

ESTTA Tracking number: **ESTTA767917**

Filing date: **08/31/2016**

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

Proceeding.	92063133
Applicant	Plaintiff TOMI Environmental Solutions, Inc.
Other Party	Defendant Astro Pak Corporation
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	Yes

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, TOMI Environmental Solutions, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

TOMI Environmental Solutions, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

TOMI Environmental Solutions, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Respectfully submitted,

/Anita B. Polott/

Anita B. Polott

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08/31/2016

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

TOMI Environmental Solutions, Inc.,

Petitioner,

v.

Astro Pak Corporation,

Respondent.

Proceeding No. 92063133

Mark: IHP

Registration No. 3,917,962

**STIPULATED MOTION TO SUSPEND PROCEEDING DUE TO PENDING
CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(A)**

Petitioner TOMI Environmental Solutions (“TOMI” or “Petitioner”) and Astro Pak Corporation (“Astro Pak” or “Registrant”) hereby move, pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), for suspension of this proceeding, which relates to Astro Pak’s registration for IHP (Reg. No. 3,917,962) for “Biological decontamination services” in Class 40 (the “Registration”).

On February 8, 2016, Petitioner filed a petition for cancellation of the Registration (the “Petition”) which was assigned Cancellation Proceeding No. 92063133 and is attached hereto as Exhibit A (“Petition”). The Petition alleges that Astro Pak’s Registration should be cancelled on the grounds that the IHP mark is generic, lacks distinctiveness, fails to function as a service mark, and constitutes an unlawful use of TOMI’s patented technology. Petition ¶¶ 11-40.

On August 8, 2016, Petitioner filed a complaint in the United States District Court for the Central District of California against Astro Pak and its wholly owned subsidiary, Six Log Corporation for patent infringement, false designation of origin, false advertising, cancellation of the Registration, and unfair competition and false advertising under California state law. A copy of Petitioner’s complaint is attached hereto as Exhibit B and referred to as Complaint.

In the Complaint, Petitioner asks the district court to find that Astro Pak's Registration is generic or, in the alternative, merely descriptive of the services in the registration because it is an ingredient, characteristic, and feature of the materials used by Astro Pak to provide its biological decontamination services and therefore cannot function as a trademark. Complaint ¶¶ 89-92. The Complaint further alleges that the designation IHP has not acquired secondary meaning signifying Astro Pak as the exclusive source of the relevant services and that Astro Pak's use of the IHP designation does not function as a service mark. *Id.* ¶¶ 93-97. Finally, Petitioner alleges that Astro Pak uses ionized hydrogen peroxide acquired from a source other than TOMI in connection with its biological decontamination services, Astro Pak's use of the ionized hydrogen peroxide would be illegal and therefore could not constitute the basis for the maintenance of the trademark registration. *Id.* ¶¶ 99-101. Based on Petitioner's foregoing allegations, Petitioner asks the district court to cancel Astro Pak's Registration.

Accordingly, the pending district court civil action encompasses issues that are involved in this opposition proceeding, including whether the IHP Registration should be cancelled. The determination of the issues in the litigation will likely have bearing on, and could be dispositive of, the issues involved in this proceeding. Petitioner therefore respectfully requests suspension of these proceedings pending resolution of the civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992) (suspending TTAB cancellation proceeding where "A decision by the district court will be dispositive of the issues before the Board.").

Date: August 31, 2016

Respectfully submitted,

/s/ Alexis Dillett Isztwan
Alexis Dillett Isztwan
Semanoff Ormsby Greenberg & Torchia LLC
2617 Huntingdon Pike

/s/ Anita B. Polott
Anita B. Polott
J. Kevin Fee
Morgan Lewis & Bockius LLP

Huntingdon Valley, PA 19006

Attorneys for Respondent.

1111 Pennsylvania Avenue NW
Washington, DC 20004

Attorneys for Petitioner.

CERTIFICATE OF SERVICE

I hereby certify that on August 31, 2016, I caused a true and complete copy of the foregoing Stipulated Motion To Suspend Proceeding Due To Pending Civil Action Pursuant To Trademark Rule 2.117(a) to be sent to has been sent via email, with consent, this 31st day of August, 2016 to:

Alexis Dillett Isztwan
Christina D. Frangiosa
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2617 Huntingdon Pike
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Email: aisztwan@sogtlaw.com
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By: /s/ Anita B. Polott
Anita B. Polott

Exhibit A

ESTTA Tracking number: **ESTTA725675**

Filing date: **02/08/2016**

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	TOMI Environmental Solutions, Inc.		
Entity	Corporation	Citizenship	Florida
Address	9454 Wilshire Boulevard Beverly Hills, CA 90212 UNITED STATES		

Attorney information	Jordana S. Rubel Morgan, Lewis & Bockius LLP 1111 Pennsylvania Avenue, NW Washington, DC 20004 UNITED STATES Jrubel@morganlewis.com, apolott@morganlewis.com, jkfee@morganlewis.com, fgordon@morganlewis.com, trademarks@morganlewis.com Phone:2027395118		
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Registration Subject to Cancellation

Registration No	3917962	Registration date	02/08/2011
Registrant	Astro Pak Corporation 270 East Baker Street Costa Mesa, CA 92626 UNITED STATES		

Goods/Services Subject to Cancellation

Class 040. First Use: 2010/01/12 First Use In Commerce: 2010/01/12 All goods and services in the class are cancelled, namely: Biological decontamination services
--

Grounds for Cancellation

The mark is or has become generic	Trademark Act section 2(e)(1), or section 23 if on Supplemental Register
The mark is merely descriptive	Trademark Act section 2(e)(1)
Failure to function as a mark	Trademark Act section 1,2 and 45
Other	Unlawful use.

