake of the Court's previous Order granting two
16 of Plaintiff's discovery motions. *See* Dkt. # 37. The basis for this motion – as with
17 Plaintiff's previous discovery motions – is Defendants' failure to comply with routine
18 discovery timelines. *See* Dkt. # 38 at 2. In truth, this motion is closer to a motion for
19 contempt for Defendants' failure to comply with the Court's prior order requiring
20 Defendants to supplement their discovery responses by September 7, 2015. *See* Dkt. #
21 37. Just as with Plaintiff's previous discovery motions, Defendants failed to file an
22 opposition. In fact, Defendants' apparent unwillingness to actually defend this action by
23 responding to Plaintiff's motion practice caused this Court to issue an Order to Show
24 Cause. *See* Dkt. # 45.

25 This kind of behavior by Defendants and their counsel is unacceptable. This Court
26 "depend[s] on effective advocacy" in performing its duties. *See Singleton v. Wulff*, 428
27 U.S. 106, 114 (1976). Defendants' (or their counsel's) failure to comply with their

1 discovery obligations and Court deadlines is not effective advocacy. This Court’s local
2 rules dictate that parties that oppose motions “*shall*, within the time prescribed in LCR
3 7(d), file with the clerk . . . a brief in opposition to the motion.” *See* Local Rules W.D.
4 Wash. LCR 7(b)(2) (emphasis added). The Washington Rules of Professional
5 Responsibility dictate that “[a] lawyer shall act with reasonable diligence and promptness
6 in representing a client.” Wash. RPC Rule 1.3; Local Rules W.D. Wash. LCR 83.3(a)(2).
7 And lawyers are required to “make reasonable efforts to expedite litigation consistent
8 with the interests of the client.” Wash. RPC Rule 3.2. These ethical rules may be
9 violated when attorneys fail to file responses to motions or to otherwise comply with
10 Court deadlines. *See In re Disciplinary Proceeding Against Cohen*, 67 P.3d 1086, 1091-
11 92 (Wash. 2003); *see also In re Disciplinary Proceeding Against Lopez*, 106 P.3d 221,
12 227-28 (Wash. 2005).

13 Happily, perhaps, Defendants ultimately did comply (at least marginally) with
14 their discovery obligations. They served, as best as this Court can tell, responses to
15 Plaintiff’s discovery on September 25, 2015 (*see* Dkt. # 41-1 (Marshall Decl.) ¶ 8; Dkt. #
16 46) – over two weeks after the Court deadline and four days after the discovery cutoff in
17 this case (*see* Dkt. # 30). This certainly amounts to a violation of the Court’s prior Order
18 and likely prejudiced Plaintiff’s ability to seek further discovery – but possibly does not
19 rise to the level of an outright violation of the ethical rules. The Court need not decide
20 these issues at this time as Defendants’ failure to respond to Plaintiff’s motion is an
21 admission that Plaintiff’s motion has merit. *See* Local Rules W.D. Wash. LCR 7(b)(2).
22 Suffice it to say that the Court does not look kindly on Defendants’ brazen failures to
23 comply with the rules and will not tolerate further malfeasance.

24 Accordingly, the Court **GRANTS** Plaintiff’s Motion for Discovery Sanctions and
25 **AWARDS** Plaintiff its reasonable attorneys’ fees of \$1,180 incurred in connection with
26 this motion. Defendants or their counsel are **HEREBY ORDERED** to pay Plaintiff this
27

1 amount by **December 18, 2015** or risk further sanctions from this Court. Defendants are
2 to file proof of their payment by the same deadline.

3 b. Motion for Partial Summary Judgment

4 Plaintiff has also filed a Motion for Partial Summary Judgment, seeking summary
5 judgment on every claim and counterclaim except for Bio Clean's seventh counterclaim
6 for false advertising. *See* Dkt. # 42 at 1. Somewhat surprisingly, Defendants have filed
7 an opposition to this motion. *See* Dkt. # 47.

8 i. *Bio Clean's Counterclaims for Trademark Cancellation*

9 Before the Court determines whether summary judgment is warranted for
10 Plaintiff's trademark infringement claims, it will determine whether summary judgment
11 should be granted on Bio Clean's counterclaims for trademark cancellation. The basis for
12 Bio Clean's counterclaims is that Plaintiff or its agents made fraudulent
13 misrepresentations in its applications for its 2009 and 2013 Registrations, although Bio
14 Clean also appears to allege that the marks are generic.

