

ESTTA Tracking number: **ESTTA356529**

Filing date: **07/06/2010**

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

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Koch Membrane Systems, Inc.
Granted to Date of previous extension	07/04/2010
Address	850 Main Street Wilmington, MA 01887 UNITED STATES

Name	Koch Membrane Systems GmbH
Granted to Date of previous extension	07/04/2010
Address	Kackerstrasse 10 Aachen, 52072 GERMANY

Attorney information	Constance M. Jordan Stinson Morrison Hecker LLP 1201 Walnut Street, Suite 2900 Kansas City, MO 64106-2150 UNITED STATES TRADEMARK@STINSON.COM Phone:816-691-3336
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Applicant Information

Application No	77639991	Publication date	01/05/2010
Opposition Filing Date	07/06/2010	Opposition Period Ends	07/04/2010
Applicant	Pureon Japan Co., Ltd 1-37 Yoshima Industrial Park Iwaki-shi, JAPAN		


Goods/Services Affected by Opposition

Class 011. First Use: 1985/08/31 First Use In Commerce: 1985/08/31
Opposed goods and services in the class:

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	79035999	Application Date	08/22/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PURON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: Hollow fiber filtration membranes and membrane modules for use in filtration of wastewater and membrane bioreactor (MBR) applications Class 042. First use: Scientific and industrial research services in the field of filtration of wastewater		

Attachments	79035999#TMSN.jpeg (1 page)(bytes) NOTICE OF OPPOSITION.PDF (14 pages)(166822 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	/constance m. jordan/
Name	Constance M. Jordan
Date	07/06/2010

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

In the matter of Trademark Application Serial No. 77/639,991
Mark: P PURERON (Stylized)
Filing Date: December 24, 2008
Published: January 5, 2010

)	
Koch Membrane Systems Gmbh, and)	
Koch Membrane Systems, Inc.)	
)	
Opposers,)	
)	
v.)	Opposition No.: _____
)	
Pureron Japan Co., Ltd.,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Pursuant to 15 U.S.C. 1063, Lanham Act Section 13, and 15 U.S.C. 1068, Lanham Act Section 18, Opposers Koch Membrane Systems GmbH ("GmbH") and Koch Membrane Systems, Inc. ("KMS") believe that they will be damaged by registration of the above mark in International Class 11, and hereby oppose such registration. Alternatively, Opposers request a restriction or modification of the existing description of goods in Class 11 only. As grounds therefor, it is alleged that:

1. Opposer GmbH is a Germany company having a place of business at Kackerstrasse 10, 52072 Aachen, Federal Republic of Germany.
2. Opposer KMS is a Delaware corporation with its principal place of business at 850 Main Street, Wilmington, Massachusetts 01887, and has been a global leader in separation and filtration products for more than 40 years.

3. GmbH and KMS are both member companies of Koch Chemical Technology Group, LLC, a Delaware limited liability company.

4. On information and belief, Applicant Pureron Japan Co., Ltd. ("Pureron") is a Japanese limited liability company, with a principal place of business at 1-37 Yoshima Industrial Park, Iwaki-Shi, Japan.

5. On December 24, 2008, Pureron filed an application, Serial No. 77/639,991, for registration of the mark P PURERON (Stylized) for, among other goods in other classes, "gas purifier; electric heaters for gas filter; water filters, filter cartridges, and filter housings" in International Class 11.

6. Applicant claims a date of first use of August 31, 1985, for goods in Class 11, a date which Opposers believe is not accurate.

7. Opposer GmbH is the owner of the mark PURON, and Opposer KMS is a licensed user of such mark.

8. Opposer GmbH is the applicant and owner of pending application Serial No. 79/035,999, filed August 22, 2006, to register the mark PURON for "hollow fiber filtration membranes and membrane modules for use in filtration of wastewater and membrane bioreactor (MBR) applications" in International Class 11; and "scientific and industrial research services in the field of filtration of wastewater," in International Class 42. The application is on a final rejection due to the description of goods, which the Examining attorney has asked be changed to "hollow fiber filtration membranes, membrane bioreactors, and membrane modules for use in filtration of wastewater," a change which Opposer GmbH intends to make. Copies of documents from pending application Serial No. 79/035,999 are attached.

9. Opposers' pending application Serial No. 79/035,999 is an extension of International Registration No. 0781436 dated February 18, 2002, which is in turn based on German Reg. No. 30150081 dated November 16, 2001. No use date in the U.S. has been claimed, but Opposers have used the mark in the United States since at least as early as August 23, 2004.

10. Opposers have invested substantial time, money and effort in promoting, advertising and familiarizing others with their products, and enjoy substantial and exclusive goodwill and a worldwide reputation in connection with their PURON mark.

11. Opposers' continued and legal use of their mark will be impaired by the continued use by Applicant of a mark which is similar to Opposers' mark in sound, meaning, connotation and commercial impression for goods broadly identified as "water filter, filter cartridges, and filter housings" in International Class 11.