Attachments	Petition to Cancel iHP registration.pdf(19819 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jordana S. Rubel/
Name	Jordana S. Rubel
Date	02/08/2016

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

TOMI ENVIRONMENTAL SOLUTIONS, INC.,

Petitioner,

v.

ASTRO PAK CORP.,

Respondent.

MARK: iHP

Registration No. 3,917,962

Cancellation No.:

PETITION FOR CANCELLATION

TOMI Environmental Solutions, Inc. (“TOMI”), a Florida corporation with its principal office at 9454 Wilshire Boulevard, Beverly Hills, CA 90212, submits this petition because it believes it is being damaged and will continue to be damaged by Registration No. 3,917,962, for the iHP designation, owned by Astro Pak Corp. (“Astro Pak” or “Respondent”). TOMI hereby petitions to cancel the registration for the iHP designation.

As grounds for the petition to cancel, TOMI alleges as follows:

Petitioner and Its Patented Technology and Products

1. TOMI is a global bacteria decontamination and infectious disease control company that provides environmentally safe solutions for decontamination of indoor surfaces.
2. TOMI owns groundbreaking technology, including, *inter alia*, a patented process that, among other things, produces an activated cleaning fluid mist comprised of activated ionized hydrogen peroxide that will neutralize biochemical contaminants, such as bacteria, viruses, toxins, and chemical agents. *See, e.g.*, United States Patent Nos. 6,969,487 and 7,008,592.

3. TOMI also owns patented technology directed, *inter alia*, to equipment that produces an activated cleaning fluid mist comprised of activated ionized hydrogen peroxide that can be used to decontaminate various locations. *See id.*

Respondent's Trademark Registration

4. On November 27, 2009, Respondent filed an intent-to-use application to register the iHP designation in connection with "biological decontamination services."

5. Respondent did not disclose in the application that the iHP designation was an acronym for "ionized hydrogen peroxide," which has a meaning in connection with the services listed in the application.

6. The term "ionized" is used in connection with hydrogen peroxide in TOMI's patents, which were owned by L-3 Communications and its subsidiary L-3 Applied Technologies, Inc. (collectively "L-3 Communications") at the time Astro Pak submitted its application.

7. L-3 Communications, and later TOMI (who acquired the patented technology from L-3 Communications), supplied Astro Pak's subsidiary, SixLog Corporation ("SixLog"), with patented equipment, materials, processes and technology that SixLog used to generate, , *inter alia*, "ionized hydrogen peroxide" for use in SixLog's biological decontamination services.

8. AstroPak and/or SixLog's ability to use the iHP designation in a manner that accurately describes the biological decontamination services they provide depends on TOMI's continued willingness to supply Astro Pak and/or SixLog with access to its patented equipment, materials, and technology.

9. On November 29, 2010, Respondent filed a Statement of Use asserting a January 12, 2010 date of first use for the iHP designation in connection with the services listed in the application.

10. To support the Statement of Use, Respondent submitted a specimen showing use of the iHP designation by SixLog, which defines iHP as “a hydrogen peroxide based technology” that is “ionized.”

11. On February 8, 2011, the Patent and Trademark Office registered Respondent’s iHP designation (Registration No. 3,917,962) (the “Registration”).

FIRST GROUND FOR CANCELLATION OF REGISTRATION
Genericness

12. TOMI incorporates by reference paragraphs 1 through 11 of this Petition for Cancellation.

13. The designation iHP is an acronym for “ionized hydrogen peroxide”.

14. The term “ionized hydrogen peroxide” refers to a mist for biological decontamination that is created using TOMI’s patented process and equipment.

15. Ionized hydrogen peroxide is the category name of a particular type of material used for biological decontamination.

16. Purchasers of Respondent’s services understand the phrase “ionized hydrogen peroxide” to refer to a type of hydrogen peroxide that is ionized, not a source.

17. “Ionized hydrogen peroxide” is not capable of distinguishing Respondent’s services pursuant to 15 U.S.C. § 1091 because it is a generic phrase.

18. The Registration should therefore be cancelled under 15 U.S.C. §§ 1091 and 1064.

SECOND GROUND FOR CANCELLATION OF REGISTRATION
Lack of Distinctiveness

19. TOMI incorporates by reference paragraphs 1 through 18 of this Petition for Cancellation.
20. The designation iHP is an acronym for “ionized hydrogen peroxide”.
21. The term “ionized hydrogen peroxide” refers to a mist for biological decontamination that is created using TOMI’s patented process and equipment.
22. If it is not generic, the phrase “ionized hydrogen peroxide” is merely descriptive of the services in the Registration because it is an ingredient, characteristic, and feature of the materials used by Respondent to provide its biological decontamination services.
23. Petitioner and other third parties have the right to use the term “ionized hydrogen peroxide” or the acronym IHP in connection with describing the mist for biological decontamination that is created using TOMI’s patented process, equipment, and materials.
24. When used on or in connection with the Respondent’s services, the designation iHP is merely descriptive of Respondent’s services and cannot function as a trademark absent a showing of secondary meaning under Section 2(f) of the Trademark Act of 1946, 15 U.S.C. § 1052(f).
25. The designation iHP has not acquired secondary meaning signifying Respondent as the exclusive source of the relevant services.
26. If Respondent is permitted to maintain the Registration, Respondent would be able to obstruct Petitioner and third parties from using the term “ionized hydrogen peroxide” or the acronym IHP descriptively.
27. The Registration should therefore be cancelled under 15 U.S.C. §§ 1052(e) and 1064.