15 "Under 15 U.S.C. § 1119, the Court may cancel a federal registration of a
16 trademark." *Moroccanoil, Inc. v. Marc Anthony Cosmetics, Inc.*, 57 F. Supp. 3d 1203,
17 1230 (C.D. Cal. 2014); *see also Hokto Kinoko Co. v. Concord Farms, Inc.*, 738 F.3d
18 1085, 1097 (9th Cir. 2013). One of the grounds for seeking cancellation is that the
19 registration was obtained fraudulently. *See id.* (citing 15 U.S.C. § 1064(3)); *see also Spin*
20 *Master, Ltd. v. Zobmondo Entm't, LLC*, 778 F. Supp. 2d 1052, 1061 (C.D. Cal. 2011).

21 In order to succeed on a claim of trademark cancellation for fraud, a party must
22 show: "(1) a false representation regarding a material fact; (2) the registrant's knowledge
23 or belief that the representation is false; (3) the registrant's intent to induce reliance upon
24 the misrepresentation; (4) actual, reasonable reliance on the misrepresentation; and (5)
25 damages proximately caused by that reliance." *Hokto Kinoko Co.*, 738 F.3d at 1097
26 (citing *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1444 (9th Cir. 1990)); *see also* 6, J.
27 Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:61 (4th ed.

1 2015). “Because a charge of fraud in the procurement of a trademark registration is a
2 disfavored defense, the party alleging fraud bears a ‘heavy’ burden of proof.” *eCash*
3 *Techs., Inc. v. Guagliardo*, 127 F. Supp. 2d 1069, 1079 (C.D. Cal. 2000) (citing *Robi*,
4 918 F.2d at 1444) (footnote omitted).

5 Plaintiff argues that Bio Clean cannot show a genuine issue of material fact that
6 Plaintiff had knowledge that a representation it made to the USPTO was false. *See* Dkt. #
7 42 at 12 (listing incorrect elements for claim of trademark cancellation for fraud).
8 Plaintiff contends, based on Julie Mazzuca’s² declaration, that when Plaintiff applied for
9 its trademark registrations, she believed (and still believes) that Plaintiff had made
10 “continuous exclusive use” of the marks “METH LAB CLEANUP LLC” and “METH
11 LAB CLEANUP”. *See* Dkt. # 43 (Mazzuca Decl.) ¶¶ 28-30. This is sufficient to create
12 an absence of a genuine issue for trial.

13 Bio Clean contends, however, that a genuine issue of material fact exists.

14 First, Bio Clean argues that two statements Plaintiff made to the USPTO were
15 false. Specifically, when the examining attorney initially refused registrations for the
16 2009 Registrations on the grounds that the proposed marks were merely descriptive (*see*
17 Dkt. # 49-3 (Waters Decl.) Ex. 3), Plaintiff subsequently filed requests for
18 reconsideration of the United States Patent and Trademark Office’s (“USPTO”) action
19 dated October 30, 2008 (*see* Dkt. # 49-4 (Waters Decl.) Ex. 4). The signatory of those
20 requests, Xavier Morales,³ indicated that the applications were being amended based on
21 Plaintiff’s “substantially exclusive and continuous use [of the mark] in commerce for at
22 least the five years immediately before the date of this statement.” *Id.* at 3. The
23 USPTO’s examining attorney also refused Plaintiff’s applications for the 2013
24 Registrations, again on the grounds that the proposed marks were merely descriptive. *See*

25 _____
26 ² Ms. Mazzuca is Plaintiff’s “majority owner” and manager. Dkt. # 43 (Mazzuca Decl.) ¶ 1.

27 ³ Bio Clean (as well as Plaintiff, puzzling enough) suggest that Ms. Mazzuca made this statement
28 to the USPTO. That is not entirely correct. Mr. Morales made this statement, though perhaps at
the direction of Plaintiff.