12. Opposers are entitled to the sole and exclusive use of their mark on and in connection with their hollow fiber filtration membranes and membrane modules for use in filtration of wastewater and membrane bioreactor (MBR) applications, and in connection with any confusingly similar marks for what may appear to be related goods.

13. If Applicant is permitted to retain the prima facie exclusive right to use in commerce of the mark P PURERON (Stylized) for goods identified as "water filters, filter cartridges, and filter housings," which could be deemed to identify goods identical to or substantially similar to those of Opposers, potential customers are likely to be confused, deceived or mistaken as to the source, affiliation or sponsorship of Class 11 goods sold under Applicant's P PURERON mark.

14. Concurrent use of the P PURERON (Stylized) mark by the Applicant and the PURON mark by Opposers may result in irreparable damage to Opposers' reputations and goodwill, if the goods sold by the Applicant are inferior, since purchasers are likely to attribute the source of Applicant's goods to the Opposers.

15. If the Applicant is permitted to retain the broad description for its goods in International Class 11, a cloud will be placed on Opposers' mark and on Opposers' right to enjoy the free and exclusive use thereof in connection with the sale of Class 11 goods, all to Opposers' injury.

16. Registration of Applicant's mark for Class 11 goods should be rejected or the description of the Applicant's goods in Class 11 should be restricted to exclude industrial and municipal wastewater treatment, as such restriction would serve to avoid a likelihood of confusion. See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 U.S.P.Q.2d 1266 (TTAB 1994). Opposers suggest the following description: "gas purifier; electric heaters for gas filter; water filters, filter cartridges, and filter housings, **said water filters, filter cartridges, and filter housings not for use with hollow fiber filtration membranes and membrane modules used in filtration of wastewater, membrane bioreactor (MBR) applications, or surface water treatment.**"

WHEREFORE, Opposers pray that registration of Applicant's goods in International Class 11 be rejected or, alternatively, that the description of goods in International Class 11 be restricted or modified to avoid any likelihood of confusion with the goods sold under Opposer's PURON mark, and for such other relief as the Board deems just and proper.

Copies of this Notice have been mailed to Applicant and to the attorney for Applicant at their respective addresses of record.

Dated this 6th day of July, 2010.

Respectfully submitted,

By: Constance M. Jordan

Constance M. Jordan
STINSON MORRISON HECKER LLP
1201 Walnut St Ste 2900
Kansas City, MO 64141-6251
Telephone: (816) 842-8600
Fax: (816) 691-3495
ATTORNEYS FOR OPPOSERS


CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Notice of Opposition was served this 16th day of July, 2010, by depositing copies thereof in the U.S. mail, postage prepaid, addressed to the following:

Applicant:
Pureon Japan Co., Ltd
1-37 Yoshima Industrial Park
Iwaki-shi
Japan

and

Attorney for Applicant:
Eric S. Hyman
Blakely Sokoloff Taylor & Zafman
12400 Wilshire Blvd Fl 7
Los Angeles, Ca 90025-1019



Attorney for Opposers

To: Koch Membrane Systems GmbH (TRADEMARK@STINSON.COM)
Subject: U.S. TRADEMARK APPLICATION NO. 79035999 - PURON - 506418-01230
Sent: 6/19/2010 7:45:54 PM
Sent As: ECOM112@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 79035999

MARK: PURON

79035999

CORRESPONDENT ADDRESS:

CONSTANCE M.JORDAN
STINSON MORRISON HECKER LLP
1201 WALNUT, SUITE 2900
STINSON TRADEMARK ADMINSTRATOR
KANSAS CITY MO 64106-2150

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Koch Membrane Systems
GmbH

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

506418-01230

CORRESPONDENT E-MAIL ADDRESS:
TRADEMARK@STINSON.COM

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/19/2010

THIS IS A FINAL ACTION.

INTERNATIONAL REGISTRATION NO. 0781436

On November 14, 2007, the Office suspended examination based on a prior pending application. That application has registered, but will not be cited. Therefore, the requirement for an acceptable identification of goods is now made FINAL for the reasons set forth below. 37 C.F.R. §2.64(a).

Identification of Goods

The identification of goods is indefinite and must be clarified because it contains vague and confusing language, specifically, “membrane bioreactor (MBR) applications.” Applicant may adopt the following identification, if accurate:

Class 11: Hollow fiber filtration membranes, membrane bioreactors, and membrane modules for use in filtration of wastewater

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau in the corresponding international registration. TMEP §§1401.03(d), 1904.02(b).

Identifications of goods and services may be amended only to clarify or limit the goods and services; adding to or broadening the scope of the goods and services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods and services that are not within the scope of the goods and services set forth in the present identification.

For assistance with identifying and classifying goods and services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

Proper Response to Final Office Action

If applicant does not respond within six months of the mailing date of this final Office action, the following classes to which the final requirement applies will be **deleted** from the application by Examiner’s Amendment: 11. The application will then proceed for the remaining class. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a).

Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b), TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

Telephone Response Suggested

Applicant is encouraged to telephone or email the assigned trademark examining attorney to resolve the issues raised in this Office action.

/DETJr/
David E. Tooley, Jr.
Trademark Examining Attorney
Law Office 112
phone: (571) 272-8206
fax: (571) 273-8206

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by (1) an individual applicant; (2) someone with legal authority to bind applicant (i.e., a corporate officer, a general partner, all joint applicants); or (3) an authorized attorney, if one is appointed to represent applicant.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/cTEASpageE.htm>.

To: Koch Membrane Systems GmbH (TRADEMARK@STINSON.COM)
Subject: U.S. TRADEMARK APPLICATION NO. 79035999 - PURON - 506418-01230
Sent: 6/19/2010 7:45:58 PM
Sent As: ECOM112@USPTO.GOV
Attachments:

IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION

Your trademark application (Serial No. 79035999) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on 6/19/2010 to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. Read the Office letter by clicking on this [link](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=79035999&doc_type=OOA&)
http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=79035999&doc_type=OOA&

OR go to <http://tmportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact TDR@uspto.gov.

PLEASE NOTE: The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. Contact the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. Respond within 6 months, calculated from 6/19/2010 (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) **Response to Office Action form**. If you have difficulty using TEAS, contact TEAS@uspto.gov.

ALERT:

Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** (loss) of your application.

Do NOT hit “Reply” to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-07-06 16:32:57 ET

Serial Number: 79035999 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

Puron

(words only): PURON

Standard Character claim: Yes

Current Status: An office action making FINAL a refusal to register the mark has been mailed.

Date of Status: 2010-06-19

Filing Date: 2006-08-22

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 112

Attorney Assigned:
TOOLEY DAVID E

Current Location: M3X -TMO Law Office 112 - Examining Attorney Assigned

Date In Location: 2010-06-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Koch Membrane Systems GmbH

Address:

Koch Membrane Systems GmbH
Kackertstrasse 10 52070 Aachen
Fed Rep Germany

Legal Entity Type: Unknown

State or Country Where Organized: (NOT AVAILABLE)

GOODS AND/OR SERVICES

International Class: 011**Class Status:** Active

Hollow fiber filtration membranes and membrane modules for use in filtration of wastewater and membrane bioreactor (MBR) applications

Basis: 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 042**Class Status:** Active

Scientific and industrial research services in the field of filtration of wastewater

Basis: 66(a)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION**International Registration Number:** 0781436**International Registration Date:** 2002-02-18**Priority Claimed:** No**Date of Section 67 Priority Claim:** (DATE NOT AVAILABLE)**International Registration Status:** Request For Extension Of Protection Processed**Date of International Registration Status:** 2007-04-12**International Registration Renewal Date:** 2012-02-18**Notification of Designation Date:** 2007-04-12**Date of Automatic Protection:** 2008-10-12**Date International Registration Cancelled:** (DATE NOT AVAILABLE)**First Refusal:** Yes**PROSECUTION HISTORY**

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-06-19 - Notification Of Final Refusal Emailed

2010-06-19 - Final refusal e-mailed

2010-06-19 - Final Refusal Written

2010-05-21 - LIE Checked Susp - To Atty For Action

2009-11-17 - Report Completed Suspension Check Case Still Suspended

2009-05-15 - Report Completed Suspension Check Case Still Suspended

2008-11-15 - Report Completed Suspension Check Case Still Suspended

2008-10-02 - Notification Of Possible Opposition - Processed By IB

2008-09-18 - Notification Of Possible Opposition Sent To IB

2008-09-18 - Notification Of Possible Opposition Created, To Be Sent To IB

2008-05-14 - Report Completed Suspension Check Case Still Suspended

2008-05-14 - Assigned To LIE

2008-02-07 - Change Of Address Received From IB

2007-12-14 - Change Of Address Received From IB

2007-11-14 - Notification Of Letter Of Suspension E-Mailed

2007-11-14 - LETTER OF SUSPENSION E-MAILED

2007-11-14 - Suspension Letter Written

2007-10-25 - Teas/Email Correspondence Entered

2007-10-25 - Communication received from applicant

2007-10-25 - TEAS Response to Office Action Received

2007-09-20 - Attorney Revoked And/Or Appointed

2007-09-20 - TEAS Revoke/Appoint Attorney Received

2007-05-10 - Refusal Processed By IB

2007-04-25 - Non-Final Action Mailed - Refusal Sent To IB

2007-04-25 - Refusal Processed By MPU

2007-04-24 - Non-Final Action (Ib Refusal) Prepared For Review

2007-04-23 - Non-Final Action Written

2007-04-17 - Limitation Of Goods/Services From IB Entered

2007-04-16 - Assigned To Examiner

2007-04-16 - New Application Entered In Tram

2007-04-12 - Sn Assigned For Sect 66a Subseq Desig From IB

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

CONSTANCE M.JORDAN

Correspondent

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