THIRD GROUND FOR CANCELLATION OF REGISTRATION
Failure to Function as a Service Mark

28. TOMI incorporates by reference paragraphs 1 through 27 of this Petition for Cancellation.

29. The specimen Respondent submitted with its Statement of Use states that iHP is “a hydrogen peroxide based technology” and repeatedly refers to “iHP technology”. The specimen does not demonstrate use of the iHP designation as a service mark used by Respondent in connection with offering or providing biological decontamination services.

30. Respondent’s use of the iHP designation to describe the source of the technology behind ionized hydrogen peroxide is false and/or misleading because ionized hydrogen peroxide technology includes a patented process and patented equipment and materials owned by TOMI.

31. Upon information and belief, at the time Respondent submitted its Statement of Use, Respondent used the iHP designation solely as the name of a method, process, system or technology for decontamination, not as a source identifier for the provision of biological decontamination services.

32. Upon information and belief, Respondent continues to use the iHP designation as the name of a method, process, system or technology for decontamination, not as a source identifier for the provision of biological decontamination services.

33. Respondent’s use of the iHP designation therefore did not and does not function as a service mark.

34. The Registration should therefore be cancelled under 15 U.S.C. §§ 1127 and 1064.

FOURTH GROUND FOR CANCELLATION OF REGISTRATION
Unlawful Use

35. TOMI incorporates by reference paragraphs 1 through 34 of this Petition for Cancellation.

36. The technology and equipment that are necessary to create ionized hydrogen peroxide that is critical to TOMI's ability to deliver the services identified in the Registration is patented by TOMI.

37. The solution that Respondent must use with TOMI's patented technology and equipment to create ionized hydrogen peroxide that is critical to Respondent's ability to deliver the services identified in the Registration is also proprietary to TOMI.

38. Respondent no longer has the ability to acquire TOMI's technology and equipment or its solution and therefore will not be able to use ionized hydrogen peroxide in connection with the delivery of its biological decontamination services.

39. To the extent that Respondent uses ionized hydrogen peroxide in connection with its biological decontamination services, its use of the ionized hydrogen peroxide will be unauthorized and therefore illegal and cannot be the basis for the maintenance of the trademark registration or for the continued maintenance of bona fide trademark rights.

40. The iHP Registration should therefore be cancelled under Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064.

WHEREFORE, for the reasons set forth in the foregoing paragraphs, TOMI believes it will be damaged by continued registration of the iHP designation shown in Registration No. 3,917,962 and respectfully requests that the Registration be cancelled.

Dated: February 8, 2016

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS, LLP

By: /s/ Anita B. Polott

Anita B. Polott

J. Kevin Fee

Jordana S. Rubel

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Attorneys for Petitioner

TOMI Environmental Solutions, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on February 8, 2016, I caused a true and complete copy of the foregoing PETITION FOR CANCELLATION to be sent to the Respondent via First Class U.S.

Mail at the following address:

Astro Pak Corporation
270 East Baker Street
Suite 100
Costa Mesa, CA 92626

By: /s/ Jordana S. Rubel

Jordana S. Rubel

Exhibit B

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 15 Environmental Solutions, Inc.

16 **UNITED STATES DISTRICT COURT**
 17 **CENTRAL DISTRICT OF CALIFORNIA**

18
 19 TOMI ENVIRONMENTAL
 SOLUTIONS, INC.,

20
 21 Plaintiff,

22 v.

23 SIXLOG CORPORATION and ASTRO
 24 PAK CORPORATION,

25 Defendants.

Case No. 2:16-cv-5916

**Complaint for Patent Infringement,
 False Designation of Origin, Unfair
 Competition, False Advertising, and
 Cancellation of Trademark**

Demand for Jury Trial

1 **COMPLAINT**

2 Plaintiff, TOMI Environmental Solutions, Inc., by its attorneys, Morgan,
3 Lewis & Bockius LLP, brings this action against SixLog Corporation and Astro
4 Pak Corporation (collectively, “Defendants”), and alleges as follows:
5

6 **THE PARTIES**

7
8 1. Plaintiff, TOMI Environmental Solutions, Inc. (“TOMI”), is a Florida
9 corporation with its principal place of business at 9454 Wilshire Boulevard,
10 Beverly Hills, California 90212.

11
12 2. Upon information and belief, Defendant SixLog Corporation
13 (“SixLog”) is a Delaware corporation with its principal place of business at 270
14 East Baker Street, Suite 100, Costa Mesa, California 92626. Upon information
15 and belief, SixLog specializes in providing biological decontamination and
16 sterilization services.
17

18
19 3. Upon information and belief, Defendant Astro Pak Corp. (“Astro
20 Pak”) is a Delaware corporation with its principal place of business at 270 East
21 Baker Street, Suite 100, Costa Mesa, California 92626. Upon information and
22 belief, Astro Pak also provides biological decontamination and sterilization
23 services. Upon information and belief, SixLog is a wholly owned subsidiary of
24 Astro Pak and is controlled by Astro Pak.
25
26
27
28

1 **JURISDICTION AND VENUE**

2 4. This is an action for patent infringement in violation of 35 U.S.C. § 1,
3 *et seq.*; for false designation of origin and false advertising in violation of the
4 Lanham Act, 15 U.S.C. §§ 1051 *et seq.*; and for violations of California Business
5 & Professions Code § 17200 and § 17500.
6