1 Dkt. # 49-6 (Waters Decl.) Ex. 6. In connection with Plaintiff's requests for
2 reconsideration for these trademark applications, Ms. Mazzuca declared on August 31,
3 2012 that Plaintiff use of the "METH LAB CLEANUP" mark "has been substantially
4 exclusive" "to the best of its knowledge and belief." See Dkt. # 49-6 (Waters Decl.) Ex.
5 6, ¶ 5.

6 Bio Clean argues that Plaintiff knew that its competitors used the phrase "meth lab
7 cleanup" prior to these declarations and, therefore, that a genuine issue exists that she
8 intentionally made a false representation to the USPTO. Bio Clean's argument of such
9 use is based on: (1) "evidence" of a trademark infringement lawsuit between Plaintiff and
10 an entity called Spaulding Decon (see Dkt. # 48 (Borst Decl.) ¶¶ 10; Dkt. # 49 (Waters
11 Decl.) ¶ 11), and (2) an email dated August 30, 2011 from Ms. Mazzuca to a Kirk Flippin
12 referencing "a series of phone conversations" between the two "in early 2007" addressing
13 "a potential trademark infringement matter regarding [Mr. Flippin's] registration and use
14 of the domain name (URL) www.Meth-Lab-Cleanup.net" (Dkt. # 49-5 (Waters Decl.)
15 Ex. 5 at 2).

16 The Court rejects Bio Clean's arguments for two reasons. First, it is questionable
17 as to whether Bio Clean has even shown that either of Plaintiff's statements – that the
18 Plaintiff's use of the marks had been "substantially exclusive" – was false. For one, Bio
19 Clean does not actually show that either Mr. Flippin or Spaulding Decon even used the
20 mark "METH LAB CLEANUP". Ms. Mazzuca's email merely references a discussion in
21 "early 2007" regarding Mr. Flippin's alleged registration of the domain name
22 "www.Meth-Lab-Cleanup.net". Dkt. # 49-5 (Waters Decl.) Ex. 5 at 2. But it is well
23 established that "the mere registration of a domain name does not constitute a
24 commercial use." *Panavision Int'l, L.P. v. Toepfen*, 141 F.3d 1316, 1324 (9th Cir. 1998)
25 (citing cases). Furthermore, the email also indicates that "[b]ased upon these discussions,
26 [Mr. Flippin] had agreed to not renew the site." See Dkt. # 49-5 (Waters Decl.) Ex. 5 at
27 2. In other words, at least in "early 2007," Mr. Flippin was not actually using the

1 “METH LAB CLEANUP” mark.⁴ As to Bio Clean’s vague references to litigation
2 between Plaintiff and Spaulding Decon, the only proof it offers is counsel’s declaration
3 that “[f]rom approximately 2010 through 2012,⁵ [Plaintiff] litigated with a Florida
4 Company called Spaulding Decon . . . That case was never tried to a jury but was rather
5 settled between the parties” (*see* Dkt. # 49 (Waters Decl.) ¶ 11) and Ms. Borst’s
6 declaration adds her summary of the “publicly available portions”⁶ of a purported
7 “confidential settlement agreement” in that action (*see* Dkt. # 48 (Borst Decl.) ¶ 10).
8 Simply because litigation arose in 2010, however, does not actually show that Spaulding
9 Decon was actually using the “METH LAB CLEANUP” mark.

10 Even crediting Bio Clean’s “evidence” as showing that these two entities made use
11 of the “METH LAB CLEANUP” mark, however, it is unlikely that they create a genuine
12 issue of material fact that Plaintiff’s knew its use of that mark was not “substantially
13 exclusive.” “In trademark law, ‘substantially exclusive’ use does not require absolutely
14 exclusive use on the part of the applicant,” meaning that “the mere use of a mark by a
15 third party may not be sufficient to defeat a claim of substantially exclusive use.”

16 *Alphaville Design, Inc. v. Knoll, Inc.*, 627 F. Supp. 2d 1121, 1131 (N.D. Cal. 2009)
17 (citing *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352 (Fed. Cir. 1999)). The mere
18

19 ⁴ The remainder of the email does not even suggest that Mr. Flippin was using the mark “METH
20 LAB CLEANUP” in August 2011, only mentioning that one portion of Mr. Flippin’s webpage
21 “still list[ed] and identif[ied] the domain name www.Meth-Lab-Cleanup.net as [his] own.” Dkt.
22 # 49-5 (Waters Decl.) Ex. 5 at 2. That is not enough to show use in commerce.

