UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mail date: May 5, 2004

Opposition No. 91158647

Ecolab, Inc.

v.

Big Planet, Inc.

Before Hohein, Walters and Bucher, Administrative Trademark Judges.

By the Board:

Applicant is seeking to register the mark ECOSPHERE for the following goods: all-purpose cleaning preparations, carpet cleaning preparations, glass cleaning preparations.[1] As grounds for the opposition, opposer alleges that applicant's mark so resembles opposer's previously used and registered ECOLAB and ECO formative and prefix marks, including ECOSPHERE, for a wide variety of cleaning, sanitizing, maintenance, and repair products and services, and which opposer alleges make up a family of marks and are famous, as to be likely to cause confusion, mistake or to deceive; and that applicant's mark will cause dilution of the

[1] Application Serial No. 78180241, filed on October 30, 2002, claiming a bona fide intention to use the mark in commerce.

distinctive quality of opposer's marks, which became well known and famous before applicant began use of its mark.[2]

In its answer, applicant denies the salient allegations of the notice of opposition and asserts six affirmative defenses that opposer's claims are barred by: untimeliness, waiver, acquiescence, estoppel, laches, and unclean hands.

This case now comes up on opposer's fully-briefed motion to strike applicant's affirmative defenses of untimeliness, acquiescence and laches.

In support of its motion, opposer argues that applicant has failed to allege any specific facts in support of the named affirmative defenses. Opposer argues further that the affirmative defenses are not applicable here because the evaluation of untimeliness, laches and acquiescence runs from the date of publication of a mark in the Official Gazette. Opposer contends that it filed its notice of opposition only four months after publication of applicant's mark and prior to the expiration of its three consecutively filed requests to extend time to oppose, all of which were granted by the Board.

In response, applicant argues that its affirmative defenses raise factual issues that cannot be resolved in a pre-discovery motion on the pleadings. Applicant argues that it has not had an opportunity to review opposer's requests to extend time to oppose

[2] Opposer pleads thirty-one registrations for ECO formative marks; and several marks at common law.

for possible deficiencies; and that opposer's third request to extend time to oppose, as viewed on the Office website, is not accompanied by a certificate of mailing, and discovery is needed to establish if it was timely filed.

In reply, opposer argues that its third extension request was timely filed, and that, even in the absence of a certificate of mailing,[3] applicant need only look at the mail room receipt on the upper right hand corner of the third request to ascertain that it was timely filed.

Applicant's application published for opposition on July 22, 2003. Just two days later, opposer filed a request to extend its time to oppose by thirty days (from the expiration of the opposition period as set by the publication date) until September 20, 2003. That request was granted by order of the Board dated July 28, 2003. On September 15, 2003, well before the expiration of its first extension of time, opposer filed a second request to extend its time to oppose by thirty days, until October 20, 2003. Such request was granted by order of the Board dated September 23, 2003. On October 20, 2003, opposer filed a third request to extend its time to oppose until November 19, 2003. That extension request was granted by order of the Board dated October 29, 2003. Opposer filed it notice of opposition on November 19, 2003.

[3] Opposer notes that it referenced a certificate of mailing in its cover letter but such certificate was not imaged into TTABVUE.

Opposer's third request to extend its time to oppose is timely filed on its face as evidenced by the USPTO Mailroom receipt date of October 20, 2003. The filing date of correspondence is the date of receipt by the Office as evidenced by the USPTO "date stamp," now a bar code label.[4] *See* Trademark Rule 2.195;[5] and TBMP Section 109 (2nd ed. rev'd March 2004).

Applicant's argument that it needs to review a certificate of mailing to determine the timeliness of the request is without merit in this case. The purpose of a certificate of mailing is to consider as timely filed correspondence sent to the Office and received after the expiration of the set period where the correspondence is mailed by first class mail, with a proper address, prior to the expiration of the set period and accompanied by a certificate of mailing. *See* Trademark Rule 2.197;[6] and TBMP Section 110 (2nd ed. rev'd March 2004).

Accordingly, opposer's motion to strike applicant's first affirmative defense that opposer's request for relief is barred as untimely is granted.

Applicant does not articulate any arguments as to why opposer's motion to strike applicant's affirmative defenses of acquiescence and laches should not be granted. With respect to acquiescence, applicant does not allege or argue that opposer

[4] There are exceptions to this general rule for the date of receipt, but none of those is applicable here.
[5] Formerly Patent and Trademark Rule 1.6.
[6] Formerly Patent and Trademark Rule 1.8.

knew of any use by applicant and failed to object to such use for long periods of time. *See, for example*, J. McCarthy, 3 McCarthy on Trademarks and Unfair Competition, §20:34 (4th ed. March 2004). In an opposition proceeding, laches can only start running from the date when the challenged application was published for opposition. Thus, laches will rarely be a defense in an opposition. *Id.* at §20:35.

Accordingly, opposer's motion to strike applicant's third and fifth affirmative defenses that opposer's request for relief is barred by the equitable and affirmative defenses of acquiescence and laches is granted. *See also* Trademark Rule 2.127(a).

In view thereof, applicant's affirmative defenses numbered (1), (3) and (5) are hereby stricken.

Proceedings are resumed, and discovery and trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	November 21, 2004
30-day testimony period for party in position of plaintiff to close:	February 19, 2005
30-day testimony period for party in position of defendant to close:	April 20, 2005
15-day rebuttal testimony period to close:	June 4, 2005

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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