7
8 5. This Court has subject matter jurisdiction over this action pursuant
9 to 28 U.S.C. §§ 1331 and 1338(a) and 15 U.S.C. § 1121(a). This Court has
10 supplemental jurisdiction over TOMI's state law claims under 28 U.S.C. §
11 1367(a). These claims are so related to the other claims in this case that they
12 form part of the same case or controversy and derive from a common nucleus
13 of operative facts.
14

15
16 6. Defendants are subject to personal jurisdiction in this District
17 because, among other reasons, their principal places of business are in this
18 District; they regularly and systematically conduct business in this District;
19 and/or they have purposefully directed their activities at this District,
20 including, without limitation, activities and actions relating to TOMI.
21

22
23 7. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) & (c)
24 and 1400(b).
25
26
27
28

1 **FACTUAL BACKGROUND**

2 8. TOMI is a global bacteria decontamination and infectious disease
3 control company that provides environmentally safe solutions for
4 decontamination of indoor surfaces. On information and belief, TOMI and
5 Defendants are direct competitors because both sell and use equipment for
6 biological decontamination.
7

9 9. TOMI owns all rights, title, and interest in and to U.S. Patent No.
10 6,969,487 (the “487 patent”), titled “Denaturing of a Biochemical Agent Using
11 an Activated Cleaning Fluid Mist,” which duly and legally issued on November
12 29, 2005. A copy of the ‘487 patent is attached as Exhibit 1.
13

14 10. The ‘487 patent is directed, among other things, to a process that
15 produces an activated cleaning fluid mist comprised of activated ionized
16 hydrogen peroxide that neutralizes biochemical contaminants, such as
17 bacteria, viruses, toxins, and chemical agents.
18

19 11. TOMI owns all rights, title, and interest in and to U.S. Patent No.
20 7,008,592 (the “592 patent”), titled “Decontamination Apparatus and Method
21 Using an Activated Cleaning Fluid Mist,” which duly and legally issued on
22 March 7, 2006. A copy of the ‘592 patent is attached as Exhibit 2.
23

24 12. The ‘592 patent is directed, among other things, to equipment that
25 produces an activated cleaning fluid mist comprised of activated ionized
26
27
28

1 hydrogen peroxide that decontaminates various locations, as well as to
2 methods for performing decontamination.
3

4 13. TOMI also manufactures and sells a cleaning fluid that can be used
5 in its patented process and apparatus. TOMI sells the cleaning fluid under the
6 trademark SteraMist™.
7

8 14. TOMI sold equipment to Defendants for use in providing biological
9 decontamination services. The equipment contained stickers that depicted
10 various trademarks owned by TOMI, including the marks SteraMist™, TOMI™,
11 and a TOMI ENVIRONMENTAL SOLUTIONS logo.
12

13 15. Upon information and belief, Defendants did not merely use TOMI's
14 equipment to provide decontamination services to others, but also sold or
15 otherwise provided some equipment to third parties.
16

17 16. Before shipping TOMI equipment to at least some of Defendants'
18 own customers, Defendants, without TOMI's permission, removed the stickers
19 depicting TOMI's trademarks from the equipment and replaced them with
20 stickers that depicted SixLog's name and logo.
21

22 17. Upon information and belief, Defendants, without TOMI's
23 permission, also made and/or caused to be made additional decontamination
24 equipment that could be used to practice TOMI's patented technology. Upon
25 information and belief, Defendants, without TOMI's permission, sold, offered
26
27
28

1 for sale, leased, and/or caused to be sold, offered for sale, and/or leased this
2 equipment and used it and/or caused it to be used to practice the '487 patent
3 and the '592 patent.
4

5 18. Defendants, without TOMI's permission, included in their marketing
6 materials photographs of TOMI equipment or the additional decontamination
7 equipment they caused to be made on which they placed stickers depicting
8 SixLog's name and logo. Attached as Exhibit 3 are excerpts from a SixLog
9 marketing brochure that show examples of TOMI equipment and/or additional
10 decontamination equipment on which Defendants placed SixLog's name and
11 logo.
12
13

14 19. TOMI has informed Defendants it will no longer provide them
15 TOMI's technology, equipment, or solution.
16

17 20. Astro Pak Corp. registered the term iHP, which is an acronym for
18 ionized hydrogen peroxide, as a service mark with the U.S. Patent and
19 Trademark Office in connection with "biological decontamination services."
20 The iHP designation is registered under U.S. Trademark Registration No.
21 3,917,962.
22

23 21. Upon information and belief, SixLog uses the iHP designation
24 pursuant to a license with Astro Pak. For that license to be valid, Astro Pak
25 must exercise quality control over SixLog's use of the iHP designation.
26
27
28

1 22. Defendants use the iHP designation, with the ® symbol, in a false
2 and/or misleading manner. They use the iHP® designation to refer to TOMI's
3 patented decontamination technology and process, which TOMI owns, not
4 Defendants. *See, e.g.*, Ex. 4 (defining iHP as “a revolutionary new advancement
5 in Hydrogen Peroxide based bio decontamination technology” and a “patented
6 process”).
7

8
9 23. Defendants have also made numerous false and/or misleading
10 statements improperly representing themselves as the source and owner of
11 TOMI's technology and products.
12

13 24. Upon information and belief, Defendants posted numerous
14 marketing materials on their websites or other websites in which they
15 describe iHP as Defendants' proprietary technology or Defendants' technology.
16 For example, Exhibit 5 depicts a page from SixLog's website which states that
17 SixLog provides biological decontamination and sterilization solutions utilizing
18 “our proprietary iHP® (ionized hydrogen peroxide) technology”
19
20