23 ⁵ In fact, the litigation appears to be ongoing. *See Meth Lab Cleanup, LLC v. Spaulding Decon,*
24 *LLC*, No. 8:14-CV-3129-T-30TBM, 2015 WL 4496193, at *1 (M.D. Fla. July 23, 2015).

25 ⁶ Ms. Borst’s declaration is baffling. First, her statement is clearly inadmissible under the Best
26 Evidence Rule as she attempts to testify as to the contents of the confidential settlement
27 agreement without providing an original. *See* Fed. R. Evid. 1002. Second, there is no reason
28 why Defendants could not have obtained a copy of the confidential agreement in discovery.
Clearly this document could be relevant. Any confidentiality concerns are well addressed by the
protective order entered in this case. *See* Dkt. # 36. And, most puzzlingly, Waters Law Group,
PLLC – Defendants’ counsel in this case – *also represented Spaulding Decon in the litigation*
Bio Clean alludes to. *See Meth Lab Cleanup, LLC v. Spaulding Decon, LLC*, No. 8:10-CV-
2550-T-30TGW, 2011 WL 398047, at *1 (M.D. Fla. Feb. 4, 2011). Plaintiff, however, has
supplied a copy of the settlement agreement. *See* Dkt. # 52-2 (Marshall Decl.) Ex. B.

1 fact that Plaintiff knew that two entities made (apparently junior and infringing) use of
2 the marks does not make Plaintiff's claims of substantially exclusive use false. *See also*
3 *Salu, Inc. v. Original Skin Store*, No. CIVS-08-1035FCD/KJM, 2010 WL 1444617, at *4
4 (E.D. Cal. Apr. 12, 2010) (denying summary judgment on trademark cancellation claim,
5 finding that plaintiff's contact with third party regarding alleged infringement of
6 trademark prior to trademark application was insufficient to show intent to deceive the
7 USPTO in claiming five years of "substantially exclusive" use).

8 Furthermore, "there are limits on what a trademark applicant must disclose to the
9 PTO." *AirWare Int'l Ltd. v. Schultz*, 84 F. Supp. 3d 943, 952 (N.D. Cal. 2015). As
10 numerous courts have explained, "an applicant is not 'obligate[d] ... to investigate and
11 report all other possible users of an identical or confusingly similar mark.'" *Id.* (quoting
12 *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 1266 (Fed. Cir. 1983)).
13 Instead, "an applicant must only disclose 'conflicting rights' of another user 'which are
14 clearly established, for example, by a court decree, by the terms of a settlement
15 agreement, or by a registration.'" *Id.* (quoting *Rosso*, 720 F.2d at 1266). "Second, the
16 statement of an applicant that no other person to the best of his knowledge has the right to
17 use the mark does not require the applicant to disclose those persons whom he may have
18 heard are using the mark *if he feels that the rights of such others are not superior to his.*"
19 *Id.* (quoting *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 755 (9th Cir. 2006)) (internal
20 quotation marks omitted).

21 Clearly, by claiming that both Mr. Flippin and Spaulding Decon were infringing
22 on the METH LAB CLEANUP marks, Plaintiff necessarily must have thought that its
23 rights were superior. If Plaintiff in good faith believed itself to be the superior right
24 holder – and all the evidence indicates as much – Bio Clean clearly cannot establish its
25 fraud in the procurement claims. *See AirWair*, 84 F. Supp. 3d at 953; *Gibson Brands,*
26 *Inc. v. John Hornby Skewes & Co.*, No. CV 14-00609 DDP SSX, 2014 WL 5419512, at
27 *5 (C.D. Cal. Oct. 23, 2014) (granting motion to strike counterclaim and affirmative

1 defense based on fraud on the USPTO where defendant did not allege that other users had
2 a superior right to the mark); *Unique Sports Prods, Inc. v. Babolat VS*, 403 F. Supp. 2d
3 1229, 1240 (N.D. Ga. 2005) (granting summary judgment in favor of plaintiff on
4 defendants' cancellation claim where only evidence offered was response to cease and
5 desist letter suggesting that two entities allegedly sold similarly infringing product).

6 Alternatively, but not entirely clear from its brief, Bio Clean also contends that
7 Plaintiff does not have a valid trademark because the mark "METH LAB CLEANUP" is
8 generic. *See* Dkt. # 47 at 10-11 (alluding to argument that the phrase "meth lab cleanup"
9 is a generic identifier of the service provided too generic to "ever be a legal trademark").
10 To be sure, trademarks that are found to be generic are subject to cancellation at any time.
11 *See* 15 U.S.C. § 1064(3); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194
12 (1985).

13 The problem with Bio Clean's argument is that Plaintiff's trademarks are federally
14 registered. "In general, when a plaintiff pursues a trademark action involving a properly
15 registered mark, that mark is presumed valid, and the burden of proving that the mark is
16 generic rests upon the defendant." *See Krav Maga Ass'n of Am., Inc. v. Yanilov*, 464 F.
17 Supp. 2d 981, 985 (C.D. Cal. 2006) (citing *Yellow Cab Co. of Sacramento v. Yellow Cab*
18 *of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005). "The general presumption of
19 validity resulting from federal registration includes the specific presumption that the
20 trademark is not generic." *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*,
21 408 F.3d 596, 604 (9th Cir. 2005) (quoting *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d
22 1250, 1254 (9th Cir. 1982)) (granting summary adjudication for trademark holder for
23 "micro colors" due to appellant's failure to provide evidence to overcome presumption of
24 trademark validity).

25 In order to overcome the presumption, Bio Clean must offer actual evidence that
26 the term "meth lab cleanup" "was used or understood by consumers as a generic term
27 rather than a brand name." *Id.* at 606. This could be done by presenting the following:

1 “(1) generic use by competitors of the mark that has not been contested by the owner of
2 the mark; (2) generic use of the trademark by the proponent of the trademark; (3)
3 dictionary definitions to determine public usage; (4) generic usage in the media of the
4 trademark, such as in trade journals and newspapers; (5) testimony of persons in the
5 trade; and (6) consumer surveys.” *Calista Enters. Ltd. v. Tenza Trading Ltd.*, 43 F. Supp.
6 3d 1099, 1116 (D. Or. 2014) (citing *McCarthy on Trademarks* §12:13; *Filipino Yellow*
7 *Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1150 (9th Cir. 1999)); *see*
8 *also CG Roxane LLC v. Fiji Water Co. LLC*, 569 F. Supp. 2d 1019, 1027-28 (N.D. Cal.
9 2008) (finding term generic where defendant offered evidence of competitors’ use of the
10 mark).

11 But Bio Clean does no such thing. Bio Clean offers no evidence (and hardly any
12 argument) on the issue, apparently is content to stand pat because “we are only at the
13 summary judgment stage.” *See* Dkt. # 47 at 11. That is not enough to create a genuine
14 issue of material fact on an issue in which Bio Clean bears a heavy burden of proof.

15 Because Bio Clean has not presented any evidence creating a genuine issue of
16 material fact, the Court **GRANTS** Plaintiff’s Motion as to Bio Clean’s counterclaims for
17 cancellation of Plaintiff’s trademark registrations.

18 ii. *Plaintiff’s Claims for Trademark Infringement*

19 Plaintiff also moves for summary judgment on its claims for trademark
20 infringement under 15 U.S.C. §§ 1114, unfair competition under 15 U.S.C. § 1125(a),
21 and for Washington common law unfair competition.

22 “The elements necessary to establish trademark infringement and unfair
23 competition claims are identical.” *eAcceleration Corp. v. Trend Micro, Inc.*, 408 F.
24 Supp. 2d 1110, 1114 (W.D. Wash. 2006) (citing *Brookfield Commc’ns, Inc. v. W. Coast*
25 *Entm’t Corp.*, 174 F.3d 1036, 1046 n.6, 1047 n.8 (9th Cir. 1999)); *Safeworks, LLC v.*
26 *Teupen Am., LLC*, 717 F. Supp. 2d 1181, 1192 (W.D. Wash. 2010). “Federal trademark
27 infringement claims under § 32 of the Lanham Act apply to registered marks, while