21 25. Attached as Exhibit 6 is a page from SixLog's website that states:
22 “The iHP® technology provides room and area disinfection/sterilization using
23 our patented misting system”
24

25 26. Attached as Exhibit 7 is an article that was posted on SixLog's
26 website that contains the headline “SixLog's iHP® Technology successfully
27
28

1 employed in airflow streams thanks to its widespread distribution qualities
2 and its ability to be easily contained.”
3

4 27. Attached as Exhibit 8 is an article that was posted on SixLog’s
5 website titled: “Norovirus Surrogate Test Exposure to SixLog’s iHP™ (ionized
6 Hydrogen Peroxide) Decontamination Technology.” The article also refers to
7 “SixLog’s iHP decontamination technology.”
8

9 28. Attached as Exhibit 9 is an article that was posted on SixLog’s
10 website that contains the headline: “Multi-National BioScience Giant Employs
11 SixLog’s iHP® Technology.”
12

13 29. The specimen Astro Pak Corp. provided to the U.S. Patent and
14 Trademark Office in support of its trademark application consists of an excerpt
15 from a SixLog brochure, which also describes the iHP technology as “our
16 proven iHP™ technology” and “our process.” A copy of that specimen is
17 attached as Exhibit 10.
18

19 30. Similarly, at trade shows and in pitches to prospective customers,
20 Defendants have made false and/or misleading statements asserting they were
21 the owners of TOMI’s technology and patented decontamination process.
22

23 31. SixLog’s website contains a hyperlink titled “EPA registration of
24 iHP®.” Upon information and belief, Defendants’ characterization of the
25 document to which this hyperlink links as a registration of iHP is false. The
26
27
28

1 hyperlink links to a PDF of the U.S. Environmental Protection Agency's
2 registration of L3 Communications' Binary Ionization Technology, which is
3 now owned by TOMI, and relates to TOMI's SteraMist™ product, not any
4 product owned by Defendants. A copy of the PDF is attached as Exhibit 11.
5

6 32. Exhibit 12 is a printout of a page from Astro Pak's website that
7 describes iHP as SixLog's technology.
8

9
10 **FIRST CLAIM FOR RELIEF**
11 **(Infringement of U.S. Patent No. 6,969,487)**
12 **(Against Defendants)**

13 33. TOMI realleges and incorporates by reference the allegations
14 contained in all prior and subsequent paragraphs.

15 34. Based on information and belief, Defendants' decontamination and
16 sterilization services directly infringe at least claim 1 of TOMI's '487 patent.
17

18 35. Based on information and belief, Defendants indirectly infringe at
19 least claim 1 of TOMI's '487 patent. Based on information and belief,
20 Defendants have induced infringement of the '487 patent by improperly
21 providing their direct and indirect customers with decontamination equipment
22 and encouraging and instructing them to use methods and to sell and offer for
23 sale services that infringe at least claim 1 of the '487 patent. Upon information
24 and belief, Defendants improperly provided their customers with
25 decontamination equipment with the intent, awareness, and/or knowledge
26
27
28

1 that they would use it in a manner that directly infringes the '487 patent, and
2 they aided and abetted their customers to directly infringe the '487 patent.
3

4 36. Upon information and belief, Defendants' actions also constitute
5 contributory infringement of the '487 patent. Upon information and belief, the
6 decontamination equipment improperly provided by Defendants are not staple
7 articles of commerce; they are not suitable for substantial noninfringing use;
8 they are especially made or especially adapted for use in directly infringing the
9 '487 patent, and/or are configured only for infringing use.
10
11

12 37. Upon information and belief, Defendants have possessed knowledge
13 of the '487 patent for years. At least as early as 2010, Defendants referred to
14 the technology at issue as a "patented misting system," referencing the '487
15 patent among others.
16

17 38. Defendants' infringement has been willful and deliberate. Their
18 infringement has injured and damaged and continues to injure and damage
19 TOMI.
20

21 39. TOMI is also entitled to a determination that this is an exceptional
22 case and to recover reasonable attorneys' fees.
23

24 40. Defendants' acts of infringement will continue, irreparably
25 damaging TOMI, unless and until enjoined by this Court.
26
27
28

1 **SECOND CLAIM FOR RELIEF**
2 **(Infringement of U.S. Patent No. 7,008,592)**
3 **(Against Defendants)**

4 41. TOMI realleges and incorporates by reference the allegations
5 contained in all prior and subsequent paragraphs.

6 42. Based on information and belief, Defendants' improper
7 manufacture, having made, use, sale and offer for sale of decontamination
8 systems and equipment directly infringes at least independent claim 1 of the
9 '592 patent.
10

11 43. Based on information and belief, Defendants' decontamination and
12 sterilization services directly infringe at least claim 14 of the '592 patent.
13

14 44. Based on information and belief, Defendants also indirectly infringe
15 at least claim 14 of the '592 patent. Based on information and belief,
16 Defendants have induced infringement by improperly providing their direct
17 and indirect customers with decontamination equipment and encouraging and
18 instructing them to use methods and to sell and offer for sale services that
19 infringe at least claim 14 of the '592 patent. Upon information and belief,
20 Defendants improperly provided their customers with decontamination
21 equipment with the intent, awareness, and/or knowledge that they would use
22 it in a manner that directly infringes the '592 patent, and they aided and
23 abetted their customers to directly infringe the '592 patent.
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1 45. Defendants' actions also constitute contributory infringement of at
2 least claim 14 of the '592 patent. Upon information and belief, the
3 decontamination equipment improperly provided by Defendants are not staple
4 articles of commerce; they are not suitable for substantial noninfringing use;
5 they are especially made or especially adapted for use in directly infringing the
6 '592 patent, and/or are configured only for infringing use.
7

9 46. Upon information and belief, Defendants have possessed knowledge
10 of the '592 patent for years. At least as early as 2010, Defendants referred to a
11 "patented misting system," referencing the '592 patent among others. Based on
12 information and belief, Defendants have induced infringement by inducing
13 their direct and indirect customers to infringe at least claims 1 and 14 of the
14 '592 patent.
15

17 47. Defendants' infringement has been willful and deliberate, and it has
18 injured and damaged and continues to injure and damage TOMI.
19

20 48. TOMI is also entitled to a determination that this is an exceptional
21 case and to recover reasonable attorneys' fees.
22

23 49. Defendants' acts of infringement will continue, irreparably
24 damaging TOMI, unless and until enjoined by this Court.
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1 **THIRD CLAIM FOR RELIEF**
2 **(Reverse Passing Off/False Designation of Origin – 15 U.S.C. § 1125(a))**
3 **(Against Defendants)**

4 50. TOMI realleges and incorporates by reference the allegations
5 contained in all prior and subsequent paragraphs.

6 51. TOMI offers for sale in the United States equipment and products
7 bearing the name and trademarks of TOMI. TOMI has neither licensed the right
8 to rebrand its products, nor given permission to any third party to affix its
9 name or brand on any TOMI product.
10

11 52. Defendants' removal of TOMI's trademarks and replacement of
12 SixLog's name and logo on the equipment constitutes a false designation of
13 origin and/or misleading description or representation of fact that is likely to
14 cause confusion, cause mistake, or to deceive as to (a) the affiliation,
15 connection, or association of TOMI's products with Defendants, and/or (b) the
16 origin, sponsorship, or approval of the manufacture of TOMI's products by
17 Defendants. Consumers are likely to be deceived as to the origin of the goods
18 offered for sale by Defendants by virtue of the presence of SixLog's name and
19 logo on the goods. Defendants do not have authority, permission or a license to
20 affix any other name, brand or affiliation onto TOMI's products. Such conduct
21 is a violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
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1 53. TOMI is informed and believes that as a result of Defendants'
2 conduct, Defendants have been, and will continue to be, unjustly enriched by
3 profits Defendants made in connection with their distribution and/or sale of
4 TOMI's equipment.
5

6 54. As a direct and proximate result of Defendants' conduct, TOMI has
7 suffered monetary harm in an amount not yet determined.
8

9 55. Defendants' conduct was in conscious and willful disregard for
10 TOMI's rights, such that a trebling of damages is warranted.
11

12 56. TOMI is also entitled to a determination that this is an exceptional
13 case and to recover reasonable attorneys' fees.
14

15 57. In addition, TOMI has suffered, and if Defendants are permitted to
16 continue their conduct, TOMI will continue to suffer, irreparable harm. This
17 harm includes a reduction to the distinctiveness of the TOMI and SteraMist
18 products, brand and reputation that cannot be remedied through damages and
19 for which there is no adequate remedy at law, such that injunctive relief is
20 necessary.
21
22

23 **FOURTH CLAIM FOR RELIEF**
24 **(Unfair Competition: Cal. Bus. & Prof. Code § 17200 et seq)**
25 **(Against Defendants)**

26 58. TOMI realleges and incorporates by reference the allegations
27 contained in all prior and subsequent paragraphs.
28

1 59. Defendants' conduct, as alleged above, constitutes unlawful and/or
2 unfair business practices in violation of the California Unfair Competition Law
3 ("UCL"), California Business and Professions Code § 17200 *et seq.*
4

5 60. Without permission, consent, or a license, Defendants rebranded
6 TOMI's equipment as SixLog products. Such conduct is likely to cause
7 confusion among consumers in California as to the source, origin or affiliation
8 of TOMI's equipment.
9

10 61. TOMI is informed and believes that as a result of Defendants'
11 conduct, Defendants have been, and will continue to be, unjustly enriched by
12 profits Defendants made in connection with their distribution and/or sale of
13 TOMI equipment.
14

15 62. As a direct and proximate result of Defendants' conduct, TOMI has
16 suffered monetary harm in an amount not yet determined.
17

18 63. TOMI has suffered, and if Defendants are permitted to continue
19 their conduct, TOMI will continue to suffer, irreparable harm. This harm
20 includes a reduction to the distinctiveness of the TOMI and SteraMist products,
21 brand and reputation that cannot be remedied through damages and for which
22 there is no adequate remedy at law, such that injunctive relief is necessary.
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1 **FIFTH CLAIM FOR RELIEF**
2 **(False Advertising in Violation of Section 43(a) of 15 U.S.C. § 1125(a))**
3 **(Against Defendants)**

4 64. TOMI realleges and incorporates by reference the allegations
5 contained in all prior and subsequent paragraphs.