1 unfair competition claims under § 43(a) of the Lanham Act apply to both registered and
2 unregistered marks and protect against a wider range of practices.” *Id.* “In both cases,
3 the plaintiff must ‘prove [1] the existence of a trademark and [2] the subsequent use by
4 another in a manner likely to create consumer confusion.’” *Id.* (quoting *Comedy III*
5 *Prod., Inc. v. New Line Cinema*, 200 F.3d 593, 594 (9th Cir. 2000)); *see also Kythera*
6 *Biopharmaceuticals, Inc. v. Lithera, Inc.*, 998 F. Supp. 2d 890, 898-99 (C.D. Cal. 2014)
7 (holding that “plaintiff must show: (1) that it has a valid, protectable trademark, and (2)
8 that defendant's use of the mark is likely to cause confusion”).

9 First, Plaintiff has established that it has six valid, protectable trademark
10 registrations. Plaintiff has presented both the 2009 and 2013 Registrations to this Court.
11 *See* Dkt. # 1-1 (Compl.) Ex. A. And “[r]egistration of a mark ‘on the Principal Register
12 in the Patent and Trademark Office constitutes prima facie evidence of the validity of the
13 registered mark and of [the registrant's] exclusive right to use the mark on the goods and
14 services, specified in the registration.” *Applied Info. Scis. Corp. v. eBay, Inc.*, 511 F.3d
15 966, 970 (9th Cir. 2007) (quoting *Brookfield Commc’ns*, 174 F.3d at 1047). Clearly,
16 Plaintiff has established that it has had a valid, protectable interest in the mark “METH
17 LAB CLEANUP LLC” 2009 and “METH LAB CLEANUP” in 2013.

18 Defendants have not presented any evidence to rebut this element. Nevertheless,
19 as explained, *supra*, they have vaguely alluded to an argument that Plaintiff’s trademarks
20 are invalid for because they are generic. Again, because Defendants have not offered any
21 evidence on this issue, they do not raise the existence of genuine issue of material fact.

22 Second, Plaintiff has presented evidence that from June 2013 to the present, Bio
23 Clean has used the words “Meth Lab Cleanup” on its website, www.biocleanwa.com to
24 promote its clandestine drug lab decontamination services. *See* Dkt. # 43 (Mazzuca
25 Decl.) ¶¶ 16-17, Exs. A at 4 & B at 1-3; *see also* Dkt. # 1-5 (Compl.) Ex. E. Plaintiff has
26 also presented evidence that Bio Clean has used the term “Meth Lab Cleanup” as a
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1 “metatag” on its website. *See* Dkt. # 43-2 (Mazzuca Decl.) Ex. B at 4-5; Dkt. # 1-5
2 (Compl.) Ex. E.

3 The question, then, is whether Bio Clean’s use of the “METH LAB CLEANUP”
4 mark is likely to cause confusion. Courts in the Ninth Circuit have traditionally applied
5 the eight factors set forth in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir.1979) to
6 determine whether a defendant's use of a mark or name creates a likelihood of confusion.
7 *See Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1199 (9th Cir. 2012).
8 Those factors are: (1) the strength of the mark; (2) the proximity of the goods; (3) the
9 similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used;
10 (6) type of goods and the degree of care likely to be exercised by the purchaser; (7)
11 defendant's intent in selecting its mark; and (8) likelihood of expansion into other
12 markets. *Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 507 (9th Cir. 2011) (citing *Sleekcraft*,
13 599 F.2d at 348).

14 Plaintiff has not offered a significant amount of evidence on these points.
15 Nevertheless, Plaintiff has at least shown that the services offered by Plaintiff and Bio
16 Clean are substantially identical. *See* Dkt. # 43 (Mazzuca Decl.) ¶¶ 3-10, 13-15. For
17 instance, both Plaintiff and Bio Clean are one of only eight companies that have been
18 certified to provide clandestine drug lab testing and decontamination services. *See id.* ¶¶
19 9, 14. In fact, their services are apparently so similar that Bio Clean sent some of its
20 employees to Plaintiff’s certification courses. *See id.* ¶ 14; Dkt. # 1-4 (Compl.) Ex. D.
21 Additionally, although Plaintiff has presented limited evidence on this point, because
22 Plaintiff and Bio Clean offer identical services and because of the limited number of
23 purveyors of the service in Washington, it seems unlikely that purchasers would exercise
24 significant care. *See See* Dkt. # 43 (Mazzuca Decl.) ¶¶ 9, 14. Additionally, Plaintiff has
25 also shown that Bio Clean has used an identical mark – “Meth Lab Cleanup” or “meth lab
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1 cleanup” – on its website and in that website’s metatags.⁷ *See id.* ¶¶ 16-17, Exs. A at 4 &
2 B; *see also* Dkt. # 1-5 (Compl.) Ex. E. Both Plaintiff and Bio Clean also use the internet
3 as a marketing channel (*see id.* ¶¶ 6, 16-18), which has been recognized as “a factor that
4 courts have consistently recognized as exacerbating the likelihood of confusion”
5 (*Treemo, Inc. v. Flipboard, Inc.*, 53 F. Supp. 3d 1342, 1363 (W.D. Wash. 2014) (quoting
6 *Brookfield Commc’ns*, 174 F.3d at 1057)). Accordingly, the Court finds that Plaintiff has
7 presented sufficient evidence to show the absence of a genuine issue of material fact that
8 Defendants’ use of the term “Meth Lab Cleanup” is likely to cause confusion.

9 Defendants do not offer any evidence on this issue – and do not address it in their
10 brief. Consequently, they have not met their burden to show the existence of a genuine
11 issue of material fact.

12 Accordingly, the Court **GRANTS** summary judgment in favor of Plaintiff on its
13 claims for trademark infringement and unfair competition.

14 **V. CONCLUSION**

15 For the foregoing reasons, the Court **GRANTS** Plaintiff’s Motion for Discovery
16 Sanctions (Dkt. # 38) and its Motion for Partial Summary Judgment (Dkt. # 42). The
17 Court hereby **ORDERS** as follows:

- 18 1. Plaintiff’s Motion for Discovery Sanctions is **GRANTED**. Dkt. # 38. Plaintiff
19 is **AWARDED** its reasonable attorneys’ fees of \$1,180 from Defendants.
20 Defendants or their counsel are **ORDERED** to pay Plaintiff this amount by
21 **December 18, 2015** or risk further sanctions from this Court. Defendants are
22 to file proof of their payment by the same deadline.
- 23 2. Plaintiff’s Motion for Partial Summary Judgment is **GRANTED**. Dkt. # 42.

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26 ⁷ “The Ninth Circuit has recognized that use of metatags that are confusingly similar to a
27 trademark can create initial interest confusion and constitute trademark infringement.” *Suarez*
28 *Corp. Indus. V. Earthwise Techs., Inc.*, 636 F. Supp. 2d 1139, 1148 (W.D. Wash. 2008) (citing
Brookfield Commc’ns, 174 F.3d at 1065, 1045).

- 1 a. Summary judgment is granted in favor of Plaintiff on its claims for
2 federal unfair competition pursuant to 15 U.S.C. § 1125(a) (*see* Compl.
3 ¶¶ 49-56), Washington State common law unfair competition (*see*
4 Compl. ¶¶ 57-64), and for federal trademark infringement pursuant to
5 15 U.S.C. § 1114 (Compl. ¶¶ 65-72).
- 6 b. At Plaintiff’s request (*see* Dkt. # 42 at 11), the issue of damages⁸ will be
7 reserved for jury trial. The Court will also entertain Plaintiff’s request
8 for a permanent injunction at that time.
- 9 c. Summary judgment is granted in favor of Plaintiff and against Bio
10 Clean on Bio Clean’s counterclaims for “Cancellation and Declaration
11 of Invalidity” of Plaintiff’s federal trademark registrations. *See* Dkt. #
12 17 (Countercl.) ¶¶ 117-134.
- 13 d. Bio Clean’s seventh counterclaim for false advertising in violation of 15
14 U.S.C. § 1125(a) is not addressed by this Order.

15
16 DATED this 15th day of December, 2015.

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20 The Honorable Richard A. Jones
21 United States District Court

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27 ⁸ The Lanham Act makes clear that it is the Court, not the jury, that “in exceptional cases may
28 award reasonable attorney fees to the prevailing party.” *See* 15 U.S.C. § 1117(a).