6 65. Defendants made false and/or misleading statements of fact by
7 claiming and/or implying that they are the source and owner of TOMI's
8 technology, equipment, and products used for biological decontamination.
9

10 66. Defendants' false and/or misleading statements of fact constitute
11 false advertising through statements and representations that are literally
12 false and/or that convey a false impression or are otherwise misleading.
13

14 67. Defendants disseminated their false and/or misleading statements
15 of fact through interstate commerce through their websites and
16 communications with customers and potential customers.
17

18 68. Defendants' dissemination of false and/or misleading statements of
19 fact has actually deceived and/or has a tendency to deceive a substantial
20 segment of TOMI and Defendants' customers and potential customers.
21

22 69. Defendants' dissemination of false and/or misleading statements of
23 fact is material in that it has influenced and/or is likely to influence the
24 purchasing decisions of TOMI and Defendants' customers and potential
25 customers.
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1 70. Defendants' dissemination of false and/or misleading statements of
2 fact was willful and intentional, with the knowledge of the falsity and/or
3 misleading nature of the statements and the knowledge that the statements
4 had the tendency to deceive a substantial segment of prospective purchasers.
5

6 71. Because Defendants are, on information and belief, direct
7 competitors or TOMI, Defendants' dissemination of false and/or misleading
8 statements of fact has caused and/or is likely to cause TOMI to suffer a
9 competitive disadvantage and the loss of sales to prospective purchasers who
10 were deceived by Defendants' conduct.
11

12 72. Defendants' conduct constitutes false advertising in violation of 15
13 U.S.C. § 1125(a)(1)(B) because it constitutes a misrepresentation of the nature,
14 characteristics, qualities or geographic origin of Defendants' products in
15 commercial advertising or promotion.
16
17

18 73. As a direct and proximate cause of Defendants' violation of 15 U.S.C.
19 § 1125(a)(1)(B), TOMI's business, goodwill and reputation have been
20 damaged, and TOMI has lost, and is likely to continue to lose, sales and profits.
21
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23 74. As a direct and proximate result of Defendants' conduct, TOMI has
24 suffered monetary harm in an amount not yet determined.
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1 75. Due to the willfulness of Defendants' conduct, the damages
2 sustained by TOMI as a result of Defendants' conduct should be trebled in
3 accordance with 15 U.S.C. § 1117(a).
4

5 76. TOMI is also entitled to a determination that this is an exceptional
6 case and entitled to recover reasonable attorneys' fees.
7

8 77. TOMI has suffered, and if Defendants are permitted to continue
9 their conduct, TOMI will continue to suffer, irreparable harm for which there is
10 no adequate remedy at law, such that injunctive relief is necessary.
11

12 **SIXTH CLAIM FOR RELIEF**
13 **(False Advertising in Violation of Cal. Bus. & Prof. Code § 17500 *et seq.*)**
14 **(Against Defendants)**

15 78. TOMI realleges and incorporates by reference the allegations
16 contained in all prior and subsequent paragraphs.
17

18 79. Defendants' conduct as described herein constitutes a violation of
19 Cal. Bus. & Prof. Code § 17500.
20

21 80. Pursuant to Cal. Bus. & Prof. Code § 17500, TOMI is entitled to
22 record monetary damages including, but not limited to, statutory penalties of
23 \$2,500 per violation.
24

25 81. TOMI is entitled to an award of attorneys' fees as a private attorney
26 general pursuant to Cal. Code Civ. P. § 1021.5.
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1 82. TOMI has suffered, and if Defendants are permitted to continue
2 their conduct, TOMI will continue to suffer, irreparable harm for which there is
3 no adequate remedy at law, such that injunctive relief is necessary.
4

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6 **SEVENTH CLAIM FOR RELIEF**
7 **(Cancellation of iHP Trademark Registration)**
8 **(Against Astro Pak)**

9 83. TOMI realleges and incorporates by reference the allegations
10 contained in all prior and subsequent paragraphs.

11 84. Astro Pak owns U.S. Trademark Reg. No. 3,917,962 for the iHP
12 designation in connection with “biological decontamination services.”
13

14 85. The designation iHP is an acronym for “ionized hydrogen peroxide.”

15 86. The term “ionized hydrogen peroxide” refers to a mist for biological
16 decontamination that is created using TOMI’s patented process and
17 equipment.
18

19 87. Ionized hydrogen peroxide is the category name of a particular type
20 of material used for biological decontamination.
21

22 88. On information and belief, purchasers of AstroPak’s services
23 understand the phrase “ionized hydrogen peroxide” to refer to a type of
24 hydrogen peroxide that is ionized, not a source.
25

26 89. “Ionized hydrogen peroxide” is not capable of distinguishing Astro
27 Pak’s services pursuant to 15 U.S.C. § 1091 because it is a generic phrase.
28

1 90. If it is not generic, the phrase “ionized hydrogen peroxide” is merely
2 descriptive of the services in the registration because it is an ingredient,
3 characteristic, and feature of the materials used by Astro Pak to provide its
4 biological decontamination services.
5

6 91. TOMI and other third parties have the right to use the term “ionized
7 hydrogen peroxide” or the acronym iHP in connection with describing the mist
8 for biological decontamination that is created using TOMI’s patented process,
9 equipment, and materials.
10

11 92. When used on or in connection with Astro Pak’s services, the
12 designation iHP is merely descriptive of Astro Pak’s services and cannot
13 function as a trademark absent a showing of secondary meaning under Section
14 2(f) of the Trademark Act of 1946, 15 U.S.C. § 1052(f).
15

16 93. The designation iHP has not acquired secondary meaning signifying
17 Astro Pak as the exclusive source of the relevant services.
18

19 94. The specimen Astro Pak submitted with its Statement of Use states
20 that iHP is “a hydrogen peroxide based technology” and repeatedly refers to
21 “iHP technology.” *See* Ex. 10. The specimen does not demonstrate use of the
22 iHP designation as a service mark used by Astro Pak in connection with
23 offering or providing biological decontamination services.
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1 95. Upon information and belief, at the time Astro Pak submitted its
2 Statement of Use, Astro Pak used the iHP designation solely as the name of a
3 method, process, system or technology for decontamination, not as a source
4 identifier for the provision of biological decontamination services.
5

6 96. Upon information and belief, Astro Pak continues to use the iHP
7 designation as the name of a method, process, system or technology for
8 decontamination, not as a source identifier for the provision of biological
9 decontamination services.
10

11 97. Astro Pak's use of the iHP designation therefore did not and does
12 not function as a service mark.
13

14 98. The technology and equipment that are necessary to create ionized
15 hydrogen peroxide that is critical to Astro Pak's ability to deliver the services
16 identified in the registration is patented by TOMI.
17

18 99. The solution that Astro Pak must use with TOMI's patented
19 technology and equipment to create the ionized hydrogen peroxide that is
20 critical to Astro Pak's ability to deliver the services identified in the
21 registration is also proprietary to TOMI.
22

23 100. TOMI has informed Defendants that it will no longer provide
24 TOMI's technology and equipment or its solution to Defendants. Therefore,
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1 Astro Pak will not be able to use ionized hydrogen peroxide in connection with
2 the delivery of its biological decontamination services.

3
4 101. To the extent that Astro Pak uses ionized hydrogen peroxide that it
5 acquires from a source other than TOMI in connection with its biological
6 decontamination services, Astro Pak's use of the ionized hydrogen peroxide
7 will be illegal and cannot be the basis for the maintenance of the trademark
8 registration or for the continued maintenance of bona fide trademark rights.

9
10 102. For the reasons set forth above, TOMI requests that U.S.
11 Trademark Reg. No. 3,917,962 should be cancelled.

12
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14 **PRAYER FOR RELIEF**

15 WHEREFORE, TOMI requests that judgment be entered in its favor and
16 against Defendants as follows:

- 17
18 A. Adjudicating and declaring that Defendants have infringed the
19 '487 patent and the '592 patent;
20
21 B. Adjudicating and declaring that Defendants' conduct violates 15
22 U.S.C. § 1125(a) and constitutes false designation of origin;
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24 C. Adjudicating and declaring that Defendants' conduct violates Cal.
25 Bus. & Prof. Code §17200 *et seq.*;

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D. Adjudicating and declaring that Defendants’ conduct constitutes false advertising in violation of 15 U.S.C. § 1125(a) and Cal. Bus. & Prof. Code §17500 *et seq.*;

E. Preliminarily and permanently enjoining Defendants and their officers, directors, agents, servants, employees, parents, subsidiaries, principals and all persons in active concert or participating with them from further infringement of the ‘487 patent and the ‘592 patent;

F. Preliminarily and permanently enjoining Defendants, their officers, directors, agents, servants, employees, parents, subsidiaries, principals and all persons in active concert or participating with them from (1) removing TOMI’s trademarks from TOMI’s equipment and replacing them with SixLog’s name and logo; (2) otherwise stating or implying that TOMI’s equipment originates with or is associated with, sponsored by or affiliated with Defendants;

G. Preliminarily and permanently enjoining Defendants and their officers, directors, agent, servants, employees, parents, subsidiaries, principals and all persons in active concert or participating with them from making any false or misleading

1 statement to consumers and potential consumers, including, but
2 not limited to, statements that indicate or suggest that Defendants
3 are the owners of TOMI's proprietary technology, equipment, and
4 products that utilize activated ionized hydrogen peroxide for
5 biological decontamination;
6
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8 H. Issuing an order requiring Defendants to: (1) recall all TOMI
9 equipment they sold and/or distributed to third parties from
10 which they removed TOMI's trademarks and replaced them with
11 SixLog's name and logo; (2) recall all similar infringing equipment
12 Defendants made or caused to be made and sold or otherwise
13 provided to third parties; and (3) destroy all literature, catalogs,
14 signs, advertising or marketing materials, and the like that contain
15 images of TOMI equipment from which SixLog removed TOMI's
16 trademarks and replaced them with SixLog's name and logo, or
17 images of similar infringing equipment, and/or that contain false
18 and/or misleading statements that indicate or suggest that
19 Defendants are the owners of TOMI's proprietary technology,
20 equipment, and products that utilize activated ionized hydrogen
21 peroxide for biological decontamination; and (4) issue a public
22 statement to all of Defendants' customers recognizing that TOMI is
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the owner of the technology, equipment, and products that utilize activated ionized hydrogen peroxide for biological decontamination;

- I. Cancelling U.S. Trademark Reg. No. 3,917,962 for the iHP designation.
- J. Ordering an award of restitution, unjust enrichment, actual damages, statutory damages and compensatory damages in an amount to be determined at trial, together with pre- and post-judgment interest;
- K. Awarding TOMI compensation for its own corrective advertising efforts in response to Defendants' false advertising;
- L. Awarding TOMI treble, exceptional, increased and/or punitive damages;
- M. Awarding TOMI reasonable litigation expenses and costs of this action;
- N. Awarding TOMI reasonable attorneys' fees; and
- O. Ordering or awarding any other such relief the Court deems just and proper.

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DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff
demands a trial by jury of all issues so triable.

Dated: August 8, 2016

Respectfully Submitted,

MORGAN, LEWIS & BOCKIUS LLP

/s/ Richard de Bodo

Richard de Bodo

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